

**TRADEMARK MANUAL  
OF  
EXAMINING PROCEDURE  
(TMEP)**

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Fourth Edition, April 2005**

## Foreword to the Fourth Edition

The Trademark Manual of Examining Procedure (TMEP) may be downloaded free of charge from the United States Patent and Trademark Office (USPTO) website at [www.uspto.gov](http://www.uspto.gov).

The Manual is published to provide trademark examining attorneys in the USPTO, trademark applicants, and attorneys and representatives for trademark applicants, with a reference work on the practices and procedures relative to prosecution of applications to register marks in the USPTO. The Manual contains guidelines for Examining Attorneys and materials in the nature of information and interpretation, and outlines the procedures which Examining Attorneys are required or authorized to follow in the examination of trademark applications.

Trademark Examining Attorneys will be governed by the applicable statutes, the Trademark Rules of Practice, decisions, and Orders and Notices issued by the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, Commissioners, or Deputy Commissioners. This fourth edition incorporates into the Manual Office practice and relevant case law reported prior to March 25, 2005. Policies stated in this revision supersede any previous policies stated in prior editions, examination guides, or any other statement of Office policy, to the extent that there is any conflict.

Suggestions for improving the form and content of the Manual are always welcome. They should be addressed to:

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# Introduction

## Constitutional Basis

The authority of Congress to provide for the registration of marks which are used in commerce stems from the power of Congress under the commerce clause of the Constitution of the United States to regulate commerce.

## Statutes

Under its authority to regulate commerce, Congress has over the years passed a number of statutes providing for the registration of marks in the USPTO. The provisions of statutes cannot be changed or waived by the USPTO. The statute now in effect is Public Law 489, 79th Congress, approved July 5, 1946, 60 Stat. 427, commonly referred to as the Trademark Act of 1946 or the Lanham Act. The Trademark Act of 1946 (as amended) forms Chapter 22 of Title 15 of the United States Code. In referring to a particular section of the Trademark Act, this Manual often gives the citation of the United States Code, e.g., 15 U.S.C. §1051. The text of the current statutes can be downloaded from the USPTO website at <http://www.uspto.gov/web/offices/tac/tmlaw2.html>.

## Rules of Practice

Section 2 of Title 35 of the United States Code authorizes the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office to establish regulations, not inconsistent with law, for the conduct of proceedings in the USPTO. The rules which govern the practices and procedures in the USPTO as they relate to the registration of marks are set forth in Title 37 of the Code of Federal Regulations.

The trademark rules are a part of the Code of Federal Regulations, which is a codification of Federal regulations under the provisions of The Federal Register Act of 1937 and The Administrative Procedure Act of 1946 and which is published pursuant to 44 U.S.C. §1510. Rules relating to patents, trademarks and copyrights are codified in Title 37 of the Code of Federal Regulations. The trademark rules constitute Part 2, the rules relating to assignments constitute Part 3, the classification of goods and services constitutes Part 6, the rules relating to filings under the Madrid Protocol constitute Part 7, and the rules relating to the representation of others before the USPTO constitute Part 10.

In creating numbers for rules, the number of the appropriate Part in Title 37 of the Code of Federal Regulations is placed first, followed by a decimal point and then the number of the rule, so that, for example, Trademark Rule 2.56 is Rule 56 in Part 2 of Title 37 of the Code of Federal Regulations. In the Code

of Federal Regulations itself, and in material published in the Federal Register, the rules are identified by the term "sections." Thus, section 2.56 in 37 C.F.R. (37 CFR §2.56) is Trademark Rule 2.56.

Rules and amendments to rules are published in the Federal Register and in the *Official Gazette* of the USPTO, and posted on the USPTO website at [www.uspto.gov](http://www.uspto.gov).

The primary function of the rules of practice is to advise the public of the regulations that have been established in accordance with the statutes, which must be followed before the USPTO.

### **Director's Orders and Notices**

From time to time the Director of the United States Patent and Trademark Office issues Orders and Notices relating to various specific situations that have arisen in operating the USPTO. Notices, circulars of information or instructions and examination guides have also been issued by other USPTO officials under authority of the Director. These Orders and Notices are published in the *Official Gazette* of the USPTO, and posted on the USPTO website at [www.uspto.gov](http://www.uspto.gov).

### **Decisions**

In addition to the statutory regulations, the actions taken by the examining attorneys in the examination of applications to register marks are to a great extent governed by decisions on prior cases. Applicants dissatisfied with an examining attorney's action may have it reviewed. In general, procedural matters may be reviewed by petition to the Director (see TMEP §1702) and substantive matters may be reviewed by appeal to the Trademark Trial and Appeal Board (see TMEP §1501).

### **Trademark Manual of Examining Procedure**

The *Trademark Manual of Examining Procedure* sets forth the guidelines and procedures followed by the examining attorneys at the USPTO.

First Edition, January 1974

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Revision 2, January 1977

Revision 3, January 1978

Revision 4, January 1979

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# CONTENTS

Foreword	
Introduction	
Contents	
Changes in TMEP Fourth Edition	
Instructions for Updating TMEP 3rd Edition to 4th Edition	
Chapter	100 General Information
	200 Application Filing Date
	300 Filing and Receipt of Documents
	400 Processing Documents and Fees
	500 Change of Ownership
	600 Attorney or Representative
	700 Procedure for Examining Applications
	800 Application Requirements
	900 Use in Commerce
	1000 Applications under Section 44
	1100 Intent-to-Use Applications and Requests to Divide
	1200 Substantive Examination of Applications
	1300 Examination of Different Types of Marks
	1400 Classification and Identification of Goods and Services
	1500 Post-Examination Procedures
	1600 Registration and Post-Registration Procedures
	1700 Matters Submitted to Director
	1800 Public Inquiries About Applications and Registrations
	1900 Madrid Protocol
Appendix A	Examining Attorneys' Appeal Briefs
Appendix B	List of Members of International Trademark Agreements
Appendix C	Notes of Other Statutes
Table of Decisions	
Index	

# TRADEMARK MANUAL OF EXAMINING PROCEDURE

(TMEP)

## CONTENTS

(By Sections)

### Chapter 100 - General Information

<b>101</b>	<b>Trademark Statute and Rules</b>
<b>102</b>	<b>United States Patent and Trademark Office World Wide Web Page</b>
<b>103</b>	<b>Trademark Forms</b>
<b>104</b>	<b>Trademark Searching</b>
<b>105</b>	<b>General Information Booklet Concerning Trademarks</b>
<b>106</b>	<b>The Official Gazette</b>
<b>107</b>	<b>Trademark Manuals</b>
<b>108</b>	<b>Status Inquiries</b>
108.01	Internet Information
108.02	Personal Telephone Assistance
108.03	Due Diligence: Duty to Monitor Status
<b>109</b>	<b>Access to Files</b>
109.01	Electronic Image Files
109.02	Paper Files
109.03	Making Copies of Materials in Files
<b>110</b>	<b>Decisions Available to the Public</b>
<b>111</b>	<b>Requests for Copies of Trademark Documents</b>
<b>112</b>	<b>Patent and Trademark Depository Libraries</b>

### Chapter 200 - Application Filing Date

<b>201</b>	<b>What Constitutes Filing Date</b>
201.01	Effective Filing Date Controls for Purposes of Determining Priority for Publication or Issue
201.02	Constructive Use Priority
<b>202</b>	<b>Requirements for Receiving a Filing Date</b>
202.01	Clear Drawing of the Mark
202.02	Listing of Recognizable Goods or Services
202.03	Filing Fee for At Least One Class of Goods or Services
202.03(a)	Fee Payment Refused or Charged Back By Financial Institution

202.03(a)(i)	Processing Fee for Payment Refused or Charged Back By Financial Institution
<b>203</b>	<b>Review for Compliance With Minimum Requirements</b>
<b>204</b>	<b>Defective or Informal Applications</b>
204.01	Filing Date Cancelled if Minimum Filing Requirements not Met
204.02	Resubmission of Defective Papers
204.03	Examining Attorney's Handling of Applications That Are Erroneously Accorded a Filing Date
<b>205</b>	<b>Filing Date Is Not Normally Changed</b>
<b>206</b>	<b>Effective Filing Date</b>
206.01	Amendment of §1(b) Application from Principal Register to Supplemental Register upon Filing of Allegation of Use
206.02	Application Claiming Priority under §44(d) or §67
206.03	Applications Filed Before November 16, 1989, That Are Amended to the Supplemental Register on or After November 16, 1989

## Chapter 300 - Filing and Receipt of Documents

<b>301</b>	<b>Trademark Electronic Application System</b>
<b>302</b>	<b>Trademark Correspondence and Signature Requirements - In General</b>
302.01	Original Documents Generally Not Required
302.02	Multiple Copies of Papers Should Not Be Filed
302.03	Identifying the Nature of Papers Filed
302.03(a)	Correspondence Pertaining to Trademark Applications
302.03(b)	Correspondence Pertaining to Trademark Registrations
<b>303</b>	<b>Receipt of Documents by the Office</b>
303.01	Date of Receipt
303.02	Acknowledgment of Receipt
303.02(a)	Electronic Mail Confirmation of Receipt of TEAS Document
303.02(b)	"Office Date" Label Showing Receipt
303.02(c)	Postcard Receipt
303.02(c)(i)	Postage on Return Receipt Postcards
<b>304</b>	<b>Electronic Mail</b>
304.01	Communications Acceptable Via Electronic Mail
304.02	Communications Not Acceptable Via Electronic Mail
304.03	Authorization of Electronic Mail Communications From the USPTO
304.04	Filing Date of Electronic Mail
304.05	Certificate of Transmission by Electronic Mail
304.06	Outgoing Electronic Mail
304.07	Signature of Electronic Mail
304.08	E-Mail Addresses for Correspondence With the Office



304.09	Paper “Confirmation” Copies of E-Mail Communications Should Not Be Sent to the Office
<b>305</b>	<b>Mailing Documents to the Office</b>
305.01	Mailing Addresses
305.02	Certificate of Mailing Procedure
305.02(a)	When Certificate of Mailing Procedure May Not Be Used
305.02(b)	Mailing Requirements
305.02(c)	Location and Form of Certificate
305.02(d)	Wording of Certificate of Mailing
305.02(e)	Effect of Certificate of Mailing
305.02(f)	Correspondence Mailed Pursuant to 37 C.F.R. §2.197 But Not Received by Office
305.02(g)	Correspondence Deposited as First Class Mail Pursuant to 37 C.F.R. §2.197 and Returned by the U.S. Postal Service
305.02(h)	Certificate of Mailing Requirements Strictly Enforced
305.03	“Express Mail”
305.04	Interruptions in U.S. Postal Service
<b>306</b>	<b>Facsimile Transmission (Fax)</b>
306.01	Documents That May Not Be Filed by Facsimile Transmission
306.02	Fax Machines Designated to Accept Relevant Trademark Documents
306.03	Effect of Filing by Fax
306.04	Procedure for Filing by Fax
306.05	Certificate of Transmission Procedure
306.05(a)	Location and Form of Certificate of Transmission
306.05(b)	Wording of Certificate of Transmission
306.05(c)	Effect of Certificate of Transmission
306.05(d)	Correspondence Transmitted by Fax Pursuant to 37 C.F.R. §2.197 But Not Received by Office
306.06	Requirements for Certificate of Transmission Strictly Enforced
<b>307</b>	<b>Hand Delivery</b>
<b>308</b>	<b>Period Ending on Saturday, Sunday or Federal Holiday</b>
<b>309</b>	<b>Unscheduled Closings of the United States Patent and Trademark Office</b>
<b>310</b>	<b>Computing Period for Response to Office Action or Notice</b>

## Chapter 400 - Processing Documents and Fees

<b>401</b>	<b>Processing New Applications</b>
401.01	Filing Receipts
401.02	Serial Numbers and Series Codes

401.03	Data Entry
401.04	Creation of Application Files
<b>402</b>	<b>Electronic Application and Registration Files</b>
402.01	USPTO No Longer Creates Paper Copies of Certain Trademark-Related Documents
<b>403</b>	<b>Correspondence Returned as Undeliverable</b>
<b>404</b>	<b>Papers Not Returnable</b>
<b>405</b>	<b>Fees</b>
405.01	Credit Cards
405.02	Checks
405.02(a)	Personal Checks
405.03	Deposit Accounts
405.04	Refunds
405.05	Electronic Funds Transfer
405.06	Payments Refused or Charged Back By Financial Institutions

## Chapter 500 - Change of Ownership

<b>501</b>	<b>Assignment of Marks</b>
501.01	Assignability of Marks in Applications and Registrations
501.01(a)	Assignability of Intent-to-Use Applications
501.01(b)	Assignability of Extensions of Protection of International Registrations to the United States
501.02	Assignments Must Be in Writing
501.03	Effect of Failure to Record Assignment
501.04	Foreign Assignee May Designate Domestic Representative
501.05	Assignee Stands in Place of Applicant or Registrant
501.06	Partial Assignments
501.07	Assignment of Extension of Protection of International Registration to the United States
<b>502</b>	<b>Establishing Ownership of Applications or Registrations</b>
502.01	Establishing The Right to Take Action in Application or Registration
502.02	Pending Applications - Issuance of Registration Certificate in Name of Assignee or in Applicant's New Name
502.02(a)	Applications Under §1 and §44 of the Trademark Act
502.02(b)	Applications Under §66(a) of the Trademark Act
502.02(c)	Examining Attorney's Action Regarding Assignment
502.03	Issuance of New Certificate to Assignee of Registrant
<b>503</b>	<b>Recording in Assignment Services Division</b>
503.01	Effect of Recording a Document
503.02	Documents That the Office Will Record

503.03	Requirements for Recording
503.03(a)	Formal Requirements for Documents
503.03(b)	Supporting Documents
503.03(c)	English Language Requirement
503.03(d)	Fee for Recording
503.03(e)	Cover Sheet
503.04	Address for Submitting Documents for Recording
503.05	Recording Procedure and Recordation Date
503.06	Correction of Errors in Cover Sheet or Recorded Document
503.06(a)	Typographical Errors in Cover Sheet
503.06(a)(i)	Typographical Errors in Cover Sheet That Do Not Affect Title to Application or Registration
503.06(a)(ii)	Typographical Errors in Cover Sheet That Do Affect Title to Application or Registration
503.06(b)	Typographical Errors in Recorded Assignment Document
503.06(c)	Assignment or Change of Name Improperly Filed and Recorded By Another Person Against Owner's Application or Registration
503.06(d)	Owner Must Notify Trademark Operation of Correction
503.06(e)	Recorded Documents Not Removed From Assignment Records
503.06(f)	Petitions to Correct or "Expunge" Assignment Records
503.07	"Indexing" Against Recorded Document Not Permitted
503.08	Accessibility of Assignment Records
503.08(a)	Abstracts of Title
<b>504</b>	<b>Automatic Updating Ownership of Trademark Applications and Registrations in Trademark Databases</b>
504.01	Circumstances in Which Trademark Database Will Not be Automatically Updated
504.02	Processing Time for Automatic Updating
504.03	Correction to Automatic Update - Last Recorded Owner Does Not Have Clear Chain of Title
504.04	Automatic Updating Does Not Apply to Requests for Recordation Filed Before November 2, 2003
504.05	Automatic Updating Does Not Apply to International Applications and Registrations Under the Madrid Protocol

## Chapter 600 - Attorney or Representative

<b>601</b>	<b>Applicant May Be Represented by Attorney at Law</b>
601.01	Office Cannot Aid in Selection of Attorney
<b>602</b>	<b>Persons Who May Practice Before Office in Trademark Matters</b>
602.01	Powers of Attorney

602.01(a)	Power of Attorney Relating to More Than One Application or Registration
602.01(b)	Associate Powers of Attorney
602.01(c)	Powers of Attorney Filed After Registration
602.02	Standards of Conduct
602.02(a)	Signature and Certificate for Correspondence filed in the United States Patent and Trademark Office
602.03	Papers Filed by Unauthorized Persons
602.04	Revocation of Power of Attorney
602.05	Permissive Withdrawal of Attorney of Record
<b>603</b>	<b>Correspondence, With Whom Held</b>
603.01	Establishing the Correspondence Address
603.01(a)	Correspondence in §66(a) Applications
603.02	Changing the Correspondence Address
603.02(a)	Changing the Correspondence Address Before Registration
603.02(b)	Changing the Correspondence Address in Multiple Applications or Registrations
603.02(c)	Changing the Correspondence Address After Registration
603.03	Applicant Has Duty to Maintain Current and Accurate Correspondence Address
603.04	Processing Correspondence Signed by Someone Other Than the Applicant or the Applicant's Designated Attorney
603.05	Correspondence with Parties Not Domiciled in the United States
<b>604</b>	<b>Designation of Domestic Representative by Parties Not Domiciled in the United States</b>

## Chapter 700 - Procedure for Examining Applications

<b>701</b>	<b>Statutory Authority for Examination</b>
<b>702</b>	<b>Order of Work</b>
702.01	Order of Examination
702.02	"Special" Applications
702.03	Related Applications
702.03(a)	Companion Applications
702.03(a)(i)	Companion Applications for the Same or Similar Marks
702.03(a)(ii)	Companion Applications for Different Marks
702.03(a)(iii)	Companion Registrations
702.03(a)(iv)	Classification and Identification in Companion Applications That Have Registered or Been Published for Opposition
702.03(b)	Conflicting Applications
<b>703</b>	<b>Office Does Not Issue Duplicate Registrations</b>

<b>704</b>	<b>Initial Examination</b>
704.01	Initial Examination Should be Complete
704.02	Examining Attorney's Search
704.03	Supervisory Examining Attorney May Indicate Action for Non-Signatory Examining Attorney
<b>705</b>	<b>The Examining Attorney's Letter or Action</b>
705.01	Language in Examining Attorney's Letter
705.02	Examining Attorneys Should Not Volunteer Statements
705.03	Citation of Reference Marks
705.04	Reference to Matter in Printed Publications
705.05	Citation of Decisions and Office Publications
705.06	Reviewing and Signing of Letters
705.07	Processing Outgoing Office Actions
705.08	Six-Month Response Clause
<b>706</b>	<b>New Matter Raised by Examining Attorney After First Action</b>
<b>707</b>	<b>Examiner's Amendment</b>
707.01	Approval of Examiner's Amendment by Applicant or Applicant's Attorney
707.02	Examiner's Amendment Without Prior Authorization by Applicant or Applicant's Attorney
707.03	Form of the Examiner's Amendment
<b>708</b>	<b>Priority Action</b>
708.01	Priority Action Defined
708.02	Discussion of Issues and Agreements
708.03	Form of the Priority Action
708.04	Refusal of Registration in Priority Action
708.05	Combined Examiner's Amendment/Priority Action
<b>709</b>	<b>Interviews</b>
709.01	How Interviews are Conducted
709.02	Persons Who May Represent Applicant in an Interview
709.03	Making Substance of Interview of Record
709.04	Telephone Communications
709.05	Informal Submissions
709.06	Interviews Prior to Filing Application
<b>710</b>	<b>Evidence</b>
710.01	Evidence Supporting Refusal or Requirement
710.01(a)	Evidence From Research Database
710.01(b)	Internet Evidence
710.01(c)	Record Must Be Complete Prior to Appeal
710.02	Evidence Indicating No Refusal or Requirement Necessary
710.03	Evidence of Third-Party Registrations
<b>711</b>	<b>Deadline for Response to Office Action</b>
711.01	Time May Run from Previous Action
711.02	Supplemental Office Action Resetting Response Period

<b>712</b>	<b>Signature of Response to Office Action</b>
712.01	Persons Who Can Sign Response
712.01(a)	Guidelines on Who Should Sign Response to Office Action
712.01(a)(i)	Signature By Joint Applicants
712.01(a)(ii)	Signature By Partnership
712.01(a)(iii)	Signature By Joint Venture
712.01(a)(iv)	Signature By Corporation
712.01(a)(v)	Signature By Foreign Companies and Corporations
712.01(a)(vi)	Signature By Unincorporated Association
712.01(a)(vii)	Signature By Limited Liability Company
712.02	Unsigned Response
712.03	Response Signed by an Unauthorized Person
<b>713</b>	<b>Examination of Amendments and Responses to Office Actions</b>
713.01	Previous Action by Different Examining Attorney
713.02	Noting All Outstanding Requirements
713.03	Response to Applicant's Arguments
<b>714</b>	<b>Final Action</b>
714.01	Not Permissible on First Action
714.02	Not Permissible on Suspension
714.03	When Final Action is Appropriate
714.04	Form of the Final Action
714.05	Delineating New Issues Requiring Issuance of Nonfinal Action
714.05(a)	Unacceptable Amendment Proposed By Applicant
714.05(a)(i)	Amendment to Supplemental Register or Submission of Claim of Acquired Distinctiveness
714.05(a)(ii)	Amendment of Identification of Goods and Services
714.05(b)	Section 2(d) Refusal Based on Prior-Filed Application That Has Matured Into Registration
714.05(c)	Advisory Statement Cannot Serve as Foundation for Final Refusal or Requirement
714.06	Applicant's Recourse When Final Action is Premature
<b>715</b>	<b>Action After Issuance of Final Action</b>
715.01	Proper Response to Final Action
715.02	Action After Final Action
715.03	Request for Reconsideration After Final Action
715.03(a)	Examining Attorney's Action After Request for Reconsideration
715.03(b)	Examining Attorney Must Issue New Nonfinal Action If New Issue Presented in Request for Reconsideration
715.03(c)	Time for Appeal Runs from Mailing Date of Final Action if No New Issue Is Presented and Requirement(s) or Refusal(s) Is Not Withdrawn

715.04	Request for Reconsideration Filed In Conjunction With Notice of Appeal
<b>716</b>	<b>Suspension of Action by Office</b>
716.01	Form of Suspension Notice
716.02	Circumstances Under Which Action May Be Suspended
716.02(a)	Applicant's Petition to Cancel Cited Registration
716.02(b)	Submission of Copy of Foreign Registration in §44(d) Application
716.02(c)	Conflicting Marks in Pending Applications
716.02(d)	<i>Inter Partes</i> or Court Proceeding
716.02(e)	Suspension Pending Cancellation or Expiration of Cited Registration
716.03	Applicant's Request to Remove Application from Suspension
716.04	Suspended Docket Checked by Examining Attorney
716.05	Inquiry by Examining Attorney Regarding Suspended Application
716.06	Suspension After Final Action
<b>717</b>	<b>Remailing of Office Action</b>
717.01	Returned Office Action
717.02	Non-Receipt of Office Action
<b>718</b>	<b>Abandonment</b>
718.01	Express Abandonment by Applicant or Applicant's Attorney
718.02	Failure by Applicant to Take Required Action During Statutory Period
718.02(a)	Partial Abandonment
718.03	Incomplete Response
718.03(a)	Holding of Abandonment for Failure to Respond Completely
718.03(b)	Granting Additional Time to Perfect Response
718.03(c)	Reconsideration of Holding of Abandonment
718.04	Failure to File Statement of Use
718.05	Failure to Perfect Appeal
718.06	Notice by Office of Abandonment for Failure to Receive a Response
718.07	Ordering Abandoned Application Files
718.08	Revival or Reinstatement of Abandoned Application - New Search Required
<b>719</b>	<b>Non-Responsive Communications</b>
<b>720</b>	<b>Fraud Upon the Office</b>

## Chapter 800 - Application Requirements

<b>801</b>	<b>Types of Applications</b>
801.01	Single or Combined Application

801.01(a)	Single (Single-Class) Application
801.01(b)	Combined (Multiple-Class) Application
801.02	Principal Register or Supplemental Register
801.02(a)	Act of 1946, Principal Register
801.02(b)	Act of 1946, Supplemental Register
<b>802</b>	<b>Application Form</b>
<b>803</b>	<b>Applicant</b>
803.01	Who May Apply
803.02	Name of Applicant
803.02(a)	Individual
803.02(b)	Partnership, Joint Venture or Other "Firm"
803.02(c)	Corporation and Association
803.03	Legal Entity of Applicant
803.03(a)	Individual or Sole Proprietorship
803.03(b)	Partnership, Joint Venture or Other "Firm"
803.03(c)	Corporation and Association
803.03(d)	Joint Applicants
803.03(e)	Trusts, Conservatorships and Estates
803.03(e)(i)	Business Trusts
803.03(f)	Governmental Bodies and Universities
803.03(g)	Banking Institutions
803.03(h)	Limited Liability Companies
803.03(i)	Common Terms Designating Entity of Foreign Applicants
803.03(j)	Federally Recognized Indian Tribe
803.04	Citizenship of Applicant
803.05	Address of Applicant
803.06	Applicant May Not Be Changed
<b>804</b>	<b>Verification and Signature</b>
804.01	Form and Wording of Verification in §1 or §44 Application
804.01(a)	Verification, with Oath
804.01(a)(i)	Verification Made in Foreign Country
804.01(b)	Declaration in Lieu of Oath
804.02	Averments Required in Verification of Application for Registration - §1 or §44 Application
804.03	Time Between Execution and Filing of Papers - §1 or §44 Application
804.04	Persons Authorized to Sign Verification or Declaration
804.05	Signature of Electronically Transmitted Documents
804.06	Verification of §66(a) Application
<b>805</b>	<b>Identification and Classification of Goods and Services</b>
<b>806</b>	<b>Filing Basis</b>
806.01	Requirements for Establishing a Basis
806.01(a)	Use in Commerce - §1(a)
806.01(b)	Intent-to-Use - §1(b)
806.01(c)	Foreign Priority - §44(d)



806.01(d)	Foreign Registration — §44(e)
806.01(e)	Extension of Protection of International Registration - §66(a)
806.02	Multiple Bases
806.02(a)	Procedure for Asserting More Than One Basis
806.02(b)	Applicant May File Under Both §1(a) and §1(b) in a Single Application
806.02(c)	Examination of Specimens of Use in a Multi-Basis Application
806.02(d)	Abandonment of Multi-Basis Applications
806.02(e)	Allegation of Bona Fide Intention to Use Mark in Commerce Even if Application is Based on Both §44 and §1
806.02(f)	Section 44(d) Combined With Other Bases
806.02(g)	Not Necessary to Repeat Allegation of Bona Fide Intention to Use Mark in Commerce in Multi-Basis Application
806.03	Amendments to Add or Substitute a Basis
806.03(a)	When Basis Can be Changed
806.03(b)	Applicant May Add or Substitute a §44(d) Basis Only Within Six-Month Priority Period
806.03(c)	Amendment From §1(a) to §1(b)
806.03(d)	Amendment From §44 to §1(b)
806.03(e)	Allegation of Use Required to Amend From §1(b) to §1(a)
806.03(f)	Use in Commerce as of Application Filing Date Required to Add or Substitute §1(a) as a Basis in §44 Application
806.03(g)	Amendment From §1(b) to §44
806.03(h)	Effect of Substitution of Basis on Application Filing Date
806.03(i)	Verification of Amendment Required
806.03(j)	Petition to Amend Basis After Publication - §1 or §44 Application
806.03(j)(i)	Amending the Basis of a §1(b) Application After Publication But Before Issuance of Notice of Allowance
806.03(j)(ii)	Amending the Basis of a §1(b) Application Between Issuance of Notice of Allowance and Filing of Statement of Use
806.03(k)	Basis Cannot be Changed in §66(a) Application
806.04	Deleting a Basis
806.04(a)	Deletion of §1(b) Basis After Publication or Issuance of the Notice of Allowance
806.04(b)	Retention of §44(d) Priority Filing Date Without Perfecting §44(e) Basis
806.05	Review of Basis Prior to Publication or Issue
<b>807</b>	<b>Drawing</b>
807.01	Drawing Must Show Only One Mark
807.02	Drawing Must Be Limited to Mark

807.03	Standard Character Drawings
807.03(a)	Requirements for Standard Character Drawings
807.03(b)	List of Standard Characters
807.03(c)	Drawings Containing Both a Standard Character Claim and Designs or Other Elements
807.03(d)	Changing From Special Form Elements to Standard Characters, or the Reverse, May be a Material Alteration
807.03(e)	Standard Character Drawing and Specimen of Use
807.03(f)	Standard Character Drawing and Foreign Registration
807.03(g)	Drawings in “Typed” Format With No Standard Character Claim
807.03(h)	Drawings Where The Format Is Unclear
807.03(i)	Drawings in Applications Filed Before November 2, 2003
807.04	Special Form Drawings
807.04(a)	Characteristics of Special Form Drawings
807.04(b)	When Special Form Drawing is Required
807.05	Electronically Submitted Drawings
807.05(a)	Standard Character Drawings Submitted Electronically
807.05(a)(i)	Long Marks in Standard Character Drawings
807.05(b)	Special Form Drawings Submitted Electronically
807.05(c)	Requirements for Digitized Images
807.06	Paper Drawings
807.06(a)	Type of Paper and Size of Mark
807.06(b)	Long Marks in Standard Character or Typed Drawings
807.06(c)	Separate Drawing Page Preferred
807.07	Color in the Mark
807.07(a)	Requirements for Color Drawings
807.07(a)(i)	Color Must Be Claimed as a Feature of the Mark
807.07(a)(ii)	Applicant Must Name and Describe Colors
807.07(b)	Color Drawings Filed Without a Color Claim
807.07(c)	Color Drawings Filed With an Incorrect Color Claim
807.07(d)	Black and White Drawings and Color Claims
807.07(e)	Gray Tones in Drawings
807.07(f)	Drawings in Applications Filed Before November 2, 2003
807.08	Broken Lines to Show Placement
807.09	“Drawing” of Sound, Scent, or Non-Visual Mark
807.10	Three Dimensional Marks
807.11	Marks With Motion
807.12	Mark on Drawing Must Agree with Mark on Specimen or Foreign Registration
807.12(a)	Applications Under §1 of the Trademark Act
807.12(b)	Applications Under §44 of the Trademark Act
807.12(c)	Applications Under §66(a) of the Trademark Act
807.12(d)	Mutilation or Incomplete Representation of Mark
807.12(e)	Compound Word Marks and Telescoped Marks
807.13	Amendment of Mark

807.13(a)	Amendment of Mark in Applications Under §§1 and 44
807.13(b)	Mark in §66(a) Application Cannot be Amended
807.14	Material Alteration of Mark
807.14(a)	Removal or Deletion of Matter from Drawing
807.14(b)	Addition or Deletion of Previously Registered Matter
807.14(c)	Amendments to Correct “Internal Inconsistencies”
807.14(d)	Material Alteration: Case References
807.15	Substitute Drawings
807.16	Amendment of Drawings by the Office
807.17	Procedures for Processing Unacceptable Amendments to Drawings
807.18	Mark Drawing Code
807.19	Use of Old Drawing in New Application
<b>808</b>	<b>Description of Mark</b>
808.01	Guidelines for Requiring Description
808.01(a)	Letters and Numerals
808.01(b)	Designs or Figurative Elements
808.01(c)	Meaning of Term in Mark
808.01(d)	Lining and Stippling Statements for Drawings
808.02	Description Must Be Accurate and Concise
808.03	Printing Description of Mark
<b>809</b>	<b>Translation and Transliteration of Non-English Wording in Mark</b>
809.01	Equivalency in Translation
809.02	Printing of Translations and Transliterations
<b>810</b>	<b>Filing Fee</b>
810.01	Collection of Fees for Multiple Classes
810.02	Refunds
811	Designation of Domestic Representative
812	Identification of Prior Registrations of Applicant
812.01	Proving Ownership of Prior Registrations
<b>813</b>	<b>Consent to Register by Living Individual Depicted in Mark</b>
<b>814</b>	<b>Requesting Additional Information</b>
815	Supplemental Register, Application Filed on
815.01	Marks Eligible for Principal Register Not Registrable on Supplemental Register
815.02	Elements Required
815.03	Examining Attorney Approves Mark for Issue
815.04	Filing on Supplemental Register is Not an Admission That the Mark Has Not Acquired Distinctiveness
815.05	Basis for Refusal of Registration of Matter That is Incapable
<b>816</b>	<b>Supplemental Register, Amending Application to</b>
816.01	How to Amend
816.02	Effective Filing Date

816.03	Amendment to Different Register
816.04	Amendment After Refusal
816.05	Amendment After Decision on Appeal
<b>817</b>	<b>Preparation of Case for Publication or Registration</b>
<b>818</b>	<b>Application Checklist</b>

## **Chapter 900 - Use in Commerce**

<b>901</b>	<b>Use in Commerce</b>
901.01	Definitions
901.02	Bona Fide Use in the Ordinary Course of Trade
901.03	Commerce That May Be Lawfully Regulated By Congress
901.04	Inquiry Regarding Use in Commerce
901.05	Use Only by Related Company
<b>902</b>	<b>Allegations of Use for §1(b) Applications</b>
<b>903</b>	<b>Dates of Use</b>
903.01	Date of First Use Anywhere
903.02	Date of First Use in Commerce
903.03	Type of Commerce
903.04	Relation Between the Two Dates of Use
903.05	Amending Dates of Use
903.06	First Use by Predecessor or Related Company
903.07	Indefinite Dates of Use
903.07(a)	Apparent Discrepancies Between Dates of Use and Date of Execution
903.08	Dates of Use in Another Form
903.09	More than One Item of Goods or Services
<b>904</b>	<b>Specimens</b>
904.01	Number of Specimens
904.01(a)	More than One Item Specified in a Class
904.01(b)	In Combined or Multiple-Class Applications
904.02	Physical Form of Specimens
904.02(a)	Electronically Filed Specimens
904.02(b)	Paper Specimens
904.02(c)	Specimens for Marks Comprising Color
904.02(d)	Marks Used on Publications
904.03	Bulky Specimens
904.04	Material Appropriate as Specimens for Trademarks
904.04(a)	Labels and Tags
904.04(b)	Stampings
904.04(c)	Commercial Packaging
904.04(d)	Specimens for Trademarks Identifying Computer Programs, Movies or Video Tapes
904.05	Material Not Appropriate as Specimens for Trademarks
904.06	Displays as Specimens for Trademarks

904.06(a)	Catalogs as Specimens for Trademarks
904.06(b)	Electronic displays as Specimens for Trademarks
904.07	Package Inserts as Specimens for Trademarks
904.08	Facsimiles as Specimens
904.09	Affidavit Supporting Substitute Specimens
904.10	Translation of Matter on Specimens
904.11	Requirements for Substitute Specimens and Statutory Refusals
<b>905</b>	<b>Method of Use</b>
<b>906</b>	<b>Federal Registration Notice</b>
906.01	Foreign Countries That Use Registration Symbol ®
906.02	Improper Use of Registration Symbol
906.03	Informing Applicant of Apparent Improper Use
906.04	Fraud
<b>907</b>	<b>Compliance with Other Statutes</b>

## Chapter 1000 - Applications Under Section 44

<b>1001</b>	<b>Section 44 Applications - General</b>
<b>1002</b>	<b>Eligible Applicants Under §44</b>
1002.01	Eligible Applicants Under §44(e)
1002.02	Eligible Applicants Under §44(d)
1002.03	Establishing Entitlement Under a Treaty
1002.04	Establishing Country of Origin
1002.05	United States Applicants
<b>1003</b>	<b>Section 44(d) - Priority Filing Date Based on a Foreign Application</b>
1003.01	The “First-Filed” Requirement
1003.02	Priority Claim Must Be Filed Within Six Months of Foreign Filing
1003.03	Basis for Registration Required
1003.04	Suspension Awaiting a Foreign Registration
1003.05	Section 44(d) and Priority for Publication
1003.06	Applicants May File Under Both §44(d) and §44(e)
1003.07	Application May be Based on More Than One Foreign Application
1003.08	Abandonment of the Foreign Application
<b>1004</b>	<b>Applications Based on Foreign Registrations under §44(e)</b>
1004.01	Copy of Foreign Registration Required
1004.01(a)	Status of the Foreign Registration
1004.01(b)	Translation of the Foreign Registration
1004.02	Application May be Based on More Than One Foreign Registration
<b>1005</b>	<b>Ownership of the Foreign Application or Registration</b>
<b>1006</b>	<b>Assignment of §44 Applications</b>

<b>1007</b>	<b>Standards for Registration Under Section 44</b>
<b>1008</b>	<b>Bona Fide Intention to Use the Mark in Commerce</b>
<b>1009</b>	<b>Allegation of Use and Specimen of Use Not Required Prior to Registration</b>
<b>1010</b>	<b>Proof of Acquired Distinctiveness in §44 Applications</b>
<b>1011</b>	<b>Drawings</b>
1011.01	Substantially Exact Representation of Mark in Foreign Registration
1011.02	One Mark Per Application
1011.03	Amendment of Drawing
<b>1012</b>	<b>Identification of Goods and Services</b>
<b>1013</b>	<b>Designation of Domestic Representative by Applicants Not Domiciled in the United States</b>
<b>1014</b>	<b>Section 44 Applications for the Supplemental Register</b>
<b>1015</b>	<b>Section 44 Registration Independent of Underlying Foreign Registration</b>
<b>1016</b>	<b>International Registration As Basis for §44 Application</b>

#### **Chapter 1100 — Intent-to-Use Applications and Requests to Divide**

<b>1101</b>	<b>Bona Fide Intention To Use the Mark In Commerce</b>
<b>1102</b>	<b>Initial Examination of Intent-to-Use Applications</b>
1102.01	Substantive Refusals
1102.02	Drawings
1102.03	Intent-to-Use Applications and the Supplemental Register
1102.04	Claims of Acquired Distinctiveness under §2(f)
1103	Allegations of Use
<b>1104</b>	<b>Amendment to Allege Use Under §1(c) of the Act</b>
1104.01	Minimum Requirements for Filing an Amendment to Allege Use
1104.01(a)	Review by Legal Instruments Examiner for Compliance with Minimum Filing Requirements
1104.01(b)	Processing an Amendment to Allege Use That Does Not Meet Minimum Filing Requirements
1104.01(c)	Processing Defective Amendment to Allege Use Filed With Other Amendments
1104.02	Form of Amendment to Allege Use
1104.03	Time for Filing Amendment to Allege Use
1104.03(a)	Use on All Goods Required Before Filing
1104.03(b)	The “Blackout Period”
1104.03(c)	Processing Amendments to Allege Use Filed During the Blackout Period
1104.04	Processing Timely Amendments to Allege Use Located After Publication

1104.05	Amendments to Allege Use Filed in Conjunction With Application
1104.06	Processing Amendments to Allege Use Received Before Application is Assigned to an Examining Attorney
1104.07	Amendments to Allege Use and Ex Parte Appeals
1104.08	Necessary Elements in a Complete Amendment to Allege Use
1104.09	Examination of Amendment to Allege Use by Examining Attorney
1104.09(a)	Ownership
1104.09(b)	Verification and Date of Execution
1104.09(c)	Identification of Goods or Services
1104.09(d)	Use in Commerce and Dates of Use
1104.09(e)	Specimen
1104.09(f)	Drawing
1104.09(g)	Fees
1104.09(h)	Issuance of Actions by Examining Attorney Related to the Amendment to Allege Use
1104.10	Amendment and Withdrawal of Amendment to Allege Use
1104.11	Approval of Amendment to Allege Use After Examination
<b>1105</b>	<b>Publication of Intent-to-Use Applications for Opposition</b>
<b>1106</b>	<b>Notice of Allowance</b>
1106.01	Issuance of the Notice of Allowance
1106.02	Action by Examining Attorney After Issuance of the Notice of Allowance
1106.03	Cancellation of Notice of Allowance
1106.04	Correction of Errors in Notice of Allowance
<b>1107</b>	<b>Amendment After Issuance of the Notice of Allowance and Before Filing of the Statement of Use</b>
1107.01	Examination of Amendment Filed After the Notice of Allowance Issues But Before a Statement of Use is Filed
<b>1108</b>	<b>Requests for Extensions of Time to File the Statement of Use</b>
1108.01	Time for Filing Requests for Extensions of Time to File the Statement of Use
1108.02	Requirements for Request For An Extension of Time to File a Statement of Use
1108.02(a)	Ownership
1108.02(b)	Verification
1108.02(c)	Filing Fee
1108.02(d)	Identification of Goods or Services
1108.02(e)	Bona Fide Intention to Use the Mark in Commerce
1108.02(f)	Good Cause Required for Extensions Beyond the First Six-Month Extension

1108.03	Only One Extension Request May Be Filed With or After a Statement of Use
1108.03(a)	Processing Extension Request Filed After Statement of Use Has Been Referred to Examining Attorney
1108.04	Recourse After Denial of Extension Request
1108.05	Petitions From Denial of Request For An Extension of Time to File Statement of Use
<b>1109</b>	<b>Statement of Use Under §1(d) of the Trademark Act</b>
1109.01	Minimum Filing Requirements for a Statement of Use
1109.02	Review for Compliance with Minimum Filing Requirements
1109.02(a)	Petition to Review Refusal Based on Noncompliance with Minimum Filing Requirements of 37 C.F.R. §2.88(e)
1109.03	Use on All Goods or Services Required Before Filing
1109.04	Time for Filing Statement of Use
1109.05	Form of Statement of Use
1109.05(a)	Papers Prepared for Filing as an Amendment to Allege Use May Be Filed as a Statement of Use
1109.06	Necessary Elements in a Complete Statement of Use
1109.07	Examination of the Statement of Use — In General
1109.08	The “Clear-Error” Standard in Examination of the Statement of Use
1109.09	Use in Commerce
1109.09(a)	Dates of Use
1109.09(b)	Specimens
<b>1109.10</b>	<b>Ownership</b>
<b>1109.11</b>	<b>Verification and Execution</b>
1109.11(a)	Authority of Signatory
1109.11(b)	Verification of Essential Elements
1109.11(c)	Date of Execution
1109.11(d)	Signature of Electronically Transmitted Statement of Use
1109.12	Drawing
1109.13	Identification of Goods and Services in Statement of Use
1109.14	Classification
1109.15	Filing Fees
1109.15(a)	Processing Deficient Fees
1109.16	Correcting Defects in Statement of Use
1109.16(a)	Statutory Requirements That Must Be Met Within Statutory Filing Period
1109.16(b)	Issuance of Examining Attorney’s Office Action Holding that a Statement of Use Does Not Meet the Minimum Filing Requirements
1109.16(c)	Requesting an Extension of Time to File a Statement of Use for the Purpose of Compliance with Minimum Filing Requirements



1109.16(d)	Response to Office Action Required Within Six Months of Mailing Date Regardless of Expiration Date of Period for Filing the Statement of Use
1109.16(e)	Applicant's Recourse After Refusal of Registration
1109.17	Withdrawal of the Statement of Use Prohibited
1109.18	Approval of the Statement of Use
<b>1110</b>	<b>Request to Divide an Application</b>
1110.01	Time for Filing Request to Divide
1110.02	Fee for Filing Request to Divide
1110.03	Processing Request to Divide
1110.04	Dividing an Application When Statement of Use is Due
1110.05	Dividing an Application When Response to Office Action is Due
1110.06	Dividing an Application Subject to a Proceeding at Trademark Trial and Appeal Board
1110.07	Dividing a §44 Application
1110.08	Dividing a §66(a) Application After Change of Ownership With Respect to Some But Not All of the Goods
1110.09	Division of Registrations

## Chapter 1200 - Substantive Examination of Applications

<b>1201</b>	<b>Ownership of Mark</b>
1201.01	Claim of Ownership May Be Based on Use By Related Companies
1201.02	Identifying the Applicant in the Application
1201.02(a)	Identifying the Applicant Properly
1201.02(b)	Application Void if Wrong Party Identified as the Applicant
1201.02(c)	Correcting Errors in How the Applicant Is Identified
1201.02(d)	Operating Divisions
1201.02(e)	Changes in Ownership After Application Is Filed
1201.03	Use by Related Companies
1201.03(a)	Use Solely by Related Company Must be Disclosed
1201.03(b)	No Explanation of Applicant's Control Over Use of Mark by Related Companies Required
1201.03(c)	Wholly Owned Related Companies
1201.03(d)	Common Stockholders, Directors or Officers
1201.03(e)	Sister Corporations
1201.03(f)	License and Franchise Situations
1201.04	Inquiry Regarding Parties Named on Specimens or Elsewhere in Record
1201.05	Acceptable Claim of Ownership Based on Applicant's Own Use
1201.06	Special Situations Pertaining to Ownership
1201.06(a)	Applicant Is Merely Distributor or Importer

1201.06(b)	Goods Manufactured in a Country Other than Where Applicant Is Located
1201.07	Related Companies and Likelihood of Confusion
1201.07(a)	“Single Source” -- “Unity of Control”
1201.07(b)	Appropriate Action with Respect to Assertion of Unity of Control
1201.07(b)(i)	When Either Applicant or Registrant Owns All of the Other Entity
1201.07(b)(ii)	When Either Applicant or Registrant Owns Substantially All of the Other Entity
1201.07(b)(iii)	When the Record Does Not Support a Presumption of Unity of Control
1201.07(b)(iv)	When the Record Contradicts an Assertion of Unity of Control
<b>1202</b>	<b>Use of Subject Matter as Trademark</b>
1202.01	Refusal of Matter Used Solely as a Trade Name
1202.02	Registration of Trade Dress
1202.02(a)	Functionality
1202.02(a)(i)	Statutory Basis for Functionality Refusal
1202.02(a)(ii)	Purpose of Functionality Doctrine
1202.02(a)(iii)	Definitions
1202.02(a)(iii)(A)	Functionality
1202.02(a)(iii)(B)	“De Jure” and “De Facto” Functionality
1202.02(a)(iii)(C)	Aesthetic Functionality
1202.02(a)(iv)	Burden of Proof in Functionality Determinations
1202.02(a)(v)	Evidence and Considerations Regarding Functionality Determinations
1202.02(a)(v)(A)	Advertising, Promotional or Explanatory Material in Functionality Determinations
1202.02(a)(v)(B)	Availability of Alternative Designs in Functionality Determinations
1202.02(a)(v)(C)	Ease or Economy of Manufacture in Functionality Determinations
1202.02(b)	Distinctiveness of Trade Dress
1202.02(b)(i)	Distinctiveness and Product Design Trade Dress
1202.02(b)(ii)	Distinctiveness and Product Packaging Trade Dress for Goods or Services
1202.02(c)	Distinctiveness and Functionality are Separate Issues
1202.02(d)	Drawing and Description of Mark in Trade Dress Applications
1202.02(e)	Trade Dress in Intent-to-Use Applications
1202.02(f)	Trade Dress in §44 and §66(a) Applications
1202.03	Refusal on Basis of Ornamentation
1202.03(a)	Commercial Impression
1202.03(b)	Practices of the Trade
1202.03(c)	“Secondary Source”

1202.03(d)	Evidence of Distinctiveness
1202.03(e)	Ornamentation with Respect to Intent-to-Use Applications
1202.03(f)	Ornamentation: Case References
1202.03(f)(i)	Slogans or Words Used on the Goods
1202.03(f)(ii)	Designs Used on the Goods
1202.03(f)(iii)	Trade Dress on the Containers for the Goods
1202.03(g)	Ornamentation Cases and Acquired Distinctiveness
1202.04	Informational Matter
1202.05	Color as a Mark
1202.05(a)	Color Marks Never Inherently Distinctive
1202.05(b)	Functional Color Marks Not Registrable
1202.05(c)	Color as a Separable Element
1202.05(d)	Drawings of Color Marks Required
1202.05(d)(i)	Drawings of Color Marks in Trademark Applications
1202.05(d)(ii)	Drawings of Color Marks in Service Mark Applications
1202.05(d)(iii)	Drawings for Marks Including Both Color and Words or Design
1202.05(e)	Written Explanation of a Color Mark
1202.05(f)	Specimens for Color Marks
1202.05(g)	Special Considerations for Service Mark Applications
1202.05(h)	Applications for Color Marks Based on Intent-to-Use
1202.05(i)	Applications for Color Marks Based on §44 or §66(a)
1202.06	Goods in Trade
1202.06(a)	Goods Must Have Utility to Others
1202.06(b)	Registration Must Be Refused if Trademark Not Used on Goods in Trade
1202.06(c)	“Goods in Trade” in Intent-to-Use Applications
1202.07	Marks That Identify Columns or Sections of Publications
1202.07(a)	Marks That Identify Columns or Sections of Printed Publications
1202.07(a)(i)	Syndicated Columns and Sections
1202.07(a)(ii)	Non-Syndicated Columns and Sections
1202.07(a)(iii)	Marks That Identify Columns and Sections of Printed Publications in Intent-to-Use Applications
1202.07(b)	Marks That Identify Columns and Sections of Online Publications
1202.08	Title of a Single Creative Work
1202.09	Names of Artists and Authors
1202.09(a)	Names of Performing Artists Used on Sound Recordings
1202.10	Model or Grade Designations
1202.11	Background Designs and Shapes
1202.12	Varietal and Cultivar Names (Examination of Applications for Seeds and Plants)
1202.13	Scent or Fragrance
1202.14	Holograms
1202.15	Sound Marks

<b>1203</b>	<b>Refusal on Basis of Immoral or Scandalous Matter; Deceptive Matter; Matter which May Disparage, Falsely Suggest a Connection, or Bring into Contempt or Disrepute</b>
1203.01	Immoral or Scandalous Matter
1203.02	Deceptive Matter
1203.02(a)	Distinction between Marks Comprising Deceptive Matter (§2(a)) and Deceptively Misdescriptive Marks (§2(e)(1))
1203.02(b)	Deceptive Matter: Case References
1203.03	Matter which May Disparage, Falsely Suggest a Connection, or Bring into Contempt or Disrepute
1203.03(a)	“Persons” Defined
1203.03(b)	“National Symbols” Defined
1203.03(c)	Disparagement, Bringing into Contempt and Bringing into Disrepute
1203.03(d)	Disparagement, Bringing into Contempt and Bringing into Disrepute: Case References
1203.03(e)	False Suggestion of a Connection
1203.03(f)	False Suggestion of a Connection: Case References
<b>1204</b>	<b>Refusal on Basis of Flag, Coat of Arms or Other Insignia of United States, State or Municipality, or Foreign Nation</b>
<b>1205</b>	<b>Refusal on Basis of Matter Protected by Statute or Convention</b>
1205.01	Statutory Protection
1205.02	Article 6ter of the Paris Convention
<b>1206</b>	<b>Refusal on Basis of Name, Portrait or Signature of Particular Living Individual or Deceased U.S. President Without Consent</b>
1206.01	Name, Portrait or Signature
1206.02	Particular Living Individual or Deceased U.S. President
1206.03	Consent of Individual or President’s Widow Required
1206.03(a)	Consent Must Be Written Consent to Registration
1206.03(b)	Implicit Consent
<b>1207</b>	<b>Refusal on Basis of Likelihood of Confusion, Mistake or Deception</b>
1207.01	Likelihood of Confusion
1207.01(a)	Relatedness of the Goods or Services
1207.01(a)(i)	Goods or Services Need Not Be Identical
1207.01(a)(ii)	Goods May Be Related to Services
1207.01(a)(ii)(A)	Food and Beverage Products Versus Restaurant Services
1207.01(a)(iii)	Reliance on Identification of Goods/Services in Registration and Application
1207.01(a)(iv)	No “Per Se” Rule
1207.01(a)(v)	Expansion of Trade Doctrine

1207.01(a)(vi)	Evidence Showing Relatedness of Goods or Services
1207.01(b)	Similarity of the Marks
1207.01(b)(i)	Word Marks
1207.01(b)(ii)	Similarity In Appearance
1207.01(b)(iii)	Comparing Marks That Contain Additional Matter
1207.01(b)(iv)	Similarity in Sound – Phonetic Equivalents
1207.01(b)(v)	Similarity in Meaning
1207.01(b)(vi)	Doctrine of Foreign Equivalents
1207.01(b)(vii)	Transposition of Terms
1207.01(b)(viii)	Marks Consisting of Multiple Words
1207.01(b)(ix)	Weak or Descriptive Marks
1207.01(b)(x)	Parody Marks
1207.01(c)	Design Marks
1207.01(c)(i)	Legal Equivalents - Comparison of Words and Their Equivalent Designs
1207.01(c)(ii)	Composite Marks Consisting of Both Words and Designs
1207.01(c)(iii)	Comparison of Standard Character Marks and Special Form Marks
1207.01(d)	Miscellaneous Considerations
1207.01(d)(i)	Doubt Resolved in Favor of Registrant
1207.01(d)(ii)	Absence of Actual Confusion
1207.01(d)(iii)	Third-Party Registrations and Evidence of Third-Party Use
1207.01(d)(iv)	Collateral Attack on Registration Improper in Ex Parte Proceeding
1207.01(d)(v)	Classification of Goods/Services
1207.01(d)(vi)	Prior Decisions of Examining Attorneys
1207.01(d)(vii)	Sophisticated Purchasers
1207.01(d)(viii)	Consent Agreements
1207.01(d)(ix)	Fame of Mark
1207.01(d)(x)	Conflicting Marks Owned by Different Parties
1207.02	Marks That Are Likely to Deceive
1207.03	Marks Previously Used in United States but Not Registered
1207.04	Concurrent Use Registration
1207.04(a)	Concurrent Use – In General
1207.04(b)	Filing Basis of Application Seeking Concurrent Use
1207.04(c)	Basis for Concurrent Use Registration
1207.04(d)	Determining Eligibility for Concurrent Use
1207.04(d)(i)	Requirements for All Concurrent Use Applications
1207.04(e)	Applications Subject to Concurrent Use Proceeding Before the Trademark Trial and Appeal Board
1207.04(e)(i)	Preparing the File for Publication
1207.04(f)	Application for Concurrent Use Registration Pursuant to Court Decree
1207.04(f)(i)	Preparing the File for Publication

<b>1208</b>	<b>Conflicting Marks in Pending Applications</b>
1208.01	Priority for Publication or Issue Based on Effective Filing Date
1208.01(a)	What Constitutes Conflict Between Pending Applications
1208.01(b)	What Constitutes Effective Filing Date
1208.01(c)	Change in Effective Filing Date During Examination
1208.01(d)	Examination of Conflicting Marks After Reinstatement or Revival
1208.02	Conflicting Applications Examination Procedure
1208.02(a)	Examination of Application with Earliest Effective Filing Date
1208.02(b)	Action on Later-Filed Application: Giving Notice of the Earlier Application or Applications
1208.02(c)	Suspension of Later-Filed Application
1208.02(d)	Action on Later-Filed Application upon Disposition of the Earlier Application or Applications
1208.02(e)	Applicant's Argument on Issues of Conflict
1208.02(f)	Conflicting Mark Mistakenly Published or Approved for Issuance on the Supplemental Register
1208.03	Procedure Relating to Possibility of Interference
1208.03(a)	Procedures on Request for Interference
1208.03(b)	Decision on Request for Interference
1208.03(c)	Procedure When Interference Is to be Declared
<b>1209</b>	<b>Refusal on Basis of Descriptiveness</b>
1209.01	Distinctiveness/Descriptiveness Continuum
1209.01(a)	Fanciful, Arbitrary and Suggestive Marks
1209.01(b)	Merely Descriptive Marks
1209.01(c)	Generic Terms
1209.01(c)(i)	Test
1209.01(c)(ii)	Terminology
1209.01(c)(iii)	Generic Matter: Case References
1209.02	Procedure for Descriptiveness and/or Genericness Refusal
1209.03	Considerations Relevant to Determination of Descriptiveness
1209.03(a)	Third-Party Registrations
1209.03(b)	No Dictionary Listing
1209.03(c)	First or Only User
1209.03(d)	Combined Terms
1209.03(e)	More Than One Meaning
1209.03(f)	Picture or Illustration
1209.03(g)	Foreign Equivalents/Dead or Obscure Languages
1209.03(h)	Incongruity
1209.03(i)	Intended Users
1209.03(j)	Phonetic Equivalent
1209.03(k)	Laudatory Terms

1209.03(l)	Telephone Numbers
1209.03(m)	Domain Names
1209.03(n)	“America” or “American”
1209.03(o)	“National” or “International”
1209.03(p)	Function or Purpose
1209.03(q)	Source or Provider of Goods or Services
1209.03(r)	Retail Store and Distributorship Services
1209.03(s)	Slogans
1209.04	Deceptively Misdescriptive Marks
<b>1210</b>	<b>Refusal on Basis of Geographic Significance</b>
1210.01	Elements
1210.01(a)	Geographically Descriptive Marks - Test
1210.01(b)	Geographically Deceptively Misdescriptive Marks - Test
1210.01(c)	Geographically Deceptive Marks - Test
1210.02	Primarily Geographic Significance
1210.02(a)	Geographic Locations
1210.02(b)	Primary Significance
1210.02(b)(i)	Other Meanings
1210.02(b)(i)(A)	Surname Significance
1210.02(b)(ii)	More Than One Geographic Location With Same Name
1210.02(b)(iii)	Non-Geographic Characteristics of Goods or Services
1210.02(b)(iv)	“America” or “American” and Similar Terms in Marks
1210.02(c)	Geographic Terms Combined With Additional Matter
1210.02(c)(i)	Two Geographic Terms Combined
1210.02(c)(ii)	Geographic Terms Combined With Descriptive or Generic Matter
1210.02(c)(iii)	Arbitrary, Fanciful or Suggestive Composites
1210.03	Geographic Origin of the Goods or Services
1210.04	Goods/Place or Services/Place Association
1210.04(a)	Establishing Goods/Place Association
1210.04(b)	Establishing Services/Place Association
1210.04(c)	Obscure or Remote Geographic Marks
1210.04(d)	Arbitrary Use of Geographic Terms
1210.05	Geographically Deceptive Marks
1210.05(a)	Basis for Refusal
1210.05(b)	Materiality of Deception
1210.05(b)(i)	Materiality of Deception In Cases Involving Goods
1210.05(b)(ii)	Materiality of Deception In Cases Involving Services
1210.06	Procedure for Examining Geographic Composite Marks
1210.06(a)	Marks That Include Primarily Geographically Descriptive Terms Combined With Additional Matter
1210.06(b)	Marks That Include Primarily Geographically Deceptively Misdescriptive and Deceptive Terms Combined With Additional Matter
1210.07	Supplemental Register and Section 2(f)

1210.07(a)	Registrability of Geographic Terms on the Supplemental Register
1210.07(b)	Registrability of Geographic Terms Under Section 2(f)
1210.08	Wines and Spirits
1210.09	Geographic Certification Marks
<b>1211</b>	<b>Refusal on Basis of Surname</b>
1211.01	“Primarily Merely a Surname”
1211.01(a)	Non-Surname Significance
1211.01(a)(i)	Ordinary Language Meaning
1211.01(a)(ii)	Phonetic Equivalent of Term With Ordinary Language Meaning
1211.01(a)(iii)	Geographical Significance
1211.01(a)(iv)	Historical Place or Person
1211.01(a)(v)	Rare Surnames
1211.01(a)(vi)	“Look And Feel” of a Surname
1211.01(b)	Surname Combined with Additional Matter
1211.01(b)(i)	Double Surnames
1211.01(b)(ii)	Stylization or Design Element
1211.01(b)(iii)	Surname Combined with Initials
1211.01(b)(iv)	Surname Combined with Title
1211.01(b)(v)	Surname in Plural or Possessive Form
1211.01(b)(vi)	Surname Combined with Wording
1211.01(b)(vii)	Surname Combined With Domain Name
1211.02	Evidence Relating to Surname Refusal
1211.02(a)	Evidentiary Burden - Generally
1211.02(b)	Evidentiary Considerations
1211.02(b)(i)	Telephone Directory Listings
1211.02(b)(ii)	LEXIS-NEXIS® Research Database Evidence
1211.02(b)(iii)	Surname of Person Associated with Applicant
1211.02(b)(iv)	Specimens Confirming Surname Significance of Term
1211.02(b)(v)	Negative Dictionary Evidence
1211.02(b)(vi)	Evidence of Fame of a Mark
<b>1212</b>	<b>Acquired Distinctiveness or Secondary Meaning</b>
1212.01	General Evidentiary Matters
1212.02	General Procedural Matters
1212.02(a)	Situations in which a Claim of Distinctiveness under §2(f) Is Appropriate
1212.02(b)	Section 2(f) Claim Is, for Procedural Purposes, a Concession that Matter Is Not Inherently Distinctive
1212.02(c)	Claiming §2(f) Distinctiveness in the Alternative
1212.02(d)	Unnecessary §2(f) Claims
1212.02(e)	Disclaimers in Applications Claiming Distinctiveness under §2(f)
1212.02(f)	Section 2(f) Claim in Part (as to a Portion of the Mark)
1212.02(g)	Examining Attorney’s Role in Suggesting §2(f) or Appropriate Kind/Amount of Evidence



1212.02(h)	Non-Final and Final Refusals
1212.02(i)	Section 2(f) Claim with Respect to Incapable Matter
1212.03	Evidence of Distinctiveness Under §2(f)
1212.04	Prior Registrations as Proof of Distinctiveness
1212.04(a)	Sufficiency of Claim vis-à-vis Nature of the Mark
1212.04(b)	“Same Mark”
1212.04(c)	Relatedness of Goods or Services
1212.04(d)	Registration Must Be in Full Force and Effect and on Principal Register or under Act of 1905
1212.04(e)	Form of §2(f) Claim Based on Ownership of Prior Registrations
1212.05	Five Years of Use as Proof of Distinctiveness
1212.05(a)	Sufficiency of Claim Vis-à-Vis Nature of the Mark
1212.05(b)	“Substantially Exclusive and Continuous”
1212.05(c)	Use “as a Mark”
1212.05(d)	Form of the Proof of Five Years’ Use
1212.06	Establishing Distinctiveness by Actual Evidence
1212.06(a)	Long Use of the Mark
1212.06(b)	Advertising Expenditures
1212.06(c)	Affidavits or Declarations Asserting Recognition of Mark as Source Indicator
1212.06(d)	Survey Evidence, Market Research and Consumer Reaction Studies
1212.06(e)	Miscellaneous Considerations Regarding Evidence Submitted to Establish Distinctiveness
1212.06(e)(i)	First or Only User
1212.06(e)(ii)	State Trademark Registrations
1212.06(e)(iii)	Design Patent
1212.06(e)(iv)	Acquiescence to Demands of Competitors
1212.07	Form of Application Asserting Distinctiveness
1212.08	Section 44 and §66(a) Applications and Distinctiveness
1212.09	Intent-to-Use Applications and Distinctiveness
1212.09(a)	Section 2(f) Claim Requires Prior Use
1212.09(b)	Claim of §2(f) “in Part” in §1(b) Application
1212.10	Printing “§2(f)” Notations
<b>1213</b>	<b>Disclaimer of Elements in Marks</b>
1213.01	History of Disclaimer Practice
1213.01(a)	Discretion in Requiring Disclaimer
1213.01(b)	Refusal to Register Because of Failure to Disclaim
1213.01(c)	Voluntary Disclaimer of Registrable or Unregistrable Matter
1213.02	“Composite” Marks
1213.03	Disclaimer of Unregistrable Components of Marks
1213.03(a)	“Unregistrable Components” in General
1213.03(b)	Generic Matter and Matter Which Does Not Function as a Mark

1213.03(c)	Pictorial Representations of Descriptive Matter
1213.03(d)	Entity Designations
1213.04	Trade Names
1213.05	“Unitary” Marks
1213.05(a)	Compound Word Marks
1213.05(a)(i)	Telescoped Words
1213.05(a)(ii)	Compound Words Formed with Hyphen or Other Punctuation
1213.05(b)	Slogans
1213.05(c)	“Double Entendre”
1213.05(d)	Incongruity
1213.05(e)	Sound Patterns
1213.05(f)	Display of Mark
1213.06	Entire Mark May Not Be Disclaimed
1213.07	Removal Rather than Disclaimer
1213.08	Form of Disclaimers
1213.08(a)	Wording of Disclaimer
1213.08(a)(i)	Standardized Printing Format for Disclaimer
1213.08(a)(ii)	Unacceptable Wording for Disclaimer
1213.08(b)	Disclaimer of Unregistrable Matter in Its Entirety
1213.08(c)	Disclaimer of Misspelled Words
1213.08(d)	Disclaimer of Non-English Words
1213.09	Mark of Another May Not Be Registered with Disclaimer
1213.10	Disclaimer in Relation to Likelihood of Confusion
1213.11	Acquiring Rights in Disclaimed Matter
<b>1214</b>	<b>“Phantom” Elements in Marks</b>
1214.01	Single Application May Seek Registration of Only One Mark
1214.02	Agreement of Mark on Drawing With Mark on Specimens or Foreign Registration
1214.03	“Phantom Marks” in Intent-to-Use Applications
1214.04	“Phantom Marks” in §44 and §66(a) Applications
<b>1215</b>	<b>Marks Composed, in Whole or in Part, of Domain Names</b>
1215.01	Background
1215.02	Use as a Mark
1215.02(a)	Use Applications
1215.02(b)	Advertising One’s Own Products or Services on the Internet is not a Service
1215.02(c)	Agreement of Mark on Drawing with Mark on Specimens of Use
1215.02(d)	Marks Comprised Solely of TLDs for Domain Name Registry Services
1215.02(e)	Intent-to-Use Applications
1215.02(f)	Section 44 and §66(a) Applications
1215.03	Surnames

1215.04	Descriptiveness
1215.05	Generic Refusals
1215.06	Marks Containing Geographical Matter
1215.07	Disclaimers
1215.08	Material Alteration
1215.08(a)	Adding or Deleting TLDs in Domain Name Marks
1215.08(b)	Adding or Deleting TLDs in Other Marks
1215.09	Likelihood of Confusion
1215.10	Marks Containing the Phonetic Equivalent of a Top-Level Domain
<b>1216</b>	<b>Effect of Applicant's Prior Registrations</b>
1216.01	Decisions Involving Prior Registrations Not Controlling
1216.02	Effect of "Incontestability" in Ex Parte Examination
<b>1217</b>	<b>Res Judicata</b>

### Chapter 1300 - Examination of Different Types of Marks

<b>1301</b>	<b>Service Marks</b>
1301.01	What Is a Service
1301.01(a)	Criteria for Determining What Constitutes a Service
1301.01(a)(i)	Performance of a Real Activity
1301.01(a)(ii)	For the Benefit of Others
1301.01(a)(iii)	Sufficiently Distinct from Activities Involved in Sale of Goods or Performance of Other Services
1301.01(b)	Whether Particular Activities Constitute "Services"
1301.01(b)(i)	Contests and Promotional Activities
1301.01(b)(ii)	Warranty or Guarantee of Repair
1301.01(b)(iii)	Publishing One's Own Periodical
1301.01(b)(iv)	Soliciting Investors
1301.01(b)(v)	Informational Services Ancillary to the Sale of Goods
1301.02	What Is a Service Mark
1301.02(a)	Matter That Does Not Function as a Service Mark
1301.02(b)	Names of Characters or Personal Names as Service Marks
1301.02(c)	Three-Dimensional Service Marks
1301.02(d)	Titles of Radio and Television Programs
1301.02(e)	Process, System or Method
1301.03	Use of Service Mark in Commerce
1301.03(a)	Use of Service Mark in Advertising to Identify Services
1301.03(b)	Rendering of Service in Commerce Regulable by Congress
1301.04	Specimens of Use for Service Marks
1301.04(a)	Specimens Must Show Use as a Service Mark
1301.04(b)	Association Between Mark and Services
1301.04(c)	Letterhead
1301.04(d)	Specimens for Entertainment Services

1301.05	Identification and Classification of Services
<b>1302</b>	<b>Collective Marks Generally</b>
1302.01	History of Collective Marks
<b>1303</b>	<b>Collective Trademarks and Collective Service Marks</b>
1303.01	Use of Collective Trademark and Collective Service Mark Is By Members
1303.02	Examination of Collective Trademark and Collective Service Mark Applications
1303.02(a)	Classification of Goods and Services in Collective Trademark and Collective Service Mark Applications
1303.02(b)	Specimens of Use for Collective Trademark and Collective Service Mark Applications
1303.02(c)	Special Elements of Collective Trademark and Collective Service Mark Applications
1303.02(c)(i)	Manner of Control
1303.02(c)(ii)	Use by Members Indicated in Dates-of-Use Clause
<b>1304</b>	<b>Collective Membership Marks</b>
1304.01	History of Membership Marks
1304.02	Purpose of Membership Mark
1304.03	Use of Membership Mark Is by Members
1304.04	Who May Apply to Register Membership Mark
1304.05	Who May Own Membership Mark
1304.06	Nature of the Collective Group
1304.07	Character of the Mark
1304.08	Refusal to Register Membership Mark
1304.08(a)	Matter That Does Not Function as a Membership Mark
1304.08(b)	Likelihood of Confusion
1304.08(c)	Degree or Title Designations Contrasted to Membership Marks
1304.09	Examination of Collective Membership Mark Applications
1304.09(a)	Classification in Membership Mark Applications
1304.09(b)	Identifications in Membership Mark Applications
1304.09(c)	Specimens of Use for Membership Marks
1304.09(d)	Special Elements of Applications for Collective Membership Marks
1304.09(d)(i)	Exercise of Control
1304.09(d)(ii)	Manner of Control
1304.09(d)(iii)	Use by Members Indicated in Dates-of-Use Clause
<b>1305</b>	<b>Trademarks and Service Marks Used by Collective Organizations</b>
<b>1306</b>	<b>Certification Marks</b>
1306.01	Definition of Certification Mark
1306.01(a)	Use Is by Person Other than Owner
1306.01(b)	Purpose Is to Certify, Not to Indicate Source
1306.02	Certification Marks That Are Indications of Regional Origin

1306.02(a)	Indicating the Region
1306.02(b)	Authority to Control a Geographical Term
1306.02(c)	The Government as Applicant for a Geographical Certification Mark
1306.03	Certification Marks Certifying that Labor Was Performed by Specific Group or Individual
1306.04	Ownership of Certification Marks
1306.05	Characteristics of Certification Marks
1306.05(a)	Same Mark Not Registrable as Certification Mark and as Any Other Type of Mark
1306.05(b)	Cancellation of Applicant's Prior Registration Required by Change from Certification Mark Use to Trademark or Service Mark Use, or Vice Versa
1306.06	Examination of Certification Mark Applications
1306.06(a)	Refusal to Register Certification Mark
1306.06(b)	The Mark on the Drawing
1306.06(c)	Specimens of Use for Certification Marks
1306.06(d)	Relation Between Certification Mark and Trademark or Service Mark on Specimens
1306.06(e)	Classification of Goods and Services in Certification Mark Applications
1306.06(f)	Identification of Goods and Services in Certification Mark Applications
1306.06(g)	Special Elements of Certification Mark Applications
1306.06(g)(i)	Statement of What the Mark Certifies
1306.06(g)(ii)	Standards
1306.06(g)(iii)	Exercise of Control
1306.06(g)(iv)	Use by Others Indicated in Dates-of-Use Clause
1306.06(g)(v)	Statement That Mark is Not Used by Applicant
1306.06(g)(vi)	Amendment to Different Type of Mark
1306.07	Relationship of §14 (Cancellation) to Examination of Certification Mark Applications
1306.08	Registration of Certification Mark on Basis of Foreign Registration
1306.09	Uncertainty Regarding Type of Mark
1306.09(a)	Distinction Between Certification Mark and Collective Mark
1306.09(b)	Distinguishing Certification Mark Use from Related-Company Use of Trademark or Service Mark
1306.09(c)	Patent Licenses
<b>1307</b>	<b>Registration as Correct Type of Mark</b>

## **Chapter 1400 — Classification and Identification of Goods and Services**

<b>1401</b>	<b>Classification</b>
1401.01	Statutory Authority

1401.02	International Trademark Classification Adopted
1401.02(a)	Headings of International Trademark Classes
1401.02(b)	Short Titles for International Trademark Classes
1401.02(c)	International Alphabetical List
1401.03	Designation of Class
1401.03(a)	Designation of Class by Applicant Normally Accepted in Applications Under §§1 and 44
1401.03(b)	Designation of Class by Office When Class Number Is Not Designated or Is Inaccurate in Application Under §1 or §44
1401.03(c)	Failure to Classify May Delay Action in Applications Under §§1 and 44
1401.03(d)	Classification Determined by World Intellectual Property Organization in §66(a) Applications
1401.04	Classification Determines Number of Fees
1401.04(a)	Prior U.S. Classification System
1401.04(b)	Limiting Goods and Services to the Number of Classes for Which Filing Fees Are Paid
1401.05	Criteria on Which International Classification Is Based
1401.06	Specimens as Related to Classification
1401.06(a)	Specimen Discloses Special Characteristics
1401.07	Classification and Plurality of Uses
1401.08	Classification and the Identification of Goods and Services, In General
1401.09	Changes in Practice Based on the Restructuring of International Class 42 in the 8th Edition of the Nice Agreement
1401.09(a)	Elimination of “Miscellaneous Class Designation”
1401.09(b)	Implementation of the Changes
<b>1402</b>	<b>Identification of Goods and Services</b>
1402.01	Specifying the Goods and/or Services - in General
1402.01(a)	General Guidelines for Acceptable Identifications of Goods or Services
1402.01(b)	Identification of Goods and Services in a §44 Application
1402.01(c)	Identification of Goods and Services in a §66(a) Application
1402.01(d)	Location of “Identification of Goods and Services”
1402.01(e)	Responsibilities of Examining Attorney as to Identification
1402.02	Entitlement to Filing Date With Respect to Specification of Goods and Services
1402.03	Specificity of Terms Used in Identifying Goods and Services
1402.03(a)	Inclusive Terminology
1402.03(b)	House Marks
1402.03(c)	Marks for a “Full Line of ...”
1402.03(d)	Identifying Computer Programs with Specificity

1402.03(e)	Identifying Publications with Specificity
1402.04	Acceptable Identification of Goods and Services Manual
1402.05	Accuracy of Identification
1402.05(a)	Goods That Are Components or Ingredients
1402.05(b)	Material Composition
1402.06	Amendments Permitted to Clarify or Limit Identification
1402.06(a)	Limiting the Identification of Goods and Services
1402.06(b)	Clarifying the Identification of Goods and Services
1402.07	Scope of Identification of Goods and Services for Purposes of Amendment
1402.07(a)	The “Ordinary-Meaning” Test
1402.07(b)	Ambiguous Identifications
1402.07(c)	Unambiguous Identifications
1402.07(d)	Permissible Scope of Identification Not Affected by Proposed Amendment That Is Unacceptable
1402.07(e)	Permissible Scope of Identification Affected by Proposed Amendment That Is Accepted
1402.08	Moving Goods and Services Between Companion Applications
1402.09	Use of Marks Inappropriate in Identifications
1402.10	Identification of Goods and Services in Documents Filed in Connection with §1(b) Applications
1402.11	Identification of Services
1402.11(a)	Computer Services
1402.11(b)	Information Services
1402.11(c)	Association Services and “Promoting the Interest of” Services
1402.11(d)	Charitable Services, Other than Monetary
1402.11(e)	Consulting Services
1402.12	Parentheses and Brackets Should Not be Used in Identifications of Goods and Services
1402.13	Requirement For Amendment of Portion of Identification of Goods/Services
1402.14	Identification of Goods/Services Must Conform to Rules and Policies in Effect at the Time of Examination
<b>1403</b>	<b>Combined or Multiple-Class Application</b>
1403.01	Requirements for Combined or Multiple-Class Application
1403.02	Amendment of Combined or Multiple-Class Application
1403.02(a)	Deletion of Classes
1403.02(b)	Correction of Classification
1403.02(c)	Addition of Classes
1403.03	Dividing of Combined or Multiple-Class Application
1403.04	Combined or Multiple-Class Marks in Official Gazette
1403.05	Action After Filing, Multiple Classes
1403.05(a)	Fees for Action After Filing, Multiple Classes
1403.05(b)	Surrender or Amendment in Multiple-Class Registrations

## Chapter 1500 - Post-Examination Procedures

<b>1501</b>	<b>Appeal to Trademark Trial and Appeal Board</b>
1501.01	Appealable Matter
1501.02	Examining Attorney's Appeal Brief
1501.02(a)	Reply Briefs in Ex Parte Appeals
1501.03	Withdrawal of Refusal or Requirement After Appeal
1501.04	Fee for Appeal
1501.05	Amendment During Appeal
1501.06	Amendment After Decision on Appeal
1501.07	Examining Attorney's Request for Reconsideration
<b>1502</b>	<b>Publication in Trademark Official Gazette</b>
1502.01	Notification of Errors in Trademark Official Gazette
<b>1503</b>	<b>Opposition</b>
1503.01	Filing a Notice of Opposition
1503.02	Joining Persons in an Opposition
1503.03	Time for Opposing
1503.04	Extension of Time to Oppose
1503.05	Opposition Fee
1503.06	Opposition to §66(a) Applications
<b>1504</b>	<b>Jurisdiction over Application</b>
1504.01	Jurisdiction of Examining Attorney
1504.02	Jurisdiction of Trademark Trial and Appeal Board
1504.03	Action By Examining Attorney After Publication
1504.04	Restoration of Jurisdiction to Examining Attorney by Director
1504.04(a)	Request for Jurisdiction
1504.05	Remand to Examining Attorney by Trademark Trial and Appeal Board
1504.05(a)	Request for Remand
<b>1505</b>	<b>Amendments Filed by Applicants After Publication</b>
1505.01	Approval of Amendments After Publication
1505.01(a)	Amendments to the Identification of Goods or Services
1505.01(b)	Amendments to Classification
1505.01(c)	Amendments to Drawings
1505.01(d)	Amendments to the Dates of Use
1505.01(e)	Amendments Adding or Deleting Disclaimers
1505.01(f)	Amendment of the Basis
1505.02	Procedures for Processing Amendments Filed by the Applicant After Publication
1505.02(a)	Form and Timing of Amendments
1505.02(b)	Processing Amendments in Cases Where No Opposition Has Been Filed
1505.02(c)	Processing Amendments in Cases Where a Request for Extension of Time to Oppose Has Been Filed or Granted
1505.02(d)	Processing Amendments in Cases Where an Opposition Has Been Filed



**1506 Concurrent Use Registration Proceeding**  
**1507 Interference**

**Chapter 1600 - Registration and Post Registration Procedures**

<b>1601</b>	<b>Types of Registrations</b>
1601.01	Registrations Now Being Issued
1601.01(a)	Certificate of Registration
1601.01(b)	Duplicate Certificate of Registration
1601.01(c)	Registered Extension of Protection of International Registration to the United States
1601.02	Repeal of Prior Acts
1601.03	Additional Registration under Act of 1946
1601.04	1881 and 1905 Act Registrations
1601.05	1920 Act Registrations
1601.06	Registrations Issued Under Prior Classification Systems
1601.07	Form of Copies of Registrations
<b>1602</b>	<b>Duration and Maintenance of Registrations</b>
1602.01	Act of 1946
1602.02	Acts of 1881 and 1905
1602.03	Act of 1920
1602.04	Trademark Law Treaty Implementation Act Changes
<b>1603</b>	<b>Bringing Prior Act Registrations Under 1946 Act, §12(c)</b>
1603.01	Notification and Printing of Mark in Official Gazette
1603.02	Cancellation and Incontestability
1603.03	Affidavits of Use in Commerce Required
<b>1604</b>	<b>Affidavit of Use or Excusable Nonuse of Mark in Commerce under §8</b>
1604.01	Registrations to Which §8 Affidavit Pertains
1604.02	Notice of When Affidavit Is Due
1604.03	Form for Filing §8 Affidavit
1604.04	Time for Filing §8 Affidavit
1604.04(a)	Premature Filing of §8 Affidavit
1604.04(b)	Registrations in Twenty-Year Terms
1604.05	Requirements for §8 Affidavit or Declaration of Use or Excusable Nonuse
1604.06	Fees for §8 Affidavit
1604.06(a)	Filing Fee for Affidavit or Declaration
1604.06(b)	Grace Period Surcharge and Deficiency Surcharge
1604.06(c)	Processing Affidavit or Declaration Filed With Insufficient Fees
1604.07	Ownership, and Who May File §8 Affidavit
1604.07(a)	Affidavit or Declaration Must be Filed by Owner
1604.07(b)	Establishing Ownership
1604.07(c)	Acceptance Notice Issued in Name of Owner of Record

1604.07(d)	Changes of Legal Entity
1604.07(e)	Changes of Name
1604.07(f)	Correction of Mistake in Setting Forth the Name of the Owner
1604.08	Execution of Affidavit or Declaration
1604.08(a)	Persons Who May Sign Affidavit or Declaration
1604.08(b)	Date of Execution of Affidavit or Declaration
1604.08(c)	Signature of Electronically Transmitted Affidavit or Declaration
1604.08(d)	Form and Wording of Verification
1604.09	Goods and/or Services Set Forth in §8 Affidavit or Declaration
1604.09(a)	Goods and/or Services Must be Specified or Expressly Incorporated by Reference
1604.09(b)	Deletion of Goods and/or Services
1604.09(c)	Failure to List All Goods and/or Services Recited in Registration
1604.09(d)	New Goods and/or Services Cannot be Added
1604.10	Use in Commerce
1604.11	“Excusable Nonuse” of Mark
1604.12	Specimen Showing Current Use of Mark in Commerce
1604.12(a)	Specimen for Each Class Required
1604.12(b)	Specimens in Electronically Filed Affidavits
1604.12(c)	Substitute Specimens
1604.13	Differences in the Mark As Used on the Specimen and the Mark as Registered
1604.13(a)	Possible Amendment of Mark in Registration
1604.14	Designation of Domestic Representative by Foreign Owner
1604.15	Office Actions and Notices Regarding Affidavit
1604.16	Response to Office Action
1604.17	Correction of Deficiencies in §8 Affidavit
1604.17(a)	Correcting Deficiencies in Affidavits or Declarations Timely Filed Within the Periods Set Forth in §§8(a) and 8(b) of the Act
1604.17(b)	Correcting Deficiencies in Affidavits or Declarations Filed During the Grace Period
1604.17(c)	Defects That Cannot be Cured After Expiration of the Grace Period
1604.18	Petition Under 37 C.F.R. §2.146
1604.18(a)	Response to Examiner’s Refusal Required Before Petition
1604.18(b)	Decision on Petition is Final Action of the Office
1604.18(c)	Request for Reconsideration of Denial of Petition
1604.18(d)	Appeal to Federal Court

1604.19	Section 8 Affidavit or Declaration of Use or Excusable Nonuse Combined with Renewal Application
<b>1605</b>	<b>Affidavit of Incontestability Under §15</b>
1605.01	Registrations to Which §15 Affidavit Pertains
1605.02	Form for Filing Affidavit of Incontestability
1605.03	Time for Filing Affidavit of Incontestability
1605.04	Requirements for Affidavit or Declaration of Incontestability
1605.05	Combining §15 Affidavit With §8 Affidavit
1605.06	Section 14 Limitation is Independent of §15 Affidavit
<b>1606</b>	<b>Renewal of Registration Under Trademark Act §9</b>
1606.01	Which Registrations Must be Renewed Under §9
1606.01(a)	Registrations Based on Applications Under §1 or §44 Must Be Renewed Under §9
1606.01(b)	Section 9 Does Not Apply to Extensions of Protection of International Registrations to the United States
1606.01(c)	Renewal of Registrations Issued Under Prior U.S. Trademark Acts Must Be Renewed Under §9
1606.02	Requirements for Renewal Under §9
1606.03	Time for Filing §9 Renewal Application
1606.03(a)	Premature Filing of §9 Renewal Application
1606.04	Form for Filing §9 Renewal Application
1606.05	Fees for §9 Renewal Applications
1606.05(a)	Fee for Filing Application for Renewal Under §9
1606.05(b)	Grace Period Surcharge and Deficiency Surcharge
1606.05(c)	Processing §9 Renewal Application Filed With Insufficient Fees
1606.06	Ownership, and Who May File §9 Renewal Application
1606.07	Execution of §9 Renewal Application
1606.08	Goods and/or Services Set Forth in §9 Renewal Application
1606.08(a)	Listing of Goods and/or Services Required Only for Partial Renewal
1606.08(b)	No Goods or Services Listed
1606.08(c)	Some Goods and/or Services Listed
1606.08(d)	Goods and/or Services Not Listed in Registration May Not Be Listed in Renewal Application
1606.09	Affidavit of Use in Commerce or Excusable Nonuse Not Required
1606.10	Designation of Domestic Representative by Foreign Applicant for Renewal Under §9
1606.11	Office Actions and Notices Regarding §9 Renewal Application
1606.12	Response to Office Action
1606.13	Correction of Deficiencies in §9 Renewal Applications

1606.13(a)	Correcting Deficiencies in §9 Renewal Applications Filed Within the Year Before the Expiration Date of the Registration
1606.13(b)	Correcting Deficiencies in Renewal Applications Filed During the Grace Period
1606.13(c)	Late Filing Cannot be Cured
1606.14	Petition Under 37 C.F.R. §2.146
1606.14(a)	Response to Examiner's Refusal Required Before Petition
1606.14(b)	Decision on Petition is Final Action of the Office
1606.14(c)	Request for Reconsideration of Denial of Petition
1606.14(d)	Appeal to Federal Court
1606.15	Section 9 Renewal Application Combined with Affidavit or Declaration of Use or Excusable Nonuse
<b>1607</b>	<b>Cancellation of Registrations Under §§14 and 37 of the Trademark Act</b>
<b>1608</b>	<b>Surrender of Registration for Cancellation</b>
<b>1609</b>	<b>Amendment and Correction of Registrations</b>
1609.01	Amendment of Registration - In General
1609.01(a)	Registered Extension of Protection Cannot be Amended Under §7
1609.01(b)	Amendment of Registration Resulting From §1 or §44 Application
1609.02	Amendment of Mark
1609.02(a)	Determining What Constitutes Material Alteration of Mark
1609.02(b)	New Drawing Required
1609.02(c)	Supporting Specimen and Declaration
1609.02(d)	Amendment of Black and White Drawing of Mark for Which Color is Claimed to Substitute Color Drawing
1609.03	Amendment of Identification of Goods or Services
1609.04	Amendment of Classification
1609.05	Disclaimer of Mark
1609.06	Territorial Restrictions
1609.07	Dates of Use
1609.08	Effect of Amendment of Registration on Limitation of Grounds for Cancellation of a Registration
1609.09	Amendment From Supplemental to Principal Register Not Permitted
1609.10	Correction of Mistake in Registration
1609.10(a)	Correction of Office Error
1609.10(b)	Correction of Registrant's Error
1609.11	Change of Owner's Address Can Be Filed Through TEAS
<b>1610</b>	<b>Court Orders Concerning Registrations</b>
<b>1611</b>	<b>Updating Automated Records to Show the Status of Registrations</b>

<b>1612</b>	<b>Powers of Attorney and Designations of Domestic Representative Filed After Registration</b>
<b>1613</b>	<b>Affidavit of Use in Commerce or Excusable Nonuse Under §71 of the Trademark Act</b>
<b>1614</b>	<b>Renewal of Registered Extension of Protection</b>
<b>1615</b>	<b>Division of Registrations</b>
1615.01	Division of Registration Based on Application Under §1 or §44 of the Trademark Act
1615.02	Division of Registered Extension of Protection
<b>1616</b>	<b>Replacement</b>

### **Chapter 1700 - Matters Submitted to Director**

<b>1701</b>	<b>Statutory Authority of Director</b>
<b>1702</b>	<b>Petitions to the Director Under 37 C.F.R. §2.146 - In General</b>
<b>1703</b>	<b>Specific Types of Petitions</b>
<b>1704</b>	<b>Petitionable Matter</b>
<b>1705</b>	<b>Petition Procedure</b>
1705.01	Standing
1705.02	Petition Fee
1705.03	Evidence and Proof of Facts
1705.04	Timeliness
1705.05	Due Diligence
1705.06	Stay or Suspension of Pending Matters
1705.07	Signature of Petition
1705.08	Request for Reconsideration of Denial of Petition
1705.09	Appeal to Federal Court
<b>1706</b>	<b>Standard of Review on Petition</b>
<b>1707</b>	<b>Director's Supervisory Authority Under 37 C.F.R. §2.146(a)(3)</b>
<b>1708</b>	<b>Waiver of Rules</b>
<b>1709</b>	<b>Matters Delegated by Director</b>
<b>1710</b>	<b>Petition to Make Special</b>
1710.01	Basis for Granting or Denying Petition
1710.02	Processing Petition Papers
<b>1711</b>	<b>Review of Denial of Filing Dates</b>
<b>1712</b>	<b>Reinstatement of Applications and Registrations</b>
1712.01	Reinstatement of Applications Abandoned Due to Office Error
1712.02	Reinstatement of Registrations Cancelled or Expired Due to Office Error
<b>1713</b>	<b>Petition to Reverse Holding of Abandonment for Failure to Respond Completely</b>
<b>1714</b>	<b>Petition to Revive Abandoned Application</b>
1714.01	Procedural Requirements for Filing Petition to Revive

1714.01(a)	Failure to Timely Respond to an Examining Attorney's Office Action
1714.01(b)	Failure to File a Statement of Use or Extension Request - Notice of Allowance Received
1714.01(b)(i)	Applicant Must File Statement of Use or Further Extension Requests During Pendency of a Petition
1714.01(c)	Notice of Allowance Not Received
1714.01(d)	Timeliness and Diligence
1714.01(e)	Signed Statement That Delay Was Unintentional
1714.01(f)	Applicability of Unintentional Delay Standard
1714.01(f)(i)	Situations Where the Unintentional Delay Standard Applies
1714.01(f)(ii)	Situations Where the Unintentional Delay Standard Does Not Apply
1714.01(g)	Request for Reconsideration of Denial of Petition to Revive
<b>1715</b>	<b>Letters of Protest in Pending Applications</b>
1715.01	Appropriate Subjects to be Raised in Letter of Protest
1715.01(a)	Issues Appropriate as Subject of Letter of Protest
1715.01(b)	Issues Inappropriate as Subject of Letter of Protest
1715.02	Letters of Protest Filed Before Publication
1715.03	Letters of Protest Filed After Publication
1715.03(a)	Timely Filing of Letter of Protest
1715.03(b)	Letter of Protest Does Not Stay or Extend Opposition Period
1715.04	Tracking of Letters of Protest by the Protestor
1715.05	Approval of Applications for Publication or Issue After Grant of a Letter of Protest
<b>1715.06</b>	<b>Recourse After Denial of Letter of Protest</b>
<b>1715.07</b>	<b>Requests for Copies of Letters of Protest</b>

## **Chapter 1800 — Public Inquiries About Applications and Registrations**

<b>1801</b>	<b>Office Personnel May Not Express Opinion on Validity of Registered Trademark</b>
1801.01	Office Personnel Cannot Testify
1802	Congressional Inquiries
1803	Freedom of Information Act Requests
1804	Inquiries from Members of the Press
1805	General Inquiries from the Public
1806	Contacts With Third Parties Regarding Ex Parte Matters
1807	United States Patent and Trademark Office World Wide Web Page

## **Chapter 1900 - Madrid Protocol**

<b>1901</b>	<b>Overview of the Madrid System of International Registration</b>
<b>1902</b>	<b>International Application Originating From the United States</b>
1902.01	Who Can File
1902.02	Minimum Requirements for Date of Receipt of International Application in USPTO
1902.02(a)	Form of International Application
1902.02(b)	Basic Application or Registration Number
1902.02(c)	Name and Address of Applicant
1902.02(d)	Reproduction (Drawing) of Mark
1902.02(e)	Color Claim
1902.02(f)	Identification of Goods/Services
1902.02(g)	Classification in International Applications
1902.02(g)(i)	Reclassifying Goods/Services
1902.02(g)(ii)	U.S. Classes A, B & 200
1902.02(g)(iii)	Kits, Gift Baskets
1902.02(h)	List of Contracting Parties
1902.02(i)	Fees
1902.02(j)	Statement of Entitlement
1902.02(k)	Description of Mark
1902.02(l)	Indication of Type of Mark
1902.02(m)	E-Mail Address
1902.03	Certification of International Application in USPTO
1902.03(a)	Petition to Review Refusal to Certify
1902.04	Date of International Registration
1902.05	IB Requirements for Complete International Application.
1902.06	Examination of Application by IB
1902.07	Irregularities in International Application
1902.07(a)	Irregularities that Must Be Remedied by the USPTO
1902.07(b)	Irregularities that Must Be Remedied by the Applicant – Applicant Must Respond Directly to the IB
1902.07(b)(i)	Fee Irregularities
1902.07(c)	Irregularities that Must Be Remedied by the Applicant – Applicant Must Respond Through the USPTO
1902.07(c)(i)	Classification of Goods and Services
1902.07(c)(ii)	Identification of Goods and Services
1902.07(d)	Other Irregularities that Must Be Remedied By Applicant – Applicant May Respond Directly to the IB or Through the USPTO
1902.07(e)	Filing Response Directly With the IB
1902.07(f)	Responding to Notice of Irregularity Through the USPTO
1902.08	Subsequent Designation - Request for Extension of Protection Subsequent to International Registration
1902.08(a)	USPTO Requirements

1902.08(b)	Form for Filing Subsequent Designation Through the United States Patent and Trademark Office
1902.08(c)	Fees for Subsequent Designation
1902.08(d)	IB Requirements for Subsequent Designation
1902.08(e)	Irregularities in Subsequent Designation
1902.09	Dependence & “Central Attack”: Restriction, Abandonment, Cancellation or Expiration of Basic Application or Registration During First 5 Years
1902.10	Transformation When the USPTO is the Office of Origin
1902.11	Representative
1902.12	USPTO Must Notify IB of Division or Merger of Basic Application or Registration
<b>1903</b>	<b>Payment of Fees</b>
1903.01	Payment of USPTO Fees
1903.02	Payment of International Fees
<b>1904</b>	<b>Request for Extension of Protection of International Registration to the United States</b>
1904.01	Filing Request for Extension of Protection to United States
1904.01(a)	Section 66(a) Basis
1904.01(b)	Filing Date
1904.01(c)	Declaration of Intent to Use Required
1904.01(d)	Use Not Required
1904.01(e)	Priority
1904.01(f)	Filing Fee
1904.01(g)	Constructive Use
1904.01(h)	Cannot be Based on USPTO Basic Application or Registration
1904.02	Examination of Request for Extension of Protection to the United States
1904.02(a)	Examined as Regular Application
1904.02(b)	Examination of Identification and Classification of Goods/Services in §66(a) Applications
1904.02(c)	Mark Must Be Registrable on Principal Register
1904.02(d)	Refusal Must Be Made Within 18 Months
1904.02(e)	Issuing Office Actions
1904.02(f)	Correspondence Address
1904.02(g)	Mark Cannot Be Amended
1904.02(h)	Jurisdiction
1904.03	Notice of Refusal
1904.03(a)	Notice Must be Sent Within 18 Months
1904.03(b)	Requirements for Notice of Refusal
1904.03(c)	§66(a) Applicant Must Respond to Notification of Refusal
1904.03(d)	Refusal Pertaining to Less Than All the Goods/Services
1904.03(e)	Confirmation or Withdrawal of Provisional Refusal
1904.04	Opposition



1904.05	Certificate of Extension of Protection
1904.06	Assignment of Extension of Protection to the United States
1904.07	Invalidation of Protection in United States
1904.08	Cancellation of International Registration By IB
1904.09	Transformation to Application Under §1 or §44
1904.09(a)	Requirements for Transformation
1904.09(b)	Examination of Transformed Application
1904.10	Affidavits of Use or Excusable Nonuse Required
1904.11	Incontestability
1904.12	Replacement
1904.13	Amendment of Registered Extension of Protection to the United States
<b>1905</b>	<b>Renewal of International Registrations</b>
<b>1906</b>	<b>Communications With International Bureau Regarding International Registrations</b>
1906.01	Recording Changes in International Register
1906.01(a)	Change in Ownership of International Registration
1906.01(a)(i)	Requirements for Submitting Changes in Ownership of International Registration Through the USPTO
1906.01(a)(ii)	International Fees for Recording Changes of Ownership of International Registration
1906.01(a)(iii)	Effect of Change of Ownership of International Registration
1906.01(a)(iv)	Dividing an International Registration After Change of Ownership With Respect to Some But Not All of the Goods
1906.01(b)	Restriction of Holder's Rights of Disposal
1906.01(c)	Change of the Holder's Name or Address
1906.01(d)	Change of Name or Address of Representative
1906.01(e)	Limitation, Renunciation, Cancellation of International Registration
1906.01(f)	Correction of Errors in International Registration
1906.01(g)	Merger of International Registrations
1906.01(h)	License
1906.01(i)	Changes That Cannot Be Made to International Registration

## **Appendix A Examining Attorneys' Appeal Briefs**

## **Appendix B List of Members of International Trademark Agreements**

## **Appendix C Notes of Other Statutes**

### **List of Decisions Cited**

### **Index**

## CHANGES: INDEX TO CHANGES IN TMEP FOURTH EDITION

Attention is directed to the following changes in the 4th edition of the TMEP, dated April, 2005.

SECTION	CHANGE
103	Updated list of documents that can be filed through TEAS, ESTTA and ETAS.
104	Assignment database can be searched online.
106	USPTO distributes <i>Trademark Official Gazette</i> only in electronic format.
108.02	Deleted.
108.03	Renumbered 108.02.
108.04	Renumbered 108.03. Due diligence standard changed from one year to six months.
109.01	Old §109.01 (access by public to pending unpublished application files) merged with §109.02 (access to files of pending but published application files, registrations, abandoned applications and terminated <i>inter partes</i> proceeding files). New §109.01 covers electronic image files (new section).
109.02	Title changed; merged with old §109.01. New locations for requests by public for access to paper files.
109.03	Public can view and print images of copies of trademark files from USPTO website.
201	Sets forth what constitutes filing date of §66(a) applications.
202	Rule 2.21 applies only to §1 and §44 applications. Compliance with minimum filing requirements for §66(a) applications is determined by International Bureau of World Intellectual Property Organization ("IB").
202.01	Drawing in §66(a) application must meet requirements of Madrid Protocol and Madrid Common Regulations. IB will determine compliance before sending application to USPTO.
202.02	This section (listing of recognizable goods or services) applies only to §1 and §44 applications.
202.03	Amount of application filing fee varies depending on whether application is filed through TEAS or on paper. Filing fee for §66(a) application is sent to USPTO by IB; Examining attorney should not require additional fees during examination.
203	IB determines compliance with minimum filing requirements in §66(a) applications.
204-204.03	These sections (procedures for processing informal applications) apply only to §1 and §44 applications.
205	This section (application normally void if it is discovered during examination that applicant did not meet minimum filing

## INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
206	requirements) applies only to §1 and §44 applications. When the effective filing date of an application changes, Office does not alter the original filing date in its automated records.
206.02	Section 66(a) application may include priority claim.
Chapter 300	Extracts of rules updated.
301	Updated list of documents that can be filed through TEAS, ESTTA and ETAS.
304.01	E-mail attachments must be in .jpg format.
304.02	Responses to examining attorneys' Office actions cannot be filed by e-mail.
304.06	Deleted.
304.07	Renumbered 304.06. If outgoing electronic mail is returned as undeliverable, USPTO will mail paper copy to the correspondence address of record.
304.08	Renumbered 304.07. Scanned image of signed document must be in .jpg format.
304.09	Renumbered 304.08.
304.10	Renumbered 304.09.
305.01	New addresses for trademark correspondence.
305.02(a)	Titled changed. Updated list of documents for which certificate of mailing cannot be used.
305.04	New section - interruptions in U.S. Postal Service.
306.01	Titled changed. Updated list of documents that cannot be filed by fax.
307	New location for hand delivery of trademark documents.
Chapter 400	Extracts of rules updated.
401	This section (processing new applications) applies only to §1 and 44 applications.
401.01	Renumbered 401.02.
401.02	Renumbered 401.03.
401.03	Renumbered 401.04. Title changed. Office does not create paper files for TEAS applications.
401.03(a)- 401.04	Deleted.
402	Old §402 (filing receipts) renumbered 401.01; added discussion of §66(a) applications. New §402 covers electronic application and registration files (new section).
402.01	New section - USPTO no longer creates paper copies of certain trademark-related documents.
403	If outgoing electronic mail is returned as undeliverable, USPTO will mail paper copy to correspondence address of record. Papers and envelopes returned by USPS are scanned into TICRS.
404	Once any document has been filed with respect to an application or registration, it becomes part of the public record

## INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
	and will not be returned.
405.01(a)	Renumbered 405.06. Revised to include all types of payments refused by financial institutions.
405.02(a)	Discussion of checks returned unpaid moved to §405.06.
Chapter 500	Extracts of rules updated.
501.01(b)	New section - assignability of extension of protection of international registrations.
501.07	New section - assignment of extension of protection of international registration.
502	Some text moved to 502.01. Added discussion of §66(a) applications.
502.01	Old §502.01 (issuance of certificate in name of new owner) renumbered 502.02(a); title changed; rewritten. Applies only to §1 and §44 applications. New §502.01 (establishing right to take action in application or registration) includes some material previously in 502, plus discussion of §66(a) applications.
502.01(a)	Renumbered 502.02(c).
502.02	Renumbered 502.03. Added discussion of §66(a) applications.
502.02(b)	New section - issuance of certificate to assignee of §66(a) application.
502.03	Added discussion of §66(a) applications.
503.03(a)	Requests to record documents in USPTO should be filed electronically to expedite recordation. Requests to record changes of ownership of requests for extension of protection of international registrations to the United States must be filed with IB.
503.03(b)	Documents filed for recordation electronically should be in TIFF format. If filing a request for recordation on paper, original documents should not be submitted.
503.03(e)	Cover sheets and requests to record documents should be filed electronically to expedite recordation.
503.05	New owner of §66(a) application or registered extension of protection must record assignment with IB.
503.06, 503.06(b)	Requests to correct errors in documents recorded with IB must be corrected at IB.
503.08	Public can search assignment records on USPTO website.
504 <i>et seq.</i>	New section - automatic updating of ownership in trademark database.
Chapter 600	Extracts of rules updated.
602.01	Powers of attorney can be filed through TEAS.
602.01(a)	Owner may appoint an attorney through TEAS for up to 20 applications or registrations that have the identical owner and

## INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
	attorney.
602.01(c)	Powers of attorney can be filed through TEAS.
602.03	Response signed by unauthorized party should be treated as incomplete response.
602.04	Revocation of power of attorney can be filed through TEAS.
602.04(a)	Renumbered 602.05. Request to withdraw as attorney in pending application can be filed through TEAS. Office will not process request for permission to withdraw in abandoned application.
603.01(a)	New section - correspondence in §66(a) applications.
604	Designations of domestic representative can be filed through TEAS.
Chapter 700	Extracts of rules updated.
703	Application under §66(a) not regarded as duplicate of application under §1 or §44. Mark in which the drawing is lined for color is considered duplicate of color drawing, if the colors are identical.
705.07	Title changed.
706	New refusal cannot be made in §66(a) application more than 18 months after the date on which the IB sends the request for extension of protection to the USPTO.
707	Examiner's amendment may not be issued on first action in §66(a) application.
707.02	Examining attorney may issue examiner's amendment to enter a standard character claim without prior approval of applicant or applicant's attorney, when the record clearly indicates that the drawing is intended to be in standard characters.
711.02	In §66(a) application, new refusal cannot be issued more than 18 months after the date on which the IB sends the request for extension of protection to the USPTO.
712.01	If response to Office action is signed by an unauthorized person, the examining attorney should treat the response as incomplete, and require a properly signed response.
712.03	New section - response signed by unauthorized party will be treated as incomplete response; response cannot be ratified by examiner's amendment.
714.05(a)	Amendment to drawing that materially alters mark raises new issue, if examining attorney had required new drawing because original drawing was of poor quality, but had not previously raised issue of material alteration.
714.05(a)(i)	In §66(a) application, amendment to Supplemental Register does not raise a new issue.
714.05(b)	In §66(a) application, refusal under §2(d) may be issued more than 18 months after the date on which the IB sends the request for extension of protection to the USPTO, provided

## INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
	that USPTO had notified IB of conflicting application prior to expiration of the 18-month period.
716.02	Examining attorney should not suspend action on application pending a decision on petition (previously stated in 1705.06).
716.02(b)	If applicant claims §44(d) in addition to another basis, there are no other outstanding issues, and examining attorney is unable to reach applicant by phone, examining attorney should issue Office action requiring a copy of foreign registration, advising applicant that it may retain the priority filing date even if it does not perfect the §44(e) basis, and inquiring as to whether applicant wants to retain §44(e) as a second basis.
716.02(c)	Where examining attorney is not persuaded by applicant's arguments that there is no conflict with an earlier-filed pending application, examining attorney should issue a suspension notice, with a statement that applicant's arguments were not persuasive. It is not necessary to address merits of applicant's arguments prior to initial suspension.
717.01	If outgoing electronic mail is returned as undeliverable, USPTO will mail paper copy to correspondence address of record. Papers and envelopes returned by USPS are scanned into TICRS.
718.01	Letter of express abandonment can be filed through TEAS. In §66(a) application, applicant may file letter of express abandonment with either USPTO or IB. Petition to withdraw an express abandonment must be filed within two months of the effective date of abandonment.
718.02(a)	New section - partial abandonment. When an applicant fails to respond to a refusal or requirement that is expressly limited to only certain goods/services/class(es), the examining attorney should issue an examiner's amendment deleting (abandoning) the goods/services/classes to which the refusal or requirement pertained.
718.03	Inquiry, request to extend response period, or communication on a matter unrelated to the preceding Office action will be treated as a non-responsive communication, not as an incomplete response.
718.03(b)	If an applicant does not receive action granting additional time to complete a response under 37 C.F.R. §2.65(b), or if applicant is unable to respond to such an action due to some other extraordinary circumstance, applicant may file a petition to the Director under 37 C.F.R. §2.146.
719	Old §719 (fraud) renumbered 720. New §719 covers non-responsive communications (new section).
Chapter 800	Extracts of rules updated.

## INDEX TO CHANGES IN TMEP FOURTH EDITION

<b>SECTION</b>	<b>CHANGE</b>
801.02(b)	Mark in §66(a) application cannot be registered on Supplemental Register.
802	Section 66(a) applications are sent to USPTO by IB.
803.03(e)(i)	New section - business trusts.
803.03(i)	Added reference to the French entity société par actions simplifiée (SAS).
803.03(j)	New section - Federally recognized Indian tribe is acceptable designation of applicant's entity.
804	Verification in §66(a) application is part of international registration on file at IB. Examining attorney does not have to examine verification.
804.01	Title changed. Section applies only to §1 and §44 applications.
804.02	Titled changed. Section applies only to §1 and §44 applications.
804.03	Titled changed. Section applies only to §1 and §44 applications.
804.04	Added discussion of §66(a) applications.
804.05	In TEAS document, if the signatory's name is not set forth, examining attorney should require that it be stated for the record.
804.06	New section - verification of §66(a) application
806.01(e)	New section - requirements for §66(a) basis.
806.02(a)	Section 66(a) applicant cannot claim more than one basis.
806.02(f)	If applicant claims §44(d) in addition to another basis, there are no other outstanding issues, and examining attorney is unable to reach applicant by phone, examining attorney should issue Office action requiring a copy of the foreign registration, advising applicant that it may retain the priority filing date even if it does not perfect §44(e) basis, and inquiring as to whether applicant wishes to retain §44(e) as a second basis.
806.02(g)	New section - not necessary to repeat allegation of bona fide intention to use mark in commerce in multi-basis application (previously stated in 806.02(e)).
806.03(g)	Old §806.03(g) (effect of substitution of basis on application filing date) renumbered 806.03(h). New §806.03(g) covers amendment of basis from §1(b) to §44 (new section).
806.03(h)	Renumbered 806.03(i).
806.03(j)	New section - petitions to amend basis after publication. Director will not grant petition to amend the basis after publication if the amendment could substantially delay prosecution of the application.
806.03(j)(i)	New section - amending the basis of a §1(b) application after publication but before issuance of notice of allowance.

## INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
806.03(j)(ii)	New section - amending the basis of a §1(b) application between issuance of notice of allowance and filing of statement of use. Director will not grant a petition to add §44 and retain the §1(b) basis unless a statement of use is filed with the petition.
806.03(k)	New section - basis cannot be changed in §66(a) application.
806.04(a)	Request to delete §1(b) basis from multi-basis application should be filed through TEAS, to expedite processing.
807.01-	Deleted.
807.01(d)	Deleted.
807.02	Deleted.
807.03	Old §807.03 (drawing must show only one mark) renumbered 807.01. New §§807.03 <i>et seq.</i> covers standard character drawings (new sections; replace sections on “typed” drawings).
807.03(f)	New section - standard character drawing and foreign registration. If foreign registration certificate does not indicate that the mark is in standard characters (or the equivalent), examining attorney must inquire whether the foreign registration includes a claim that the mark is in standard characters.
807.04	Renumbered 807.02.
807.05	Old §807.05 (drawing no longer considered separate element) deleted; substance moved to 807.01 and 807.06(c). New §§807.05 <i>et seq.</i> cover TEAS drawings (new sections).
807.06 <i>et seq.</i>	Old §807.06 <i>et seq.</i> (typed drawings) renumbered 807.03 <i>et seq.</i> ; title changed (standard character drawings); reorganized & rewritten to incorporate rules change. New §§807.06 <i>et seq.</i> covers paper drawings (new sections).
807.07 <i>et seq.</i>	Old §807.07 <i>et seq.</i> (special form drawings) renumbered 807.04 <i>et seq.</i> ; rewritten. New §§807.07 <i>et seq.</i> cover revised rules for color drawings.
807.08	Renumbered 807.12(e).
807.09 <i>et seq.</i>	(Color drawings) Renumbered 807.07 <i>et seq.</i> , reorganized & rewritten to incorporate rules change.
807.09(e)	(Markings that do not indicate color) Renumbered 808.01(d); rewritten.
807.10	Renumbered 807.08.
807.11	Renumbered 807.09.
807.12	Renumbered 807.10.
807.12(c)	New section - mark in §66(a) application must be substantially exact representation of mark in international registration.
807.13	Old §807.13 (marks with motion) renumbered 807.11. New §§807.13 <i>et seq.</i> cover amendment of mark.
807.13(b)	Mark in §66(a) application cannot be amended.



## INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
807.14	(Mark on drawing must agree with mark on specimen or foreign registration) Renumbered and broken into subsections 807.12 through 807.12(b).
807.14(a)	(Material alteration) Renumbered 807.14 <i>et seq.</i> ; rewritten.
807.14(a)(i)	Renumbered 807.14(c).
807.14(b)	Renumbered 807.12(d).
807.15	Renumbered 807.14(a).
807.16	Renumbered 807.15.
807.17	Renumbered 807.16.
807.18	Old §807.18 renumbered 807.17. New §807.18 covers mark drawing codes (new section).
808.01(c)	Statement that a term has no meaning should not be entered as a description of the mark.
808.01(d)	New section - lining and stippling statements.
808.03	If description of mark should not be printed, examining attorney should delete it from TRAM and enter note to file.
809.02	If translation or transliteration should not be printed, examining attorney should delete it from TRAM and enter note to file.
810	Amount of the trademark application filing fee varies depending whether the application is filed through TEAS or on paper. Filing fee for §66(a) application is sent to USPTO by IB; examining attorney should not require additional fees during examination.
810.01	Filing fee for §66(a) application will be sent to USPTO by IB. Examining attorney should not require additional fees during examination. Classes cannot be added or changed.
812	If claim of ownership of prior registration should not be printed, examining attorney should delete it from TRAM and enter note to the file.
813	If mark is comprised, in whole or in part, of the name or likeness of an individual, consent to register is implicit if the individual whose name or likeness appears in the mark signs the application, personally or through an authorized signatory. If statement as to whether mark comprises name, portrait or signature of a living individual should not be printed, examining attorney should delete it from TRAM and enter note to the file.
814	Statement that information about the goods/services is available on applicant's website is inappropriate response to examining attorney's requirement for information about goods/services.
815	Mark in §66(a) application cannot be registered on Supplemental Register.
816.01 & 816.04	Mark in §66(a) application cannot be amended to

## INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
817	Supplemental Register. When preparing application for publication or registration, examining attorney should ensure that information to be printed has been properly entered, and that information that should not be printed is deleted from TRAM.
901	Use not required in §66(a) applications.
903.07	When applicant sets forth indefinite dates of use, only the information provided by applicant is printed in <i>Official Gazette</i> and on certificate of registration.
903.07(a)	Rewritten to clarify.
904.02	(Physical form of specimens) Broken into subsections (a) (electronic specimens) and (b) (paper specimens) (new sections).
904.02(a)	Old §904.02(a) (color specimens) renumbered 904.02(c). New §904.02(a) covers electronic specimens. TEAS specimen must be in .jpg format. In application for registration of sound mark that comprises music or words set to music, applicant may submit the musical score for the record, in .wav format, as an attachment to e-mail message, after filing the application.
904.02(b)	Old §904.02(b) (marks used on publications) renumbered 904.02(d). New 904.02(b) covers paper specimens.
904.04(d)	Specimen showing use of proposed mark on a website for downloadable software is acceptable only if it provides sufficient information to enable user to download software from website.
904.06(a)	An advertisement that includes a phone number, Internet address and/or mailing address is not an acceptable catalog specimen under <i>Lands' End Inc. v. Manbeck</i> , if there is no offer to accept orders or instructions on how to place an order on the specimen.
904.06(b)	New section - electronic displays as specimens for trademarks.
904.09	When submitting an additional specimen in support of a multiple class application that is not identical to the specimen originally filed, applicant must include affidavit or declaration under 37 C.F.R. §2.20 verifying that specimen is in use in commerce.
Chapter 1000	Title changed (applications under §44).
1003.03	Section 44(d) applicant cannot assert a §66(a) basis.
1003.04	If an applicant claims §44(d) in addition to another basis, there are no other outstanding issues, and examining attorney is unable to reach applicant by phone, examining attorney should issue Office action requiring copy of foreign registration, advising applicant that it may retain the priority

## INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
	filing date even if it does not perfect a §44(e) basis, and inquiring as to whether applicant wishes to retain §44(e) as a second basis.
1004	Applicant may not file application under §44(e) before registration in applicant's country of origin has issued.
1004.01	In §44(e) application, examining attorney will not suspend application pending submission of a copy of foreign registration unless applicant establishes that it cannot obtain a copy of the foreign registration due to extraordinary circumstances.
1004.01(a)	Caselaw updated.
1005	If application is properly filed based on §1(a) or §1(b), and applicant later amends the application to add or substitute §44 as a basis, applicant must be the owner of the foreign application or registration as of the filing date of the amendment adding or substituting §44 as a basis for registration. If the applicant owned the foreign application or registration on the filing date of the amendment, but not on the U.S. application filing date, applicant will retain the original filing date, as long as there was a continuing valid basis since the U.S. application filing date.
1007	Caselaw updated.
1011.01	If foreign registration certificate does not indicate that mark is in standard characters, examining attorney must inquire whether the foreign registration includes a claim that mark is in standard characters.
1016	New section - international registration as basis for §44 application
1104.01	Amendment to allege use ("AAU") that omits allegation of use in commerce, but asserts verified date of first use in commerce, may be accepted as substantially in compliance with the minimum filing requirement of 37 C.F.R. §2.76(e)(3) for a verified statement that the mark is in use in commerce.
1104.04	If application is under extension of time to oppose when a timely AAU is associated with an application, the potential opposer must continue to file further request(s) for extension(s) of time to oppose, or file a notice of opposition. Board will not suspend the potential opposer's time to file a notice of opposition.
1104.09(c)	If applicant files AAU through TEAS, and fails to identify and pay the fee for an entire class(es), then examining attorney should consider the goods/services in the omitted class(es) to have been expressly deleted, and should not issue any inquiry with respect to those goods/services. If the applicant lists all the goods/services identified in the application in the section of

## INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
1104.09(e)	<p>a pre-printed AAU form designated for the identification of goods that are not in use, then the applicant has not expressed a clear intention to delete these goods/services, and examining attorney must inquire as to the discrepancy. TEAS specimen must be in .jpg format.</p> <p>If applicant submits additional specimen in support of a multiple class application that is not identical to specimen originally filed, applicant must verify that applicant used new specimen in commerce on or in connection with goods/services prior to filing the AAU.</p>
1108.02(d)	<p>In extension request, if applicant lists goods/services to be deleted and the result would be to delete all the goods/services in the notice of allowance, the Office will presume this was a typographical error and will allow the applicant to correct the mistake. However, if applicant mistakenly lists goods/services to be deleted and this would not result in the deletion of all the goods/services, the goods/services specifically listed will be deleted and may not later be reinserted.</p>
1109.09(b) 1109.13	<p>TEAS specimen must be in .jpg format.</p> <p>If applicant files SOU through TEAS, and fails to identify and pay the fee for an entire class(es), then examining attorney should consider the goods/services in the omitted class(es) to have been expressly deleted, and should not issue any inquiry with respect to those goods/services.</p>
1110.02	<p>Since request to divide cannot be filed through TEAS, applicant who seeks to divide out some, but not all, of the goods or services in a class must pay the paper application filing fee for each new separate application created by the division.</p>
1110.08	<p>Old §1110.08 (division of registration) renumbered 1110.09; rewritten; substance moved to §1615. New §1110.08 covers division of pending §66(a) application after change of ownership with respect to some but not all the goods/services (new section).</p>
1201	<p>§66(a) application must be filed by the holder of the international registration.</p>
1201.02(c)	<p>If applicant has been identified as “ABC Corporation, formerly known as XYZ, Inc.,” and the true owner is “XYZ, Inc.,” applicant’s name may be amended to “XYZ, Inc.,” as long as “ABC Corporation, formerly known as XYZ, Inc.” was not a different <i>existing</i> legal entity.</p>
1202.02(b)(ii) 1202.02(d)	<p>Caselaw updated.</p> <p>Examining attorney should ensure that description of mark has been entered into TRAM.</p>

## INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
1202.02(f)	New section - trade dress in §44 and §66(a) applications
1202.05(i)	New section - applications for color marks based on §44 or §66(a).
1202.12	Registration should be refused if an applicant seeks to register a varietal or cultivar name as a mark for fresh fruits or vegetables.
1202.15	When filing a musical score in sound mark application through TEAS, applicant must send .wav file after application is filed, as attachment to an e-mail message.
1203.01	Dictionary definitions alone may be sufficient to establish that a proposed mark comprises scandalous matter, where multiple dictionaries, including at least one standard dictionary, uniformly indicate that a word is vulgar, and the applicant's use of the word is limited to the vulgar meaning of the word.
1203.02(a)	Discussion of distinction between deceptive matter and primarily geographically deceptively misdescriptive matter moved to 1210.05(a).
1203.03(f)	Caselaw updated.
1205.02	When USPTO receives requests for protection under Article 6 <sup>ter</sup> of Paris Convention, USPTO searches its records for conflicting marks, but the requests are not subject to a full examination.
1207.01(a)(i)	Caselaw updated.
1207.01(a)(ii)(A)	New section - food and beverage products versus restaurant services
1207.01(b)	Caselaw updated.
1207.01(b)(i)	Caselaw updated.
1207.01(b)(iii)	Caselaw updated.
1207.01(b)(vi)	Doctrine of foreign equivalents is not an absolute rule, but merely a guideline that should be applied only when it is likely that the ordinary American purchaser would stop and translate a foreign word into its English equivalent.
1207.01(d)(iii)	Caselaw updated.
1207.01(d)(ix)	New caselaw incorporated.
1207.04(b)	Applicant may seek concurrent use registration in application under §44 or §66(a).
1207.04(e)(i)	Deleted reference to paper copies of application.
1209.01(b)	Caselaw updated.
1209.01(c)(i)	Caselaw updated.
1209.03(d)	Caselaw updated.
1209.03(i)	Caselaw updated.
1209.03(m)	Caselaw updated.
1210.01(b)	New test for determining whether a mark is primarily geographically deceptively misdescriptive.

## INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
1210.02(b)	(Primary significance) Subsections added. Some text moved to 1210.02(b)(i), 1210.02(b)(i)(A), 1210.02(b)(ii) & 1210.02(c)(i).
1210.02(c)	Renumbered 1210.02(b)(iv).
1210.02(d)	Renumbered 1210.02(b)(iii); caselaw updated.
1210.04(a)	Old §1210.04(a) (place does not have to be well known for the goods or services) deleted. New §1210.04(a) covers goods/place association.
1210.04(b)	Old §1210.04(b) (geographically descriptive marks - association presumed unless applicant raises genuine issue as to whether primary significance of term is geographic or place is obscure or remote) deleted; incorporated in 1210.04. New §1210.04(b) covers services/place association (new section).
1210.04(c)	Old §1210.04(c) (establishing goods/place or services/place association) broken & renumbered 1210.04(a) (goods) & 1210.04(b) (services).
1210.04(d)	Renumbered 1210.04(c).
1210.04(e)	Renumbered 1210.04(d).
1210.05(a)	Old §1210.05(a) (deceptive geographical marks - in general) deleted. New §1210.05(a) (basis for refusal) discusses new caselaw regarding distinction between deceptive matter and primarily geographically deceptively misdescriptive matter, and basis for refusal of deceptive geographic marks.
1210.05(b)	Old §1210.05(b) renumbered 1210.08. New §§1210.05(b) <i>et seq.</i> discuss materiality of deception.
1210.06-06(b)	Renumbered 1210.07-07(b).
1210.07	(Geographic terms combined with additional matter) Renumbered 1210.02(c); some text moved to 1210.06 (procedure for examining geographic composite marks).
1210.07(a)	Renumbered 1210.02(c)(ii); title changed.
1210.07(b)	Renumbered 1210.06(a).
1210.07(c) & (d)	Merged & renumbered 1210.06(b).
1210.07(e)	Renumbered 1210.02(c)(iii).
1210.08	(Disclaimer) Deleted; incorporated in 1210.06(a), (b), and (c).
1211.01(a)(v)	Media attention is factor to be considered in determining how rarely a surname is used.
1212.02(d)	Unnecessary §2(f) claim should be deleted from TRAM.
1212.08	This section also applies to §66(a) applications.
1212.10	Examining attorney should ensure that §2(f) claim has been entered into the TRAM database, so that it will be printed in <i>Official Gazette</i> and on certificate of registration.
1213.08(d)	Examples of disclaimers added.
1214.04	New section - if application under §44 or §66(a) indicates that the applicant is seeking registration of a “phantom mark,”

## INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
	examining attorney should issue a refusal of registration on ground that application seeks registration of more than one mark.
1215.02(f)	New section - if record indicates that proposed mark would be perceived merely as an informational indication of the address used to access a web site rather than an indicator of source, examining attorney should refuse registration in a §44 or §66(a) application, on ground that subject matter does not function as a mark.
1215.04	New caselaw incorporated.
1215.05	New caselaw incorporated.
1304.09(a)	In §66(a) applications, collective membership marks are not reclassified in Class 200.
1306.03	Caselaw updated.
1306.06(e)	In §66(a) applications, certification marks are not reclassified in Classes A and B.
1401.02	If registration issued under U.S. classification system, registrant may amend to reclassify under international classification system.
1401.03(a)-(c)	Title changed. These sections apply only to §1 and §44 applications.
1401.03(d)	New section - classification is determined by IB in §66(a) applications; USPTO does not reclassify.
1401.04	Generally, examining attorney will not question sufficiency of filing fee in §66(a) application.
1401.04(b)	Generally, examining attorney will not question sufficiency of filing fee in §66(a) application. Classes cannot be added or changed.
1402.01(c)	Old §1402.01(c) (location of identification of goods and services) renumbered 1402.01(d). New §1402.01(c) covers identification of goods/services in §66(a) application (new section).
1402.01(d)	Renumbered 1402.01(e).
1402.02	This section applies only to §1 and §44 applications. Office will not deny a filing date if the applicant uses the language of an international class heading as an identification of goods/services. However, the Office strongly discourages the use of the language of the international class headings or statements that the mark is used on all goods or services in a class to identify the goods or services for which registration of the mark is sought, and will require amendment of any such identification.
1402.03(b)	Applicant who seeks to register a house mark in application under §44 or §66(a) must submit evidence that mark is in fact used as house mark.

## INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
1402.03(c)	Applicant who seeks to register mark for a “full line of” a genre of products in an application under §44 or §66(a) must submit evidence that mark is in fact used for a full line of products.
1402.08	Goods and services can be moved between companion applications only in §1 or §44 applications.
1402.13	New section - requirement for amendment of portion of identification of goods/services. When applicant fails to respond to a requirement to amend some terminology in an otherwise acceptable identification of goods/services, examining attorney should issue an examiner’s amendment deleting the unacceptable terminology from the identification.
1402.14	New section - identification of goods/services must conform to rules and policies in effect at the time of examination.
1403.02	Classes cannot be added or changed in §66(a) application.
1403.02(b)	Classes cannot be added or changed in §66(a) application.
1403.02(c)	Amount of fee for adding classes to §1 or §44 application varies depending on whether the amendment adding additional classes is filed through TEAS or on paper.
1403.05	Classes cannot be added or changed in §66(a) application. If applicant fails to respond to a refusal or requirement that is expressly limited to only certain class(es), application shall be abandoned only as to those class(es).
1501	If appeal is dismissed for failure to file a brief, applicant may file a motion or request with Board to set aside the dismissal and accept a late-filed brief; applicant cannot file petition to revive.
1501.03	When a refusal or requirement is withdrawn after appeal, examining attorney does not have to notify the Board.
1503.01	Notice of opposition to §66(a) application must be filed through ESTTA.
1503.04	TTAB will not grant an extension of time to oppose aggregating more than 180 days from date of publication. Request for extension of time to oppose a §66(a) application must be filed through ESTTA. Extension request must be signed by potential opposer or potential opposer’s attorney.
1503.05	Opposition must be accompanied by required fee for each party joined as opposer for each class in application for which registration is opposed.
1503.06	New section - opposition to §66(a) applications.
1504.02	In §66(a) application, examining attorney may not request a remand during an opposition.
1504.03	It is not necessary for examining attorney to notify the Board when taking an action on an application that is the subject of a request for extension of time to oppose.



## INDEX TO CHANGES IN TMEP FOURTH EDITION

<b>SECTION</b>	<b>CHANGE</b>
1504.04	When deciding whether to grant requests for jurisdiction of §66(a) applications, Director will consider time limits for notifying IB of refusal.
1504.05(a)	In §66(a) application, examining attorney may not request a remand during an opposition.
1505.01(b)	Republication not required when classification is amended after publication. Classification cannot be changed in §66(a) application.
1505.01(f)	Applicant cannot change basis in §66(a) application. In §1 or §44 application, once the Director has granted a petition to amend the basis after publication, the Director will not grant a second petition to amend the basis with respect to the same application.
1505.02(b)	Title changed. This section applies to all cases where no opposition has been filed, regardless of whether extension of time to oppose has been filed or granted.
1505.02(c)	Title changed. It is not necessary for an examining attorney to notify the Board of an action taken on an amendment of an application that is under an extension of time to oppose. Board will not suspend potential opposer's time to file a notice of opposition pending consideration of post-publication amendment.
1601.01(c)	New section - registered extension of protection of international registration.
1601.06	Registrant may amend from U.S. classification system to international classification.
1602.01	Requirement for renewal under §9 of the Act applies only to registrations based on applications under §1 or §44; renewal of registered extensions of protection of international registrations to the United States is made at IB.
1604.01	Section 8 applies only to registrations based on applications under §1 or §44 of the Trademark Act; §71 requires affidavit of use or excusable nonuse for registered extensions of protection.
1604.05	Extract of rule updated.
1604.08(b)	If §8 affidavit is signed but not dated, owner must provide date of execution for the record.
1604.11	Discussion of excusable nonuse rewritten.
1604.12(b)	TEAS specimen must be in .jpg format.
1604.16	Failure to receive Office action is extraordinary circumstance that warrants waiver of deadline for response to Office action.
1605	Acknowledging receipt of §15 affidavit provides notice to the public that affidavit has been filed; it is not a determination by the Office that the registration is in fact incontestable. New filing fee is required with substitute affidavit.

## INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
1605.01	Section 15 affidavit may be filed for registered extension of protection.
1605.03	If §15 affidavit is filed too early, Office will not review it and will refund the filing fee.
1605.04	If Office finds that there is a proceeding pending that involves registrant's right to register the mark or to keep the mark on the register, Office will not acknowledge §15 affidavit, even if proceeding was instituted after the registrant executed and filed the affidavit but before the affidavit was reviewed by the Office.
1606.01	New filing fee is required with substitute affidavit. Old §1606.01 (renewal of registrations issued under prior acts) renumbered 1606.01(c); title changed. New §§1606.01 <i>et seq.</i> discuss which registrations must be renewed under §9.
1606.01(b)	Requirement for §9 renewal does not apply to registered extensions of protection.
1606.02	Renumbered 1606.04; title changed.
1606.04	Renumbered 1606.02.
1606.12	Failure to receive Office action is extraordinary circumstance that warrants waiver of deadline for response to Office action.
1608	Surrender of registered extension of protection can be filed either with IB or with USPTO.
1609.01	Text moved to 1609.01(b) (amendment of registration resulting from §1 and 44 applications).
1609.01(a)	New section - Registered extension of protection cannot be amended under §7.
1609.02	Mark in registered extension of protection cannot be amended.
1609.02(a)	Changing from special form to standard characters, or the reverse, may be a material alteration.
1609.02(d)	New section - substitution of color drawing for black and white drawing of mark for which color is claimed.
1609.03	Identification of goods/services cannot be amended in registered extension of protection.
1609.04	Old §1609.04 (disclaimer) renumbered 1609.05. New §1609.04 covers amendment of classification (new section). Registrant may amend from U.S. classification system to international classification. Classification cannot be amended in registered extension of protection.
1609.05	Renumbered 1609.06.
1609.06	Renumbered 1609.07.
1609.07	Renumbered 1609.08.
1609.08	Renumbered 1609.09.
1609.09	(Correction of mistake) Renumbered 1609.10 <i>et seq.</i>

## INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
	expanded; broken into subsections.
1609.10(a)	Correction of Office error.
1609.10(b)	Correction of registrant's error by registrant in registered extension of protection must be corrected at IB.
1609.11	New section - owner's address can be changed through TEAS.
1612	Appointment of attorney or domestic representative can be filed through TEAS.
1613	New section - affidavits of use or excusable nonuse under §71.
1614	New section - renewal of international registrations.
1615 <i>et seq.</i>	New section - division of registrations.
1616	New section - replacement.
1702	Text of rule updated.
1705.05	Due diligence standard changed from one year to six months. Two-month deadline in 37 C.F.R. §2.146(d) applies where a petitioner does not receive the action that prompts the filing of a petition, running from the date of the petitioner's actual knowledge of said action.
1705.07	Old §1705.07 (processing petition papers) deleted. New §1705.07 covers signature of petition (new section). Petition must be signed by petitioner's attorney or by someone with legal authority to bind petitioner.
1711	Application filing date may be restored if applicant provides evidence that applicant attempted to file the application through TEAS, but TEAS was unavailable due to technical problems.
1712.02	Generally, where there is proof that a registration was cancelled solely due to an Office error, the USPTO will not deny a request for reinstatement solely because the registrant was not diligent in monitoring the status of a §8 affidavit or renewal application.
1714	Petitions to revive should be filed through TEAS, to expedite processing. Text of rule updated.
1714.01(f)(ii)	Applicant cannot file petition to revive if application is abandoned because the Board dismisses an appeal for failure to file a brief.
1715.03(a)	Letter of protest procedure applies only to pending applications. Letters of protest are denied as untimely if the mark registers before issuance of decision on the protest.
1715.03(b)	Board will not suspend a potential opposer's time to file a notice of opposition when a letter of protest has been filed.
1801.01	Text of rule updated.
1803	New address for sending FOIA requests.
1900	New chapter - Madrid Protocol.

# INDEX TO CHANGES IN TMEP FOURTH EDITION

**TRADEMARK MANUAL OF EXAMINING PROCEDURE  
INSTRUCTIONS REGARDING TMEP FOURTH EDITION**

This 4<sup>th</sup> edition replaces the 3<sup>rd</sup> edition and revisions thereto.

# Chapter 100

## General Information

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- 101 Trademark Statute and Rules**
- 102 United States Patent and Trademark Office World Wide Web Page**
- 103 Trademark Forms**
- 104 Trademark Searching**
- 105 General Information Booklet Concerning Trademarks**
- 106 The *Official Gazette***
- 107 Trademark Manuals**
- 108 Status Inquiries**
  - 108.01 Internet Information
  - 108.02 Personal Telephone Assistance
  - 108.03 Due Diligence: Duty to Monitor Status
- 109 Access to Files**
  - 109.01 Electronic Image Files
  - 109.02 Paper Files
  - 109.03 Making Copies of Materials in Files
- 110 Decisions Available to the Public**
- 111 Requests for Copies of Trademark Documents**
- 112 Patent and Trademark Depository Libraries**

### **101 Trademark Statute and Rules**

The federal registration of trademarks is governed by the Trademark Act of 1946, 15 U.S.C. §§1051 *et seq.* (also known as the Lanham Act), and the Trademark Rules of Practice, 37 C.F.R. Parts 2 and 7. The text of the Act

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

and Rules can be accessed and downloaded from the Office's website at <http://www.uspto.gov>.

### **102 United States Patent and Trademark Office World Wide Web Page**

The United States Patent and Trademark Office ("USPTO") has a website at <http://www.uspto.gov> that provides access to a wide variety of information about patents and trademarks, and offers electronic filing of trademark applications and other trademark documents.

The Trademark Electronic Business Center on the USPTO website contains all the information needed for the entire registration process. A customer may search the trademark database for conflicting marks using the Trademark Electronic Search System ("TESS"), file applications and other trademark documents online using the Trademark Electronic Application System ("TEAS"), check the status of applications and registrations through the Trademark Applications and Registrations Retrieval ("TARR") database, or view and print images of the contents of trademark application and registration files through the Trademark Document Retrieval ("TDR") portal on the USPTO website at <http://www.uspto.gov>. See TMEP §104 regarding TESS, TMEP §108.01 regarding TARR, TMEP §109.01 regarding electronic image files, and TMEP §§103 and 301 for further information about electronic filing.

Trademark information available for downloading from the USPTO website includes the trademark statute and rules, *Trademark Manual of Examining Procedure*, *Trademark Trial and Appeal Board Manual of Procedure*, *Acceptable Identification of Goods and Services Manual*, *Federal Register* notices, *Official Gazette* notices, examination guides, fee schedules, and certain USPTO forms.

Certified or uncertified copies of trademark documents can be purchased over the Internet. See TMEP §111 for further information.

### **103 Trademark Forms**

Trademark documents can be filed electronically through TEAS, on the USPTO website at <http://www.uspto.gov/teas/index.html>. TEAS can be used to file an application for registration of a mark, response to an examining attorney's Office action; amendment to allege use under 15 U.S.C. §1051(c); statement of use under 15 U.S.C. §1051(d); request for extension of time to file a statement of use under 15 U.S.C. §1051(d)(2); affidavit of continued use under 15 U.S.C. §1058; affidavit of incontestability under 15 U.S.C. §1065; combined affidavit under 15 U.S.C. §§1058 and 1065; combined filing under 15 U.S.C. §§1058 and 1059; notice of change of address; petition to revive an abandoned application; appointment or revocation of attorney or domestic

## GENERAL INFORMATION

representative; withdrawal of attorney in pending application; or request for express abandonment of an application. See TMEP §301 for more information about electronic filing. Additional forms may be available online at [www.uspto.gov](http://www.uspto.gov), or through the Trademark Assistance Center (see TMEP §108.02).

Requests for recordation of assignments and other documents affecting title to an application or registration can be filed through the Electronic Trademark Assignment System (“ETAS”) on the USPTO website at <http://etas.uspto.gov>.

The Electronic System for Trademark Trials and Appeals (“ESTTA”), at <http://estta.uspto.gov>, can be used to file requests for extensions of time to oppose, notices of opposition, notices of change of address, motions, briefs, and other papers in opposition and cancellation proceedings.

### 104 Trademark Searching

X-Search, the USPTO's computerized search system, contains text and images of registered marks, and marks in pending and abandoned applications. X-Search is used by examining attorneys when searching for conflicting marks during examination.

The public may conduct searches free of charge using TESS, on the USPTO website at <http://www.uspto.gov>. Like X-Search, TESS provides access to text and images of registered marks, and marks in pending and abandoned applications. Additional information, including current status, for pending and registered trademarks can be obtained by entering the trademark serial number or registration number in the TARR database. See TMEP §108.01. TESS and TARR are available in Patent and Trademark Depository Libraries (“PTDLs”) (see TMEP §112). X-Search is also available for public use in some of the PTDLs.

The public may also use the X-Search system and the Trademark Reporting and Monitoring (“TRAM”) System without charge in the Trademark Search Library. The Search Library is located on the first floor of the James Madison Building - East Wing, 600 Dulany Street, Alexandria, Virginia, and is open from 8:00 a.m. to 8:00 p.m. Eastern Standard Time, Monday through Friday, except on holidays. The Trademark Search Library also contains paper copies of registered marks and marks in pending applications, copies of State emblems and official signs and hallmarks of member countries of the Paris Convention for the Protection of Industrial Property, which are protected under Article 6*ter* of the Convention (see TMEP §1205.02), and copies of the official insignia of state and federally recognized Native American tribes.



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If a mark includes a design element, it can be searched by using a design code. To locate the proper design code(s), the public can use the *Design Search Code Manual* on the USPTO website at <http://www.uspto.gov>.

USPTO personnel cannot conduct trademark searches for the public. Private trademark search firms will conduct searches for a fee. The USPTO cannot aid in the selection of a search firm or an attorney. 37 C.F.R. §2.11. Search firms are often listed in the yellow page section of telephone directories under the heading "Trademark Search Services" or "Patent and Trademark Search Services."

The public can search the trademark assignment records of the Assignment Services Division on the USPTO website at <http://assignments.uspto.gov/assignments>. In addition, there is a Trademark Assignment Search Room in the Trademark Search Library that maintains records of transactions affecting the ownership of marks.

### **105 General Information Booklet Concerning Trademarks**

The booklet entitled *Basic Facts About Trademarks* contains information and instructions for registering a trademark or service mark. The booklet can be accessed or downloaded from the USPTO website at <http://www.uspto.gov/>, or may be obtained by calling the Trademark Assistance Center. See TMEP §108.02 regarding the Trademark Assistance Center.

### **106 The Official Gazette**

The *Official Gazette*, issued every Tuesday, is a publication of the USPTO. Since February 2, 1971, the *Official Gazette* has been separated into two parts, one designated the *Patent Official Gazette* and the other the *Trademark Official Gazette*.

The *Trademark Official Gazette* ("TMOG") contains an illustration of each mark published for opposition on the Principal Register, marks registered on the Principal Register under 15 U.S.C. §1051(d), and marks registered on the Supplemental Register on the date of the particular issue in which the marks appear.

The TMOG also includes general information such as notices of changes in rules or Office procedures; notices to parties who cannot be reached by mail; and indices of trademark registrations issued, renewed, cancelled, amended or corrected on the date of the particular issue in which the marks appear, with an index of registrants.

Effective July 15, 2003, the USPTO publishes the TMOG only in electronic format. See notice at 68 Fed. Reg. 37803 (June 25, 2003), at <http://www.uspto.gov/web/offices/com/sol/notices/68fr37803.pdf>. However, annual subscriptions or single copies of the TMOG in hard copy (Stock No.

## GENERAL INFORMATION

703-034-00000-4) may still be purchased from the United States Government Printing Office (“GPO”) at <http://bookstore.gpo.gov>. GPO’s general information telephone numbers are (202) 512-1800 and (866) 512-1800.

### **107 Trademark Manuals**

The following manuals may be downloaded free of charge from the USPTO website at <http://www.uspto.gov>:

- *Trademark Manual of Examining Procedure* (“TMEP”)
- *Trademark Trial and Appeal Board Manual of Procedure* (“TBMP”)
- *Acceptable Identification of Goods and Services Manual*

The TMEP may also be purchased from GPO at <http://bookstore.gpo.gov>. GPO’s general information telephone numbers are (202) 512-1800 and (866) 512-1800.

### **108 Status Inquiries**

#### **108.01 Internet Information**

The TARR database on the USPTO website at <http://tarr.uspto.gov> provides detailed, up to the minute information about the status and prosecution history of trademark applications and registrations. The TARR database is available 24 hours a day, 7 days a week.

#### **108.02 Personal Telephone Assistance**

If additional information regarding the status of an application or registration is required, callers may telephone the Trademark Assistance Center (“TAC”) at (571) 272-9250 or (800) 786-9199 and request a status check. TAC also provides general information about the trademark registration process. TAC is open from 8:30 a.m. to 5:00 p.m. Eastern Standard Time, Monday through Friday, except on holidays.

The Trademark Assistance Center will gladly answer questions about the application process. However, USPTO employees cannot:

- conduct trademark searches for the public (see TMEP §104);
- comment on the validity of registered marks (see TMEP §1801);
- answer questions on whether a particular mark or type of mark is eligible for trademark registration;

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- offer legal advice or opinions about common law trademark rights, state registrations, or trademark infringement claims; or
- aid in the selection of a private trademark attorney or search firm (37 C.F.R. §2.11).

See TMEP Chapter 1800 regarding public inquiries about applications and registrations.

### **108.03 Due Diligence: Duty to Monitor Status**

Trademark applicants and registrants should monitor the status of their applications or registrations in cases where a notice or action from the USPTO is expected. Inquiries regarding the status of pending matters should be made during the following time periods:

- (1) During the pendency of an application, an applicant should check the status of the application every six months between the filing date of the application and issuance of a registration; and
- (2) After filing an affidavit of use or excusable nonuse under §8 or §71 of the Trademark Act, or a renewal application under §9 of the Act, a registrant should check the status of the registration every six months until the registrant receives notice that the affidavit or renewal application has been accepted.

Should the status inquiry reveal that a paper is lost, or that some other problem exists, the applicant or registrant must promptly request corrective action. 37 C.F.R. §2.146(i). Failure to act diligently and follow up with appropriate action may result in denial of the requested relief. The USPTO may deny petitions to reactivate abandoned applications and cancelled registrations when a party fails to inquire about the status of a pending matter within a reasonable time. See TMEP §§1705.05 and 1714.01(d).

Written status inquiries are discouraged, because they can delay processing. Whenever possible, status inquiries should be made through the TARR database. If additional information regarding the status of an application or registration is required, callers may telephone the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199.

### **109 Access to Files**

*18 U.S.C. §2071. Concealment, removal, or mutilation generally.*

*(a) Whoever willfully and unlawfully conceals, removes, mutilates, obliterates, or destroys, or attempts to do so, or, with intent to do so takes and carries away any record, proceeding, map, book, paper, document, or other thing, filed or deposited with any clerk or officer of any court of the United*

## GENERAL INFORMATION

*States, or in any public office, or with any judicial or public officer of the United States, shall be fined under this title or imprisoned not more than three years, or both.*

*(b) Whoever, having the custody of any such record, proceeding, map, book, document, paper, or other thing, willfully and unlawfully conceals, removes, mutilates, obliterates, falsifies, or destroys the same, shall be fined under this title or imprisoned not more than three years, or both; and shall forfeit his office and be disqualified from holding any office under the United States. As used in this subsection, the term “office” does not include the office held by any person as a retired officer of the Armed Forces of the United States.*

*37 C.F.R. §2.27(b). Except as provided in paragraph (e) of this section, access to the file of a particular pending application will be permitted prior to publication under §2.80 upon written request.*

*37 C.F.R. §2.27(d). Except as provided in paragraph (e) of this section, after a mark has been registered, or published for opposition, the file of the application and all proceedings relating thereto are available for public inspection and copies of the papers may be furnished upon paying the fee therefor.*

*37 C.F.R. §2.27(e). Anything ordered to be filed under seal pursuant to a protective order issued or made by any court or by the Trademark Trial and Appeal Board in any proceeding involving an application or registration shall be kept confidential and shall not be made available for public inspection or copying unless otherwise ordered by the court or the Board, or unless the party protected by the order voluntarily discloses the matter subject thereto. When possible, only confidential portions of filings with the Board shall be filed under seal.*

### **109.01            Electronic Image Files**

The public may view and print images of the contents of trademark application and registration files through the Trademark Document Retrieval (“TDR”) portal on the USPTO website at <http://www.uspto.gov>. Electronic images of TTAB proceeding files are also available on the USPTO website at <http://ttabvue.uspto.gov/ttabvue/>. TDR and TTABVUE are available 24 hours a day, seven days a week, free of charge.

The public can also view and print images of the contents of trademark application and registration files through the Trademark Image Capture and Retrieval System (“TICRS”), available in the Trademark Search Library on the USPTO premises. See TMEP §402.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 109.02 Paper Files

In order to inspect the contents of a trademark file, it is not necessary to show good cause or to have a power to inspect from the applicant or registrant.

*Procedure for Requesting Files.* A member of the public must make a request for access to the file. The request must include the name and phone number of the person requesting the file. USPTO personnel must keep a record of all files being removed, and enter the new location of the file (e.g., charged to non-USPTO personnel) in the TRAM database. The public must inspect the file on the premises of the USPTO, and nothing may be removed from the file without written authorization from the Office of the Commissioner for Trademarks. Requests for files should be made at the following locations:

- *Files Located Within the Trademark Operation or at the Trademark Trial and Appeal Board.* A request for access to a paper file that is located within the Trademark Operation or at the Trademark Trial and Appeal Board should be directed to TAC, located at the James Madison Building - East Wing, Concourse Level, 600 Dulany Street, Alexandria, VA, between 8:30 a.m. and 5:00 p.m. This includes files located in the law offices, Publication and Issue Section, Pre-Examination Section, ITU Unit, and Post Registration Section. These files will normally be available within approximately two hours from the time the files are requested. However, there may be instances when a file is not immediately available. See *Official Gazette* noticed dated April 6, 2004, posted at [http://www.uspto.gov/web/trademarks/notice\\_paperfiles.htm](http://www.uspto.gov/web/trademarks/notice_paperfiles.htm).
- *Files Located at the Warehouse.* Requests for access to paper files located at the warehouse should be directed to the Trademark Search Library, located on the first floor of the James Madison Building - East Wing, 600 Dulany Street, Alexandria, Virginia, between 8:30 a.m. and 5:00 p.m. This includes files for abandoned applications, cancelled and expired registrations, and terminated Trademark Trial and Appeal Board proceedings. The file will usually be available to the requester within a few days.

The public can check TRAM or TARR to determine where a file is located.

An unsent letter or draft is not part of the file. USPTO personnel should ensure that such material is removed before making the file available to a member of the public.

Paper files for abandoned applications and cancelled and expired registrations are stored in the warehouse for two years after the date of abandonment, and then destroyed. See TMEP §718.07. See notice at 980 TMOG 16, reprinted at 1232 TMOG 625 (March 21, 2000). See TBMP

## GENERAL INFORMATION

§120.03 regarding the retention schedule for the files of terminated Board proceedings.

No file or related document may be removed from the premises occupied by the USPTO, except as required by the issue process or other official process, unless specifically authorized by the Director. 18 U.S.C. §2071(b). If such authorization is given, the employee having custody will be responsible for conforming with the requirements of law.

### **109.03 Making Copies of Materials in Files**

The public may print images of the contents of trademark application, registration, and TTAB proceeding files through TDR or TTABVUE on the USPTO website at <http://www.uspto.gov>. See TMEP §109.01. The public can also print electronic copies of applications or registrations through TESS (see TMEP §104), and prosecution histories through TARR (see TMEP §108.01) on the USPTO website. There is no charge for use of these databases.

The public can also print trademark documents from TICRS, TTABVUE, TARR or X-Search in the Trademark Search Library on the USPTO premises. There is a fee for printing images of documents in the Trademark Search Library. See TMEP §104.

Photocopiers for making copies of paper files are available to the public on the premises of the USPTO for a fee.

See TMEP §111 regarding requests that the USPTO provide copies of trademark documents.

### **110 Decisions Available to the Public**

*37 C.F.R. §2.27(c). Decisions of the Director and the Trademark Trial and Appeal Board in applications and proceedings relating thereto are published or available for inspection or publication.*

Precedential decisions of the Director and the Trademark Trial and Appeal Board are noted as such and published in the United States Patents Quarterly (cited as USPQ or USPQ2d), which is a periodical reporting service of a non-governmental publishing company. The USPTO does not print these decisions in its own publications. Non-precedential decisions of the Director and the Trademark Trial and Appeal Board are not published.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

A weekly summary of final decisions issued by the Trademark Trial and Appeal Board appears on the USPTO's website at [www.uspto.gov](http://www.uspto.gov) and in each issue of the TMOG.

See TMEP §1803 regarding decisions that are available under the Freedom of Information Act.

### 111 Requests for Copies of Trademark Documents

The public may print images of the contents of trademark application, registration, and TTAB proceeding files through TDR or TTABVUE on the USPTO website at <http://www.uspto.gov>. See TMEP §109.01. The public can also print electronic copies of applications or registrations through TESS (see TMEP §104), and prosecution histories through TARR (see TMEP §108.01) on the USPTO website. There is no charge for use of these databases.

The public may purchase certified or uncertified copies of trademark documents (e.g., application or registration records, trademark title and status reports, etc.). Fee schedules are posted on the USPTO's website. Requests for copies of trademark documents are handled by the Certification Division of the Office of Public Records.

Copies of trademark documents can be ordered through the USPTO's website at [www.uspto.gov](http://www.uspto.gov), for delivery by the United States Postal Service. The fee must be paid by credit card, EFT, or deposit account authorization. Requests for copies of trademark documents may also be e-mailed to [dsd@uspto.gov](mailto:dsd@uspto.gov), with an authorization to charge the fee to a credit card or deposit account.

Requests for certified or uncertified copies of trademark documents may be mailed to: Mail Stop Document Services, Director of the United States Patent and Trademark Office, P. O. Box 1450, Alexandria VA 22313-1450. 37 C.F.R. §2.190(d).

### 112 Patent and Trademark Depository Libraries

There is a network of PTDLs throughout the United States that provides access to many of the same products and services offered at the USPTO. A list of the PTDLs and their telephone numbers appears on the USPTO website at <http://www.uspto.gov> and is printed in each issue of the TMOG.

Information available free of charge at the PTDLs includes the text of the trademark statute and rules (see TMEP §101), the *Trademark Manual of Examining Procedure*; *Trademark Trial and Appeal Board Manual of Procedure*; *Acceptable Identification of Goods and Services Manual*, and the Trademark Electronic Search System. Photocopiers are generally provided for a fee.

## **GENERAL INFORMATION**

The scope of PTDL collections, hours of operation, services and fees (where applicable) may vary from one library to another.



# Chapter 200

## Application Filing Date

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### **201 What Constitutes Filing Date**

- 201.01 Effective Filing Date Controls for Purposes of Determining Priority for Publication or Issue
- 201.02 Constructive Use Priority

### **202 Requirements for Receiving a Filing Date**

- 202.01 Clear Drawing of the Mark
- 202.02 Listing of Recognizable Goods or Services
- 202.03 Filing Fee for At Least One Class of Goods or Services
  - 202.03(a) Fee Payment Refused or Charged Back By Financial Institution
    - 202.03(a)(i) Processing Fee for Payment Refused or Charged Back By Financial Institution

### **203 Review for Compliance With Minimum Requirements**

### **204 Defective or Informal Applications**

- 204.01 Filing Date Cancelled if Minimum Filing Requirements not Met
- 204.02 Resubmission of Defective Papers
- 204.03 Examining Attorney's Handling of Applications That Are Erroneously Accorded a Filing Date

### **205 Filing Date Is Not Normally Changed**

### **206 Effective Filing Date**

- 206.01 Amendment of §1(b) Application from Principal Register to Supplemental Register upon Filing of Allegation of Use
- 206.02 Application Claiming Priority under §44(d) or §67
- 206.03 Applications Filed Before November 16, 1989, That Are Amended to the Supplemental Register on or After November 16, 1989

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 201 What Constitutes Filing Date

In an application under §1 or §44 of the Trademark Act, 15 U.S.C. §1051 or §1126, the filing date of an application is the date on which all the elements set forth in 37 C.F.R. §2.21(a) (see TMEP §202) are received in the United States Patent and Trademark Office (“USPTO”).

In a request for an extension of protection of an international registration to the United States under §66(a) of the Trademark Act, 15 U.S.C. §1141f(a), the filing date is (1) the international registration date, if the request for extension of protection to the United States is made in an international application; or (2) the date that the subsequent designation was recorded by the International Bureau of the World Intellectual Property Organization (“IB”), if the request for extension of protection to the United States is made in a subsequent designation. 15 U.S.C. §1141f(b); 37 C.F.R. §7.26. See TMEP §§1904 *et seq.* for further information about §66(a) applications.

Granting a filing date to an application does not necessarily mean that all requirements for registration have been satisfied. The applicant must comply with requirements issued by the examining attorney during examination, in accordance with applicable rules and statutes, in order to obtain a registration.

#### 201.01 Effective Filing Date Controls for Purposes of Determining Priority for Publication or Issue

The filing date of an application (see TMEP §201) is also the *effective* filing date, *except* where (1) the applicant is entitled to priority under 15 U.S.C. §1126(d) or §1141g (see TMEP §206.02); (2) the applicant amends an intent-to-use application filed under 15 U.S.C. §1051(b) to the Supplemental Register (see TMEP §206.01); or (3) the application was filed before November 16, 1989, the applicant had not used the mark in commerce for one year before the application filing date, and the applicant amends to the Supplemental Register on or after November 16, 1989 (see TMEP §206.03). The effective filing date is controlling for purposes of determining priority for publication or issue (see TMEP §1208.01) and constructive use priority (see TMEP §201.02).

#### 201.02 Constructive Use Priority

Under 15 U.S.C. §§1057(c) and 1141f(b), filing *any* application for registration on the Principal Register, including an intent-to-use application, constitutes constructive use of the mark, provided the application matures into a registration. Upon registration, filing affords the applicant nationwide priority over others, except: (1) parties who used the mark before the applicant’s filing date; (2) parties who filed in the USPTO before the applicant; or (3) parties who are entitled to an earlier priority filing date based on the filing

## APPLICATION FILING DATE

of a foreign application under 15 U.S.C. §1126(d) or §1141g (see TMEP §206.02). See *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991).

### **202 Requirements for Receiving a Filing Date**

Under 37 C.F.R. §2.21(a), the USPTO will grant a filing date to an application under §1 or §44 of the Trademark Act that contains all of the following:

- (1) the name of the applicant;
- (2) a name and address for correspondence;
- (3) a clear drawing of the mark;
- (4) a listing of the goods or services; and
- (5) the filing fee for at least one class of goods or services.

If the application does not satisfy all the above requirements, it will not be given a filing date. The USPTO will notify the applicant of the reason(s) why the application was not given a filing date, and refund the application filing fee.

Applications that do not meet the minimum requirements for receipt of a filing date are referred to as “informal.” See TMEP §203 regarding review for compliance with minimum filing requirements, and TMEP §§204 *et seq.* for information about how the USPTO handles informal applications.

In an application under §66(a) of the Trademark Act, 15 U.S.C. §1141f(a), compliance with the minimum filing requirements of §66(a) of the Act will be determined by the IB prior to sending the request for extension of protection of an international registration to the United States to the USPTO. See TMEP §§1904 *et seq.* for further information about §66(a) applications.

### **202.01 Clear Drawing of the Mark**

In a §66(a) application, the drawing must meet the requirements of the Madrid Protocol and Madrid Common Regulations. The IB will determine whether the drawing meets these requirements before sending the application to the USPTO. See TMEP §§1904 *et seq.* for further information about §66(a) applications.

Under 37 C.F.R. §2.21(a)(3), a §1 or §44 applicant must submit “a clear drawing of the mark” to receive a filing date. A separate drawing page (or digital image of a separate drawing page in an application filed through the Trademark Electronic Application System (“TEAS”)) is not mandatory, but is encouraged.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

An application that includes two or more drawings displaying materially different marks does not meet the requirement for a “clear drawing of the mark.” Therefore, an application is denied a filing date if the applicant submits two or more drawings displaying materially different marks. See *Humanoids Group v. Rogan*, 375 F.3d 301, 71 USPQ2d 1745 (4<sup>th</sup> Cir. 2004).

However, if an applicant submits a separate drawing page showing a mark, and a different mark appears in the written application, the drawing will control for purposes of determining what the mark is. The USPTO will grant a filing date to the application, and disregard the mark in the written application. The applicant will not be permitted to amend the mark if the amendment is a material alteration of the mark on the drawing page. *In re L.G. Lavorazioni Grafite S.r.l.*, 61 USPQ2d 1063 (Dir USPTO 2001). See 37 C.F.R. §2.72 and TMEP §§807.14 *et seq.* regarding material alteration of a mark.

A specimen showing the mark does not satisfy the requirement for a drawing. If the only depiction of the mark is on the specimen, then there is no drawing, and the application will be denied a filing date.

See TMEP §§807 *et seq.* for additional information about the examination of drawings.

See *also* TMEP §204.03 regarding the examining attorney’s handling of applications that are erroneously granted a filing date.

### **202.02 Listing of Recognizable Goods or Services**

The USPTO will deny a filing date to an application under §1 or §44 of the Trademark Act if the application does not identify recognizable goods or services. See TMEP §1402.02 for further information.

### **202.03 Filing Fee for At Least One Class of Goods or Services**

Under 37 C.F.R. §2.21(a)(5), in an application under §1 or §44 of the Trademark Act, the applicant must pay the filing fee for at least one class of goods or services before an application can be given a filing date. The fee can be paid by credit card, check, money order, electronic funds transfer (“EFT”), or by an authorization to charge a deposit account. 37 C.F.R. §2.207. See TMEP §§405 *et seq.* for additional information about fees.

The amount of the trademark application filing fee varies depending whether the application is filed through TEAS or on paper. It is less expensive to file through TEAS. See notice at 70 Fed. Reg. 2952 (Jan. 19, 2005). The current fee schedule is available on the USPTO website at <http://www.uspto.gov>.

The complete fee for at least a single class must be submitted with the application as filed. Partial or piecemeal fee payments are unacceptable and will be refunded.

## APPLICATION FILING DATE

If an application does not include a filing fee for at least a single class, the USPTO will deny a filing date. *In re Buckhead Marketing & Distribution, Inc.*, 71 USPQ2d 1620 (Dir USPTO 2004); *In re Paulsen*, 35 USPQ2d 1638 (Comm'r Pats. 1995). If a filing date has been granted when the USPTO discovers that the applicant has not paid the filing fee for at least a single class, the filing date will be cancelled. See TMEP §204.01.

See TMEP §§202.03(a) and 405.06 regarding payments that are refused or charged back by financial institutions, and TMEP §405.03 regarding deposit accounts.

The filing fee for a §66(a) application will be sent to the USPTO by the IB, pursuant to Article 8 of the Madrid Protocol. Generally, the examining attorney should not require additional fees during examination. See TMEP §§1904 *et seq.* for further information about §66(a) applications.

### **202.03(a) Fee Payment Refused or Charged Back By Financial Institution**

Where a check submitted as payment of an application filing fee is returned to the USPTO unpaid, or an EFT or credit card payment is refused or charged back by a financial institution, the application is treated as though the fee had never been paid.

If the original application was accompanied by an authorization to charge fee deficiencies to a deposit account (37 C.F.R. §2.208), then the application filing fee and the \$50 processing fee required by 37 C.F.R. §2.6(b)(12) (see TMEP §§202.03(a)(i) and 405.06) are charged to the deposit account, and the original filing date remains unchanged.

However, if the original application was not accompanied by an authorization to charge deficient fees to a deposit account, and the applicant has not paid the filing fee for at least one class of goods or services, the filing date is void and will be cancelled. *In re Paulsen*, 35 USPQ2d 1638 (Comm'r Pats. 1995).

In some cases, the applicant will have resubmitted the fee before the USPTO discovers that the payment was refused. In these cases, the USPTO will change the filing date to the date when the fee for a single class of goods or services was resubmitted.

In a multi-class application, if the fee for at least a single class has been paid, but the payment of the filing fee for additional class(es) is refused, the filing date of the application is not affected. The applicant must (1) resubmit the fee for the additional class(es), or delete the additional class(es); and (2) pay the \$50 processing fee required by 37 C.F.R. §2.6(b)(12). The applicant must pay the processing fee even if the applicant chooses to delete the additional class(es).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

See TMEP §§202.03(a)(i) and 405.06 regarding payments refused by financial institutions, and TMEP §204.03 regarding the examining attorney's handling of applications that are erroneously granted a filing date.

### **202.03(a)(i) Processing Fee for Payment Refused or Charged Back By Financial Institution**

Under 37 C.F.R. §2.6(b)(12), there is a \$50 fee for processing any payment refused (including a check returned unpaid) or charged back by a financial institution. See TMEP §405.06. However, this is not a filing date requirement. If an applicant resubmits the filing fee without paying the processing fee, the USPTO will give the application a filing date as of the date of resubmission, and the examining attorney will require submission of the processing fee during examination.

### **203 Review for Compliance With Minimum Requirements**

In applications under §66(a) of the Trademark Act, 15 U.S.C. §1141f(a), the IB will determine whether the application complies with §66(a) prior to sending the request for extension of protection of an international registration to the USPTO. See TMEP §§1904 *et seq.* for further information about §66(a) applications.

Applications under §1 or §44 of the Act are given a receipt date (see TMEP §303.01) and then reviewed for compliance with the minimum requirements for receipt of a filing date (see 37 C.F.R. §2.21(a) and TMEP §202 for a list of these requirements).

If the minimum requirements of 37 C.F.R. §2.21 have been met, the USPTO assigns a filing date as of the date of receipt in the USPTO. See TMEP §§401 *et seq.* regarding the processing of new applications that meet the minimum requirements for receipt of a filing date, and TMEP §§204 *et seq.* regarding the processing of applications that do not meet the minimum requirements for receipt of a filing date.

The minimum requirements for receipt of a filing date under 37 C.F.R. §2.21(a) apply to all applications under §§1 and 44 of the Act, whether filed electronically or on paper. When an application is filed electronically, the TEAS system will not accept the transmission if the fields corresponding to the minimum filing requirements are not filled in. However, if the fields are filled in with incomplete or inappropriate information, the TEAS system will accept the transmission, but the USPTO will deny the application a filing date upon review for compliance with minimum filing requirements. For example, if the goods and services were identified as "all services in Class 42," TEAS would accept the transmission, but the USPTO would not give the application a filing date (see TMEP §§202.02 and 1402.02).

## APPLICATION FILING DATE

### **204 Defective or Informal Applications**

If an application under §1 or §44 of the Trademark Act does not meet the minimum requirements for receipt of a filing date set forth in 37 C.F.R. §2.21(a) (see TMEP §202), the application is void. These applications are also referred to as “incomplete” or “informal.”

#### **204.01 Filing Date Cancelled if Minimum Filing Requirements not Met**

Applications under §1 or §44 of the Trademark Act are labeled with a receipt date and then reviewed for compliance with the minimum requirements for receipt of a filing date set forth in 37 C.F.R. §2.21(a). If the minimum filing requirements have not been met, the USPTO denies a filing date, refunds the filing fee, and notifies the applicant of the reason(s) why the filing date was denied. If a filing date has been granted and a serial number has been assigned to the application, the USPTO cancels the filing date and serial number, and sends a notice to the applicant explaining why the application is defective.

See TMEP §1711 regarding the procedures for requesting review by the Office of the Commissioner for Trademarks of the denial of a filing date.

#### **204.02 Resubmission of Defective Papers**

The USPTO recommends that all applications be filed through TEAS. However, if the USPTO denies a filing date in a paper application, the applicant may resubmit the original papers or a copy of the original papers, together with the item(s) necessary to correct the defect(s). The original check for the filing fee may be resubmitted unless it is more than six months old, in which case it is considered to be “stale.” *A filing fee for at least a single class of goods or services must be included when the applicant resubmits an application, even if the applicant has not yet received a refund of the fee previously submitted.*

The new filing date will be the date on which a complete application, including all elements required by 37 C.F.R. §2.21(a), is received in the USPTO. There is no time limit for resubmitting papers, except that a claim of priority under 15 U.S.C. §1126(d) must be submitted within six months of the filing date of the foreign application. 37 C.F.R. §2.34(a)(4)(i); TMEP §1003.02.

#### **204.03 Examining Attorney’s Handling of Applications That Are Erroneously Accorded a Filing Date**

Sometimes an application under §1 or §44 that does not meet the minimum requirements of 37 C.F.R. §2.21 for receipt of a filing date is erroneously referred to an examining attorney for examination. In this situation, if the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

examining attorney discovers the error *before* issuing an action in the case, then the examining attorney should have the application declared informal. The USPTO will cancel the filing date and refund the filing fee. See TMEP §204.01.

If, however, an examining attorney discovers *after* issuing an action that the application as filed did not meet the minimum requirements for receipt of a filing date, then the examining attorney should issue a supplemental Office action, refusing registration on the ground that the application was not eligible to receive a filing date. Any outstanding refusals and requirements should be maintained and incorporated into the supplemental Office action. The applicant should be given six months to comply with all filing date requirements. If the applicant fails to qualify for a filing date within the response period, the application is void. The examining attorney should have the filing fee refunded and update the USPTO's automated records to indicate that the application is abandoned.

If the applicant complies with the filing date requirements within the six-month period, the application will receive a new filing date as of the date on which the applicant satisfied all the minimum filing date requirements. In such a case, the examining attorney must conduct a new search of Office records for conflicting marks, and issue a another Office action if necessary.

### **205 Filing Date Is Not Normally Changed**

After an application has been given a filing date, the USPTO will normally not vacate the filing date or physically alter the designation of the original filing date in the Trademark Reporting and Monitoring ("TRAM") System, except where the application as originally filed was erroneously accorded a filing date (see TMEP §204.03).

In an application under §1 or §44 of the Trademark Act, if the application met the minimum requirements for receipt of a filing date (see TMEP §202) when originally filed, but during examination it is discovered that the applicant did not have a right to apply on the assigned filing date (*e.g.*, because the applicant did not own the mark), the application is *void*, because a valid application was not created. See TMEP §§803.06 and 1201.02(b). The USPTO will *not* refund the filing fee in such a case. If, subsequent to the assigned filing date, the applicant became eligible to apply, the applicant may file a new application, including a filing fee.

### **206 Effective Filing Date**

The filing date of an application (see TMEP §201) is also the *effective* filing date, *except* in the situations described in the subsections below. In these situations, the USPTO does not alter the original filing date in its automated records.



## APPLICATION FILING DATE

If the effective filing date is subsequent to the date on which the examining attorney searched Office records for conflicting marks, the examining attorney must conduct another search.

### **206.01            Amendment of §1(b) Application from Principal Register to Supplemental Register upon Filing of Allegation of Use**

An applicant relying on a bona fide intention to use the mark in commerce under 15 U.S.C. §1051(b) may not seek registration on the Supplemental Register until the applicant has submitted an acceptable amendment to allege use under 15 U.S.C. §1051(c) or statement of use under 15 U.S.C. §1051(d). 37 C.F.R. §§2.47(d) and 2.75(b).

If an application is based solely on §1(b), and the applicant files an acceptable amendment to allege use or statement of use *and* an acceptable amendment to the Supplemental Register, the USPTO will consider the filing date of the amendment to allege use or statement of use to be the effective filing date of the application. 37 C.F.R. §2.75(b). The examining attorney must conduct a new search of Office records for conflicting marks.

See TMEP §§816.02 and 1102.03 for additional information about examination of intent-to-use applications on the Supplemental Register.

### **206.02            Application Claiming Priority under §44(d) or §67**

When an applicant is entitled to priority in view of a foreign application, the effective filing date is the date on which the foreign application was first filed in the foreign country. The priority claim for the United States application must be filed within six months after the filing date of the foreign application. 15 U.S.C. §§1126(d)(1) and 1141g; 37 C.F.R. §§2.34(a)(4)(i) and 7.27(c); TMEP §§1003.02 and 1904.01(e).

In application under §44(d) of the Trademark Act, the applicant can submit a priority claim after the filing date of the United States application if: (1) the applicant submits the priority claim within the six-month priority period (37 C.F.R. §2.35(b)(5)), and (2) the applicant was entitled to priority on the filing date of the United States application.

In an application under §66(a) of the Act, the priority claim must be set forth in the international application or subsequent designation filed with the IB. The priority claim will be part of the request for extension of protection sent to the USPTO by the IB. TMEP §1904.01(e).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **206.03 Applications Filed Before November 16, 1989, That Are Amended to the Supplemental Register on or After November 16, 1989**

In an application filed before November 16, 1989, the date of the amendment to the Supplemental Register becomes the effective filing date of the application if: (1) the applicant had not used the mark in commerce for one year before the application filing date; and (2) the applicant amends to the Supplemental Register on or after November 16, 1989. See TMEP §816.02.

# Chapter 300

## Filing and Receipt of Documents

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### **301 Trademark Electronic Application System**

### **302 Trademark Correspondence and Signature Requirements - In General**

302.01 Original Documents Generally Not Required

302.02 Multiple Copies of Papers Should Not Be Filed

302.03 Identifying the Nature of Papers Filed

302.03(a) Correspondence Pertaining to Trademark Applications

302.03(b) Correspondence Pertaining to Trademark Registrations

### **303 Receipt of Documents by the Office**

303.01 Date of Receipt

303.02 Acknowledgment of Receipt

303.02(a) Electronic Mail Confirmation of Receipt of TEAS Document

303.02(b) "Office Date" Label Showing Receipt

303.02(c) Postcard Receipt

303.02(c)(i) Postage on Return Receipt Postcards

### **304 Electronic Mail**

304.01 Communications Acceptable Via Electronic Mail

304.02 Communications *Not* Acceptable Via Electronic Mail

304.03 Authorization of Electronic Mail Communications From the USPTO

304.04 Filing Date of Electronic Mail

304.05 Certificate of Transmission by Electronic Mail

304.06 Outgoing Electronic Mail

304.07 Signature of Electronic Mail

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- 304.08 E-Mail Addresses for Correspondence With the Office
- 304.09 Paper "Confirmation" Copies of E-Mail Communications Should Not Be Sent to the Office

### **305 Mailing Documents to the Office**

- 305.01 Mailing Addresses
- 305.02 Certificate of Mailing Procedure
  - 305.02(a) When Certificate of Mailing Procedure May Not Be Used
  - 305.02(b) Mailing Requirements
  - 305.02(c) Location and Form of Certificate
  - 305.02(d) Wording of Certificate of Mailing
  - 305.02(e) Effect of Certificate of Mailing
  - 305.02(f) Correspondence Mailed Pursuant to 37 C.F.R. §2.197 But Not Received by Office
  - 305.02(g) Correspondence Deposited as First Class Mail Pursuant to 37 C.F.R. §2.197 and Returned by the U.S. Postal Service
  - 305.02(h) Certificate of Mailing Requirements Strictly Enforced
- 305.03 "Express Mail"
- 305.04 Interruptions in U.S. Postal Service

### **306 Facsimile Transmission (Fax)**

- 306.01 Documents That May Not Be Filed by Facsimile Transmission
- 306.02 Fax Machines Designated to Accept Relevant Trademark Documents
- 306.03 Effect of Filing by Fax
- 306.04 Procedure for Filing by Fax
- 306.05 Certificate of Transmission Procedure
  - 306.05(a) Location and Form of Certificate of Transmission
  - 306.05(b) Wording of Certificate of Transmission
  - 306.05(c) Effect of Certificate of Transmission
  - 306.05(d) Correspondence Transmitted by Fax Pursuant to 37 C.F.R. §2.197 But Not Received by Office
- 306.06 Requirements for Certificate of Transmission Strictly Enforced

## FILING AND RECEIPT OF DOCUMENTS

- 307 Hand Delivery**
- 308 Period Ending on Saturday, Sunday or Federal Holiday**
- 309 Unscheduled Closings of the United States Patent and Trademark Office**
- 310 Computing Period for Response to Office Action or Notice**

### **301 Trademark Electronic Application System**

The Trademark Electronic Application System (“TEAS”) makes electronic filing available on the United States Patent and Trademark Office (“USPTO”) website, at <http://www.uspto.gov>. TEAS can be used to file:

- Applications for registration of marks;
- Amendments to allege use under 15 U.S.C. §1051(c);
- Statements of use under 15 U.S.C. §1051(d);
- Requests for extensions of time to file a statement of use under 15 U.S.C. §1051(d)(2);
- Affidavits of continued use under 15 U.S.C. §1058;
- Affidavits of incontestability under 15 U.S.C. §1065;
- Combined affidavits under 15 U.S.C. §§1058 and 1065;
- Combined filings under 15 U.S.C. §§1058 and 1059;
- Responses to examining attorneys’ Office actions in applications based on §§1 and 44. NOTE: Responses to examining attorneys’ Office actions in §66(a) applications cannot be filed through TEAS;
- Preliminary amendments;
- Notices of change of correspondence address;
- Notices of change of owner’s address;
- Petitions to revive abandoned applications;
- Appointment or revocation of attorney or domestic representative;
- Withdrawal of attorney in pending application;
- Requests for express abandonment (withdrawal) of applications.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

When a document is filed electronically, the USPTO receives it within seconds after filing, and immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission. This confirmation is evidence of filing should any question arise as to the filing date of the document. Also, electronic filing creates an automatic entry of receipt of this filing into the USPTO's automated system, helping to avoid improper abandonment or cancellation.

Applications filed electronically are less expensive, and are examined much faster than their paper counterparts.

Under 37 C.F.R. §2.195(a)(2), correspondence transmitted electronically using TEAS is considered filed on the date the USPTO receives the transmission, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia.

TEAS is available 24 hours a day, 7 days a week. However, during the hours between 12:00 a.m. to 4:00 a.m. Sunday, Eastern Time, credit card payments cannot be processed; therefore, no documents requiring fees can be filed during that time period.

See TMEP §804.05 regarding signature of documents filed electronically.

See TMEP §§807.05 *et seq.* regarding drawings in electronically transmitted applications, and TMEP §904.02(a) regarding specimens in electronically transmitted applications.

Requests for recordation of assignments and other documents affecting title to an application or registration can be filed through the Electronic Trademark Assignment System ("ETAS") on the USPTO website at <http://etas.uspto.gov>.

The Electronic System for Trademark Trials and Appeals ("ESTTA"), at <http://estta.uspto.gov>, can be used to file requests for extensions of time to oppose, notices of opposition, motions, briefs, notices of change of address, and other papers in opposition and cancellation proceedings.

If a document transmitted through TEAS, ETAS or ESTTA is due on a Saturday, Sunday, or a Federal holiday within the District of Columbia, the document will be considered timely if the USPTO receives the transmission on the following day that is not a Saturday, Sunday or a Federal holiday within the District of Columbia. 37 C.F.R. §2.196; TMEP §308.

### **302 Trademark Correspondence and Signature Requirements - In General**

*Extract from 37 C.F.R. §2.193.*

*(a) Since each file must be complete in itself, a separate copy of every document to be filed in a trademark application, trademark registration file, or*

## FILING AND RECEIPT OF DOCUMENTS

*proceeding before the Trademark Trial and Appeal Board must be furnished for each file to which the document pertains, even though the contents of the documents filed in two or more files may be identical. Parties should not file duplicate copies of correspondence, unless the Office requires the filing of duplicate copies. The Office may dispose of duplicate copies of correspondence.*

*(b) Since different matters may be considered by different branches or sections of the Office, each distinct subject, inquiry or order must be contained in a separate document to avoid confusion and delay in answering correspondence dealing with different subjects.*

*(c)(1) Each piece of correspondence that requires a person's signature, must:*

*(i) Be an original, that is, have an original signature personally signed in permanent ink by that person; or*

*(ii) Be a copy, such as a photocopy or facsimile transmission (§2.195(c)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original; or*

*(iii) Where an electronically transmitted trademark filing is permitted or required, the person who signs the filing must either:*

*(A) Place a symbol comprised of numbers and/or letters between two forward slash marks in the signature block on the electronic submission; or*

*(B) Sign the verified statement using some other form of electronic signature specified by the Director.*

*(2) The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any document by a party, whether a practitioner or non-practitioner, constitutes a certification under §10.18(b) of this chapter.*

*Violations of §10.18(b)(2) of this chapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under §10.18(c) of this chapter. Any practitioner violating §10.18(b) may also be subject to disciplinary action. See §§10.18(d) and 10.23(c)(15).*

*(d) When a document that is required by statute to be certified must be filed, a copy, including a photocopy or facsimile transmission, of the certification is not acceptable.*

The USPTO recommends filing through TEAS whenever possible. See TMEP §301. Trademark documents may also be sent through the United States Postal Service ("USPS"), delivered by a courier service, or hand carried to the USPTO. Except for documents listed in TMEP §306.01, correspondence may be transmitted by facsimile ("fax"). (Note that a trademark application may *not* be filed by fax, but can be filed through TEAS. 37 C.F.R. §§2.195(d)(1) and 2.197(a)(2)). Certain documents can be sent through electronic mail ("e-mail").

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

See TMEP §§304 *et seq.* regarding e-mail, TMEP §§305 *et seq.* regarding mailing documents to the USPTO, TMEP §§306 *et seq.* regarding fax transmission, and TMEP §307 regarding hand delivery.

### **302.01 Original Documents Generally Not Required**

The USPTO does not generally require the submission of original documents. See 37 C.F.R. §2.193(c)(1)(ii). Copies (*e.g.*, photocopies or fax transmissions) may be submitted except for certified copies of court orders and certified copies of U.S. registrations, where required.

Copies are *not* acceptable for trademark correspondence specified in 37 C.F.R. §2.193(d). That is, a copy is *not* acceptable when a document is required by statute to be certified (*e.g.*, a certified copy of a final court order pursuant to 15 U.S.C. §1119). The requirement for an original certification does not apply to certifications such as those required under 37 C.F.R. §§2.197 and 3.73(b), because these certifications are not required by statute.

When a party files a copy of a paper related to an application or registration, the USPTO will normally not require the party to submit the original document. However, the party who filed the copy should retain the original in case questions arise as to the authenticity of the signature on the photocopy or faxed correspondence. 37 C.F.R. §2.193(c)(2).

### **302.02 Multiple Copies of Papers Should Not Be Filed**

*Extract from 37 C.F.R. §2.193(a).*

*\* \* \* Parties should not file duplicate copies of correspondence, unless the Office requires the filing of duplicate copies. The Office may dispose of duplicate copies of correspondence.*

As a general rule, only one copy of each paper should be filed, unless more than one copy is specifically required by statute or rule, or a USPTO employee specifically requests more than one copy.

When filing a document electronically or by fax, a party should *not* send a follow-up copy unless the USPTO specifically requests a follow-up copy. 37 C.F.R. §2.193(a). Submission of duplicate papers can delay processing.

### **302.03 Identifying the Nature of Papers Filed**

#### **302.03(a) Correspondence Pertaining to Trademark Applications**

Documents filed through TEAS are automatically transmitted to the appropriate location and associated with the appropriate file.



## FILING AND RECEIPT OF DOCUMENTS

For paper documents, to ensure the timely matching of papers with files, every piece of correspondence filed in the USPTO pertaining to a trademark application should be identified at the beginning of the paper by a heading or caption and by the serial number of the application to which the paper pertains. 37 C.F.R. §2.194(b)(1). Cover letters and transmittal letters should identify the material that they accompany.

To expedite processing, **all** incoming papers pertaining to an application should include the following identifying data:

- (1) Serial number;
- (2) Filing date;
- (3) Mark;
- (4) A title indicating the nature of the paper;
- (5) Law office (identified in the most recent Office action);
- (6) Name of examining attorney identified on the most recent Office action;
- (7) Mailing date of the Office action to which the paper is in response, if applicable;
- (8) The name, address (including ZIP code) and telephone number of the applicant or the applicant's attorney; and
- (9) The applicant's or attorney's e-mail address.

To facilitate the matching of responses to Office actions with the correct files, examining attorneys' Office actions issued on paper include peel-off response labels that reference the application serial number, the mark and the assigned law office. If filing a response on paper, the applicant is encouraged to affix this label to the upper right-hand corner of the response.

### **302.03(b) Correspondence Pertaining to Trademark Registrations**

Correspondence relating to a registered trademark should identify the registration by specifying the mark, the registrant's name, and the registration number. 37 C.F.R. §2.194(b)(2).

Correspondence filed under 15 U.S.C. §§1057, 1058 and 1059 should be directed to the Post Registration Section of the Office.

Petitions to cancel a registered mark should be directed to the Trademark Trial and Appeal Board.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Court orders relating to registered trademarks should be sent to the Office of the Solicitor. See TMEP §1610.

### 303 Receipt of Documents by the Office

*Extract from 37 C.F.R. §2.195. Receipt of trademark correspondence.*

*(a) Date of receipt and Express Mail date of deposit. Trademark correspondence received in the Office is given a filing date as of the date of receipt except as follows:*

*(1) The Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted electronically under paragraph (a)(2) of this section or transmitted by facsimile under paragraph (a)(3) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.*

*(2) Trademark-related correspondence transmitted electronically will be given a filing date as of the date on which the Office receives the transmission.*

*(3) Correspondence transmitted by facsimile will be given a filing date as of the date on which the complete transmission is received in the Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the filing date will be the next succeeding day that is not a Saturday, Sunday, or Federal holiday within the District of Columbia.*

*(4) Correspondence filed in accordance with §2.198 will be given a filing date as of the date of deposit as "Express Mail" with the United States Postal Service.*

*(b) Correspondence delivered by hand. In addition to being mailed, correspondence may be delivered by hand during hours the Office is open to receive correspondence.*

*(c) Facsimile transmission. Except in the cases enumerated in paragraph (d) of this section, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See §2.196. To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application, registration or proceeding before the Office. The application serial number, registration number, or proceeding number should be entered as a part of the sender's identification on a facsimile cover sheet.*

*(d) Facsimile transmissions are not permitted and if submitted, will not be accorded a date of receipt, in the following situations:*

- (1) Applications for registration of marks;*
- (2) Drawings submitted under §2.51, §2.52, §2.72, or §2.173;*
- (3) Correspondence to be filed with the Trademark Trial and Appeal Board, except notices of ex parte appeal;*

## FILING AND RECEIPT OF DOCUMENTS

(4) *Requests for cancellation or amendment of a registration under section 7(e) of the Trademark Act; and certificates of registration surrendered for cancellation or amendment under section 7(e) of the Trademark Act; and*

(5) *Madrid-related correspondence submitted under §7.11, §7.21, §7.14, §7.23, §7.24, or §7.31.*

(e) *Interruptions in U.S. Postal Service. If interruptions or emergencies in the United States Postal Service which have been so designated by the Director occur, the Office will consider as filed on a particular date in the Office any correspondence which is:*

(1) *Promptly filed after the ending of the designated interruption or emergency; and*

(2) *Accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service.*

### **303.01            Date of Receipt**

Correspondence transmitted through TEAS is considered to have been filed on the date the USPTO receives the transmission, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. 37 C.F.R. §2.195(a)(2).

For paper correspondence, the date of actual receipt in the USPTO is assigned as the filing date of all correspondence. 37 C.F.R. §2.195(a). However, under 37 C.F.R. §§2.195(a)(1) and (3), no correspondence is “received” in the USPTO on Saturdays, Sundays, or Federal holidays within the District of Columbia. See TMEP §308 regarding response periods that end on a Saturday, Sunday, or Federal holiday within the District of Columbia.

The filing date of an e-mail communication (see TMEP §304 *et seq.*) or fax transmission (see TMEP §§306 *et seq.*) is the date the complete transmission is received in the USPTO, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the filing date is the next succeeding day that is not a Saturday, Sunday, or Federal holiday within the District of Columbia. 37 C.F.R. §§2.195(a)(1) and (3). However, if the communication is properly filed using the “certificate of transmission” procedure under 37 C.F.R. §2.197, the USPTO looks to the date on the certificate to determine whether the filing is timely. TMEP §§304.05 and 306.05(c).

Similarly, if a document is mailed to the USPTO using the “certificate of mailing” procedure under 37 C.F.R. §2.197 (see TMEP §§305.02 *et seq.*), the filing date is the date of receipt in the USPTO, but the USPTO looks to the date on the certificate to determine whether the filing is timely. TMEP §305.02(e).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

See TMEP §1904.01(b) regarding the filing date of a request for an extension of protection of an international registration to the United States under §66(a) of the Trademark Act, 15 U.S.C. §1141f(a).

### **303.02 Acknowledgment of Receipt**

#### **303.02(a) Electronic Mail Confirmation of Receipt of TEAS Document**

When a document is filed through TEAS, the USPTO receives it within seconds after filing, and immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission. See TMEP §301 regarding TEAS. This e-mail confirmation is evidence of filing should any question arise as to the filing date of the document.

#### **303.02(b) “Office Date” Label Showing Receipt**

The USPTO places a bar code label indicating the date of receipt on every application, part of an application, amendment, letter or other document submitted to the USPTO on paper. The label is referred to as the “Office Date” label, and it establishes the date of receipt (*i.e.*, the filing date) of any paper. Before 1998, the USPTO used a stamp, known as the “Office Date Stamp,” to indicate the date of receipt of incoming papers.

#### **303.02(c) Postcard Receipt**

When documents are filed through TEAS, a party need not send a postcard in order to receive a confirmation of filing, because the USPTO immediately issues a confirmation via e-mail that includes the date of receipt and a summary of the submission.

For documents filed on paper, a party may obtain a receipt by enclosing a self-addressed, stamped postcard identifying the document. The USPTO will place a label indicating the receipt date on the card and return it to the party who filed the paper.

The identifying data on the postcard should be complete and specific. The nature of the paper being filed (*e.g.* application, affidavit, amendment, appeal, petition); the name of the applicant or registrant; the mark; the application filing date or registration date; and the application serial number, registration number or proceeding number should be included when that information is available. Each specific element of the filing should be listed on the postcard (*e.g.*, written application, drawing page, fee, specimen) so that the postcard can be used as evidence that the element was submitted if it is lost or disassociated from the file.

## FILING AND RECEIPT OF DOCUMENTS

The party submitting the postcard is responsible for placing proper postage on the self-addressed postcard. See TMEP §303.02(c)(i) regarding the use of postage meters.

If a postcard with proper postage accompanies application papers that are mailed to the USPTO, the postcard will be stamped with the serial number assigned to the application.

If the postcard accompanies application papers that are hand carried, the serial number is not stamped on the postcard. Therefore, if application papers are hand carried, the applicant may submit a second postcard with proper postage so that, upon serialization, the USPTO may send the additional card, stamped with the serial number, to the applicant.

When papers for more than one application or registration are filed under a single cover, a return postcard should be attached to each paper for which a receipt is desired.

### **303.02(c)(i) Postage on Return Receipt Postcards**

The party submitting a return receipt postcard (see TMEP §303.02(c)) is responsible for placing proper postage on the self-addressed postcard. Proper postage means that it has a stamp(s) in the correct amount or a meter stamp postmark that complies with USPS requirements.

The USPS provides in its Domestic Mail Manual that the date in a meter postmark must be the actual date of deposit, with limited exceptions, and that meter postmarks used to prepay reply postage must *not* show the date. The USPS will not accept for mailing a post card that contains a postage meter date more than ten days old. Thus, a return receipt postcard containing a dated meter postmark may not be delivered by the USPS, because the postcard will be mailed by the Office substantially after the date on which the meter postmark is printed on the card.

Therefore, to ensure the receipt of a confirmation post card, the party filing the postcard should: (1) affix postage stamps to their postcards, or purchase already stamped post cards from the USPS; or (2) if a postage meter is used, ensure that the meter postmark does not show the date, and follow the instructions in the postage meter license agreement regarding prepay reply postage. See notice at 1246 TMOG 42 (May 8, 2001).

## **304 Electronic Mail**

### **304.01 Communications Acceptable Via Electronic Mail**

Applicants and registrants may use e-mail to respond to a Post Registration or ITU paralegal's Office action, to conduct informal communications regarding a particular application or registration, or to reply or respond to a

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

letter from a petitions attorney or paralegal in the Office of the Commissioner for Trademarks.

*Attachments.* The USPTO will accept legible attachments to Internet e-mail **in .jpg format**. *The USPTO will not accept or open attachments in any other format.*

*Informal Communications.* The USPTO accepts informal communications from applicants via e-mail, as an alternative to telephone communications. For example, an applicant may submit via e-mail:

- Questions that do not constitute a response;
- Authorization to issue an examiner's amendment or priority action (see TMEP §§707, 708.01, and 708.03);
- Objection to examiner's amendment (see TMEP §§707 and 707.02);
- Notification of termination of cancellation proceeding which is basis for suspension (see TMEP §716.02(a)).

These are just examples and not an exhaustive list of informal communications.

The examining attorney must ensure that all informal e-mail communications are scanned into the electronic record.

### **304.02                    Communications *Not* Acceptable Via Electronic Mail**

Internet e-mail may **not** be used to file applications for registration of marks, responses to examining attorneys' Office actions, amendments to allege use under 15 U.S.C. §1051(c), statements of use under 15 U.S.C. §1051(d), requests for extensions of time to file statements of use under 15 U.S.C. §1051(d)(2), affidavits of continued use or excusable nonuse under 15 U.S.C. §1058, affidavits of incontestability under 15 U.S.C. §1065; combined affidavits under 15 U.S.C. §§1058 and 1065, or combined filings under 15 U.S.C. §§1058 and 1059. These documents may be filed electronically using TEAS (see TMEP §301).

Effective September 20, 2004, applicants wishing to transmit responses to examining attorneys' Office actions electronically must use TEAS, available at <http://www.uspto.gov/teas/index.html>. Responses to Office actions that are transmitted by any other electronic means (*e.g.*, responses sent directly to an examining attorney's e-mail address) will not be accepted. See *Trademark Operation Will No Longer Accept Responses to Office Actions that are Transmitted by E-Mail* (TMOG Apr. 6, 2004), posted at [http://www.uspto.gov/web/trademarks/notice\\_emailresponses.htm](http://www.uspto.gov/web/trademarks/notice_emailresponses.htm).

## FILING AND RECEIPT OF DOCUMENTS

The Trademark Trial and Appeal Board does not accept e-mail communications.

### **304.03 Authorization of Electronic Mail Communications From the USPTO**

The USPTO will send communications concerning an application or registration by e-mail only if e-mail communication is authorized by the applicant or registrant, or the applicant's or registrant's attorney.

The applicant or registrant may authorize the USPTO to communicate by e-mail by so indicating in the initial application or in any official written communication. The authorization must include the e-mail address to which e-mail is to be sent. The USPTO will not send e-mail to more than one e-mail address.

It is the responsibility of the applicant, registrant or attorney to notify the USPTO of any changes of e-mail address.

See TMEP §304.06 regarding outgoing e-mail.

### **304.04 Filing Date of Electronic Mail**

The filing date of an incoming e-mail communication is the date the communication is received in the USPTO, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the filing date will be the next succeeding day that is not a Saturday, Sunday, or Federal holiday within the District of Columbia. 37 C.F.R. §2.195(a)(1).

See TMEP §304.05 regarding certificates of transmission by e-mail.

### **304.05 Certificate of Transmission by Electronic Mail**

Under 37 C.F.R. §2.197, e-mail correspondence will be considered to be timely filed, even if received after the due date, if the correspondence is: (1) transmitted to the USPTO by e-mail on or before the due date; and (2) accompanied by a certificate attesting to the date of transmission. See TMEP §§306.05 *et seq.* regarding the certificate of transmission procedure under 37 C.F.R. §2.197.

If e-mail correspondence is timely filed with a certificate of transmission, but is not received by or is lost within the USPTO, the correspondence will be considered timely based on the date of transmission set forth on the certificate of transmission, if the party who transmitted the correspondence: (1) informs the USPTO in writing of the previous e-mail transmission of the correspondence within two months after becoming aware that the USPTO has no evidence of its receipt; (2) provides a copy of the previously transmitted correspondence, including the certificate of transmission; and

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

(3) submits a statement attesting to the personal knowledge of transmission of the response. 37 C.F.R. §2.197(b). The statement attesting to the personal knowledge of transmission does not have to be verified. See TMEP §306.05(d) for additional information about correspondence that is transmitted with a certificate of transmission but not received by or lost within the USPTO.

The following wording is suggested for the certificate of transmission:

### CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted by electronic mail to the United States Patent and Trademark Office on the date shown below.

\_\_\_\_\_  
(Typed or Printed Name of Person Signing Certificate)

\_\_\_\_\_  
(Signature)

\_\_\_\_\_  
(Date)

See TMEP §304.07 regarding signature of electronic mail.

Effective September 10, 2004, responses to examining attorneys' Office actions cannot be filed by e-mail. See TMEP §304.02. Therefore, the certificate of transmission by e-mail procedure cannot be used for such responses.

### **304.06           Outgoing Electronic Mail**

The USPTO will not send e-mail to an applicant or registrant unless the applicant or registrant authorizes the USPTO to do so. TMEP §304.03.

When authorized to communicate by e-mail, the USPTO may send Office actions and other official correspondence to the Internet e-mail address designated by the applicant or registrant. The USPTO will not send correspondence to more than one e-mail address. See TMEP §304.08 regarding addresses for e-mail correspondence directed to the USPTO.

If outgoing electronic mail is returned as undeliverable, the USPTO will mail a paper copy to the correspondence address of record.

The USPTO is not required to send Office actions and other official correspondence by e-mail whenever the applicant or registrant authorizes e-mail correspondence. The USPTO may send correspondence by e-mail, regular mail, fax, or other appropriate means.



## FILING AND RECEIPT OF DOCUMENTS

### 304.07 Signature of Electronic Mail

An applicant, registrant or attorney may sign an e-mail communication by entering a “symbol” that he or she has adopted as a signature between two slashes. See 37 C.F.R. §§2.33(d) and 2.193(c)(1)(iii)(A) and TMEP §804.05 regarding signature of electronically-filed documents.

In addition, the USPTO will accept an e-mail communication containing the “/s/” (“/(signature)/”) notation in lieu of a signature.

A scanned image of a document signed in ink is also acceptable, as long as the image is attached in .jpg format.

Under 37 C.F.R. §10.18(b), the use of an electronic signature under 37 C.F.R. §§2.33(d) and 2.193(c)(1)(iii)(A) or an “/s/” notation, will be understood to constitute a certificate that:

- (1) The correspondence has been read by the applicant, registrant or attorney;
- (2) The filing of the correspondence is authorized;
- (3) To the best of the signatory’s knowledge, information, and belief, there is good ground to support the correspondence; and
- (4) The correspondence is not presented for purposes of delay.

### 304.08 E-Mail Addresses for Correspondence With the Office

Where an applicant or registrant is permitted to send communications to the USPTO by e-mail (see TMEP §304.01), the applicant or registrant should send e-mail to the address designated by the Office on the filing receipt or other correspondence sent by the USPTO. Applicants and registrants should **not** send e-mail to more than one address in the USPTO, and should not send courtesy copies of an e-mail message (e.g., “Cc” or “Bcc”) to additional e-mail addresses within the USPTO.

Effective September 10, 2004, responses to examining attorneys’ Office actions cannot be filed by e-mail. See TMEP §304.02.

### 304.09 Paper “Confirmation” Copies of E-Mail Communications Should Not Be Sent to the Office

Applicants, registrants and attorneys should **not** send paper “confirmation” copies of e-mail communications to the USPTO by fax, regular mail, or any other means, because this can delay processing.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 305 Mailing Documents to the Office

#### 305.01 Mailing Addresses

Documents filed through TEAS are automatically sent to the appropriate location.

For trademark-related documents filed on paper, except for documents sent to the Assignment Services Division for recordation, requests for copies of trademark documents, and certain documents filed under the Madrid Protocol (listed below), all trademark-related correspondence that is mailed to the USPTO should be addressed to:

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

The names of individual employees should *not* be placed on the *envelopes* in which official communications are sent to the USPTO. Envelopes may be marked "Attention: Trademark Examining Operation." Responses to Office actions should include the name of the examining attorney in the heading.

#### ***Mailing Address for Certain Documents Filed Under the Madrid Protocol***

International applications under 37 C.F.R. §7.11, subsequent designations under 37 C.F.R. §7.21, responses to irregularity notices under 37 C.F.R. §7.14, requests to record changes in the International Register under 37 C.F.R. §§7.23 and 7.24, requests for transformation under 37 C.F.R. §7.31, and petitions to the Director to review the actions of the USPTO's Madrid Processing Unit, when filed by mail, must be mailed to:

Commissioner for Trademarks  
P.O. Box 16471  
Arlington, VA 22215-1471  
Attn: MPU

37 C.F.R. §§2.190(e) and 7.4(b).

#### ***Mailing Address for Documents to be Recorded in Assignment Services Division***

To expedite processing, the USPTO recommends filing requests to record documents in the Assignment Services Division through the USPTO website, at <http://etas.uspto.gov>. Documents filed electronically are recorded much faster than their paper counterparts. Paper documents and cover sheets to be recorded in the Assignment Services Division should be sent to Mail Stop Assignment Recordation Services, Director of the United States Patent and

## FILING AND RECEIPT OF DOCUMENTS

Trademark Office, P. O. Box 1450, Alexandria VA 22313-1450. 37 C.F.R. §§2.190(c) and 3.27.

### ***Mailing Address for Requests for Copies of Trademark Documents***

Copies of trademark documents can be ordered through the USPTO website at [www.uspto.gov](http://www.uspto.gov). Requests for copies of documents can also be faxed or e-mailed to the USPTO, with an authorization to charge the fee to a credit card or USPTO deposit account. See TMEP §111 for additional information.

All other requests for certified or uncertified copies of trademark documents should be sent to: Mail Stop Document Services, Director of the United States Patent and Trademark Office, P. O. Box 1450, Alexandria VA 22313-1450. 37 C.F.R. §2.190(d).

### **305.02 Certificate of Mailing Procedure**

37 C.F.R. §2.197. *Certificate of mailing or transmission.*

*(a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.*

*(1) Correspondence will be considered as being timely filed if:*

*(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:*

*(A) Addressed as set out in §2.190 and deposited with the U.S. Postal Service with sufficient postage as first class mail; or*

*(B) Transmitted by facsimile to the Office in accordance with §2.195(c); and*

*(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have a reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.*

*(2) The procedure described in paragraph (a)(1) of this section does not apply to:*

*(i) Applications for the registration of marks under 15 U.S.C. 1051 or 1126; and*

*(ii) Madrid-related correspondence filed under §7.11, §7.21, §7.14, §7.23, §7.24 or §7.31.*

*(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Office, and an application is abandoned, a registration is cancelled or expired, or a proceeding is dismissed, terminated, or decided*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:*

*(1) Informs the Office of the previous mailing or transmission of the correspondence within two months after becoming aware that the Office has no evidence of receipt of the correspondence;*

*(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and*

*(3) Includes a statement that attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.*

*(c) The Office may require additional evidence to determine whether the correspondence was timely filed.*

In 37 C.F.R. §2.197, there is a “certificate of mailing or transmission” procedure to avoid lateness due to mail delay. This procedure may be used for all trademark correspondence except applications for registration of marks. 37 C.F.R. §2.197(a)(2). Under the certificate of mailing or transmission procedure, correspondence is considered to be timely even if received after the due date, if the correspondence was (1) deposited with the United States Postal Service as first class mail or transmitted to the USPTO by facsimile transmission before the expiration of the filing period, and (2) accompanied by a certificate attesting to the date of deposit or transmission.

Filers must retain a copy of the correspondence, including the signed and dated certificate. *In re Sasson Licensing Corporation*, 35 USPQ2d 1510 (Comm'r Pats. 1995).

See TMEP §§305.02 *et seq.* regarding the certificate of mailing procedure, and TMEP §§306.05 *et seq.* regarding the certificate of transmission procedure.

### **305.02(a) When Certificate of Mailing Procedure May Not Be Used**

The certificate of mailing procedure may be used for all trademark filings **except:**

- An application to register a mark;
- International applications under 37 C.F.R. §7.11;
- Subsequent designations under 37 C.F.R. §7.21;
- Responses to notices of irregularity under 37 C.F.R. §7.14;

## FILING AND RECEIPT OF DOCUMENTS

- Requests to record changes of ownership of international registrations under 37 C.F.R. §7.23;
- Requests to record restrictions of the holder's right of disposal of an international registration, or the release of such restrictions, under 37 C.F.R. §7.24; and
- Requests for transformation under 37 C.F.R. §7.31.

37 C.F.R. §§2.197(a)(2).

### **305.02(b) Mailing Requirements**

The correspondence must be deposited in the United States mail, properly addressed (see TMEP §305.01 for mailing addresses), and the envelope must have sufficient postage as first-class mail. Since first-class mail services of the USPS are not available in foreign countries, the certificate of mailing procedure may not be used for sending mail to the USPTO from a foreign country.

### **305.02(c) Location and Form of Certificate**

The certificate of mailing must: (1) state the date of deposit in the mail, which must be a date within the set filing period (this includes the last day of the period, or the succeeding day that is not a Saturday, Sunday or Federal holiday within the District of Columbia when the last day of the period falls on a Saturday, Sunday or Federal holiday within the District of Columbia); and (2) be signed by a person who has a reasonable basis to expect the correspondence to be deposited in the mail on the date indicated. The signature of the certificate must be separate from any signature for the correspondence being deposited.

The best location for the certificate of mailing is at the beginning of the correspondence to which it pertains, typed in its entirety.

The certificate of mailing should be separated from contents of the correspondence that are on the same page. Several blank lines between the contents and the certificate will suffice.

If the certificate of mailing does not fit on the correspondence to which it pertains, the certificate may be placed on a separate sheet of paper that is attached securely to the correspondence. The separate sheet must exhibit or bear a complete identification of the nature of the paper or fee as well as an identification of the application, registration and/or proceeding to which the paper pertains (including serial number or registration number). The separate sheet may be a cover letter or transmittal letter, with the certificate placed at the bottom of the letter and signed separately from the letter. If there is any

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

doubt concerning the correspondence to which a certificate of mailing on a separate sheet relates, the USPTO will not accept the certificate.

There must be a certificate of mailing for each piece of correspondence. When correspondence for more than one application or registration is mailed in a single envelope, each item of correspondence must have its own certificate of mailing. Similarly, when more than one type of correspondence is submitted in connection with the same application, each item of correspondence must have its own certificate of mailing.

It is suggested that the certificate be signed by the applicant or the party involved in the proceeding, or by the attorney for such person. If someone else signs, it should be a responsible person in a position to know that the mail will be deposited on the date specified.

The USPTO accepts the date of deposit stated in the certificate of mailing on the basis of the statement of personal knowledge. The USPTO does not normally inspect the postmark on the envelope.

### **305.02(d) Wording of Certificate of Mailing**

The following wording is suggested for the certificate of mailing.

#### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on the date shown below:

\_\_\_\_\_  
(Typed or Printed Name of Person Signing Certificate)

\_\_\_\_\_  
(Signature)

\_\_\_\_\_  
(Date)

### **305.02(e) Effect of Certificate of Mailing**

The date of actual receipt is the filing date of paper correspondence. 37 C.F.R. §2.195(a). The USPTO does not retain the envelopes in which material is received or record the date of the postmark.

The date of deposit indicated on the certificate of mailing is used only to determine whether the correspondence was deposited with the USPS within the filing period. Therefore, if the correspondence is actually received in the

## FILING AND RECEIPT OF DOCUMENTS

USPTO within the filing period, the certificate of mailing is ignored. If, however, the USPTO receives the correspondence after the filing period has expired, the USPTO looks to see whether a certificate of mailing was included. If no certificate is found, the correspondence is untimely.

When a paper received after the expiration of the filing period includes a signed certificate of mailing, and the date of deposit on the certificate is within the filing period, the USPTO considers the correspondence to be timely filed.

If the filing period ends on a Saturday, Sunday or Federal holiday within the District of Columbia, the correspondence is considered timely if the date of deposit on the certificate of mailing is the next succeeding day that is not a Saturday, Sunday or Federal holiday within the District of Columbia (see 37 C.F.R. §2.196 and TMEP §308).

Whenever it is necessary to change the effective filing date of an application (for example, when an application filed under §1(b) of the Trademark Act is amended to request registration on the Supplemental Register after submission of an allegation of use), the date of actual receipt rather than the date on the certificate is the new effective filing date. See TMEP §§206 *et seq.* as to changes in the effective filing date of an application.

### **305.02(f) Correspondence Mailed Pursuant to 37 C.F.R. §2.197 But Not Received by Office**

If correspondence filed with a certificate of mailing is not received by (or is lost within) the USPTO, the USPTO will consider the correspondence to be timely based on the date of deposit stated in the certificate of mailing if the party who filed the correspondence:

- (1) informs the USPTO in writing of the previous mailing of the correspondence within two months after becoming aware that the USPTO has no evidence of receipt of the correspondence;
- (2) supplies an additional copy of the previously mailed correspondence, including a copy of the signed and dated certificate of mailing (see *In re Sasson Licensing Corporation*, 35 USPQ2d 1510 (Comm'r Pats. 1995)); and
- (3) includes a statement attesting to the previous timely mailing on the basis of the signer's personal knowledge. This statement does not have to be verified.

37 C.F.R. §2.197(b).

Under 37 C.F.R. §§2.146(d) and 2.197(b)(1), a party must notify the USPTO of the mailing of the correspondence within two months after becoming aware that the USPTO has no evidence of receipt of the correspondence. Where no written action is generated that can be used as a starting point for measuring

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

the petition's timeliness, the two-month deadline runs from the date that the party who filed the correspondence became aware that there was a problem with the filing date of the correspondence. See TMEP §1705.04.

The required evidence should be sent to the area in the USPTO where the misplaced or lost document was intended to be filed, e.g., the law office, ITU Unit, or Post Registration Section.

If *all* three criteria listed above cannot be met, the only remedy available is a petition to revive under 37 C.F.R. §2.66 (if appropriate) or a petition under 37 C.F.R. §2.146, which must include a petition fee of \$100, and a statement that attests on a personal knowledge basis to the previous timely mailing, along with any additional evidence. See 37 C.F.R. §§2.66 and 2.146; TMEP §§1702 through 1708 regarding petitions under 37 C.F.R. §2.146 and TMEP §§1714 *et seq.* regarding petitions to revive.

The above procedure does *not* apply to the filing of an application for registration of a mark, or to the Madrid-related documents listed in 37 C.F.R. §2.197(a)(2) and TMEP §305.02(a).

Under 37 C.F.R. §2.197(c), the USPTO may require additional evidence relating to the mailing or transmission of correspondence. See, e.g., *In re Klein*, 6 USPQ2d 1547 (Comm'r Pats. 1987), *aff'd sub nom. Klein v. Peterson*, 696 F. Supp. 695, 8 USPQ2d 1434 (D.D.C. 1988), *aff'd*, 866 F.2d 412, 9 USPQ2d 1558 (Fed. Cir. 1989), *cert. denied*, 490 U.S. 1091 (1989).

### **305.02(g) Correspondence Deposited as First Class Mail Pursuant to 37 C.F.R. §2.197 and Returned by the U.S. Postal Service**

The USPS requires that all domestic first class mail that weighs sixteen ounces or more be presented to a retail clerk at a USPS office. All such mail that is not presented to a retail clerk at a USPS office (e.g., is placed in a mailbox) will be returned by the USPS. The USPS has posted notice of this requirement on mailboxes. The "Express Mail" service of the USPS is not affected.

Correspondence must be deposited with the USPS as first class mail in compliance with any and all applicable requirements of the USPS to be considered "[d]eposited with the U.S. Postal Service," within the meaning of 37 C.F.R. §2.197(a)(1)(i)(A). Therefore, correspondence returned by the USPS as not mailed in compliance with USPS requirements concerning mail weighing sixteen ounces or more is not entitled to any benefit under 37 C.F.R. §2.197. See notice at 1192 TMOG 43 (Nov. 12, 1996).



## FILING AND RECEIPT OF DOCUMENTS

### 305.02(h) Certificate of Mailing Requirements Strictly Enforced

The requirements of 37 C.F.R. §2.197 are strictly enforced, and the USPTO denies petitions to consider a document timely filed as of the date on the certificate if a party fails to comply with these requirements.

A party's inadvertent failure to comply with the requirements of a rule is not considered an extraordinary situation that would warrant waiver of a rule under 37 C.F.R. §2.146(a)(5) or §2.148. See *Honigsbaum v. Lehman*, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995), *aff'd mem.*, 95 F.3d 1166 (Fed. Cir. 1996) (Commissioner did not abuse his discretion in refusing to waive requirements of 37 C.F.R. §1.10(c) and grant filing date to patent application, when applicant failed to produce "Express Mail" customer receipt or any other evidence that application was actually deposited with USPS as "Express Mail"); *In re Sasson Licensing Corporation*, 35 USPQ2d 1510 (Comm'r Pats. 1995) (failure to retain executed hard copy of certificate of mailing under 37 C.F.R. §1.8 not extraordinary situation that would justify waiver of rule); *Gustafson v. Strange*, 227 USPQ 174 (Comm'r Pats. 1985) (counsel's unawareness of 37 C.F.R. §1.8 not extraordinary situation warranting waiver of a rule); *In re Chicago Historical Antique Automobile Museum, Inc.*, 197 USPQ 289 (Comm'r Pats. 1978) (lateness due to mail delay not deemed to be extraordinary situation, because certificate of mailing procedure under 37 C.F.R. §1.8 was available to petitioner).

### 305.03 "Express Mail"

37 C.F.R. §2.198. *Filing of correspondence by "Express Mail."*

(a)(1) *Except for documents listed in paragraphs (a)(1)(i) and (ii) of this section, any correspondence received by the Office that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed with the Office on the date of deposit with the USPS. The Express Mail procedure does not apply to:*

- (i) *Applications for registration of marks;*
- (ii) *Amendments to allege use under section 1(c) of the Act;*
- (iii) *Statements of use under section 1(d) of the Act;*
- (iv) *Requests for extension of time to file a statement of use under section 1(d) of the Act;*
- (v) *Affidavits of continued use under section 8 of the Act;*
- (vi) *Renewal requests under section 9 of the Act; and*
- (vii) *Requests to change or correct addresses.*

(2) *The date of deposit with USPS is shown by the "date in" on the "Express Mail" label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the date of receipt in the Office as the filing date.*

(b) *Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in an “Express Mail” drop box) do so at the risk of not receiving a copy of the “Express Mail” mailing label with the desired “date-in” clearly marked. The paper(s) or fee(s) that constitute the correspondence should also include the “Express Mail” mailing label number thereon. See paragraphs (c), (d) and (e) of this section.

(c) Any person filing correspondence under this section that was received by the Office and delivered by the “Express Mail Post Office to Addressee” service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the “date-in” on the “Express Mail” mailing label or other official USPS notation, may petition the Director to accord the correspondence a filing date as of the “date-in” on the “Express Mail” mailing label or other official USPS notation, provided that:

(1) The petition is filed within two months after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the “Express Mail” mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing; and

(3) The petition includes a true copy of the “Express Mail” mailing label showing the “date-in,” and of any other official notation by the USPS relied upon to show the date of deposit.

(d) Any person filing correspondence under this section that was received by the Office and delivered by the “Express Mail Post Office to Addressee” service of the USPS, who can show that the “date-in” on the “Express Mail” mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Director to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

(1) The petition is filed within two months after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) The number of the “Express Mail” mailing label was placed on the paper(s) or fee(s) prior to the original mailing; and

(3) The petition includes a showing that establishes, to the satisfaction of the Director, that the correspondence was deposited in the “Express Mail Post Office to Addressee” service prior to the last scheduled pickup on the requested filing date. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or evidence that came into being within one business day after the deposit of the correspondence in the “Express Mail Post Office to Addressee” service of the USPS.

(e) If correspondence is properly addressed to the Office pursuant to §2.190 and deposited with sufficient postage in the “Express Mail Post Office to Addressee” service of the USPS, but not received by the Office, the party

## FILING AND RECEIPT OF DOCUMENTS

who mailed the correspondence may petition the Director to consider such correspondence filed in the Office on the USPS deposit date, provided that:

(1) The petition is filed within two months after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) prior to the original mailing;

(3) The petition includes a copy of the originally deposited paper(s) or fee(s) showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup on the requested filing date; and

(4) The petition includes a statement that establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.

(f) The Office may require additional evidence to determine whether the correspondence was deposited as "Express Mail" with the USPS on the date in question.

### **Documents Excluded From 37 C.F.R. §2.198**

Trademark Rule 2.198, 37 C.F.R. §2.198, provides a procedure for obtaining a filing date as of the date that correspondence is deposited as "Express Mail" with the USPS. However, this procedure does **not** apply to the following trademark documents:

- Applications for registration of marks;
- Amendments to allege use under §1(c) of the Trademark Act, 15 U.S.C. §1051(c);
- Statements of use under §1(d) of the Trademark Act, 15 U.S.C. §1051(d);
- Requests for extension of time to file a statement of use under §1(d) of the Trademark Act, 15 U.S.C. §1051(d);

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- Affidavits of continued use under §8 of the Trademark Act, 15 U.S.C. §1058;
- Renewal applications under §9 of the Trademark Act, 15 U.S.C. §1059;
- Requests to change or correct addresses;
- Combined filings under §§8 and 9 of the Trademark Act, 15 U.S.C. §§1058 and 1059;
- Combined affidavits or declarations under §§8 and 15 of the Trademark Act, 15 U.S.C. §§1058 and 1065;
- Responses to notices of irregularity under 37 C.F.R. §7.14; and
- Requests for transformation under 37 C.F.R. §7.31.

37 C.F.R. §§2.198(a)(1) and 7.4(b)(2). See notice at 67 Fed. Reg. 36099 (May 23, 2002), available at <http://www.uspto.gov/web/offices/com/sol/notices/expmailrule2.pdf>.

If the documents listed above are filed by Express Mail, they will receive a filing date as of the date of receipt in the USPTO and *not* the date of deposit with USPS. 37 C.F.R. §2.195(a). Under 37 C.F.R. §§2.195(a)(1) and (3), no correspondence is “received” in the USPTO on Saturdays, Sundays, or Federal holidays within the District of Columbia. See TMEP §§303.01 and 308.

If the documents are filed through TEAS ([www.uspto.gov/teas/index.html](http://www.uspto.gov/teas/index.html)), they will receive a filing date as of the date the USPTO receives the transmission (Eastern Standard Time), regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. 37 C.F.R. §2.195(a)(2). See TMEP 301 for further information about TEAS.

### ***Lost Documents***

If one of the documents listed above is sent by Express Mail but is lost within the USPTO, and the applicant or registrant presents proof of actual receipt in the form of evidence that a USPTO employee signed for or acknowledged the Express Mail package (*e.g.*, an Express Mail mailing label that bears an Office date stamp or label or the signature of an USPTO employee, or evidence from the USPS website showing that the document was actually received in the USPTO), the USPTO will grant the document a filing date as of the *date of actual receipt in the USPTO*. The applicant or registrant must submit a request to change the filing date that include a true copy of the document(s), and an affidavit or declaration under 37 C.F.R. §2.20 attesting to the contents of the Express Mail package. See TMEP §1711 regarding

## FILING AND RECEIPT OF DOCUMENTS

restoration of application filing dates, TMEP §1712.01 regarding reinstatement of abandoned applications, and TMEP §1712.02 regarding reinstatement of cancelled or expired registrations.

If a document is sent by Express Mail but is not received by or is lost within the USPTO, and the applicant does not have proof of actual receipt in the USPTO, the USPTO will not grant a filing date to the document.

### ***Certificate of Mailing Under 37 C.F.R. §2.197 for Documents Sent by Express Mail***

For documents other than applications for registration of marks and the Madrid-related documents listed in 37 C.F.R. §2.197(a)(2) (see TMEP §305.02(a)), the certificate of mailing procedure of 37 C.F.R. §2.197 may be used for documents sent by Express Mail as well as documents sent by first class mail. The certificate of mailing procedure may *not* be used for documents listed in 37 C.F.R. §2.197(a)(2). Under the certificate of mailing procedure, correspondence is considered to be timely filed even if received after the due date, if the correspondence is deposited with the USPS with sufficient postage as first class mail before the expiration of the filing period and accompanied by a certificate attesting to the date of deposit. Correspondence sent by Express Mail is deemed to meet the requirements of 37 C.F.R. §2.197(a)(1)(i)(A) for postage as first class mail, because the postage for Express Mail exceeds the postage required for first class mail. However, to use the certificate of mailing procedure for documents mailed by Express Mail, a certificate attesting to the date of deposit and meeting the requirements of 37 CFR §2.197(a)(1)(ii) must be placed on the document prior to mailing. See TMEP §§305.02 *et seq.* for further information about the certificate of mailing procedure.

The following wording is suggested for a certificate of mailing when correspondence is sent by Express Mail:

#### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on the date shown below:

\_\_\_\_\_  
(Typed or Printed Name of Person Signing Certificate)

\_\_\_\_\_  
(Signature)

\_\_\_\_\_  
(Date)

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### ***Documents Not Excluded From 37 C.F.R. §2.198***

The procedures for filing documents by Express Mail under 37 C.F.R. §2.198 may be used for documents *not expressly excluded by 37 C.F.R. §2.198(a)*, e.g., documents filed with the Trademark Trial and Appeal Board or the Assignment Services Division of the Office. These documents are entitled to a filing date as of the date of deposit with USPS if the filer meets the requirements of 37 C.F.R. §2.198. The rule requires: (1) the document must be sent through the “Post Office to Addressee” service of the USPS; (2) it must be deposited prior to the last scheduled pickup on the relevant date; (3) it must be properly addressed in accordance with the requirements of 37 C.F.R. §2.190; and (4) the number of the “Express Mail” mailing label must be placed on the document prior to mailing.

If a document not excluded by 37 C.F.R. §2.198(a) is filed in accordance with the requirements of 37 C.F.R. §2.198, but the document is not given a filing date as of the date of deposit as Express Mail, the filer may request the USPTO to change the filing date of the document, pursuant to 37 C.F.R. §2.198(c), (d) or (e). Rule 2.198(c) applies when there is a discrepancy between the filing date assigned by the USPTO and the “date-in” entered by the USPS on the “Express Mail” mailing label; Rule 2.198(d) applies when the “date-in” is incorrectly entered or omitted by the USPS; and Rule 2.198(e) applies when correspondence deposited with the USPS as “Express Mail” is not received by (or is lost within) the USPTO. A petition to change the filing date of a document pursuant to 37 C.F.R. §2.198 must:

- (1) be filed within two months of the mailing date of the action from which relief is requested, or, if there is no “mailing of an action,” within two months of the date that the party who filed the correspondence became aware that there was a problem with the USPTO’s receipt of the correspondence (37 C.F.R. §§2.146(d), 2.198(c)(1), 2.198(d)(1) and 2.198(c)(1); TMEP §1705.04);
- (2) include a showing that the number of the “Express Mail” mailing label was placed on the correspondence prior to the original mailing (37 C.F.R. §§2.198(c)(2), 2.198(d)(2) and 2.198(e)(2));
- (3) include a true copy of the “Express Mail” mailing label with the “date in” clearly marked (37 C.F.R. §§2.198(c)(3), 2.198(d)(3) and 2.198(e)(3));
- (4) if the filer contends that the “date in” was entered incorrectly by the USPS, include: (a) a showing that the correspondence was deposited as Express Mail prior to the last scheduled pickup on the requested filing date; and (b) evidence from the USPS or evidence that came into being *after* deposit and within one business day of the deposit of the correspondence as “Express Mail” (37 C.F.R. §2.198(d)(3)); and

## FILING AND RECEIPT OF DOCUMENTS

- (5) if the correspondence is lost within or never received by the USPTO, include: (a) a true copy of the originally deposited correspondence showing the number of the "Express Mail" mailing label; and (b) a statement, signed by the person who deposited the documents as "Express Mail" with the USPS, setting forth the date and time of deposit, and stating that the copies of the correspondence and "Express Mail" mailing label accompanying the petition are true copies of those originally sent (37 C.F.R. §§2.198(e)(3) and 2.198(e)(4)).

When correspondence not excluded by 37 C.F.R. §2.198(a) is placed in an "Express Mail" drop box after the box has been cleared for the last time on a given day, it is considered to have been deposited as of the date of receipt indicated on the "Express Mail" mailing label by the USPS employee. See notice at 61 Fed. Reg. 56439 (Nov. 1, 1996) and 1192 TMOG 95 (Nov. 26, 1996).

### **305.04 Interruptions in U.S. Postal Service**

Under 35 U.S.C. §21(a) and 37 C.F.R. §2.195(e), if there is an interruption or emergency in the United States Postal Service, the Director may consider correspondence to have been filed in the Office on a particular date if the correspondence is: (1) filed promptly after the ending of the designated interruption or emergency; and (2) accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service.

### **306 Facsimile Transmission (Fax)**

*Extract from 37 C.F.R. §2.195. Receipt of trademark correspondence.*

(a) \* \* \*

*Trademark correspondence received in the Office is given a filing date as of the date of receipt except as follows:*

\* \* \*

*(3) Correspondence transmitted by facsimile will be given a filing date as of the date on which the complete transmission is received in the Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the filing date will be the next succeeding day that is not a Saturday, Sunday, or Federal holiday within the District of Columbia.*

\* \* \* \* \*

*(c) Facsimile transmission. Except in the cases enumerated in paragraph (d) of this section, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Office, unless that date is a Saturday, Sunday, or Federal*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*holiday within the District of Columbia. See §2.196. To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application, registration or proceeding before the Office. The application serial number, registration number, or proceeding number should be entered as a part of the sender's identification on a facsimile cover sheet.*

*(d) Facsimile transmissions are not permitted and if submitted, will not be accorded a date of receipt, in the following situations:*

- (1) Applications for registration of marks;*
- (2) Drawings submitted under §2.51, §2.52, §2.72, or §2.173;*
- (3) Correspondence to be filed with the Trademark Trial and Appeal Board, except notices of ex parte appeal;*
- (4) Requests for cancellation or amendment of a registration under section 7(e) of the Trademark Act; and certificates of registration surrendered for cancellation or amendment under section 7(e) of the Trademark Act; and*
- (5) Madrid-related correspondence submitted under §7.11, §7.21, §7.14, §7.23, §7.24, or §7.31.*

\* \* \* \* \*

The USPTO permits the filing of certain correspondence by fax. See TMEP §306.03 regarding the date of receipt of correspondence that is filed by fax.

A certificate of transmission may be used to establish timely filing in the event that the correspondence is transmitted within the response period but is received in the Office after expiration of the response period, or is not received by or lost within the Office. See TMEP §§306.05 *et seq.* regarding the requirements for the certificate of transmission procedure.

### **306.01 Documents That May Not Be Filed by Facsimile Transmission**

All trademark documents ***except the documents listed below*** may be filed by fax, and are eligible for the benefits of the certificate of transmission provided for in 37 C.F.R. §2.195.

The following types of trademark correspondence may *not* be filed by facsimile transmission and, if submitted by fax, will not be given a filing date:

- (1) Trademark applications;
- (2) Drawings submitted under 37 C.F.R. §§2.51, 2.52 or 2.72;
- (3) Requests for cancellation or amendment of a registration under 15 U.S.C. §1057(e);
- (4) Certificates of registration;
- (5) Correspondence to be filed with the Trademark Trial and Appeal Board, except a notice of *ex parte* appeal;



## FILING AND RECEIPT OF DOCUMENTS

- (6) Madrid-related correspondence submitted under 37 C.F.R. §7.11, §7.21, §7.14, §7.23, §7.24, or §7.31; and
- (7) Documents that are required by statute to be certified (e.g., certified copies of court orders).

37 C.F.R. §2.195(d). Applications for registration of marks may be filed electronically using TEAS (see TMEP §301).

When any trademark document specifically excluded from the fax transmission procedure is received in the USPTO by fax, the document will not be accepted. As a courtesy, the USPTO will attempt to notify senders whenever correspondence that falls within one of these prohibitions is sent to the USPTO by fax.

### **306.02 Fax Machines Designated to Accept Relevant Trademark Documents**

The fax machines that are designated to accept trademark documents are attended between the business hours of 8:30 a.m. and 5:00 p.m., Eastern Standard Time, Monday through Friday, excluding holidays.

Submissions by fax should be transmitted to the location for which they are intended. A USPTO Contacts List, which includes fax numbers, is available on the USPTO website at [www.uspto.gov](http://www.uspto.gov), and appears periodically in the *Official Gazette*. In addition, questions about fax numbers may be directed to the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199.

The USPTO does not formally acknowledge receipt of documents transmitted by fax, but USPTO fax machines will usually confirm to the sending unit that the transmission is complete.

Each fax machine location in the USPTO maintains a log comprising a collection of daily activity sheets recording all fax transmissions received. These logs can be used as evidence of receipt in the USPTO, and may be used to reinstate applications and registrations. The individual activity report that pertains to a particular transmission received in the USPTO is kept with the correspondence.

### **306.03 Effect of Filing by Fax**

The filing date of correspondence received in the USPTO by fax, regardless of whether it contains a certificate of transmission, is the date that the complete transmission is received by a USPTO fax machine, unless the transmission is completed on a Saturday, Sunday or Federal holiday within the District of Columbia. Correspondence for which transmission is completed on a Saturday, Sunday or Federal holiday within the District of Columbia is given a filing date as of the next succeeding day that is not a

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Saturday, Sunday or Federal holiday within the District of Columbia.  
37 C.F.R. §2.195(a)(3).

For example, a 20-minute fax transmission to the USPTO from California starting on a Friday at 8:45 p.m. Pacific Standard Time would be completed at 9:05 p.m. Pacific Standard Time. The complete transmission would be received in the USPTO at approximately 12:05 a.m. Eastern Standard Time on Saturday. The filing date accorded to the correspondence is the date of the following business day, which in this case would be Monday (assuming that Monday is not a Federal holiday within the District of Columbia).

The phrase “complete transmission” means that the transmission was received in its entirety. For example, if page one of a ten-page fax transmission is received in the USPTO at 11:55 p.m. on a Tuesday and page ten of that transmission is received at 12:05 a.m. Wednesday, the filing date accorded to that correspondence will be the date of that Wednesday (assuming that Wednesday is not a Federal holiday within the District of Columbia).

If the sender wants the correspondence to be considered timely filed as of the date that the transmission began, the correspondence must include a certificate of transmission under 37 C.F.R. §2.197(a). See TMEP §306.05(c) regarding the effect of a certificate of transmission.

### **306.04 Procedure for Filing by Fax**

Each transmission session should be limited to correspondence to be filed in a single application or other proceeding before the Office. The application serial number or registration number should be entered as a part of the sender’s identification on a facsimile cover sheet. 37 C.F.R. §2.195(c). Applicants should wait until an application serial number is assigned before filing any document related to a new application by fax. See 37 C.F.R. §2.194(a).

It is recommended that each transmission include a cover sheet that, in addition to stating the application serial number or registration number, specifies the mark, the number of pages being transmitted, and the name, address, fax number and telephone number of the transmitting party.

Each facsimile-transmitted document must be legible. The preferred size of the document being submitted is 8½ inches by 11 inches, letter size or A4 paper. Because equipment used by the Office cannot print a document larger than 8½ inches by 11 inches, correspondence should not be transmitted on larger sized paper.

When correspondence is filed by facsimile transmission, it is recommended that the sending facsimile machine generate a report confirming transmission for each transmission session. This report should be retained by the

## FILING AND RECEIPT OF DOCUMENTS

applicant, along with the original correspondence, as evidence of content and date of transmission.

Unless specifically requested to do so by the Office, parties should **not** mail follow up copies of documents transmitted by fax. 37 C.F.R. §2.193(a). This can delay processing.

### **306.05 Certificate of Transmission Procedure**

*Extract from 37 C.F.R. §2.197. Certificate of mailing or transmission.*

*(a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.*

*(1) Correspondence will be considered as being timely filed if:*

*(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:*

*(A) Addressed as set out in §2.190 and deposited with the U.S. Postal Service with sufficient postage as first class mail; or*

*(B) Transmitted by facsimile to the Office in accordance with §2.195(c); and*

*(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have a reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.*

*(2) The procedure described in paragraph (a)(1) of this section does not apply to:*

*(i) Applications for the registration of marks under 15 U.S.C. 1051 or 1126; and*

*(ii) Madrid-related correspondence filed under §7.11, §7.21, §7.14, §7.23, §7.24 or §7.31.*

*(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Office, and an application is abandoned, a registration is cancelled or expired, or a proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:*

*(1) Informs the Office of the previous mailing or transmission of the correspondence within two months after becoming aware that the Office has no evidence of receipt of the correspondence;*

*(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and*

*(3) Includes a statement that attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*sending unit's report confirming transmission may be used to support this statement.*

*(c) The Office may require additional evidence to determine whether the correspondence was timely filed.*

Trademark Rule 2.197, 37 C.F.R. §2.197, provides a certificate of transmission procedure to avoid lateness when correspondence is faxed within the response period but is received in the USPTO after expiration of the response period, or not received, or lost within the USPTO. The certificate of transmission procedure can be used for any correspondence that can be filed by fax. See TMEP §306.01 regarding documents that can be filed by fax.

Under the certificate of transmission procedure, certain correspondence will be considered to be timely filed even if received after the end of the filing period, if the correspondence is transmitted by fax to the USPTO before the expiration of the filing period and accompanied by a certificate attesting to the date of transmission. The person signing the certificate certifies the expectation that the transmission would be initiated before midnight, local time, on the date specified.

Filers must retain a copy of the correspondence, including the signed and dated certificate. See *In re Sasson Licensing Corporation*, 35 USPQ2d 1510 (Comm'r Pats. 1995).

See TMEP §306.05(d) regarding the procedure for establishing the timely filing of correspondence that was faxed to the USPTO with a certificate of transmission under 37 C.F.R. §2.197, but was lost or misplaced.

See TMEP §304.05 regarding certificates of transmission by e-mail.

### **306.05(a) Location and Form of Certificate of Transmission**

The certificate of transmission should be clearly labeled as such and should include a reference to the registration number or application serial number, the date of transmission, and the signature of the person attesting that the document is being transmitted on a certain date.

When possible, the certificate should appear on the paper being transmitted, rather than on a separate sheet of paper. See notices at 58 Fed. Reg. 54494 (Oct. 22, 1993) and 1157 TMOG 87, 92-93 (Dec. 28, 1993).

If the certificate of facsimile transmission is presented on a separate paper, it *must* identify the paper, and the application or registration to which it relates.

## FILING AND RECEIPT OF DOCUMENTS

### **306.05(b) Wording of Certificate of Transmission**

The following wording is suggested for the certificate of transmission:

#### CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on the date shown below.

\_\_\_\_\_  
(Typed or Printed Name of Person Signing Certificate)

\_\_\_\_\_  
(Signature)

\_\_\_\_\_  
(Date)

### **306.05(c) Effect of Certificate of Transmission**

As noted in TMEP §306.03, the filing date given to correspondence received by fax transmission is the date that the complete transmission is received by a USPTO fax machine, unless the transmission is completed on a Saturday, Sunday or Federal holiday within the District of Columbia, in which case the filing date is the next succeeding day that is not a Saturday, Sunday or Federal holiday within the District of Columbia.

The date of transmission on the certificate is used only to determine whether the correspondence was transmitted to the USPTO within the filing period. Therefore, if the complete transmission is actually received in the USPTO within the filing period, the certificate of transmission is ignored. If the transmission is completed after the expiration of the filing period, the USPTO looks at the correspondence to see if a certificate of transmission was included. If no certificate is found, the correspondence is untimely.

If the correspondence includes a signed certificate of transmission, and the date of transmission on the certificate is within the filing period, the correspondence is considered to be timely.

For example, if a West Coast applicant transmitted correspondence by fax on the last day of the response period, beginning before 9:00 p.m. Pacific Standard Time (midnight Eastern time) but completed after 9:00 p.m. Pacific Standard Time, the USPTO would give the correspondence a filing date as of the next business day, because that is the date on which the USPTO received the complete transmission. However, if the practitioner affixed a certificate of transmission to the faxed correspondence indicating that the correspondence was being transmitted on the last day of the response period, then the correspondence would be considered timely filed, even though the transmission completed after 9:00 p.m. Pacific Standard Time (midnight

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Eastern time) was received in the USPTO the day after the deadline for response.

If the filing period ends on a Saturday, Sunday or Federal holiday within the District of Columbia, the correspondence will be considered to be timely if the date of transmission on the certificate is the next succeeding day that is not a Saturday, Sunday or Federal holiday within the District of Columbia (see 37 C.F.R. §2.196 and TMEP §308).

Whenever it is necessary to change the effective filing date of an application (for example, when an application filed under §1(b) of the Trademark Act is amended to request registration on the Supplemental rather than the Principal Register after submission of an allegation of use) and the correspondence included a certificate of transmission under 37 C.F.R. §2.197, the date of actual receipt (as stamped or labeled on the relevant correspondence) rather than the date on the certificate is used as the new effective filing date. See TMEP §§206 *et seq.* as to changes in the effective filing date of an application.

### **306.05(d) Correspondence Transmitted by Fax Pursuant to 37 C.F.R. §2.197 But Not Received by Office**

Rule 2.197(b) sets forth procedures for requesting that correspondence be considered timely when the correspondence is filed with a certificate of transmission, but is not received by or is lost within the USPTO. Such correspondence will be considered timely based on the date of transmission set forth on the certificate of transmission, if the party who transmitted the correspondence:

- (1) informs the USPTO in writing of the previous fax transmission of the correspondence within two months after becoming aware that the USPTO has no evidence of receipt of the correspondence;
- (2) supplies an additional copy of the previously transmitted correspondence, including a copy of the signed and dated certificate of transmission (see *In re Sasson Licensing Corporation*, 35 USPQ2d 1510 (Comm'r Pats. 1995)); and
- (3) includes a statement attesting to the previous timely transmission on the basis of the signer's personal knowledge. A copy of the sending unit's report confirming transmission may be used to support this statement. The statement does not have to be verified.

Under 37 C.F.R. §§2.146(d) and 2.197(b)(1), a party must notify the USPTO of the transmission of the correspondence within two months after becoming aware that the USPTO has no evidence of receipt of the correspondence. Where no written action is generated that can be used as a starting point for measuring the petition's timeliness, the two-month deadline runs from the

## FILING AND RECEIPT OF DOCUMENTS

date that the party who filed the correspondence became aware that there was a problem with the filing date. See TMEP §1705.04.

The required evidence should be directed to the area in the USPTO where the misplaced or lost document was intended to be filed, e.g., the law office, ITU Unit or Post Registration Section.

If *all* the above criteria cannot be met, the only remedy available is a petition to revive under 37 C.F.R. §2.66 (if appropriate), or a petition under 37 C.F.R. §2.146, which must include a petition fee of \$100, and a statement that attests on a personal knowledge basis to the previous timely transmission, along with any additional evidence. See 37 C.F.R. §§2.66 and 2.146; TMEP §§1702 through 1708 regarding petitions under 37 C.F.R. §2.146, and TMEP §§1714 *et seq.* regarding petitions to revive.

The above procedure does *not* apply to submissions that are excluded from the certificate of mailing or transmission procedures under 37 C.F.R. §2.195(d) or §2.197(a)(2). See TMEP §306.01.

Under 37 C.F.R. §2.197(c), the USPTO may require evidence relating to the transmission of correspondence under 37 C.F.R. §2.197(a), to establish an actual date of transmission. See, e.g., *In re Klein*, 6 USPQ2d 1547 (Comm'r Pats. 1987), *aff'd sub nom. Klein v. Peterson*, 696 F. Supp. 695, 8 USPQ2d 1434 (D.D.C. 1988), *aff'd*, 866 F.2d 412, 9 USPQ2d 1558 (Fed. Cir. 1989), *cert. denied*, 490 U.S. 1091 (1989).

### **306.06 Requirements for Certificate of Transmission Strictly Enforced**

The requirements of 37 C.F.R. §2.197 are strictly enforced, and petitions to consider a document timely filed as of the date on the certificate are denied when a party fails to comply with these requirements. A party's inadvertent failure to comply with the requirements of a rule is not considered an extraordinary situation that would warrant waiver of the rule under 37 C.F.R. §2.146(a)(5) or §2.148. See TMEP §305.02(h) and cases cited therein.

### **307 Hand Delivery**

*Trademark Operation, Madrid Processing Unit, and Trademark Trial and Appeal Board.* Correspondence may be hand-delivered between 8:00 a.m. and 5:00 p.m., Eastern Time, Monday through Friday, except Federal holidays within the District of Columbia, to the following location:

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Trademark Assistance Center  
James Madison Building - East Wing  
Concourse Level  
600 Dulany Street  
Alexandria, VA

Trademark examining attorneys *will not* accept papers for filing (either with or without fees).

If the filer wants a receipt, he or she should provide a card, which will be date-labeled and handed back to the person delivering the paper. When a card is used for receipt, it should include the applicant's name, the application serial number or registration number, the mark, and the title or a description of the paper being filed. The card should also specify the items submitted (e.g., drawing, specimen, fee). See TMEP §303.02(c).

*Customer Service Window.* The USPTO strongly encourages parties who are hand-delivering trademark correspondence to bring it directly to the Trademark Assistance Center at the address listed above. Use of any patent box for trademark-related correspondence is strongly discouraged, and may result in delayed processing. However, the USPTO will accept trademark correspondence delivered to the Customer Service Window located in the Randolph Building, 401 Dulany Street, Alexandria, Virginia. The USPTO will stamp postcard-type receipts to acknowledge the receipt of correspondence filed at the Customer Service Window. The Customer Service Window is open from 8:30 a.m. until 12:00 midnight, Monday through Friday, except holidays.

See TMEP §309 regarding unscheduled closings of the USPTO.

### **308 Period Ending on Saturday, Sunday or Federal Holiday**

*35 U.S.C. §21(b) When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.*

*37 C.F.R. §2.196. Whenever periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or by regulation under this part for taking any action or paying any fee in the Office falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding day that is not a Saturday, Sunday, or a Federal holiday.*

(See also 37 C.F.R. §2.145 for time for appeal to court and civil action.)



## FILING AND RECEIPT OF DOCUMENTS

Any action or fee that is due on a date falling on a Saturday, Sunday, or a Federal holiday within the District of Columbia is considered timely if the action is received, or the fee paid, on the following day that is not a Saturday, Sunday or a Federal holiday within the District of Columbia. This applies to all documents, whether filed through TEAS or on paper.

The following days are Federal holidays in the District of Columbia, under 5 U.S.C. §6103:

- New Year's Day, January 1.
- Birthday of Martin Luther King, Jr., the third Monday in January.
- Washington's Birthday, the third Monday in February.
- Memorial Day, the last Monday in May.
- Independence Day, July 4.
- Labor Day, the first Monday in September.
- Columbus Day, the second Monday in October.
- Veterans Day, November 11.
- Thanksgiving Day, the fourth Thursday in November.
- Christmas Day, December 25.
- Inauguration Day (January 20 of each fourth year after 1965), **except** when it falls on a Saturday (see Note below).

As to the observance of holidays that fall on Saturday, 5 U.S.C. §6103 also provides:

*(b)(1) Instead of a holiday that occurs on a Saturday, the Friday immediately before is a legal public holiday...*

**NOTE:** If Inauguration Day (January 20 of each fourth year after 1965) falls on a Saturday, the preceding Friday is **not** a legal public holiday for purposes of 35 U.S.C. §21. When Inauguration Day falls on Sunday, the next succeeding day selected for the public observance of the inauguration of the President is a legal public holiday. 5 U.S.C. §6103(c).

### **309                      Unscheduled Closings of the United States Patent and Trademark Office**

When the USPTO is officially closed by executive order of the President or by the Office of Personnel Management for an entire day because of some unscheduled event, such as adverse weather conditions, the USPTO will

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

consider that day to be a “Federal holiday within the District of Columbia” under 35 U.S.C. §21. 37 C.F.R. §2.2(d). Any action or fee due that day is considered timely if the action is taken, or the fee paid, on the next succeeding business day that the USPTO is open.

However, when the USPTO is open for business during any *part* of a business day between 8:30 a.m. and 5:00 p.m., papers are due on that day even though the USPTO may be officially closed for some period of time during the business day because of an unscheduled event. TEAS, or the procedures of 37 C.F.R. §2.197, may be used, as appropriate, for the filing of papers during unscheduled closings of the USPTO.

### **310                      Computing Period for Response to Office Action or Notice**

The deadline for responding to an Office action, notice of allowance, or other notice issued by the USPTO is computed from the mailing date stamped on the action or notice to the date the response is received in the USPTO. See TMEP §303.01 regarding the date of receipt in the USPTO.

For example, a response to an examining attorney’s Office action dated August 31 is due on the following February 28 (or 29 if it is a leap year); a response to an Office action dated February 28 is due on August 28 and not on the last day of August. *Ex parte Messick*, 1930 C.D. 6 (Comm’r Pats. 1930).

Under 37 C.F.R. §2.197, correspondence is considered to be timely filed even if it is received after the expiration of the filing period, if the correspondence was deposited with the USPS as first class mail or transmitted to the USPTO by facsimile transmission before the expiration of the filing period and accompanied by a certificate attesting to the date of mailing or transmission. See TMEP §§305.02 *et seq.* regarding the certificate of mailing procedure, and TMEP §§306.05 *et seq.* regarding the certificate of transmission procedure.

If a response or fee is due on a Saturday, Sunday, or a Federal holiday within the District of Columbia, the response or fee is considered timely if it is received on the following day that is not a Saturday, Sunday or a Federal holiday within the District of Columbia. 35 U.S.C. §21(b); 37 C.F.R. §2.196; TMEP §308.

See TMEP §309 regarding unscheduled closings of the USPTO.

# Chapter 400

## Processing Documents and Fees

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### **401 Processing New Applications**

- 401.01 Filing Receipts
- 401.02 Serial Numbers and Series Codes
- 401.03 Data Entry
- 401.04 Creation of Application Files

### **402 Electronic Application and Registration Files**

- 402.01 USPTO No Longer Creates Paper Copies of Certain Trademark-Related Documents

### **403 Correspondence Returned as Undeliverable**

### **404 Documents Not Returnable**

### **405 Fees**

- 405.01 Credit Cards
- 405.02 Checks
  - 405.02(a) Personal Checks
- 405.03 Deposit Accounts
- 405.04 Refunds
- 405.05 Electronic Funds Transfer
- 405.06 Payments Refused or Charged Back By Financial Institutions

### **401 Processing New Applications**

Upon receipt in the USPTO, trademark applications filed under §1 or §44 of the Trademark Act are given a date of receipt and reviewed for compliance with the minimum requirements for receipt of a filing date (see TMEP §202).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

See TMEP §§201 and 1904.01(b) regarding the filing date of applications under §66(a) of the Trademark Act.

If an application meets the minimum filing date requirements, it is given a filing date and serial number. See 37 C.F.R. §2.23.

See TMEP §§204 *et seq.* regarding the processing of applications that are not entitled to a filing date.

### **401.01 Filing Receipts**

#### ***TEAS Applications***

For applications filed through the Trademark Electronic Application System (“TEAS”), the USPTO immediately issues a confirmation of filing via e-mail that includes the serial number and date of receipt. This e-mail confirmation serves as evidence of filing should any question arise as to the filing date of the application. No paper filing receipt is generated.

The e-mail confirmation includes a summary of all the data provided by applicant in the application. The applicant or attorney should review this information for accuracy. If the information in the e-mail confirmation is inconsistent with the information transmitted by applicant, the applicant or attorney should notify the USPTO by replying to the e-mail confirmation.

#### ***Applications Under §66(a)***

For §66(a) applications (requests for extensions of protection of international registrations to the United States), an acknowledgment of receipt of the application will be sent to the International Bureau of the World Intellectual Property Organization (“IB”). The IB will send the acknowledgment to the applicant. See TMEP §§1904 *et seq.* for further information about §66(a) applications.

#### ***Paper Applications Under §1 or §44***

For paper applications under §1 or §44 of the Trademark Act, after an application has been given a filing date, the Trademark Reporting and Monitoring (“TRAM”) System generates a filing receipt and sends it to the applicant or the applicant’s attorney. The filing receipt identifies the following: (1) the application serial number and filing date; (2) the statutory basis or bases for filing, if provided at the time of filing; (3) information regarding the mark, the applicant, and the goods and/or services; (4) the international class(es); and (5) the address to be used for correspondence.

The applicant or attorney should review the information on the filing receipt for accuracy and notify the USPTO in writing of any discrepancy. A request for correction of a filing receipt should be directed to the Pre-Examination Section

## PROCESSING DOCUMENTS AND FEES

of the Office of Trademark Services, or sent via e-mail to [TMfiling.receipt@uspto.gov](mailto:TMfiling.receipt@uspto.gov).

An applicant should send a request for correction of a filing receipt *only* if the information on the filing receipt is inconsistent with the information in the application as filed. If the applicant made an error in the application, the applicant should file an amendment rather than a request for correction of the filing receipt.

### **401.02 Serial Numbers and Series Codes**

Each application for registration is assigned a six digit serial number, preceded by a two digit series code.

As a general rule, the serial numbers of applications filed prior to the 1905 - 1920 Acts series are preceded by the series code "70."

Applications filed under the 1905 - 1920 Acts (*i.e.*, applications filed through July 4, 1947) were preceded by the series code "71." The last serial number was 526,346.

As of July 5, 1947, applications were filed under the 1946 Act, beginning with number 526,500 and running through number 700,943 (preceded by the series code "71").

On January 3, 1956, a new series of serial numbers preceded by the series code "72" was started, after a change in record keeping methods. This series ran through number 467,233, issued on August 31, 1973.

A new series of serial numbers preceded by the series code "73" began with applications filed on September 4, 1973, which was the first day of receipt of mail after the adoption of the international classification of goods and services as of September 1, 1973 (see TMEP §1401.02).

A new series of serial numbers preceded by the series code "74" began with applications filed on November 16, 1989, the date on which the Trademark Law Revision Act of 1988 took effect.

A new series of serial numbers preceded by the series code "75" began with applications filed on October 1, 1995.

A new series of serial numbers preceded by the series code "76" began with applications filed on March 20, 2000.

A series of serial numbers preceded by the series code "78" is used for applications filed through TEAS.

Effective November 2, 2003, a series of serial numbers preceded by the series code "79" is used for requests for extension of protection of

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

international registrations to the United States under §66(a) of the Trademark Act.

A range of serial numbers, beginning with number 800,000, is used for applications that are created through the “dividing” of an application (see TMEP §§1110 *et seq.*).

See TMEP §1205.02 regarding series code “89.”

### **401.03 Data Entry**

For applications filed through TEAS, the data provided by the applicant is loaded directly into the USPTO’s automated TRAM System.

For applications filed on paper, the application data is scanned into the TRAM System. TRAM may be used by USPTO employees to obtain information about the location and status, prosecution history, ownership, and correspondence address for applications and registrations. This information is available to the public through the Trademark Applications and Registrations Retrieval (“TARR”) database, available on the USPTO’s website at <http://tarr.uspto.gov>.

### **401.04 Creation of Application Files**

For TEAS applications, the USPTO maintains an electronic file containing all incoming and outgoing papers. See TMEP §402.

For paper applications, the USPTO scans all incoming papers and creates an electronic file. The USPTO also creates a paper file jacket and places all incoming papers into the file jacket. The examining attorney works from the electronic file, and outgoing communications are put into the electronic file only.

All applications are routed directly to the law offices.

### **402 Electronic Application and Registration Files**

The USPTO maintains the Trademark Image Capture and Retrieval System (“TICRS”), which includes images of the contents of trademark application and registration files.

TICRS is available in the Trademark Search Library, free of charge, to all members of the public who visit the USPTO. Members of the public can print images of documents from TICRS for a fee.

The public may also view and print images of the contents of trademark application and registration files through the Trademark Document Retrieval (“TDR”) portal on the USPTO website at <http://www.uspto.gov/>. Electronic

## PROCESSING DOCUMENTS AND FEES

images of Trademark Trial and Appeal Board proceeding files are also available on the USPTO website at <http://ttabvue.uspto.gov/ttabvue/>. TDR and TTABVUE are available 24 hours a day, seven days a week, free of charge.

### **402.01 USPTO No Longer Creates Paper Copies of Certain Trademark-Related Documents**

Effective April 12, 2004, the USPTO no longer creates paper copies of certain trademark-related documents that are submitted to the USPTO in electronic format. Furthermore, the USPTO does not generate paper copies of certain trademark documents that the USPTO creates, except for copies that are sent to recipients by mail. See *New USPTO Policies Regarding (1) Generation of Paper Copies of Trademark-Related Documents and (2) Public Access to Existing Paper Copies of Trademark-Related Documents* (TMOG Apr. 6, 2004), at <http://www.uspto.gov/web/offices/com/sol/og/2004/week14/pattmcp.htm>.

All these documents can be viewed through TIGRS and TDR.

The USPTO still provides certified paper copies of all trademark documents, upon request and payment of the appropriate fee. See TMEP §111.

### **403 Correspondence Returned as Undeliverable**

If a paper Office action or notice (e.g., a notice of allowance) is returned to the USPTO because the United States Postal Service has not been able to deliver it, the USPTO will try to ascertain the correct address and forward the correspondence. However, the re-mailed correspondence will not receive a new mailing date unless the USPTO sent the Office action to the wrong address due to an Office error.

When returned correspondence is received in the USPTO, it should be forwarded to the Supervisor of the office where the file is located (e.g., the supervisory legal instruments examiner in the law office, or supervisor of the ITU/Divisional Unit or Post Registration Section). If the application is abandoned, the returned Office action should be forwarded to the Office of the Commissioner for Trademarks.

The supervisor will review the file to determine whether the correspondence address was entered correctly, and/or whether a notice of change of address has been filed.

If the USPTO sent the Office action or notice to the wrong address due to an Office error, the Office action will be re-mailed with a new mailing date. An "Office error in sending the Office action to the wrong address" means that the USPTO either entered the correspondence address incorrectly or failed to properly enter a notice of change of address filed *before* the mailing date of

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

the action. The transmittal of a response on letterhead bearing a new address is *not* a proper notice of change of address. The applicant or attorney must specifically request that the correspondence address be changed. TMEP §603.02(a).

If the Office action or notice was sent to the correspondence address of record (see TMEP §§603 *et seq.* regarding the correspondence address), but was returned as undeliverable, the USPTO will try to obtain the correct address and forward the Office action or notice. However, the Office action or notice will not be given a new mailing date, and the time for response will not be extended.

The USPTO scans the returned action and envelope into TICRS.

If outgoing electronic mail (“e-mail”) is returned as undeliverable, the USPTO will mail a paper copy to the correspondence address of record. See TMEP §§304 *et seq.* regarding e-mail.

### **404 Documents Not Returnable**

After an application has received a filing date, the application will not be returned to the applicant for any purpose. 37 C.F.R. §2.25. Furthermore, once any document has been filed with respect to an application or registration, it becomes part of the public record and will not be returned.

The USPTO will furnish copies of the contents of trademark application, registration, and TTAB proceeding files upon request and payment of the required fee. See TMEP §111.

### **405 Fees**

*37 C.F.R. §2.207. Methods of payment.*

*(a) All payments of money required in trademark cases, including fees for the processing of international trademark applications and registrations that are paid through the Office, shall be made in U.S. dollars and in the form of a cashier’s or certified check, Treasury note, national bank note, or United States Postal Service money order. If sent in any other form, the Office may delay or cancel the credit until collection is made. Checks and money orders must be made payable to the Director of the United States Patent and Trademark Office. (Checks made payable to the Commissioner of Patents and Trademarks will continue to be accepted.) Payments from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required. Money sent to the Office by mail will be at the risk of the sender, and letters containing money should be registered with the United States Postal Service.*

*(b) Payments of money required for trademark fees may also be made by credit card, except for replenishing a deposit account. Payment of a fee by*



## PROCESSING DOCUMENTS AND FEES

*credit card must specify the amount to be charged to the credit card and such other information as is necessary to process the charge, and is subject to collection of the fee. The Office will not accept a general authorization to charge fees to a credit card. If credit card information is provided on a form or document other than a form provided by the Office for the payment of fees by credit card, the Office will not be liable if the credit card number becomes public knowledge.*

See 37 C.F.R. §2.6(a)(i) and TMEP §§810 *et seq.* regarding the fee for filing an application for registration.

See TMEP §1903 regarding payment of fees to the IB through the USPTO.

### **405.01 Credit Cards**

Under 37 C.F.R. §2.207, the USPTO accepts payment of fees by credit card, subject to actual collection of the fee.

Any payment of a fee by credit card must be in writing. 37 C.F.R. §2.191. A form for authorizing charges to a credit card can be accessed through TEAS for all filings for which a filing fee is required. Parties who file on paper can download a Credit Card Payment Form (PTO-2038) from the USPTO's website at <http://www.uspto.gov/>. The USPTO does not put the Credit Card Payment Form in application or registration files.

A party is not required to use the Office's Credit Card Payment Form when paying a fee by credit card. However, if a party provides a credit card charge authorization in another form or document (*e.g.*, in the body of an application, cover letter, response to an Office action, or other correspondence relating to a trademark application or registration), the credit card information becomes part of the public record. 37 C.F.R. §2.207(b).

All credit card authorizations must include: (1) a valid credit card number; (2) a valid expiration date; (3) the name of the cardholder with the cardholder's signature and the date; (4) a billing address, including zip code; (5) a description and purpose of the payment; and (6) a specific payment amount. See TMEP §804.05 regarding signature of documents filed electronically.

If a Credit Card Payment Form or other document authorizing the USPTO to charge a fee to a credit card does not contain the information necessary to charge the fee to the credit card, the form will be returned and the fee will not be processed. USPTO employees will not accept oral instructions to complete the Credit Card Payment Form or otherwise charge a fee to a credit card.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The USPTO will only accept an authorization to charge a fee in a specific dollar amount to a credit card.

The USPTO currently accepts charges to the following credit cards: AMERICAN EXPRESS®, DISCOVER®, MASTER CARD®, and VISA®.

Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged. 37 C.F.R. §2.209(a). The USPTO will not refund a fee paid by credit card by Treasury check, electronic funds transfer, or credit to a deposit account.

See notice at 65 Fed. Reg. 33452 (May 24, 2000) and 1235 TMOG 38 (June 13, 2000).

See TMEP §405.06 regarding credit card authorizations that are refused or charged back by a financial institution.

### **405.02            Checks**

Trademark Rule 2.207(a), 37 C.F.R. §2.207(a), provides that:

All payments of money required in trademark cases, including fees for the processing of international trademark applications and registrations that are paid through the Office, shall be made in U.S. dollars and in the form of a cashier's or certified check, Treasury note, national bank note, or United States Postal Service money order. If sent in any other form, the Office may delay or cancel the credit until collection is made....

### **405.02(a)        Personal Checks**

It is the practice of the USPTO to accept, as "conditional" payment of a fee, a signed uncertified check (e.g., a personal check). If an uncertified check clears, then the USPTO considers the fee paid as of the date it received the check.

However, if such a check is returned unpaid, then the fee remains unpaid, and the paper that included the returned check is processed as though the fee had been omitted. See *In re Paulsen*, 35 USPQ2d 1638 (Comm'r Pats. 1995). See TMEP §405.06 for further information about processing checks that are returned unpaid.

Under 37 C.F.R. §2.6(b)(12), there is a processing fee for any check returned to the Office unpaid.

## PROCESSING DOCUMENTS AND FEES

### 405.03 Deposit Accounts

*Extract from 37 C.F.R. §2.208.*

*(a) For the convenience of attorneys, and the general public in paying any fees due, in ordering copies of records, or services offered by the Office, deposit accounts may be established in the Office upon payment of the fee for establishing a deposit account (§2.6(b)(13)). A minimum deposit of \$1,000 is required for paying any fees due or in ordering any services offered by the Office. The Office will issue a deposit account statement at the end of each month. A remittance must be made promptly upon receipt of the statement to cover the value of items or services charged to the account and thus restore the account to its established normal deposit. An amount sufficient to cover all fees, copies, or services requested must always be on deposit. Charges to accounts with insufficient funds will not be accepted. A service charge (§2.6(b)(13)) will be assessed for each month that the balance at the end of the month is below \$1,000.*

*(b) A general authorization to charge all fees, or only certain fees to a deposit account containing sufficient funds may be filed in an individual application, either for the entire pendency of the application or with respect to a particular document filed. An authorization to charge a fee to a deposit account will not be considered payment of the fee on the date the authorization to charge the fee is effective as to the particular fee to be charged unless sufficient funds are present in the account to cover the fee.*

*(c) A deposit account holder may replenish the deposit account by submitting a payment to the Office. A payment to replenish a deposit account must be submitted by one of the methods set forth in paragraphs (c)(1), (c)(2), (c)(3), or (c)(4) of this section.*

*(1) A payment to replenish a deposit account may be submitted by electronic funds transfer through the Federal Reserve Fedwire System, which requires that the following information be provided to the deposit account holder's bank or financial institution:*

*(i) Name of the Bank, which is Treas NYC (Treasury New York City);*

*(ii) Bank Routing Code, which is 021030004;*

*(iii) United States Patent and Trademark Office account number with the Department of the Treasury, which is 13100001; and*

*(iv) The deposit account holder's company name and deposit account number.*

*(2) A payment to replenish a deposit account may be submitted by electronic funds transfer over the Office's Internet Web site (<http://www.uspto.gov>).*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*(3) A payment to replenish a deposit account may be submitted by mail with the USPS to: Director of the United States Patent and Trademark Office, P.O. Box 70541, Chicago, Illinois 60673.*

*(4) A payment to replenish a deposit account may be submitted by mail with a private delivery service or hand-carrying the payment to: Director of the United States Patent and Trademark Office, Deposit Accounts, One Crystal Park, Suite 307, 2011 Crystal Drive, Arlington, Virginia 22202.*

A party cannot charge a fee to a deposit account unless he or she has prior authorization to do so. The Office of Finance maintains a list of persons authorized to request transactions by deposit account. The USPTO will not charge a fee to a deposit account unless the person requesting the charge appears on the authorized list or files a proper request to have his or her name added to the authorized list.

If an applicant submits an authorization to charge a filing fee to a deposit account that has insufficient funds to cover the fee, the applicant has not paid the fee.

If a deposit account has insufficient funds to cover an authorization to charge the initial filing fee for an application for registration, the filing date will be cancelled. 37 C.F.R. §2.21(a)(5). See TMEP §204.01.

When a deposit account contains insufficient funds to cover a fee that has been authorized, the USPTO notifies the party who filed the authorization of the fee deficiency. If the fee in question is statutory (e.g., the filing fee for a notice of appeal, statement of use, or request for extension of time to file a statement of use), the fee deficiency must be cured before the expiration of the statutory filing period. If the deadline for filing the fee is not set by statute, the party who filed the authorization may cure the fee deficiency within the set period for response to the Office action.

A showing that the deposit account contained sufficient funds on the date the authorization was first filed, as opposed to the date USPTO personnel attempted to charge the fee, will not cure the fee deficiency. Trademark Rule 2.208 clearly requires that sufficient funds to cover all outstanding charge authorizations be on deposit at all times. The funds must be available in the account at the time the authorization is presented for debiting.

See TMEP §1104.09(g) regarding fee deficiencies in amendments to allege use, TMEP §1108.02(c) regarding fee deficiencies in requests for extensions of time to file a statement of use, TMEP §1109.15(a) regarding fee deficiencies in statements of use, TMEP §1604.06(c) regarding fee deficiencies in affidavits under §8 of the Act, and TMEP §1606.05(c) regarding fee deficiencies in renewal applications.

## PROCESSING DOCUMENTS AND FEES

### 405.04 Refunds

*Extract from 37 C.F.R. §2.209.*

*(a) The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a trademark application, appeal or other trademark filing for which a fee was paid, will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts. If a party paying a fee or requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer (31 U.S.C. 3332 and 31 CFR part 208), or instruct the Office that refunds are to be credited to a deposit account, the Director may require such information, or use the banking information on the payment instrument to make a refund. Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged.*

*(b) Any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in this paragraph. If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§2.208(b)), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.*

Under 35 U.S.C. §42(d) and 37 C.F.R. §2.209, only money paid by mistake or in excess (when a fee is not required by statute or rule, or is not required in the amount paid) may be refunded. A mere change of purpose after the payment of money does not entitle a party to a refund. For example, if a party deletes a class from an application, or withdraws an application or appeal, the party is not entitled to a refund.

If an examining attorney or other USPTO employee erroneously requires a fee, the USPTO will refund the fee submitted in response to the erroneous requirement.

The USPTO will refund the filing fee for an application that is denied a filing date, or a filing fee that is untimely (e.g., the fee for a statement of use or request for an extension of time to file a statement of use filed after expiration of the statutory filing period). However, after the USPTO has processed an application or other document, the USPTO normally will not refund the filing fee. The USPTO will not refund an application filing fee when registration is refused, nor will it refund a fee when a timely filed document (such as a statement of use or §8 affidavit of use or excusable nonuse) is rejected for failure to meet the requirements of the statute and rules.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Refunds are processed at the Customer Service Window located in the Trademark Assistance Center, James Madison Building - East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia. When a USPTO employee determines that a refund is appropriate, the employee should complete a form with the information necessary for processing the refund, and send it to the Fee Processing Office.

### **405.05                    Electronic Funds Transfer**

The Electronic Funds Transfer (“EFT”) payment method allows customers to send a payment over the Internet as easily as writing a check. In general, the Automated Clearing House performs EFT transactions through the Federal Reserve system. The customer must establish a User ID and Password. For further information, see <http://www.uspto.gov/teas/payment.htm>.

### **405.06                    Payments Refused or Charged Back By Financial Institutions**

If a check is returned unpaid, or an EFT or credit card is refused or charged back by a financial institution, the paper that accompanied the payment is processed as though the fee had been omitted. *See In re Paulsen*, 35 USPQ2d 1638 (Comm’r Pats. 1995). If the paper included an authorization to charge deficient fees to a deposit account (37 C.F.R. §2.208), the USPTO charges the fee in question, together with a \$50 fee for processing the payment that was refused, to the deposit account.

If the paper was not accompanied by an authorization to charge fees to a deposit account, the USPTO notifies the party who filed the paper of the fee deficiency in a written action. If the deadline for filing the fee is not set by statute, the fee may be resubmitted within the period set for response to the Office action. If the fee in question is statutory (*e.g.*, a filing fee for an appeal, statement of use, or request for extension of time to file a statement of use), the fee must be resubmitted before the expiration of the statutory filing period.

Under 37 C.F.R. §2.6(b)(12), there is a \$50.00 fee for processing any payment that is refused or charged back by a financial institution. This fee covers the work done by USPTO personnel in processing the payment that is refused or charged back. The requirement for submission of the processing fee is strictly enforced. The USPTO will not approve a pending application for publication or registration, nor take any other requested action in an application or registration, until all outstanding fees, including the processing fee, have been paid. Any request for waiver of this processing fee should be referred to the Office of the Commissioner for Trademarks.

See TMEP §§202.03(a) and 202.03(a)(i) regarding the processing of an application in which the application filing fee payment is refused or charged back by a financial institution, TMEP §1104.09(g) regarding fee deficiencies in

## PROCESSING DOCUMENTS AND FEES

amendments to allege use, TMEP §1108.02(c) regarding fee deficiencies in requests for extensions of time to file a statement of use, TMEP §1109.15(a) regarding fee deficiencies in statements of use, TMEP §1604.06(c) regarding fee deficiencies in affidavits under §8 of the Act, and TMEP §1606.05(c) regarding fee deficiencies in renewal applications.

# Chapter 500

## Change of Ownership

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### **501 Assignment of Marks**

- 501.01 Assignability of Marks in Applications and Registrations
  - 501.01(a) Assignability of Intent-to-Use Applications
  - 501.01(b) Assignability of Extensions of Protection of International Registrations to the United States
- 501.02 Assignments Must Be in Writing
- 501.03 Effect of Failure to Record Assignment
- 501.04 Foreign Assignee May Designate Domestic Representative
- 501.05 Assignee Stands in Place of Applicant or Registrant
- 501.06 Partial Assignments
- 501.07 Assignment of Extension of Protection of International Registration to the United States

### **502 Establishing Ownership of Applications or Registrations**

- 502.01 Establishing The Right to Take Action in Application or Registration
- 502.02 Pending Applications - Issuance of Registration Certificate in Name of Assignee or in Applicant's New Name
  - 502.02(a) Applications Under §1 and §44 of the Trademark Act
  - 502.02(b) Applications Under §66(a) of the Trademark Act
  - 502.02(c) Examining Attorney's Action Regarding Assignment
- 502.03 Issuance of New Certificate to Assignee of Registrant

### **503 Recording in Assignment Services Division**

- 503.01 Effect of Recording a Document
- 503.02 Documents That the Office Will Record



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 503.03 Requirements for Recording

503.03(a) Formal Requirements for Documents

503.03(b) Supporting Documents

503.03(c) English Language Requirement

503.03(d) Fee for Recording

503.03(e) Cover Sheet

### 503.04 Address for Submitting Documents for Recording

### 503.05 Recording Procedure and Recordation Date

### 503.06 Correction of Errors in Cover Sheet or Recorded Document

503.06(a) Typographical Errors in Cover Sheet

503.06(a)(i) Typographical Errors in Cover Sheet That Do Not Affect Title to Application or Registration

503.06(a)(ii) Typographical Errors in Cover Sheet That Do Affect Title to Application or Registration

503.06(b) Typographical Errors in Recorded Assignment Document

503.06(c) Assignment or Change of Name Improperly Filed and Recorded By Another Person Against Owner's Application or Registration

503.06(d) Owner Must Notify Trademark Operation of Correction

503.06(e) Recorded Documents Not Removed From Assignment Records

503.06(f) Petitions to Correct or "Expunge" Assignment Records

### 503.07 "Indexing" Against Recorded Document Not Permitted

### 503.08 Accessibility of Assignment Records

503.08(a) Abstracts of Title

## **504 Automatic Updating Ownership of Trademark Applications and Registrations in Trademark Databases**

504.01 Circumstances in Which Trademark Database Will Not be Automatically Updated

## CHANGE OF OWNERSHIP

- 504.02 Processing Time for Automatic Updating
- 504.03 Correction to Automatic Update - Last Recorded Owner Does Not Have Clear Chain of Title
- 504.04 Automatic Updating Does Not Apply to Requests for Recordation Filed Before November 2, 2003
- 504.05 Automatic Updating Does Not Apply to International Applications and Registrations Under the Madrid Protocol

### **501 Assignment of Marks**

#### **501.01 Assignability of Marks in Applications and Registrations**

*Extract from 15 U.S.C. §1060(a):*

*(1) A registered mark or a mark for which an application to register has been filed shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark. Notwithstanding the preceding sentence, no application to register a mark under section 1(b) shall be assignable prior to the filing of an amendment under section 1(c) to bring the application into conformity with section 1(a) or the filing of the verified statement of use under section 1(d), except for an assignment to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing.*

*(2) In any assignment authorized by this section, it shall not be necessary to include the good will of the business connected with the use of and symbolized by any other mark used in the business or by the name or style under which the business is conducted.*

*(3) Assignments shall be by instruments in writing duly executed...*

*Extract from 37 C.F.R. §3.1. \*\*\* Assignment means a transfer by a party of all or part of its right, title and interest in a patent, patent application, registered mark or a mark for which an application to register has been filed.*

#### **501.01(a) Assignability of Intent-to-Use Applications**

*Extract from 15 U.S.C. §1060(a)(1). A registered mark or a mark for which an application to register has been filed shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark. Notwithstanding the preceding sentence, no application to register a mark under section 1(b) shall be*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*assignable prior to the filing of an amendment under section 1(c) to bring the application into conformity with section 1(a) or the filing of the verified statement of use under section 1(d), except for an assignment to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing.*

An applicant cannot assign an application that was filed under 15 U.S.C. §1051(b) before the applicant files an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d), except to a successor to the applicant's business, or portion of the business to which the mark pertains, if that business is ongoing and existing. Section 10 of the Trademark Act, 15 U.S.C. §1060; 37 C.F.R. §3.16.

The primary purpose of this provision is to ensure that a mark may only be assigned along with some business or goodwill, and to prevent "trafficking" in marks.

As a general rule, the United States Patent and Trademark Office ("USPTO") does not investigate or evaluate the validity of assignments. Therefore, the examining attorney should issue an inquiry concerning the compliance of an assignment with the cited provisions of §10 only if:

- (1) The application itself includes a statement indicating that the assignee is not a successor to the original applicant's business, or portion of the business to which the mark pertains, if that business is ongoing and existing; or
- (2) *All* of the following conditions are present:
  - (a) The assignment is executed before the filing of an acceptable amendment to allege use or statement of use;
  - (b) The applicant submits the assignment document for inclusion in the application record; *and*
  - (c) The assignment document fails to include the relevant language from §10 to the effect that the assignment includes the entire business of the applicant/assignor or the portion of the business to which the mark pertains.

The examining attorney should not require the submission of assignment documents to determine compliance.

## CHANGE OF OWNERSHIP

If the examining attorney issues an inquiry, the applicant's statement that the assignment was in compliance with the cited provision of §10 is sufficient to resolve the issue. This statement may be entered through an examiner's amendment.

The assignment of an intent-to-use application to someone who is not the successor to the applicant's business before filing an allegation of use renders the application and any resulting registration void. *Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098 (TTAB 1996).

### **501.01(b) Assignability of Extensions of Protection of International Registrations to the United States**

Under §72 of the Trademark Act, 15 U.S.C. §1141*l*, an extension of protection to the United States may be assigned, together with the goodwill associated with the mark, only to a person who is a national of, is domiciled in, or has a bona fide and effective industrial or commercial establishment in a country that is party to the Madrid Protocol (or in a country that is a member of an intergovernmental organization that is a party to the Madrid Protocol). See TMEP §501.07 for further information about assignment of §66(a) applications and registered extensions of protection to the United States, and TMEP Chapter 1900 for further information about the Madrid Protocol.

### **501.02 Assignments Must Be in Writing**

*Extract from 15 U.S.C. §1060(a)(3). Assignments shall be by instruments in writing duly executed.*

### **501.03 Effect of Failure to Record Assignment**

*Extract from 15 U.S.C. §1060(a).*

*(3) \* \* \* Acknowledgment shall be prima facie evidence of the execution of an assignment, and when the prescribed information reporting the assignment is recorded in the United States Patent and Trademark Office, the record shall be prima facie evidence of execution.*

*(4) An assignment shall be void against any subsequent purchaser for valuable consideration without notice, unless the prescribed information reporting the assignment is recorded in the United States Patent and Trademark Office within 3 months after the date of the assignment or prior to the subsequent purchase.*

See TMEP §§503 *et seq.* regarding the recordation of assignments in the Assignment Services Division of the Office.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **501.04 Foreign Assignee May Designate Domestic Representative**

*15 U.S.C. §1060(b). An assignee not domiciled in the United States may designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the assignee does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served upon the Director.*

*37 C.F.R. §3.61. If the assignee of a patent, patent application, trademark application or trademark registration is not domiciled in the United States, the assignee may designate a domestic representative in a document filed in the United States Patent and Trademark Office. The designation should state the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the application, patent or registration or rights thereunder.*

An assignee not domiciled in the United States may designate, by a document filed in the USPTO, the name and address of a domestic representative. 15 U.S.C. §§1051(e), 1058(f), 1059(c) and 1060; 37 C.F.R. §3.61; TMEP §604. The USPTO encourages assignees who do not reside in the United States to designate domestic representatives.

When an assignee designates a domestic representative, the designation should be in a paper separate from the assignment document. One copy of the designation of domestic representative should be sent to the Assignment Services Division with the document to be recorded. In addition, the assignee should send a separate copy of the designation for each registration or application to which an assignment pertains to the Trademark Branch of the USPTO ("Trademark Operation"), so that a copy of the designation can be entered in each file that is identified in the assignment document. 37 C.F.R. §1.4(b).

### **501.05 Assignee Stands in Place of Applicant or Registrant**

*Extract from 15 U.S.C. §1127. The terms "applicant" and "registrant" embrace the legal representatives, predecessors, successors and assigns of such applicant or registrant.*

## CHANGE OF OWNERSHIP

*Extract from 37 C.F.R. §3.71. \*\*\* The assignee of a registered trademark or a trademark for which an application to register has been filed is entitled to conduct the prosecution of the trademark application or registration to the exclusion of the original applicant or previous assignee.*

An assignee, like an applicant, must be a natural or juristic person. See 15 U.S.C. §1127 and TMEP §803.

### **501.06 Partial Assignments**

A trademark may be owned by two or more persons (see TMEP §803.03(d)), and a co-owner may assign his or her interest in a mark. Also, a party who is the sole owner of a mark may transfer a portion (e.g., 50%) of his or her interest in the mark to another party.

A trademark owner may also assign a separate portion of a business, together with the good will and trademarks associated with that portion of the business, but retain rights in the mark for uses pertaining to another part of the business. See *VISA, U.S.A., Inc. v. Birmingham Trust National Bank*, 696 F.2d 1371, 216 USPQ 649 (Fed. Cir. 1982). A single trademark of a company can be validly assigned if the assignor transfers the good will associated with only some of the goods or services on which that mark appears. After a registration has been assigned with respect to only some of the goods or services, both owners must file the necessary renewal applications and affidavits of continued use or excusable nonuse under 15 U.S.C. §1058 or §1141k to maintain the registration. If only one party files, only those goods or services in the registration for which that party owns the mark are continued or renewed. See TMEP §§1604 *et seq.* and 1613 regarding affidavits of continued use or excusable nonuse, and TMEP §§1606 *et seq.* and 1614 regarding renewal.

A trademark owner may not use an assignment to impose geographic restrictions on a registration. This must be done by way of a concurrent use proceeding before the Trademark Trial and Appeal Board or pursuant to a final determination by a federal court. 15 U.S.C. §1052(d). See TMEP §§1207.04 *et seq.* and *Trademark Trial and Appeal Board Manual of Procedure* ("TBMP") Chapter 1100 regarding concurrent use registration. However, the Assignment Services Division of the USPTO will record an assignment purporting to transfer rights in an unrestricted registration for less than the entire United States, because it is a transfer that may affect title to the registration. As noted in TMEP §503.01, the Assignment Services Division does not examine the substance of documents submitted for recording. The act of recording the document is not a determination of the validity or effect of the purported assignment and does not create a concurrent use registration.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

See TMEP §§1615 *et seq.* regarding a registrant's request to divide a registration in which ownership has changed with respect to some but not all of the goods/services, and TMEP §1110.08 regarding an applicant's request to divide a pending application in which ownership has changed with respect to some but not all of the goods/services.

### **501.07            Assignment of Extension of Protection of International Registration to the United States**

*15 U.S.C. §1141l. Assignment of an Extension of Protection:*

*An extension of protection may be assigned, together with the goodwill associated with the mark, only to a person who is a national of, is domiciled in, or has a bona fide and effective industrial or commercial establishment either in a country that is a Contracting Party or in a country that is a member of an intergovernmental organization that is a Contracting Party.*

Under §72 of the Trademark Act, 15 U.S.C. §1141l, an extension of protection of an international registration to the United States may be assigned, together with the goodwill associated with the mark, only to a person who is a national of, is domiciled in, or has a bona fide and effective industrial or commercial establishment in a country that is party to the Madrid Protocol (or in a country that is a member of an intergovernmental organization that is a party to the Madrid Protocol).

Because the extension of protection remains part of the international registration, assignments of extensions of protection to the United States must be recorded at the International Bureau of the World Intellectual Property Organization ("IB"). The IB will notify the USPTO of any changes in ownership recorded in the International Register. The USPTO will record only those assignments (or other documents affecting title) that have been recorded in the International Register, and will automatically update the Trademark Reporting and Monitoring ("TRAM") System and the Trademark Applications and Registrations Retrieval ("TARR") database to reflect these changes.

See TMEP §§1906.01 and 1906.01(a) for information about recording changes of ownership of international registrations with the IB.

Section 10 of the Trademark Act and 37 C.F.R. Part 3 do not apply to assignments of international registrations or extensions of protection to the United States. 37 C.F.R. §7.22(b).

See TMEP §§1110.08 and 1615.02 regarding division of an extension of protection to the United States after ownership of an international registration has changed with respect to some, but not all, of the goods/services.

## CHANGE OF OWNERSHIP

### 502 Establishing Ownership of Applications or Registrations

*Extract from 37 C.F.R. §3.73(a). \* \* \* The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.*

*Section 1 or §44 Applications.* In an application or registration based on §1 or §44 of the Trademark Act, 15 U.S.C. §1051 or §1126, an assignee is not required to record the assignment in order to take an action with respect to an application or registration. 37 C.F.R. §3.73(b); TMEP §502.01. However, the assignee must record the assignment (or other document affecting title) with the Assignment Services Division of the USPTO to obtain a certificate of registration in the name of the assignee. 37 C.F.R. §3.85; TMEP §§502.02(a) and 502.03. Moreover, it is advisable for an applicant or registrant to record the assignment to ensure that it is valid under §10(a)(4) of the Trademark Act against subsequent purchasers for valuable consideration without notice. See TMEP §501.03.

*Section 66(a) Applications.* In an application under §66(a) of the Trademark Act or a registered extension of protection of an international registration to the United States, the new owner must record the assignment with the IB in order to take an action with respect to an application or registration, or to obtain a certificate of registration in the name of a new owner. TMEP §§502.01, 502.02(b) and 502.03. See TMEP §501.07 regarding the assignment of extensions of protection of international registrations, and TMEP §§1906.01 and 1906.01(a) for information about recording changes of ownership of international registrations with the IB.

#### 502.01 Establishing The Right to Take Action in Application or Registration

*Extract from 37 C.F.R. §3.73(b).*

*(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:*

*(i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). The documents submitted to establish ownership may be required to be recorded pursuant to §3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or*

*(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office*



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

(e.g., reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

### **Applications and Registrations Based on §§1 and 44 of the Trademark Act**

In an application or registration based on §1 or §44 of the Trademark Act, when a party other than the owner of record attempts to take an action with respect to an application or registration (e.g., filing a response to an Office action, allegation of use under 15 U.S.C. §1051(c) or §1051(d), request for an extension of time to file a statement of use under 15 U.S.C. §1051(d)(2), or affidavit of continued use or excusable nonuse under 15 U.S.C. §1058), the party must establish ownership of the application or registration. To establish ownership, the new owner must either: (1) record the assignment (or other document affecting title) with the Assignment Services Division of the USPTO, and notify the Trademark Operation that the document has been recorded; or (2) submit other evidence of ownership, in the form of a document transferring ownership from one party to another or an explanation, in the form of an affidavit or declaration under 37 C.F.R. §2.20, that a valid transfer of legal title has occurred. 37 C.F.R. §3.73(b)(1). The document(s) must show a clear chain of title from the original owner to the party who is taking the action.

See 37 C.F.R. §3.85 and TMEP §§502.02(a) and 502.03 regarding issuance of a certificate of registration in the name of a new owner. See also TMEP §§504 and 504.01 regarding the circumstances in which the Trademark Database will be updated automatically upon recordation of a document affecting title.

### **Section 66(a) Applications and Registered Extensions of Protection**

In an application under §66(a) of the Trademark Act or a registered extension of protection of an international registration to the United States, the new owner must record the assignment with the IB in order to take an action with respect to an application or registration. The IB will notify the USPTO of any changes in ownership recorded in the International Register. The USPTO will record only those assignments (or other documents affecting title) that have been recorded in the International Register. See TMEP §501.07 for further information about assignment of extensions of protection of international registrations, and TMEP §§1906.01 and 1906.01(a) for

## CHANGE OF OWNERSHIP

information about recording changes of ownership of international registrations with the IB. The document(s) must show a clear chain of title from the original owner to the party who is taking the action.

In an application under §66(a) of the Trademark Act or a registered extension of protection, the new owner does not have the option of submitting documentary evidence of ownership, pursuant to 37 C.F.R. §3.73(b). Part 3 of 37 C.F.R. does not apply to §66(a) applications and registered extensions of protection. 37 C.F.R. §7.22.

### **502.02 Pending Applications - Issuance of Registration Certificate in Name of Assignee or in Applicant's New Name**

#### **502.02(a) Applications Under §1 and §44 of the Trademark Act**

*37 C.F.R. §3.85. Issue of registration to assignee. The certificate of registration may be issued to the assignee of the applicant, or in a new name of the applicant, provided that the party files a written request in the trademark application by the time the application is being prepared for issuance of the certificate of registration, and the appropriate document is recorded in the Office. If the assignment or name change document has not been recorded in the Office, then the written request must state that the document has been filed for recordation. The address of the assignee must be made of record in the application file.*

*Document Must Be Recorded With Assignment Services Division.* In an application under §1 or §44 of the Trademark Act, an assignee must record the assignment, change of name, or other document affecting title with the Assignment Services Division of the USPTO to obtain a certificate of registration in the name of the assignee. 37 C.F.R. §3.85. However, the registration will not issue in the name of the new owner unless the ownership field in the Trademark Database (*i.e.*, TRAM and TARR) is updated to reflect the recorded assignment prior to approval of the mark for publication (or registration on the Supplemental Register) in an application based on 1(a) or §44, or prior to acceptance of the statement of use in an intent-to-use application based on §1(b).

For some documents recorded on or after November 2, 2003, recording a document with the Assignment Services Division will automatically update ownership in TRAM, even if the new owner does not notify the Trademark Operation that the document has been recorded. See TMEP §§504 and 504.01 regarding the circumstances in which the Trademark Database will be updated automatically upon recordation of a document affecting title. In all other cases, a written request for issuance in the new name is required.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Under 37 C.F.R. §3.85, a new owner bears the burden of recording *and* notifying appropriate Office personnel of assignments or changes of name to ensure that the registration issues in the name of the new owner, as necessary. Thus, if the recorded document does not meet the criteria for automatic updating set forth in TMEP §§504 and 504.01, or if there is insufficient time for the Assignment Services Division to process a recently recorded document for automatic updating (see TMEP §504.02), the new owner must file a written request that the certificate issue in the name of the new owner. The new owner can search the Assignment Services Division's database on the USPTO website at <http://assignments.uspto.gov/assignments> to determine whether the assignment has been recorded, and can check the TARR database at <http://tarr.uspto.gov> to determine whether the Trademark Database has been updated to reflect the change of ownership. The TARR database contains the same information as TRAM.

A request that a registration issue in a new name should be directed to the examining attorney, and should state that the appropriate document has been recorded (or filed for recordation) and that the applicant wants the registration to issue in the name of the assignee or the new name of the applicant. The request should specify the assignee's address, and set forth the assignee's citizenship or state (or country) of incorporation or organization. If the assignee is a partnership or joint venture, the request should set forth the names, legal entities, and national citizenship (or the state or country of organization) of all general partners or active members. See TMEP §502.02(c) regarding an examining attorney's handling of an application in which the mark has been assigned.

If the applicant states that a request to record a change of ownership has been filed with the Assignment Services Division but is not yet recorded, and the application is in condition to be approved for publication or registration on the Supplemental Register, the examining attorney should suspend action pending recordation of the document and entry of the information into the Trademark Database. See TMEP §§716 *et seq.* regarding suspension.

*Clear Chain of Title Required.* A new owner's request that a registration issue in a new name will not be granted unless documents recorded in the Assignment Services Division show a clear chain of title from the original applicant to the party requesting the change. The examining attorney should check the Assignment Services Division's Database ("Assignment Database") on the USPTO website at <http://assignments.uspto.gov/assignments> to ensure that there is a clear chain of title. If the Assignment Database shows a clear chain of title, the examining attorney should ensure that the TRAM database is updated, if necessary. If the Assignment Database does not show a clear chain of title, the examining attorney should issue an Office action advising applicant that it must record the necessary documents if it wants the

## CHANGE OF OWNERSHIP

registration to issue in the name of the new owner. If the applicant does not record the necessary documents, the registration will issue in the name of the party who has a clear chain of title according to the Assignment Database.

*Time for Recordation and Filing of Request for Issuance in Name of New Owner.* To ensure that the registration issues in the name of the new owner, the new owner should record the assignment before the mark is approved for publication (or registration on the Supplemental Register) in an application based on 15 U.S.C. §1051(a) or §1126, or prior to acceptance of a statement of use in an application based on 15 U.S.C. §1051(b). The USPTO cannot ensure that a request to issue the certificate in a new name filed after the mark has been approved for publication or registration will be processed in time for the registration to issue in the name of the new owner.

If, before a mark is approved for publication or registration, an applicant has filed a proper request that the certificate issue in the name of the new owner, but the registration does not issue in the name of the new owner, the USPTO will issue a certificate of correction. See 15 U.S.C. §1057(g), 37 C.F.R. §2.174, and TMEP §1609.10(a) regarding the procedures for requesting correction of a USPTO error, and TMEP §502.03 regarding issuance of a new certificate of registration to the new owner of a registered mark.

### **502.02(b) Applications Under §66(a) of the Trademark Act**

In an application under §66(a) of the Trademark Act, a new owner must record any assignment, change of name, or other document affecting title with the IB. The document(s) must show a clear chain of title from the original owner to the party who is taking the action. See TMEP §501.07 regarding assignment of §66(a) applications, and TMEP §§1906.01 and 1906.01(a) regarding requests to record changes with the IB. The IB will notify the USPTO when the change of ownership is recorded in the International Register. The USPTO will record only those assignments (or other documents affecting title) that have been recorded in the International Register, and will automatically update the ownership field in the Trademark Database. A new owner can check the TARR database at <http://tarr.uspto.gov> to determine whether the Trademark Database has been updated to reflect a change in ownership that has been recorded with the IB.

If the Trademark Database has not been updated, before the mark is approved for publication the new owner/assignee should file a written request that the registration issue in the name of the new owner/assignee. The request that a registration issue in a new name should be directed to the examining attorney, and should state that the appropriate document has been recorded (or filed for recordation) with the IB, and that the applicant wants the registration to issue in the name of the assignee or the new name of the applicant. The request should specify the assignee's address, and set forth the assignee's citizenship or state (or country) of incorporation or organization. If the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

assignee is a partnership or joint venture, the request should set forth the names, legal entities, and national citizenship (or state or country of organization) of all general partners or active members. See TMEP §502.02(c) regarding an examining attorney's handling of an application after a mark has been assigned.

If the applicant states that a request to record a change of ownership has been filed with the IB but is not yet recorded, and the application is in condition to be approved for publication, the examining attorney should suspend action pending recordation of the document and entry of the information into the Trademark Database. See TMEP §§716 *et seq.* regarding suspension.

If, before a mark is approved for publication, an applicant has filed a proper request that the certificate issue in the name of the new owner, but the registration does not issue in the name of the new owner, the USPTO will issue a certificate of correction. See 15 U.S.C. §1057(g), 37 C.F.R. §2.174, and TMEP §1609.10(a) regarding the procedures for requesting correction of a USPTO error.

### **502.02(c) Examining Attorney's Action Regarding Assignment**

If, prior to approval for publication for opposition or registration on the Supplemental Register, or prior to acceptance of a statement of use in an application under 15 U.S.C. §1051(b), the applicant advises the examining attorney or the examining attorney learns through some other source that an assignment has been recorded, the examining attorney should check the Assignment Database at <http://assignments.uspto.gov/assignments> to ensure that there is a clear chain of title, and should ensure that the TRAM database is updated before approving the mark for publication or registration.

In general, the examining attorney should only issue an Office action questioning whether an assignment has occurred if an entity attempts to take action with respect to the application, and Office records show ownership in another party. In this situation, the assignee must establish entitlement to take the action, either by recordation of an assignment, or submission of proof of the assignment. 37 C.F.R. §3.73(b); TMEP §502.01.

During initial examination, the examining attorney should not suspend action or delay issuance of a final action to await recordation of a document. However, if the applicant submits a request indicating that the relevant document *has been submitted for recordation* and the application is in condition to be approved for publication for opposition or registration on the Supplemental Register, the examining attorney should withhold approval for publication or registration until the document has been recorded and the information regarding the assignment or the change of name has been entered

## CHANGE OF OWNERSHIP

into TRAM. Likewise, during examination of the statement of use in an application under 15 U.S.C. §1051(b), the examining attorney should withhold final approval for registration until the relevant document has been recorded and the information regarding the assignment or the applicant's new name has been entered in TRAM. If the application is in condition to be approved for publication or registration, the examining attorney should suspend action pending the recordation of the document and the entry of the information into the application record and in TRAM. See TMEP §§716 *et seq.* regarding suspension.

### **502.03 Issuance of New Certificate to Assignee of Registrant**

#### ***Registrations Under §1 and §44 of the Trademark Act***

In registrations that issued based on applications under §1 or §44 of the Trademark Act, the USPTO will issue a new certificate of registration of the mark for the unexpired part of the registration period in the name of the new owner, if the new owner: (1) records the appropriate document (*e.g.*, assignment document, change of name certificate) in the Assignment Services Division; (2) files a written request that a certificate of registration be issued in the new owner's name; *and* (3) pays the required fee (37 C.F.R. §§2.6(a)(8) and 3.41). The new owner must sign the request for a new certificate. 15 U.S.C. §1057(d); 37 C.F.R. §§2.171(a) and 3.85. The recorded document(s) must show a clear chain of title from the original registrant to the party requesting issuance of a new certificate.

Upon request and payment of the appropriate fee (see TMEP §111), the Certification Division of the USPTO will provide a certified copy of the registration that reflects ownership according to the records shown in the Assignment Database. The certified copy will not show any transfer of ownership that has not been recorded in the Assignment Services Division.

See TMEP §1604.07(c) regarding the issuance of a notification of acceptance of an affidavit or declaration under 15 U.S.C. §1058 in the name of the new owner of a registration.

#### ***Registered Extensions of Protection of International Registration to the United States***

In a registered extension of protection of an international registration to the United States, the new owner must record the assignment, change of name, or other document affecting title with the IB. See TMEP §501.07 regarding assignment of registered extensions of protection, and TMEP §§1906.01 and 1906.01(a) regarding requests to record changes in the International Register. The IB will notify the USPTO when the change of ownership is recorded in the International Register, and the USPTO will record the change in the Assignment Database and update the ownership field in

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

TRAM. The USPTO will record only those assignments (or other documents affecting title) that have been recorded in the International Register. The recorded document(s) must show a clear chain of title from the original owner to the party requesting issuance of a new certificate.

The USPTO will issue a new certificate of registration of the mark for the unexpired part of the registration period in the name of the new owner, if the new owner: (1) records the appropriate document (e.g., assignment document, change of name certificate) with the IB; (2) files a written request that a certificate of registration be issued in the new owner's name; and (3) pays the required fee (37 C.F.R. §2.6(a)(8)). The new owner must sign the request for a new certificate. 15 U.S.C. §1057(d); 37 C.F.R. §2.171(a).

Upon request and payment of the appropriate fee (see TMEP §111), the Certification Division of the USPTO will provide a certified copy of the registration that reflects ownership according to the records shown in the Assignment Database. The certified copy will not show any transfer of ownership that has not been recorded with the IB.

Section 10 of the Trademark Act and 37 C.F.R. Part 3 do not apply to assignments of an international registration. 37 C.F.R. §7.22.

### **503 Recording in Assignment Services Division**

#### **503.01 Effect of Recording a Document**

*37 C.F.R. §3.54. Effect of recording. The recording of a document pursuant to §3.11 is not a determination by the Office of the validity of the document or the effect that document has on the title to an application, a patent, or a registration. When necessary, the Office will determine what effect a document has, including whether a party has the authority to take an action in a matter pending before the Office.*

Recording a document with the Assignment Services Division does not necessarily change the ownership of record shown in TRAM. See TMEP §504 and 504.01 regarding the circumstances in which the Trademark Database will be updated automatically upon recordation of an assignment, change of name, or other document transferring title. In all other cases, the new owner must notify the Trademark Operation of the recordation of a document, and request that the Trademark Database be updated manually. See TMEP §§502.02 *et seq.* and 502.03 regarding issuance of a certificate of registration in the name of a new owner.

The Assignment Services Division does not examine the substance of documents submitted for recording. The act of recording a document is a ministerial act, and not a determination of the document's validity or of its effect on title to an application or

## CHANGE OF OWNERSHIP

registration. The USPTO will determine the effect of a document only when an assignee attempts to take an action in connection with an application or registration (e.g., when an assignee files a statement of use under 15 U.S.C. §1051(d)(1) or an affidavit or declaration of use under 15 U.S.C. §1058). 37 C.F.R. §3.54.

Recording a document with the Assignment Services Division does *not* constitute a response to an Office action.

If an assignment is conditional on a given act or event at the time of its execution, the USPTO will view the submission of the assignment for recordation as an indication that the act or event has occurred. See 37 C.F.R. §3.56.

### **503.02 Documents That the Office Will Record**

*37 C.F.R. §3.11 Documents which will be recorded.*

*(a) Assignments of applications, patents, and registrations, accompanied by completed cover sheets as specified in §§3.28 and 3.31, will be recorded in the Office. Other documents, accompanied by completed cover sheets as specified in §§3.28 and 3.31, affecting title to applications, patents, or registrations, will be recorded as provided in this part or at the discretion of the Director.*

*(b) Executive Order 9424 of February 18, 1944 (9 FR 1959, 3 CFR 1943-1948 Comp., p. 303) requires the several departments and other executive agencies of the Government, including Government-owned or Government-controlled corporations, to forward promptly to the Director for recording all licenses, assignments, or other interests of the Government in or under patents or patent applications. Assignments and other documents affecting title to patents or patent applications and documents not affecting title to patents or patent applications required by Executive Order 9424 to be filed will be recorded as provided in this part.*

The USPTO records assignments of trademark applications and registrations, accompanied by completed cover sheets. The USPTO also records documents that affect title to a trademark application or registration, such as certificates issued by appropriate authorities showing a change of name of a business, or a merger of businesses. Although a mere change of name does not constitute a change of legal entity, it is a proper link in the chain of title. Documents of merger are also proper links in the chain of title.

Some instruments that relate to registered marks or to marks in pending applications may be recorded, even though they do not constitute a transfer or change of title to the mark or do not convey the entire title or interest in the business in which the mark is used. Typically, these instruments are license agreements, security agreements, and agreements between parties limiting future extension of use of a mark with regard to the



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

goods or services or other circumstances of use. These instruments are recorded to give third parties notification of equitable interests or other matters relevant to the ownership of a mark.

The USPTO may also record a partial assignment of an interest in a mark. See TMEP §501.06.

In an application under §66 of the Trademark Act or a registered extension of protection of an international registration to the United States, the new owner must record any change of ownership with the IB, who will record the change in the International Register and notify the USPTO accordingly. The USPTO will record only those assignments (or other documents affecting title) that have been recorded in the International Register. See TMEP §§1906.01 and 1906.01(a) for information about recording changes of ownership of international registrations with the IB. Section 10 of the Trademark Act and 37 C.F.R. Part 3 do not apply to assignments of §66(a) applications and registered extensions of protection. 37 C.F.R. §7.22. See TMEP §501.07.

### **503.03 Requirements for Recording**

#### **503.03(a) Formal Requirements for Documents**

##### ***Applications and Registrations Based on §§1 and 44 of the Trademark Act***

All documents submitted for recording must be accompanied by a cover sheet that meets the requirements of 37 C.F.R. §3.31. See TMEP §503.03(e).

To expedite recordation, new owners are encouraged to file requests for recordation electronically through the Electronic Trademark Assignment System (“ETAS”) on the USPTO website at <http://etas.uspto.gov>. Documents filed electronically are recorded much faster than paper documents. Using ETAS, a party can create and submit a Trademark Assignment Recordation Coversheet by completing an online form, and attach the supporting legal documentation as an image in tagged image file format (“TIFF”) for submission via the Internet.

See TMEP §§503.03(b) *et seq.* regarding the requirements for recordation.

##### ***Section 66(a) Applications and Registered Extensions of Protection***

In an application under §66 of the Trademark Act or a registered extension of protection of an international registration to the United States, the new owner must record the change of ownership with the IB, who will record the change in the International Register and notify the USPTO accordingly. See TMEP §501.07. The IB does not

## CHANGE OF OWNERSHIP

require supporting documents. See TMEP §§1906.01 and 1906.01(a) for information about recording changes of ownership of international registrations with the IB.

### **503.03(b) Supporting Documents**

To record a document affecting title to a trademark application or registration with the Assignment Services Division, a legible cover sheet and one of the following must be submitted:

- (1) A copy of the document;
- (2) A copy of an extract from the document evidencing the effect on title; or
- (3) A statement signed by both the party conveying the interest *and* the party receiving the interest explaining how the conveyance affects title.

37 C.F.R. §3.25(a).

To record a name change, only a legible cover sheet is required. 37 C.F.R. §3.25(b).

Documents filed through ETAS must be in TIFF format. When printed to a paper size of either 21.6 by 27.9 cm (8½ by 11 inches) or 21.0 by 29.7 cm (DIN size A4), a 2.5 cm (one-inch) margin must be present on all sides. 37 C.F.R. §3.25(c)(1).

All paper documents submitted for recordation must be submitted on white and non-shiny paper that is either 8½ by 11 inches (21.6 by 27.9 cm) or DIN size A4 (21.0 by 29.7 cm) with a one-inch (2.5 cm) margin on all sides in either case. Only one side of each page may be used. Original documents should not be submitted, because the Office does not return recorded documents. 37 C.F.R. §3.25(c)(2).

Documents that do not meet these requirements will not be recorded. 37 C.F.R. §3.51. See TMEP §503.05.

### **503.03(c) English Language Requirement**

The USPTO will not record a document that is not in the English language unless it is accompanied by an English translation that is signed by the translator. 37 C.F.R. §3.26.

### **503.03(d) Fee for Recording**

All requests to record documents in the Assignment Services Division must be accompanied by the appropriate fee. A fee is required for *each* application and registration against which a document is recorded, as identified in the cover sheet. 37 C.F.R. §§2.6 and 3.41. The fee does not depend on the length of the document.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If the Assignment Services Division determines that materials submitted for recording do not meet the recording requirements, the fee is not refunded.

### **503.03(e) Cover Sheet**

Each document submitted for recording in the Assignment Services Division must be accompanied by a cover sheet that meets the requirements of 37 C.F.R. §3.31. Only one set of documents and cover sheets to be recorded should be filed. 37 C.F.R. §3.28.

To expedite recordation, new owners are encouraged to file requests for recordation through the USPTO website, at <http://etas.uspto.gov>. Documents filed electronically are recorded much faster than paper documents. Using ETAS, a new owner can create a Trademark Assignment Recordation Coversheet by completing an online form, and attach the supporting legal documentation as a TIFF image for submission via the Internet.

If the new owner decides to file the assignment or name change on paper, the cover sheet must be legible. 37 C.F.R. §3.25(a). The USPTO has a trademark cover sheet form that can be downloaded from the USPTO website at <http://www.uspto.gov/web/forms/pto1594.pdf>. Questions regarding cover sheets should be directed to the Assignment and Certification Services Division. Contact information is provided on the USPTO website at <http://etas.uspto.gov/>. See notice at 1140 TMOG 65, 69 (July 28, 1992). Use of the USPTO's form is preferred, but not mandatory.

Under 37 C.F.R. §3.31, a trademark cover sheet must contain the following:

- The name of the party conveying the interest;
- The name and address of the party receiving the interest;
- A description of the interest conveyed or transaction to be recorded (e.g., assignment, license, change of name, merger, security agreement);
- Each application serial number or registration number against which the document is to be recorded, if known. If the application serial number is not known, the party seeking to record the document must submit a copy of the application and/or a reproduction of the mark and an estimate of the date that the USPTO received the application;
- The name and address of the party to whom correspondence concerning the request to record the document should be sent;

## CHANGE OF OWNERSHIP

- The date the document was executed; and
- The signature of the party submitting the document. For a document filed electronically, the person who signs the cover sheet must either: (1) place a symbol comprised of letters, numbers, and/or punctuation marks between forward slash marks (*e.g.* “/Thomas O’Malley/”) in the signature block on the electronic submission; or (2) sign the cover sheet using some other form of electronic signature specified by the Director.

The cover sheet should also include:

- The entity of the conveying party, and the relevant entity information for the receiving party (*e.g.*, the citizenship of an individual, state or country of incorporation or organization of a corporation, or names and citizenship of the general partners of a partnership);
- The number of applications and/or registrations identified in the cover sheet;
- The total fee; and
- An identification or description of the mark.

In addition, if the receiving party has designated a domestic representative (see TMEP §§501.04 and 604), the cover sheet should include an indication to this effect.

Documents that are not accompanied by a completed cover sheet will not be recorded. 37 C.F.R. §3.51.

Separate patent and trademark cover sheets should be submitted for documents that include interests in, or transactions involving, both patents and trademarks. If a cover sheet contains both patent and trademark information, any information contained therein about pending patent applications will become public record upon recordation. 37 C.F.R. §§3.28 and 3.31(b).

### **503.04 Address for Submitting Documents for Recording**

To expedite recordation, new owners are encouraged to file requests to record documents in the Assignment Services Division through the USPTO website, at <http://etas.uspto.gov>. Paper documents and cover sheets to be recorded in the Assignment Services Division should be sent to Mail Stop Assignment Recordation Services, Director of the United States Patent and Trademark Office, P. O. Box 1450, Alexandria VA 22313-1450. 37 C.F.R. §§2.190(c) and 3.27.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 503.05 Recording Procedure and Recordation Date

#### ***Applications and Registrations Under §1 and §44 of the Trademark Act***

The recording of documents in the Assignment Services Division of the Office is governed by 37 C.F.R. Part 3.

To expedite recordation, new owners are encouraged to file requests for recordation through the USPTO website, at <http://etas.uspto.gov>. Using ETAS, a new owner can create and submit a Trademark Assignment Recordation Coversheet by completing an online form, and attach the supporting legal documentation as a TIFF image for submission via the Internet. Documents filed electronically are recorded much faster than paper documents.

The date of recordation is the date that the USPTO receives a cover sheet that meets the requirements of 37 C.F.R. §3.31 and a document affecting title that meets the requirements of 37 C.F.R. §3.25. 37 C.F.R. §3.51.

The party recording the assignment (or other document affecting title) should carefully review the assignment or other document and cover sheet for accuracy and completeness. The Assignment Services Division does not examine the substance of documents submitted for recording or compare the cover sheet with the supporting documents. Rather, the USPTO merely examines the materials submitted for form, to determine whether the requirements for recording (*see* TMEP §§503.03 *et seq.*) have been met.

If the materials submitted meet the requirements for recordation, the Assignment Services Division will record the document and cover sheet. Only the data specified on the cover sheet will be entered in the Assignment Database. After recording the document and cover sheet, the USPTO will issue a notice of recordation that reflects the data as recorded in the Assignment Database. The party recording the document should carefully review the notice of recordation. *See* TMEP §§503.06 *et seq.* regarding correction of errors in a cover sheet or recorded document.

Under 37 C.F.R. §3.51, the USPTO will return papers that do not meet the requirements for recording (*e.g.*, documents submitted without a completed cover sheet, the appropriate fee, or an English translation, where applicable) to the sender for correction. The returned papers, stamped with the original date of receipt in the USPTO, will be accompanied by a letter indicating that, if the returned papers are corrected and resubmitted to the USPTO within a specified period of time, the USPTO will consider the original filing date of the papers as the recordation date of the document. The USPTO will not extend the time period specified in the letter. If the returned papers are corrected and resubmitted *after* the time specified in the letter, the recordation date is

## CHANGE OF OWNERSHIP

the date the USPTO receives corrected papers that meet the requirements for recording. The certificate of mailing procedure of 37 C.F.R. §2.197 and the “Express Mail” procedure of 37 C.F.R. §2.198 may be used for resubmitting the returned papers, to avoid lateness due to mail delay.

If papers submitted for recording are returned unrecorded by the Assignment Services Division, and the submitter believes that the papers were returned in error, he or she may file a petition under 37 C.F.R. §2.146. See TMEP §§1702 through 1708 regarding petitions.

Applicants and registrants can search the Assignment Services Division’s database on the USPTO website at <http://assignments.uspto.gov/assignments/> to determine whether an assignment has been recorded.

### ***Section 66(a) Applications and Registered Extensions of Protection***

In an application under §66(a) of the Trademark Act or a registered extension of protection, the IB will notify the USPTO of any changes in ownership recorded in the International Register, and of the date of recordation. The USPTO will record only those assignments (or other documents affecting title) that have been recorded in the International Register. See TMEP §501.07 for further information about assignment of §66(a) applications and registered extensions of protection, and TMEP §§1906.01 and 1906.01(a) for information about recording changes of ownership of international registrations with the IB.

Section 10 of the Trademark Act and 37 C.F.R. Part 3 do not apply to assignments of an international registration. 37 C.F.R. §7.22.

### **503.06 Correction of Errors in Cover Sheet or Recorded Document**

*37 C.F.R. §3.34. Correction of cover sheet errors.*

*(a) An error in a cover sheet recorded pursuant to §3.11 will be corrected only if:*

*(1) The error is apparent when the cover sheet is compared with the recorded document to which it pertains, and*

*(2) A corrected cover sheet is filed for recordation.*

*(b) The corrected cover sheet must be accompanied by a copy of the document originally submitted for recording and by the recording fee as set forth in §3.41.*

Once a document is recorded with the Assignment Services Division, the Assignment Services Division will not remove the papers from the record relating to that application or registration. See TMEP §503.06(e).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

During the recording process, the Assignment Services Division will check to see that a trademark cover sheet is complete and record the data exactly as it appears on the cover sheet. The Assignment Services Division does not compare the cover sheet with the assignment document (or other document affecting title). Once the document is recorded, the USPTO will issue a notice of recordation.

The party recording the document should carefully review the notice of recordation.

Typographical errors made by the USPTO will be corrected promptly and without charge upon written request directed to the Assignment Services Division. For any other error, the party recording the document is responsible for filing the papers and paying the recordation fees necessary to correct the error, using the procedures set forth in TMEP §§503.06(a) through 503.06(d).

In an application under §66(a) of the Trademark Act or a registered extension of protection of an international registration to the United States, any request to correct an error in a document recorded with the IB must be corrected at the IB. Such a request cannot be sent to the IB through the USPTO. See TMEP §§1906.01 *et seq.* for information about requests to record changes in the International Register.

### **503.06(a) Typographical Errors in Cover Sheet**

A party who wishes to correct a typographical error on a recorded cover sheet must submit the following to the Assignment Services Division: (1) a copy of the originally recorded assignment document (or other document affecting title); (2) a corrected cover sheet; and (3) the required fee for each application or registration to be corrected (37 C.F.R. §§2.6 and 3.41). 37 C.F.R. §3.34. The party requesting correction should also submit a copy of the original cover sheet, to facilitate comparison of this cover sheet with the originally recorded document.

The party filing the corrected cover sheet should check the box titled “Other” in the area of the sheet requesting “Nature of Conveyance,” and indicate that the submission is to correct an error in a cover sheet previously recorded. The party should also identify the reel and frame numbers (if known), and the nature of the correction (*e.g.*, “correction to the spelling of assignor’s name” or “correction of a serial number or registration number”).

The USPTO will then compare the corrected cover sheet with the original cover sheet and the originally recorded assignment document (or other document affecting title) to determine whether the correction is typographical in nature. If the error is typographical in nature, the Assignment Services Division will record the corrected cover sheet and correct the Assignment Database.

## CHANGE OF OWNERSHIP

### **503.06(a)(i) Typographical Errors in Cover Sheet That Do Not Affect Title to Application or Registration**

If the original cover sheet contains a typographical error that does not affect title to the application or registration against which the original assignment or name change is recorded, the Assignment Services Division will correct the Assignment Database and permit the recording party to keep the original date of recordation.

### **503.06(a)(ii) Typographical Errors in Cover Sheet That Do Affect Title to Application or Registration**

If the original cover sheet contains a typographical error that affects title to the application or registration against which the assignment or name change is recorded, the recording party will not be entitled to keep the original date of recordation. See TMEP §503.05. Rather, the Assignment Services Division will correct its automated records and change the date of recordation to the date on which the corrected cover sheet was received in the USPTO.

### **503.06(b) Typographical Errors in Recorded Assignment Document**

If there is an error in the recorded assignment document (or other document affecting title) rather than in the cover sheet, the party responsible for an erroneous document (e.g., the assignor) must either draft and record a new document or make corrections to the original document and re-record it. If an assignor is not available to correct an original document or execute a new one, the assignee may submit an affidavit in which the assignee identifies the error and requests correction. The affidavit must be accompanied by a copy of the originally recorded papers, a cover sheet (see TMEP §503.03(e)) and the required fee for each application or registration to be corrected (37 C.F.R. §§2.6 and 3.41). See *In re Abacab International Computers Ltd.*, 21 USPQ2d 1078 (Comm'r Pats. 1987).

In an application under §66(a) of the Trademark Act or a registered extension of protection of an international registration to the United States, any request to correct an error in a document recorded with the IB must be corrected at the IB. Such a request cannot be sent to the IB through the USPTO.

### **503.06(c) Assignment or Change of Name Improperly Filed and Recorded By Another Person Against Owner's Application or Registration**

When the owner of an application or registration discovers that another party has improperly recorded an assignment or name change against the owner's application or



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

registration, the owner must correct the error by having a corrected cover sheet filed with the Assignment Services Division.

The owner should contact the party who recorded the papers with the erroneous information and have that party record corrective papers. However, if the party cannot be located or is unwilling to file corrective papers, then the true owner must record the necessary papers with the Assignment Services Division to correct the error.

Specifically, the owner should submit the following to the Assignment Services Division: (1) a completed cover sheet identifying the application or registration against which the assignment or change of name was improperly recorded; (2) an affidavit or declaration identifying itself as the correct owner, stating that the previously recorded document was submitted with erroneous information, and providing the reel and frame number of the previously recorded document; and (3) the recording fee (37 C.F.R. §§2.6 and 3.41) for each application or registration to be corrected.

The affidavit or declaration should include a summary of the true chain of title to make it clear that the chain of title for the registration or application identified should not be considered altered by the incorrect assignment or name change, and a statement that the original registrant or last correct assignee has been and continues to be the owner of the application or registration at issue.

On the corrected cover sheet, the owner should check the box titled "Other" in the area of the cover sheet requesting the "Nature of Conveyance," and indicate that the submission is to correct an error made in a previously recorded document that erroneously affects the identified application(s) or registration(s). The party should also write the name of the correct owner in *both* the box requesting the name of the conveying party *and* the box requesting the name and address of the receiving party, to make it clear that ownership of the mark never changed and that any assignment or name change recorded against the application(s) or registration(s) was erroneous.

### **503.06(d) Owner Must Notify Trademark Operation of Correction**

Recording a corrective document with the Assignment Services Division does not change the owner of record in the TRAM database maintained by the Trademark Operation. The owner must notify the Trademark Operation that the corrective document has been recorded.

See TMEP §504.03 regarding correction of the Trademark Database where it has been automatically updated to show ownership of an application or registration in a party who does not have a clear chain of title as evidenced by the Assignment Database.

## CHANGE OF OWNERSHIP

### **503.06(e) Recorded Documents Not Removed From Assignment Records**

Once an assignment or other document is recorded against an application or registration, the Assignment Services Division will not remove the document from the records relating to that application or registration in the Assignment Database, even if the assignment or other document is subsequently found to be invalid.

The goal of the USPTO is to maintain a complete history of claimed interests in a mark. Since the act of recording a document is not a determination of the document's validity, maintaining a complete record of claimed interests does not preclude an owner from using a mark, or from establishing its ownership of the mark in a proper forum, such as a federal court. *In re Ratny*, 24 USPQ2d 1713 (Comm'r Pats. 1992).

### **503.06(f) Petitions to Correct or “Expunge” Assignment Records**

To correct an error in a recorded document, the owner of an application or registration should record corrective papers with the Assignment Services Division, in accordance with the procedures outlined in TMEP §§503.06 through 503.06(d).

If the Assignment Services Division denies the request to correct the error, the owner may file a petition under 37 C.F.R. §2.146. See TMEP Chapter 1700 regarding petitions.

However, petitions to correct, modify or “expunge” assignment records are rarely granted. Such petitions are granted only if the petitioner can prove that: (1) the normal corrective procedures outlined in TMEP §§503.06 through 503.06(d) will not provide the petitioner with adequate relief, and (2) the integrity of the assignment records will not be affected by granting the petition.

Even if a petition to “expunge” a document is granted with respect to a particular application or registration, the images of the recorded document remain in the records of the Assignment Services Division. The USPTO will delete the links to the application or registration that was the subject of the petition, so that no information about the recorded document will appear when someone searches for that application or registration number in the Assignment Database. However, the image of the document remains at the same reel and frame number, and it still will appear when someone views that reel and frame number.

### **503.07 “Indexing” Against Recorded Document Not Permitted**

The USPTO does not process requests for “indexing” or “cross-referencing” additional trademark registration numbers or application serial numbers against a document previously recorded in the Assignment Services Division.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Therefore, even when an assignment document (or other document affecting title) has already been recorded in the Assignment Services Division in connection with a trademark registration or application, a party who wants to record that document against additional applications or registrations must submit the following:

- (1) A copy of the originally recorded assignment document (or other document affecting title), a copy of an extract from the recorded document evidencing the effect on title, or a statement signed by both the party conveying the interest and the party receiving the interest explaining how the conveyance affects title (this may comprise a copy of the previously recorded papers on which the Assignment Services Division has stamped the reel and frame numbers at which they are recorded, or a copy of these papers);
- (2) A completed cover sheet (see TMEP §503.03(e)) that includes the number of each additional registration and/or application against which recordation of the assignment document (or other document affecting title) is requested; and
- (3) The appropriate recording fee (37 C.F.R. §§2.6 and 3.41).

The USPTO will assign a new date of recordation for the additional applications or registrations, update the Assignment Database, and create an electronic record of the cover sheet and assignment document (or other document affecting title), which will become part of the official record. See notice at 1157 TMOG 12 (Dec. 7, 1993).

### **503.08            Accessibility of Assignment Records**

The public can search the trademark assignment records of the Assignment Services Division on the USPTO website at <http://assignments.uspto.gov/assignments>.

The Assignment Services Division of the USPTO maintains separate records for patents and trademarks. 15 U.S.C. §1060; 37 C.F.R. §2.200(a)(1).

Assignments of trademark applications and registrations are open to public inspection upon recordation in the Assignment Services Division. See 37 C.F.R. §3.31(b) and TMEP §503.03(e) regarding the submission of separate cover sheets for documents that include interests in, or transactions involving, both patents and trademarks.

Before 1955, documents were recorded in bound volumes. The location of documents in these volumes is designated by “liber and page,” that is, by the number of the book (liber) and the number of the page in the book. Since 1955, documents have been recorded on microfilm, and are available for immediate inspection in the Trademark Assignment Search Room. The location of these documents is designated by “reel and

## CHANGE OF OWNERSHIP

frame,” that is, by the number of the reel on which they are microfilmed and the number of the frame on the reel.

All assignment records related to pre-1955 trademark records were transferred to the National Archives and Records Administration (“NARA”) in 1990. The USPTO still maintains records of all trademark assignments recorded on or after January 1, 1955.

All trademark assignment records from 1837 to December 31, 1954 are maintained and available for public inspection in the National Archives Research Room located at the Washington National Records Center Building, 4205 Suitland Road, Suitland, Maryland 20746. Assignments recorded before 1837 are maintained at the National Archives and Records Administration, 841 South Pickett Street, Alexandria, Virginia 22304.

Copies of assignment records recorded on or after January 1, 1955, may be ordered from the USPTO upon payment of the fee required by 37 C.F.R. §2.6. An order for a copy of an assignment record should identify the reel and frame at which it is recorded in the Assignment Services Division. If the correct reel and frame numbers are not identified (*e.g.*, the order identifies the document only by the name of the registrant and the number of the registration, or by the name of the applicant and the serial number of the application), the USPTO will charge an additional fee for the time spent searching for the document.

Requests for copies of pre-1955 trademark assignment records should be directed to NARA. Payment of the fees required by NARA should accompany all requests for copies. 37 C.F.R. §2.200(a)(2).

### **503.08(a) Abstracts of Title**

Members of the public may obtain abstracts of title to particular registrations or applications from the Certification Division, Office of Public Records, upon payment of the fee required by 37 C.F.R. §2.6. See notices at 1140 TMOG 65, 66 (July 28, 1992) and 1165 TMOG 13 (Aug. 2, 1994).

### **504 Automatic Updating Ownership of Trademark Applications and Registrations in Trademark Databases**

Prior to November 2, 2003, recording a document with the Assignment Services Division of the USPTO did not automatically change the ownership record in the Trademark Database. To change the ownership record in the Trademark Database, a new owner had to notify the Trademark Operation that ownership had changed. 37 C.F.R. §3.85. The Trademark Database includes the TRAM System and the TARR database.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Effective November 2, 2003, except in the limited circumstances set forth in TMEP §504.01, the USPTO will automatically update the ownership information in the Trademark Database of registrations and pending applications when one of the following documents is recorded with the Assignment Services Division:

- Assignment of entire interest and goodwill
- Nunc Pro Tunc Assignment of entire interest and goodwill
- Merger
- Name Change

In these situations, it is unnecessary for the new owner to notify the Trademark Operation of the change of ownership, or to file a request in a pending application that the certificate of registration issue in the name of the new owner. In all other situations, the new owner must notify the Trademark Operation that ownership has changed in order to update the ownership information in TRAM and TARR.

To ensure that the Trademark Database is automatically updated, the party filing the assignment, merger or name change should identify the “Nature of the Conveyance” by checking the “Assignment,” “Merger” or “Name Change” box in the “Nature of Conveyance” field and should not check the “Other” box.

The Trademark Database will show only the last recorded owner, not the complete chain of title. The complete chain of title can be obtained from the Assignment Services Division’s database on the USPTO website at <http://assignments.uspto.gov/assignments>. The ownership field in the Trademark Database will be automatically updated regardless of whether the records of the Assignment Services Division show a clear chain of title transferring ownership to the last recorded owner. The Trademark Database will include the reel and frame number and execution date of the recorded document, as well as a notation to “Check Assignments.” Both examining attorneys and trademark owners should check assignment records to ensure that the owner of record in the Trademark Database has a clear chain of title.

Trademark owners can check the TARR database at <http://tarr.uspto.gov> to determine whether the Trademark Database has been updated.

### **504.01                    Circumstances in Which Trademark Database Will Not be Automatically Updated**

In the circumstances discussed below, the USPTO will not automatically update the Trademark Database to show the change in ownership, even if the appropriate

## CHANGE OF OWNERSHIP

document is recorded in the Assignment Services Division on or after November 2, 2003. In these situations, the applicant must notify the Trademark Operation that the assignment or other title document has been recorded and request that the Trademark Database be updated to show title in the new owner. 37 C.F.R. §3.85; TMEP §§502.02 *et seq.* and 502.03.

- (1) *Execution Date Conflicts With Previously Recorded Document.* If a previously recorded assignment, merger or change of name document for the same application or registration has an execution date that is the same as or later than the execution date of the subsequently recorded document, the Trademark Database will not be automatically updated. Office personnel will have to review the assignment records and update the database manually.
- (2) *Blackout Period: Ownership of Pending Applications Cannot be Updated During Certain Time Periods.* The Trademark Database will not be automatically updated to show a change of ownership during the following stages of the registration process:
  - (a) For §1(a) and §44 applications:
    - Between approval for publication and issuance of registration
  - (b) For §1(b) applications:
    - Between approval for publication and issuance of notice of allowance;  
*and*
    - Between approval for registration and issuance of registration
- (3) *Maximum Number of Ownership Changes.* The Trademark Database will not be automatically updated if the maximum number of ownership changes permitted for the following time periods has been reached:
  - *Prior to publication* - up to nine changes of ownership
  - *Between publication and registration* - up to nine additional changes of ownership

### **504.02 Processing Time for Automatic Updating**

The process for automatically updating the Trademark Database requires that the Assignment Services Division: (1) record the document transferring title in the Assignment Database; and (2) extract the trademark assignment information from the Assignment Database and send it electronically to the Trademark Operation for

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

automatic updating. The Assignment Services Division will extract trademark assignment information from the Assignment Database and transmit it to the Trademark Operation once a week.

To expedite recordation, new owners are encouraged to file requests for recordation through the USPTO website, at <http://etas.uspto.gov>.

If a trademark owner wants the Trademark Database updated within a certain timeframe, and there is insufficient time for the Assignment Services Division to process a recently recorded title document for automatic updating, the owner should notify the Trademark Operation of the change of ownership. 37 C.F.R. §3.85; TMEP §§502.02 *et seq.* and 502.03. Trademark owners can search the Assignment Services Division's database on the USPTO website at <http://assignments.uspto.gov/assignments> to determine whether an assignment has been recorded, and can check the TARR database at <http://tarr.uspto.gov> to determine whether the Trademark Database has been updated.

### **504.03 Correction to Automatic Update - Last Recorded Owner Does Not Have Clear Chain of Title**

In the situations set forth in TMEP §504, the Trademark Database will be automatically updated to show the last recorded owner regardless of whether the Assignment Database shows that the last recorded owner has a clear chain of title. If the Trademark Database is automatically updated to show ownership of an application or registration in a party who does not have a clear chain of title as evidenced by the Assignment Database, the true owner of the application or registration may file a written request to have the ownership field in the Trademark Database corrected. The USPTO will grant a request for correction of the ownership field if:

- (1) The Trademark Database was automatically updated to show ownership in a party who does not have a clear chain of title according to the Assignment Database; *and*
- (2) The Assignment Database shows a clear chain of title in the party requesting correction of the ownership field in the Trademark Database.

The correction of the Trademark Database will not be automatically reflected in the Assignment Database. To correct the assignment records, a party must follow the procedures set forth in TMEP §§503.06 *et seq.* for correcting errors in the Assignment Database.

*Example:* ABC Corporation owns Application No. 1. An assignment of the entire interest and goodwill is filed transferring ownership of Application 1 from ZED Corporation to XYZ Corporation. The

## CHANGE OF OWNERSHIP

Assignment Services Division records the assignment and transmits the trademark assignment information to the Trademark Operation. The Trademark Database is automatically updated to show XYZ Corporation as the new owner of Application 1. The Trademark Operation will correct its database, upon ABC Corporation's request, because the Assignment Database does not show a clear chain of title from ABC Corporation to XYZ Corporation, and the Assignment Database shows a clear chain of title in ABC Corporation.

In all other situations, a party requesting correction of the ownership records of the Trademark Operation must follow the procedures for correcting errors in recorded documents or cover sheets, as set forth in TMEP §§503.06 *et seq.* That is, the party must file corrective documents with the Assignment Services Division and pay the recordal fees necessary to correct the error, then notify the Trademark Operation that the corrective documents have been recorded.

Prior to registration, a request for correction of the ownership field in the Trademark Database should be made in an amendment directed to the examining attorney. If such a request is filed after publication, it will be handled in accordance with standard procedures for processing amendments after publication, as set forth in TMEP §§1505.02 *et seq.* In a §1(b) application, if a request for correction of the ownership field is filed between the issuance of the notice of allowance and the submission of a statement of use, the USPTO will place the request in the file for consideration at the time of examination of the statement of use. 37 C.F.R. §2.77; TMEP §1107.

After registration, a request for correction of the ownership field should be made in the form of a request for correction under §7(g) of the Trademark Act and 37 C.F.R. §2.174.

### **504.04 Automatic Updating Does Not Apply to Requests for Recordation Filed Before November 2, 2003**

The automatic updating procedures discussed in §§504.01 through 504.03 apply to all assignments, mergers, and name changes recorded in the Assignment Services Division on or after November 2, 2003, even if the request for recordation was filed before November 2, 2003.

These procedures do not apply to assignments, mergers, or name changes that were recorded in the Assignment Services Division prior to November 2, 2003. For documents recorded prior to November 2, 2003, the new owner must notify the Trademark Operation of the change of ownership, and request that the Trademark Database be updated. 37 C.F.R. §3.85.



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **504.05            Automatic Updating Does Not Apply to International Applications and Registrations Under the Madrid Protocol**

The procedures discussed in §§504.01 *et seq.* do not apply to §66(a) applications and registered extensions of protection of international registrations to the United States. Changes of ownership of international registrations and requests for extensions of protection of international registrations to the United States must be recorded with the IB. The USPTO will record only those assignments (or other documents of title) that have been recorded in the International Register. The Trademark Databases will be automatically updated to reflect any change of ownership that is recorded in the International Register. See TMEP §501.07 for further information about assignment of §66(a) applications and registered extensions of protection, and TMEP §§1906.01 and 1906.01(a) for information about recording changes of ownership of international registrations with the IB.

# Chapter 600

## Attorney or Representative

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### **601 Applicant May Be Represented by Attorney at Law**

601.01 USPTO Cannot Aid in Selection of Attorney

### **602 Persons Who May Practice Before Office in Trademark Matters**

602.01 Powers of Attorney

602.01(a) Power of Attorney Relating to More Than One Application or Registration

602.01(b) Associate Powers of Attorney

602.01(c) Powers of Attorney Filed After Registration

602.02 Standards of Conduct

602.02(a) Signature and Certificate for Correspondence filed in the United States Patent and Trademark Office

602.03 Papers Filed by Unauthorized Persons

602.04 Revocation of Power of Attorney

602.05 Permissive Withdrawal of Attorney of Record

### **603 Correspondence, With Whom Held**

603.01 Establishing the Correspondence Address

603.01(a) Correspondence in §66(a) Applications

603.02 Changing the Correspondence Address

603.02(a) Changing the Correspondence Address Before Registration

603.02(b) Changing the Correspondence Address in Multiple Applications or Registrations

603.02(c) Changing the Correspondence Address After Registration

603.03 Applicant Has Duty to Maintain Current and Accurate Correspondence Address

603.04 Processing Correspondence Signed by Someone Other Than the Applicant or the Applicant's Designated Attorney

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

603.05 Correspondence with Parties Not Domiciled in the United States

### **604 Designation of Domestic Representative by Parties Not Domiciled in the United States**

#### **601 Applicant May Be Represented by Attorney at Law**

The owner of a mark may file and prosecute his or her own application for registration of the mark, or may be represented by a practitioner qualified under 37 C.F.R. §10.14 to practice before the United States Patent and Trademark Office (“USPTO”) in trademark cases. 37 C.F.R. §§2.11 and 10.14. See TMEP §602 regarding persons who may practice before the USPTO in trademark cases. If the applicant is represented by a practitioner qualified under 37 C.F.R. §10.14 to practice before the USPTO in trademark cases, the USPTO will communicate only with the practitioner, unless that representation is terminated. If the applicant contacts the USPTO regarding the application, the applicant will be advised that the USPTO will only discuss the matter with applicant’s attorney. See TMEP §602.04 regarding revocation of a power of attorney.

##### **601.01 USPTO Cannot Aid in Selection of Attorney**

The USPTO cannot aid in the selection of an attorney. 37 C.F.R. §2.11.

If it is apparent that an applicant is unfamiliar with the proper preparation and prosecution of an application and needs more detailed or technical assistance than the examining attorney is permitted to give, the examining attorney may suggest to the applicant that it may be desirable to employ an attorney who is familiar with trademark matters. The following language may be used in the Office action:

The applicant may wish to hire a trademark attorney because of the technicalities involved in the application. The United States Patent and Trademark Office cannot aid in the selection of an attorney.

#### **602 Persons Who May Practice Before Office in Trademark Matters**

*37 C.F.R. §10.14. Individuals who may practice before the Office in trademark and other non-patent cases.*

*(a) Attorneys. Any individual who is an attorney may represent others before the Office in trademark and other non-patent cases. An attorney is not required to apply for registration or recognition to practice before the Office in trademark and other non-patent cases.*

*(b) Non-lawyers. Individuals who are not attorneys are not recognized to practice*

## ATTORNEY OR REPRESENTATIVE

*before the Office in trademark and other non-patent cases, except that individuals not attorneys who were recognized to practice before the Office in trademark cases under this chapter prior to January 1, 1957, will be recognized as agents to continue practice before the Office in trademark cases.*

*(c) Foreigners. Any foreign attorney or agent not a resident of the United States who shall prove to the satisfaction of the Director that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark cases, provided: The patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark cases before the United States Patent and Trademark Office. Recognition under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.*

*(d) Recognition of any individual under this section shall not be construed as sanctioning or authorizing the performance of any act regarded in the jurisdiction where performed as the unauthorized practice of law.*

*(e) No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark cases. Any individual may appear in a trademark or other non-patent case in his or her own behalf. Any individual may appear in a trademark case for (1) a firm of which he or she is a member or (2) a corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, corporation, or association is a party to a trademark proceeding pending before the Office.*

### **United States Attorneys**

An attorney who is a member in good standing of the bar of any United States court or the highest court of any State may practice before the USPTO in trademark matters. No application for recognition to practice is necessary. The USPTO does not give an examination for eligibility or maintain a register of persons entitled to practice in trademark cases. An attorney at law who appears in person or signs a document on behalf of an applicant or registrant will be accepted as the representative of the applicant or registrant. 37 C.F.R. §§2.17(a) and (c).

Only individuals, not law firms, are entitled to be recognized to represent others. Generally, attorneys who have not specifically been mentioned in either a power of attorney or in correspondence filed with the USPTO may discuss but not conclude business with the USPTO over the telephone. However, if an attorney from the same firm as the attorney of record claims to be authorized by the attorney of record to conduct discussions with respect to a specific application, the examining attorney will permit the attorney to conclude business, and will note this fact in any resulting

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Office action.

### ***Foreign Attorneys***

Under 37 C.F.R. §10.14(c), a foreign attorney who is not a resident of the United States may represent parties located in the country in which the foreign attorney resides and practices, if (1) he or she proves to the satisfaction of the USPTO'S Office of Enrollment and Discipline ("OED") that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices; and (2) the patent or trademark office of that foreign country allows substantially reciprocal privileges to those permitted to practice before the USPTO. A foreign attorney who meets the requirements of 37 C.F.R. §10.14(c) can only represent parties located in the country in which the foreign attorney resides and practices. The foreign attorney cannot represent parties located in the United States or other foreign countries.

Currently, Canadian attorneys are the only foreign attorneys recognized as meeting the qualification criteria of 37 C.F.R. §10.14(c). OED maintains a list of attorneys who are registered or in good standing with the Canadian Intellectual Property Office, which is available to USPTO employees through the USPTO's internal computer network. When a Canadian attorney represents a party in a proceeding in the USPTO, the examining attorney should verify that the attorney is in fact recognized by the Director of OED.

An attorney who resides and practices in a foreign country other than Canada and who is not a member in good standing of the bar of a United States court or the highest court of any State may not practice before the USPTO. Any such attorney who wishes to represent an applicant in a trademark matter must file a written request to do so with OED. This request should include proof that the attorney is in good standing with the foreign patent or trademark office, and that the foreign patent or trademark office provides substantially reciprocal rights to United States attorneys.

See TMEP §603.05 regarding correspondence with parties not domiciled in the United States, and TMEP §602.03 regarding papers filed by unauthorized persons.

### ***Non-Attorneys***

Non-attorneys are not permitted to practice except under the limited circumstances specified in 37 C.F.R. §10.14(b).

When an applicant is represented by counsel, the USPTO encourages the practice of direct communication with the appointed attorney(s). Although paralegals and legal assistants may convey information between the examining attorney and the appointed attorney(s), they are not authorized to conduct business before the

## ATTORNEY OR REPRESENTATIVE

USPTO. 37 C.F.R. §10.14(b). For example, a non-attorney who is authorized to verify facts on behalf of an applicant under 37 C.F.R. §2.33(a)(2) (see TMEP §804.04) may not sign responses to Office actions, or authorize examiner's amendments and priority actions, unless he or she has legal authority to bind the applicant (e.g., a corporate officer or partner of a partnership). See 37 C.F.R. §§10.14(e) and 10.18(a). See also TMEP §§712.01 *et seq.* for more information about persons who can sign responses to Office actions, TMEP §§707 *et seq.* regarding examiner's amendments, and TMEP §§708 *et seq.* regarding priority actions. Paralegals and legal assistants are not authorized to negotiate, argue a position, officially accept or reject Office requirements, or otherwise prosecute a matter before the USPTO.

Use of the term "agent" in connection with a representative in a trademark case is only appropriate under the limited circumstances specified in 37 C.F.R. §10.14(b).

### 602.01 Powers of Attorney

*37 C.F.R. §2.17(c). To be recognized as a representative, an attorney as defined in §10.1(c) of this chapter may file a power of attorney, appear in person, or sign a document on behalf of an applicant or registrant that is filed with the Office in a trademark case.*

*37 C.F.R. §2.17(d) A party may file a power of attorney that relates to more than one trademark application or registration, or to all existing and future applications and registrations of that party. A party relying on such a power of attorney must:*

*(1) Include a copy of the previously filed power of attorney; or*

*(2) Refer to the power of attorney, specifying the filing date of the previously filed power of attorney; the application serial number (if known), registration number, or inter partes proceeding number for which the original power of attorney was filed; and the name of the party who signed the power of attorney; or, if the application serial number is not known, submit a copy of the application or a copy of the mark, and specify the filing date.*

Generally, it is not necessary for an attorney at law to file a power of attorney or any other special authorization in a trademark case. An attorney at law who appears in person or signs a document on behalf of an applicant or registrant will be accepted as the representative of the applicant or registrant. 37 C.F.R. §§2.17(a) and (c).

If an attorney files a proper power of attorney from the party he or she represents, the USPTO will accept the power. To be acceptable as a power of attorney, the power must identify an individual attorney(s) by name, not merely specify the name of a law firm. If a power specifies only the name of a law firm, the USPTO will treat it

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

as a correspondence address rather than an authorization to conduct business. See TMEP §§603 *et seq.* regarding the correspondence address.

To expedite processing, the USPTO recommends that powers of attorney be filed through Trademark Electronic Application System (“TEAS”), at <http://www.uspto.gov/teas/index.html>. When powers of attorney are filed electronically, the data is automatically entered into the USPTO’s Trademark Reporting and Monitoring (“TRAM”) System.

An attorney cannot sign an original power of attorney on behalf of his or her client. An original power of attorney, other than one associating an additional attorney with an already authorized attorney (see TMEP §602.01(b)), must be signed by the individual applicant, or by someone with legal authority to bind a juristic applicant (e.g., a corporate officer or partner of a partnership). See TMEP §804.05 regarding signature of documents transmitted electronically.

If a power of attorney is signed by an improper person (e.g., the applicant’s attorney), the examining attorney generally does not have to require a properly signed power, because the filing of a power of attorney is not mandatory in a trademark case. See 37 C.F.R. §2.17(c). (However, if an applicant is already represented by an attorney, and a new attorney takes over, the applicant must file either a new power of attorney or a written request to change the correspondence address, signed by the applicant, before the USPTO will correspond with the new attorney. See TMEP §603.02(a). See also TMEP §602.03 regarding papers filed by unauthorized parties.)

If no power of attorney is filed, the USPTO will presume that an attorney is the attorney of record in an application if: (1) the original application is accompanied by a cover letter or transmittal letter that is signed by an attorney and identifies the name and address of that attorney; (2) the application is filed electronically using TEAS (see TMEP §301), and the attorney information section is completed; or (3) the application is filed by a *pro se* applicant (i.e., an applicant who does not have an attorney), and correspondence is subsequently filed that is signed by an attorney and identifies the name and address of that attorney, either on the correspondence itself or on the transmittal letter that accompanies the correspondence. The USPTO presumes that documents filed by practitioners are authorized to be filed.

The USPTO considers a power of attorney to end with respect to a particular application when the mark is registered, when ownership changes, or when the application is abandoned. See TMEP §602.01(c) regarding the processing of powers of attorney filed after registration.

If an attorney is suspended or excluded by the Director of the USPTO, a power of attorney should be regarded as void as of the date of suspension or exclusion, and no oral or written communication should be made with the attorney on or after that

## ATTORNEY OR REPRESENTATIVE

date. Any correspondence filed by a suspended or excluded attorney should be treated as correspondence filed by an unauthorized person, pursuant to TMEP §602.03.

See also TMEP §602.04 regarding revocation of a power of attorney, and TMEP §§603.02 *et seq.* regarding changes in the correspondence address.

### **602.01(a) Power of Attorney Relating to More Than One Application or Registration**

Using TEAS, at [www.uspto.gov/teas/index.html](http://www.uspto.gov/teas/index.html), an owner may appoint an attorney for up to 20 applications or registrations that have the identical owner and attorney. A power of attorney relating to future applications cannot be filed through TEAS.

An applicant or registrant may file a power of attorney *on paper* that relates to more than one trademark application or registration, or to all existing and future applications and registrations. Someone relying on such a power of attorney must: (1) include a copy of the previously filed power of attorney; or (2) refer to the previously filed power of attorney, specifying: the filing date of the power; the application serial number (if known), registration number, or *inter partes* proceeding number for which the original power of attorney was filed; and the name of the party who signed the power of attorney; or, if the application serial number is not known, submit a copy of the application or a copy of the mark, and specify the filing date. 37 C.F.R. §2.17(d). If the applicant or registrant meets these requirements, the examining attorney should accept the power of attorney.

### **602.01(b) Associate Powers of Attorney**

Once the applicant has designated an attorney, the attorney may sign an associate power of attorney appointing another attorney as an additional person authorized to prosecute the application. If the applicant revokes the original power of attorney, this revocation also discharges any associate power signed by the attorney whose power has been revoked. See TMEP §602.04 regarding revocation of a power of attorney.

### **602.01(c) Powers of Attorney Filed After Registration**

To expedite processing, the USPTO recommends that powers of attorney be filed through TEAS, at <http://www.uspto.gov/teas/index.html>. When a power of attorney is filed through TEAS, the data is automatically entered into the USPTO's TRAM database.

The USPTO considers a power of attorney to end with registration.



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

When a new power of attorney is filed *on paper* after registration, the USPTO scans an image of the document into the record, but does not change the attorney of record in the TRAM database unless the owner of the registration concurrently files an affidavit of continued use under 15 U.S.C. §1058 (“§8 affidavit”), affidavit of incontestability under 15 U.S.C. §15 (“§15 affidavit”), renewal application under 15 U.S.C. §1059, or request to amend or correct the registration under 15 U.S.C. §1057(e). Likewise, when the owner of a registration files a *paper* request to revoke a power of attorney, or an attorney files a request to withdraw as attorney of record, the USPTO scans an image of the document into the record but does not change the attorney of record in TRAM. See TMEP §602.04 regarding revocation of powers of attorney and TMEP §602.05 regarding withdrawal.

When the owner of a registration files an affidavit, renewal application, or request to amend or correct a registration through an attorney, the USPTO will update TRAM to indicate the name of the attorney who filed the affidavit, renewal application, or amendment.

See *also* TMEP §1612.

### **602.02 Standards of Conduct**

*37 C.F.R. §10.15. Refusal to recognize a practitioner. Any practitioner authorized to appear before the Office may be suspended or excluded in accordance with the provisions of this part. Any practitioner who is suspended or excluded under this subpart or removed under section 10.11(b) shall not be entitled to practice before the Office.*

*37 C.F.R. §10.20. Canons and Disciplinary Rules.*

*(a) Canons are set out in §§10.21, 10.30, 10.46, 10.56, 10.61, 10.76, 10.83, 10.100, and 10.110. Canons are statements of axiomatic norms, expressing in general terms the standards of professional conduct expected of practitioners in their relationships with the public, with the legal system, and with the legal profession.*

*(b) Disciplinary Rules are set out in §§10.22 - 10.24, 10.31 - 10.40, 10.47 - 10.57, 10.62 - 10.68, 10.77, 10.78, 10.84, 10.85, 10.87 - 10.89, 10.92, 10.93, 10.101 - 10.103, 10.111, and 10.112. Disciplinary Rules are mandatory in character and state the minimum level of conduct below which no practitioner can fall without being subjected to disciplinary action.*

Part 10 of Title 37 of the Code of Federal Regulations pertains to representation of others before the USPTO. Part 10 identifies and defines individuals entitled to practice before the USPTO, and establishes a mandatory Code of Professional Responsibility, and defines a procedure for investigations and disciplinary proceedings.

## ATTORNEY OR REPRESENTATIVE

### **602.02(a) Signature and Certificate for Correspondence filed in the United States Patent and Trademark Office**

*37 C.F.R. §10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.*

*(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or §2.193(c)(1) of this chapter.*

*(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-*

*(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and*

*(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that-*

*(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;*

*(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;*

*(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and*

*(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.*

*(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of-*

- (1) Holding certain facts to have been established;*
- (2) Returning papers;*
- (3) Precluding a party from filing a paper, or presenting or contesting an issue;*
- (4) Imposing a monetary sanction;*
- (5) Requiring a terminal disclaimer for the period of the delay; or*
- (6) Terminating the proceedings in the Patent and Trademark Office.*

*(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See §10.23(c)(15).*

### **602.03 Papers Filed by Unauthorized Persons**

Under 37 C.F.R. §10.18(a), every document filed by a practitioner qualified under 37 C.F.R. §10.14 to practice before the USPTO in trademark cases (except for papers required to be signed by the applicant, registrant or party to a proceeding) must be personally signed by the practitioner. The signature constitutes a certificate that the document's filing is authorized. 37 C.F.R. §10.18(b)(1). Therefore, the USPTO presumes that papers signed by practitioners are authorized to be filed and will enter such papers in the record.

An individual who is not qualified under 37 C.F.R. §10.14(a), (b), or (c) to practice before the USPTO in trademark cases is not permitted to represent a party in the prosecution of a trademark application, maintenance of a registration, or in a proceeding before the USPTO. 5 U.S.C. §500(d); 37 C.F.R. §10.14(e). If the examining attorney suspects that an individual who does not meet the requirements of 37 C.F.R. §10.14 is representing an applicant, the examining attorney should bring the matter to the attention of the Administrator for Trademark Policy and Procedure in the Office of the Commissioner for Trademarks, who will coordinate appropriate action with the Office of Enrollment and Discipline.

If it appears that a response to an Office action was signed by an improper party, the examining attorney should treat the response as an incomplete response, and should grant the applicant additional time to perfect the response, pursuant to 37 C.F.R. §2.65(b) and TMEP §718.03(b). The applicant must submit a response signed by someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or by an attorney who is qualified to practice under 37 C.F.R. §10.14. Where a response was signed by an unauthorized party, it is not acceptable for the applicant to ratify the response through an examiner's amendment. See TMEP §712.03.

## ATTORNEY OR REPRESENTATIVE

### 602.04 Revocation of Power of Attorney

*37 C.F.R. §2.19(a). Authority to represent an applicant, registrant or a party to a proceeding may be revoked at any stage in the proceedings of a case upon written notification to the Director; and when it is revoked, the Office will communicate directly with the applicant, registrant or party to the proceeding, or with the new attorney or domestic representative if one has been appointed. The Office will notify the person affected of the revocation of his or her authorization.*

An applicant may revoke a power of attorney by filing a written revocation. The USPTO will acknowledge the revocation and will no longer recognize the attorney in that case unless he or she is again specifically appointed.

To expedite processing, the USPTO recommends that revocations of powers of attorney be filed through TEAS, at <http://www.uspto.gov/teas/index.html>.

When an applicant is represented by an attorney, a change in representation can be made only by a written request signed by the applicant. If the applicant files a new power of attorney, the address contained in the new power of attorney becomes the correspondence address of record. If the applicant files a revocation of the previous power of attorney without a new power of attorney, correspondence will be sent either to (1) the applicant, or (2) the attorney signing the cover letter or action accompanying the revocation.

The new attorney cannot sign a new power of attorney or revocation of the previous power of attorney on behalf of the applicant. The revocation must be signed by the individual applicant, or by someone with legal authority to bind a juristic applicant (e.g., a corporate officer or partner of a partnership).

The USPTO considers a power of attorney to end with registration. After registration, if the owner of a registration files a *paper* request to revoke a power of attorney appointed before registration, the USPTO scans an image of the revocation into the record but does not change the attorney of record in TRAM unless the owner concurrently files a §8 or §15 affidavit, §9 renewal application, or request to amend or correct the registration under §7 of the Act. See TMEP §1612.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 602.05 Permissive Withdrawal of Attorney of Record

*37 C.F.R. §2.19(b). If the requirements of §10.40 of this chapter are met, an attorney authorized under §10.14 to represent an applicant, registrant or party in a trademark case may withdraw upon application to and approval by the Director.*

An attorney may withdraw from representing an applicant or registrant, but may not withdraw in a way that would prejudice the applicant or registrant. *In re Legendary, Inc.*, 26 USPQ2d 1478 (Comm'r Pats. 1992) (attorney's request to withdraw denied where the request was filed on the last day of the period for response to an Office action and attorney stated neither that the applicant was given due notice of the attorney's withdrawal from employment nor that the attorney had delivered all papers and property in his file concerning the prosecution of the application to the applicant). See 37 C.F.R. §10.40 regarding mandatory and permissive withdrawal from employment by an attorney.

To expedite processing, the USPTO recommends that requests to withdraw as the attorney of record prior to registration be filed through TEAS, at <http://www.uspto.gov/teas/index.html>. Requests to withdraw as attorney cannot be filed through TEAS after registration.

Before registration, a request for permission to withdraw as attorney will be handled by the appropriate managing attorney, or, if a notice of allowance has issued and the application is awaiting the filing of a statement of use, by the Supervisor of the ITU/Divisional Unit. After registration, a request for permission to withdraw as attorney will be handled by the Supervisor of the Post Registration Section of the Office.

A request to withdraw must include the following:

- (1) A statement of the reason(s) for the request to withdraw (see 37 C.F.R. §10.40);
- (2) A statement that the attorney has given due notice to the applicant or registrant that the attorney is withdrawing from employment and will be filing the necessary papers with the USPTO; and that the applicant or registrant was given notice of the withdrawal at least two months before the expiration of the response period;
- (3) A statement that the attorney has delivered to the applicant or registrant all papers and property in the attorney's file concerning the prosecution of the application or registration; and
- (4) A statement that the attorney notified the applicant or registrant of any responses that may be due, and of the deadline for response.

## ATTORNEY OR REPRESENTATIVE

A request to withdraw should be filed soon after the representative notifies the applicant or registrant of his or her intent to withdraw. If an applicant or registrant was notified of the attorney's withdrawal from employment at least two months before the expiration of the response period, and the request to withdraw meets all the requirements listed above, the request will be granted. *In re Slack*, 54 USPQ2d 1504 (Comm'r Pats. 2000).

The request for permission to withdraw should also contain the following:

- (1) The application serial number or registration number;
- (2) The law office to which the application is assigned, in a pending application;
- (3) The name of the examining attorney or Post Registration examiner assigned; and
- (4) The present mailing address of the attorney who is withdrawing and the present mailing address of the applicant or registrant.

If filed on paper, the request should be titled "Request for Permission to Withdraw as Attorney of Record."

The managing attorney or supervisor will approve or deny the request, notify the applicant or registrant and the attorney of the approval or denial of the request, and place a record of this notification (*i.e.*, a copy of the written communication or telephone call record) in the record. If the request is approved, the managing attorney or supervisor should ensure that the correspondence address is changed in the USPTO's automated records. It is the responsibility of the managing attorneys or supervisors to establish procedures that permit withdrawal requests to be given priority and acted on promptly.

If the attorney who seeks to withdraw is also the domestic representative, the managing attorney or supervisor should inquire as to whether the attorney intends to withdraw as domestic representative. This inquiry should be made by phone or e-mail, if possible. If the attorney withdraws as domestic representative, the managing attorney or supervisor should ensure that the domestic representative field in TRAM is updated accordingly. See TMEP §604 regarding designations of domestic representative, and TMEP §603.05 regarding correspondence with parties not domiciled in the United States.

If an attorney appointed before registration files a request to withdraw after registration, the USPTO scans an image of the request into the record but does not change the attorney of record in TRAM. See TMEP §§602.01(c) and 1612.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The USPTO will not process a request for permission to withdraw in an abandoned application. When an attorney files a request to withdraw in an abandoned application, the USPTO scans an image of the request into the record but does not change the TRAM database. See TMEP §1612.

### **603 Correspondence, With Whom Held**

*37 C.F.R. §2.18 Correspondence, with whom held.*

*(a) If documents are transmitted by an attorney, or a written power of attorney is filed, the Office will send correspondence to the attorney transmitting the documents, or to the attorney designated in the power of attorney, provided that the attorney is an attorney as defined in §10.1(c) of this chapter.*

*(b) The Office will not undertake double correspondence. If two or more attorneys appear or sign a document, the Office's reply will be sent to the address already established in the record until the applicant, registrant or party, or its duly appointed attorney, requests in writing that correspondence be sent to another address.*

*(c) If an application, registration or proceeding is not being prosecuted by an attorney but a domestic representative has been appointed, the Office will send correspondence to the domestic representative, unless the applicant, registrant or party designates in writing another correspondence address.*

*(d) If the application, registration or proceeding is not being prosecuted by an attorney and no domestic representative has been appointed, the Office will send correspondence directly to the applicant, registrant or party, unless the applicant, registrant or party designates in writing another correspondence address.*

#### **603.01 Establishing the Correspondence Address**

When a trademark application is filed, the USPTO enters into its automated records an address (consisting of a name, street address or post office box, city, state and postal code) where correspondence from the USPTO will be sent. This often differs from the applicant's address. Correspondence will be sent to any address within the United States that the applicant selects. The USPTO will send correspondence to Canada if the applicant selects a Canadian attorney or agent who is duly qualified under 37 C.F.R. §10.14(c) to practice before the USPTO (see TMEP §602). See TMEP §603.05 regarding correspondence with applicants who are not domiciled in the United States, and TMEP §603.01(a) regarding correspondence in §66(a) applications.

The USPTO may send communications concerning an application by e-mail if e-mail communication is authorized by the applicant or the applicant's attorney. See TMEP §304.03.

## ATTORNEY OR REPRESENTATIVE

When the application includes a power of attorney that designates an attorney(s) and an address, or a form that has the appearance of a power of attorney that designates the name and address of an attorney, the USPTO will correspond with the designated attorney. In addition, the USPTO will presume that the applicant wishes correspondence to be sent to an attorney's address rather than directly to the applicant when:

- (1) The name and address of an attorney appears in the original application papers;
- (2) The original application is accompanied by a transmittal letter on letterhead that identifies an attorney;
- (3) The application is filed through TEAS (see TMEP §301), and the attorney information section is completed; or
- (4) The original application is written on paper that identifies the name and address of an attorney.

The above procedures are also used to establish the correspondence address when a registrant files a §8 or §71 affidavit, §9 renewal application, or request for amendment or correction of a registration under 15 U.S.C. §1057. The USPTO will update TRAM to indicate the name of the attorney who filed the affidavit, renewal application, or amendment.

See TMEP §603.02(a) for information about changing the correspondence address in a pending application, and TMEP §603.02(c) for information about changing the correspondence address after registration.

### **603.01(a) Correspondence in §66(a) Applications**

The USPTO will send the first Office action in an application under §66(a) of the Trademark Act to the International Bureau of the World Intellectual Property Organization ("IB"). The IB will send it to the applicant. The USPTO will send second and subsequent Office actions directly to the applicant, at the correspondence address set forth in the request for extension of protection to the United States, or to the correspondence address provided in a subsequent communication filed in the USPTO. See TMEP §1904.02(e) for further information about Office actions in §66(a) applications.

The USPTO will accept a notice of change of the correspondence address in a §66(a) application or a registered extension of protection of an international registration to the United States, and will send correspondence to the new address. However, this will not change the representative designated in the international registration, to which the IB sends correspondence. A request to record a change of



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

the name or address of the representative designated in the international registration must be filed with the IB; it cannot be filed through the USPTO. There are forms on the IB website at <http://www.wipo.int/madrid/en/>. See Madrid Protocol Common Reg. 36(i).

See TMEP §§1906 *et seq.* regarding requests to record changes with the IB.

### **603.02 Changing the Correspondence Address**

To expedite processing, notices of change of correspondence address should be filed through TEAS, at [www.uspto.gov/teas/index.html](http://www.uspto.gov/teas/index.html). When a notice is filed electronically, the USPTO receives it within seconds after filing, and immediately issues a confirmation of filing via e-mail. The TEAS form can be used to change the correspondence address on any application or registration that is currently active. The data from the form is inputted directly into the automated records of the USPTO. See TMEP §603.02(b) for information about how to change the correspondence address in multiple applications or registrations.

#### **603.02(a) Changing the Correspondence Address Before Registration**

Once the correspondence address is established for a particular application, it is not changed unless there is a written request by the applicant or the attorney of record to change the address. The mere transmittal of a response to an Office action bearing a new address for an applicant or an applicant's attorney does not effect a change in a correspondence address.

If an applicant is represented by an attorney ("A"), and another attorney ("B") later responds on behalf of the applicant and requests that correspondence be sent to B, B will be required to submit written authorization from the applicant for the requested change in correspondence address. Correspondence will continue to be sent to A until B submits the necessary authorization from the applicant. Attorney B cannot sign a request to change the correspondence address on behalf of the applicant. See TMEP §603.04 regarding processing of correspondence that is signed by someone other than the applicant or the applicant's designated attorney.

The USPTO will construe the following as a written request to change the correspondence address:

- (1) A new power of attorney, signed by someone authorized to bind the applicant (see TMEP §602.01), is filed, even if there is no revocation of a previous power of attorney (however, the filing of an "associate power of attorney" or similar document does not change the correspondence address); or

## ATTORNEY OR REPRESENTATIVE

- (2) The application is filed by a *pro se* applicant, and correspondence is subsequently filed that identifies the name and address of an attorney, either on the correspondence itself or on the transmittal letter that accompanies the correspondence, even if no power of attorney is filed.

In these two situations, the USPTO will change the correspondence address to the address of the new attorney. In all other situations, a written request to change the correspondence address, signed by the applicant, is required.

To expedite processing, the USPTO recommends that the notice of change of address be filed through TEAS, at [www.uspto.gov/teas/index.html](http://www.uspto.gov/teas/index.html). The TEAS form can be used to change the correspondence address on any application or registration that is currently active. When the notice is filed electronically, the USPTO receives it within seconds after filing, and immediately issues a confirmation of filing via e-mail. The data from the form is inputted directly into the automated records of the USPTO. See TMEP §603.02(b) for information about how to change the correspondence address in multiple applications or registrations.

When a request to change the correspondence address is filed *on paper*, the USPTO manually enters the new correspondence address into its automated records and places the request in the application record, but does not send a confirmation or other acknowledgment of the request to change the correspondence address. The applicant may check the Trademark Applications and Registrations Retrieval (“TARR”) database at <http://tarr.uspto.gov> to determine whether the change of address has been entered into the automated records of the USPTO.

A change of correspondence address cannot be entered by examiner’s amendment.

When ownership of an application changes and the proper document is recorded in the Assignment Services Division, the USPTO will update its automated records to reflect the address of the assignee or the assignee’s attorney, even if the assignee does not specifically request a change of address.

The USPTO will not process a request to change the correspondence address in an abandoned application. When an applicant files a request to change the correspondence address in an abandoned application, the USPTO simply places the request in the record.

The USPTO will not undertake double correspondence with the applicant and the applicant’s attorney or with more than one attorney or representative.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **603.02(b) Changing the Correspondence Address in Multiple Applications or Registrations**

A single TEAS form for recording a change of address, found at [www.uspto.gov/teas/index.html](http://www.uspto.gov/teas/index.html), can be used to notice a change of address for more than one application or registration. The TEAS form can be used to change the correspondence address only on applications or registrations that are currently active.

### **603.02(c) Changing the Correspondence Address After Registration**

To expedite processing, the USPTO recommends that the notice of change of address be filed through TEAS, at [www.uspto.gov/teas/index.html](http://www.uspto.gov/teas/index.html). The TEAS form can be used to change the correspondence address on any registration that is currently active. When the notice is filed electronically, the USPTO receives it within seconds after filing, and immediately issues a confirmation of filing via e-mail. The data from the form is inputted directly into the USPTO's automated system.

When the owner of a registration files a request *on paper* to change the correspondence address after registration, the USPTO scans an image of the request into the record, but does not update the TRAM System unless the owner concurrently files a §8 or §15 affidavit, §9 renewal application, or request to amend or correct a registration under 15 U.S.C. §1057. If the owner wants the new address entered into the TRAM system, the owner must file the notice of change of address through TEAS.

When a §8 or §15 affidavit, §9 renewal application, or request to amend or correct a registration is filed through an attorney, the USPTO will update TRAM to indicate the name of the attorney who filed the affidavit, renewal application or request. If the owner of the registration does not have an attorney, the USPTO updates TRAM to indicate the owner's address as shown in the affidavit, renewal application or amendment.

### **603.03 Applicant Has Duty to Maintain Current and Accurate Correspondence Address**

It is the applicant's responsibility to maintain a current and accurate correspondence address in its application. If the correspondence address changes, the USPTO must be promptly notified in writing, preferably through TEAS. 37 C.F.R. §2.18. This also applies to e-mail addresses, if the applicant has authorized the Office to send correspondence by e-mail (see TMEP §304.03).

## ATTORNEY OR REPRESENTATIVE

### **603.04 Processing Correspondence Signed by Someone Other Than the Applicant or the Applicant's Designated Attorney**

During the prosecution of a trademark application, every action that is not signed by the applicant must be signed by a practitioner qualified under 37 C.F.R. §10.14 to practice before the USPTO in trademark cases. 37 C.F.R. §10.18(a). Any action that is so signed will be accepted regardless of whether the practitioner who has signed is the same person who signed previously submitted papers, and regardless of whether the practitioner has filed a power of attorney. 37 C.F.R. §2.17(c). However, if the signer is different, the USPTO will continue to send correspondence to the correspondence address already established unless and until there is a written request to change that address, signed by the applicant.

*Example:* If an application as originally filed is accompanied by a transmittal letter bearing the name and address of an attorney, the attorney's name and address will be entered into the records of the USPTO as the correspondence address (see TMEP §603.01). If a response to an Office action signed by a different attorney is subsequently filed, the USPTO will accept and act on the response, but will continue to send correspondence to the mailing address originally established until there is a written request to change that address.

See TMEP §§603.02 *et seq.* regarding requests to change the correspondence address.

The examining attorney should ensure that the person who signs each document, if not the applicant, is either an attorney authorized to practice before the USPTO (which normally can be presumed from the attorney's own statement or identification) or other authorized party. See TMEP §602 regarding persons who may practice before the USPTO in trademark matters, TMEP §602.03 regarding papers filed by unauthorized persons, and TMEP §§712.01 *et seq.* regarding the proper person to sign a response to an Office action.

### **603.05 Correspondence with Parties Not Domiciled in the United States**

If an applicant, registrant or party to a proceeding before the USPTO has not clearly stated a preferred correspondence address, the USPTO will process correspondence as follows:

If an applicant, registrant or party to a proceeding before the USPTO has authorized a practitioner qualified to practice before the USPTO in trademark cases under 37 C.F.R. §10.14, the USPTO will send correspondence to that attorney only if: (1) the practitioner has a United States correspondence address, or (2) the practitioner resides in a foreign country but is qualified under 37 C.F.R. §10.14(c).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Currently, Canadian attorneys are the only foreign attorneys recognized as meeting the qualification criteria in 37 C.F.R. §10.14(c) (see TMEP §602).

If the applicant, registrant or party is not represented by an attorney qualified under 37 C.F.R. §10.14, and the applicant/registrant/party has appointed a domestic representative, the USPTO will send correspondence to the domestic representative, unless the applicant/registrant/party designates in writing another correspondence address. However, the domestic representative is not authorized to prosecute an application or represent a party in a proceeding before the USPTO, unless the domestic representative is a practitioner qualified under 37 C.F.R. §10.14 to practice before the USPTO in trademark cases. 37 C.F.R. §2.24. See TMEP §604 regarding domestic representatives.

If the applicant, registrant or party is not represented by a practitioner qualified under 37 C.F.R. §10.14, and the applicant/registrant/party does not designate a domestic representative, the USPTO will send correspondence directly to the applicant/registrant/party's foreign address, unless the applicant/registrant/party designates in writing another correspondence address.

See TMEP §603.01(a) regarding correspondence in §66(a) applications.

### **604                    Designation of Domestic Representative by Parties Not Domiciled in the United States**

An applicant, registrant, or party to a proceeding before the USPTO who is not domiciled in the United States may file a document designating the name and address of a domestic representative on whom may be served notices or process in proceedings affecting the mark. 15 U.S.C. §§1051(e), 1058(f), 1059(c), 1060(b), and 1141h(d). The USPTO encourages parties who do not reside in the United States to designate domestic representatives, but it is not mandatory. If the applicant, registrant, or party does not designate a domestic representative, the USPTO will not require a designation.

To expedite processing, the USPTO recommends that designations of domestic representative be filed through TEAS, at <http://www.uspto.gov/teas/index.html>. TEAS can also be used to revoke a designation of a domestic representative.

The designation is not the same as a power of attorney. The designation serves a different purpose, namely, to bring foreign applicants, registrants and parties under the jurisdiction of the United States legal system. The designation of a domestic representative does not authorize the person designated to prosecute the application or to represent a party in a proceeding before the USPTO. 37 C.F.R. §2.24. Similarly, a power of attorney does not serve as a designation of a domestic representative unless the power of attorney specifically states that the attorney is

## ATTORNEY OR REPRESENTATIVE

also the domestic representative on whom may be served notices or process in proceedings affecting the mark.

If a party designates a domestic representative, the designation should include the name and address of the person designated, and a clear statement that the party intends to designate this person as a domestic representative upon whom notices or process affecting the mark may be served. The designation must be in writing. A person who is properly authorized to sign a designation of domestic representative is:

- (1) A person with legal authority to bind the applicant or party; or
- (2) A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant or party; or
- (3) An attorney as defined in 37 C.F.R. §10.1(c) who has an actual written or verbal power of attorney or an implied power of attorney from the applicant or party.

TMEP §804.04. See TMEP §804.05 regarding signature of documents transmitted electronically.

The person designated as a domestic representative may be a natural person or a juristic person as defined in 15 U.S.C. §1127.

If an applicant, registrant or party to a proceeding before the USPTO does not file a document designating a domestic representative, or if the last person designated cannot be found at the address given in the designation, then notices or process in proceedings affecting the mark may be served on the Director. 15 U.S.C. §§1051(e), 1058(f), 1059(c), 1060(b), and 1141h(d).

See TMEP §603.05 regarding correspondence with parties who are not domiciled in the United States.

# Chapter 700

## Procedure for Examining Applications

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### **701 Statutory Authority for Examination**

### **702 Order of Work**

702.01 Order of Examination

702.02 “Special” Applications

702.03 Related Applications

702.03(a) Companion Applications

702.03(a)(i) Companion Applications for the Same or Similar Marks

702.03(a)(ii) Companion Applications for Different Marks

702.03(a)(iii) Companion Registrations

702.03(a)(iv) Classification and Identification in Companion Applications  
That Have Registered or Been Published for Opposition

702.03(b) Conflicting Applications

### **703 Office Does Not Issue Duplicate Registrations**

### **704 Initial Examination**

704.01 Initial Examination Should be Complete

704.02 Examining Attorney’s Search

704.03 Supervisory Examining Attorney May Indicate Action for Non-Signatory  
Examining Attorney

### **705 The Examining Attorney’s Letter or Action**

705.01 Language in Examining Attorney’s Letter

705.02 Examining Attorneys Should Not Volunteer Statements

705.03 Citation of Reference Marks

705.04 Reference to Matter in Printed Publications

705.05 Citation of Decisions and Office Publications

705.06 Reviewing and Signing of Letters

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

705.07 Processing Outgoing Office Actions

705.08 Six-Month Response Clause

### **706 New Matter Raised by Examining Attorney After First Action**

#### **707 Examiner's Amendment**

707.01 Approval of Examiner's Amendment by Applicant or Applicant's Attorney

707.02 Examiner's Amendment Without Prior Authorization by Applicant or Applicant's Attorney

707.03 Form of the Examiner's Amendment

#### **708 Priority Action**

708.01 Priority Action Defined

708.02 Discussion of Issues and Agreements

708.03 Form of the Priority Action

708.04 Refusal of Registration in Priority Action

708.05 Combined Examiner's Amendment/Priority Action

#### **709 Interviews**

709.01 How Interviews are Conducted

709.02 Persons Who May Represent Applicant in an Interview

709.03 Making Substance of Interview of Record

709.04 Telephone Communications

709.05 Informal Submissions

709.06 Interviews Prior to Filing Application

#### **710 Evidence**

710.01 Evidence Supporting Refusal or Requirement

710.01(a) Evidence From Research Database

710.01(b) Internet Evidence

710.01(c) Record Must Be Complete Prior to Appeal

710.02 Evidence Indicating No Refusal or Requirement Necessary

710.03 Evidence of Third-Party Registrations



## PROCEDURE FOR EXAMINING APPLICATIONS

### **711 Deadline for Response to Office Action**

711.01 Time May Run from Previous Action

711.02 Supplemental Office Action Resetting Response Period

### **712 Signature of Response to Office Action**

712.01 Persons Who Can Sign Response

712.01(a) Guidelines on Who Should Sign Response to Office Action

712.01(a)(i) Signature By Joint Applicants

712.01(a)(ii) Signature By Partnership

712.01(a)(iii) Signature By Joint Venture

712.01(a)(iv) Signature By Corporation

712.01(a)(v) Signature By Foreign Companies and Corporations

712.01(a)(vi) Signature By Unincorporated Association

712.01(a)(vii) Signature By Limited Liability Company

712.02 Unsigned Response

712.03 Response Signed by an Unauthorized Person

### **713 Examination of Amendments and Responses to Office Actions**

713.01 Previous Action by Different Examining Attorney

713.02 Noting All Outstanding Requirements

713.03 Response to Applicant's Arguments

### **714 Final Action**

714.01 Not Permissible on First Action

714.02 Not Permissible on Suspension

714.03 When Final Action is Appropriate

714.04 Form of the Final Action

714.05 Delineating New Issues Requiring Issuance of Nonfinal Action

714.05(a) Unacceptable Amendment Proposed By Applicant

714.05(a)(i) Amendment to Supplemental Register or Submission of Claim of Acquired Distinctiveness

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

714.05(a)(ii) Amendment of Identification of Goods and Services

714.05(b) Section 2(d) Refusal Based on Prior-Filed Application That Has Matured Into Registration

714.05(c) Advisory Statement Cannot Serve as Foundation for Final Refusal or Requirement

714.06 Applicant's Recourse When Final Action is Premature

### **715 Action After Issuance of Final Action**

715.01 Proper Response to Final Action

715.02 Action After Final Action

715.03 Request for Reconsideration After Final Action

715.03(a) Examining Attorney's Action After Request for Reconsideration

715.03(b) Examining Attorney Must Issue New Nonfinal Action If New Issue Presented in Request for Reconsideration

715.03(c) Time for Appeal Runs from Mailing Date of Final Action if No New Issue Is Presented and Requirement(s) or Refusal(s) Is Not Withdrawn

715.04 Request for Reconsideration Filed In Conjunction With Notice of Appeal

### **716 Suspension of Action by Office**

716.01 Form of Suspension Notice

716.02 Circumstances Under Which Action May Be Suspended

716.02(a) Applicant's Petition to Cancel Cited Registration

716.02(b) Submission of Copy of Foreign Registration in §44(d) Application

716.02(c) Conflicting Marks in Pending Applications

716.02(d) *Inter Partes* or Court Proceeding

716.02(e) Suspension Pending Cancellation or Expiration of Cited Registration

716.03 Applicant's Request to Remove Application from Suspension

716.04 Suspended Docket Checked by Examining Attorney

716.05 Inquiry by Examining Attorney Regarding Suspended Application

716.06 Suspension After Final Action

### **717 Remailing of Office Action**

717.01 Returned Office Action

## PROCEDURE FOR EXAMINING APPLICATIONS

717.02 Non-Receipt of Office Action

### **718 Abandonment**

718.01 Express Abandonment by Applicant or Applicant's Attorney

718.02 Failure by Applicant to Take Required Action During Statutory Period

718.02(a) Partial Abandonment

718.03 Incomplete Response

718.03(a) Holding of Abandonment for Failure to Respond Completely

718.03(b) Granting Additional Time to Perfect Response

718.03(c) Reconsideration of Holding of Abandonment

718.04 Failure to File Statement of Use

718.05 Failure to Perfect Appeal

718.06 Notice by Office of Abandonment for Failure to Receive a Response

718.07 Ordering Abandoned Application Files

718.08 Revival or Reinstatement of Abandoned Application - New Search Required

### **719 Non-Responsive Communications**

### **720 Fraud Upon the Office**

### **701 Statutory Authority for Examination**

*Extract from 15 U.S.C. §1062.*

*(a) Upon the filing of an application for registration and payment of the prescribed fee, the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made....*

*(b) If the applicant is found not entitled to registration, the examiner shall advise the applicant thereof and of the reason therefor. The applicant shall have a period of six months in which to reply or amend his application, which shall then be reexamined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of six months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, whereupon such time may be extended.*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 702 Order of Work

#### 702.01 Order of Examination

In general, examining attorneys should examine applications in the order in which they are received in the United States Patent and Trademark Office (“USPTO”), unless the application is made “special.” See TMEP §702.02 regarding “special” applications.

Generally, amended applications (*i.e.*, applications that contain a response from the applicant), remands from the Trademark Trial and Appeal Board, and statements of use are also reviewed in the order in which they are received in the USPTO.

Examining attorneys should act on applications that have been suspended as soon as they are removed from suspension. See TMEP §§716 *et seq.* regarding suspension.

Examining attorneys should immediately act on inquiries regarding applications approved for publication or issue that are returned to the examining attorney to take action or provide information.

Where appropriate, the managing attorney may direct that a particular case be given special handling.

When an examining attorney resigns, the examining attorney should spend his or her remaining time in the Office acting on older cases or those with involved records, and in getting his or her amended cases (including statements of use under 15 U.S.C. §1051(d) and appeal briefs) ready for final disposition.

#### 702.02 “Special” Applications

While the USPTO normally processes applications in the order in which they are received, there is a procedure whereby an application can be made “special,” and thereby expedited. The following applications are deemed “special” and should be expedited.

- (1) *Petition to Make Special Granted.* Applications made “special” as a result of a petition under 37 C.F.R. §2.146 (see TMEP §§1710 *et seq.*);
- (2) *Registration Inadvertently Cancelled Under 15 U.S.C. §1058 or §1059.* A new application for registration of a mark that was the subject of a previous registration that was inadvertently cancelled or expired under 15 U.S.C. §1058 or §1059 will be made “special” upon the applicant’s request. No petition fee is required in this situation. However, *both the mark and the goods or services in the new application must be identical to the mark and goods or services in the cancelled or expired registration*, or the USPTO will not make the application “special.” To ensure that these applications are processed as “special,” the applicant should include a cover letter

## PROCEDURE FOR EXAMINING APPLICATIONS

requesting that the application be made “special,” together with a copy of the cancelled or expired registration, when filing the application; and

- (3) *Revived or Reinstated Applications.* Applications that have been abandoned and then revived or reinstated are made “special.” See TMEP §1712.01 regarding requests for reinstatement, and TMEP §§1714 *et seq.* regarding petitions to revive. The applicant does not have to file a separate petition to make “special” in these situations.

The examining attorney should promptly examine any application that has been made “special.”

Once an application is made “special,” the USPTO will expedite initial examination, examination of responses and amendments, and appeal. However, the USPTO cannot change the publication and issuance cycles. Therefore, “special” status terminates when the date of publication in the *Official Gazette* is assigned to the application.

### **702.03 Related Applications**

#### **702.03(a) Companion Applications**

The term “companion applications” refers to pending applications filed by the same applicant. An application is pending until it registers or abandons. Pending applications include applications that have been approved for publication or for registration on the Supplemental Register, applications in the Intent-to-Use (“ITU”) Unit of the Office, and revived or reinstated applications.

When assigned a new application, the examining attorney must search the USPTO’s automated records to determine whether the applicant has any companion applications. If the applicant has companion applications, the examining attorney must follow the procedures set forth in TMEP §§702.03(a)(i) through (a)(iv).

#### **702.03(a)(i) Companion Applications for the Same or Similar Marks**

If an applicant has multiple pending applications for the same or similar mark(s), the issues in the applications are likely to be similar.

The examining attorney must check the Trademark Reporting and Monitoring (“TRAM”) automated system to determine whether a companion application has been assigned to an examining attorney. If TRAM indicates that the companion application has not been assigned, the examining attorney is encouraged to obtain and examine the unassigned file.

If TRAM indicates that a companion application was previously assigned to a different examining attorney, the examining attorney should **not** transfer his or her application to that person. However, the examining attorney should review the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

electronic record of the earlier companion application before taking action in a later companion case, and should act consistently, unless it would be clear error to do so. If the examining attorney believes that acting consistently with the prior action(s) would be erroneous, he or she should bring the issue to the attention of the managing attorney or senior attorney.

See TMEP §702.03(a)(iv) regarding classification and identification in companion applications that have been published for opposition.

### **702.03(a)(ii) Companion Applications for Different Marks**

If an applicant has multiple pending applications, but the companion applications are not for the same or similar marks, examining attorneys should *not* transfer the companion cases to one examining attorney. However, examining attorneys should act consistently in companion cases, unless it would be clear error to do so. If necessary, the examining attorney should review the electronic record of the earlier companion application before taking action in a later companion case.

See TMEP §702.03(a)(iv) regarding classification and identification in companion applications that have been published for opposition.

### **702.03(a)(iii) Companion Registrations**

If the applicant previously filed another application that has matured into a registration, the examining attorney should *not* transfer his or her application to the prior examining attorney. Generally, in the later application, the examining attorney should act consistently with the registration, unless it would be clear error to do so. However, the USPTO is not bound by the decisions of the examiners who examined the applications for the applicant's previously registered marks, based on different records. Eligibility for registration must be determined on the basis of the facts that exist at the time registration is sought. See TMEP §1216.01 and cases cited therein.

See TMEP §702.03(a)(iv) regarding classification and identification in companion registrations.

### **702.03(a)(iv) Classification and Identification in Companion Applications That Have Registered or Been Published for Opposition**

If a companion application has been published for opposition or has registered, the examining attorney may presume that the classification and identification of goods or services in the companion application or registration are acceptable, unless the identification or classification is clearly wrong. If the examining attorney accepts the classification and identification of goods or services because they were accepted in a companion application or registration, the examining attorney should note the companion application serial number or registration number in the "Notes to the File" section of the record.

## PROCEDURE FOR EXAMINING APPLICATIONS

Sometimes the classification and identification of goods or services in the prior companion application or registration will be clearly wrong. For example, the Nice Agreement classification system (see TMEP §§1401.02 *et seq.*) and Office policy on acceptable identifications change periodically. In these cases, the examining attorney cannot adopt the classification and identification listed in the companion application or registration. See TMEP §1402.14.

### **702.03(b) Conflicting Applications**

The term “conflicting applications” refers to two or more pending applications that are filed by different applicants and may ultimately require a refusal of registration under §2(d) of the Trademark Act, 15 U.S.C. §1052(d), due to a likelihood of confusion between the marks. When assigned a new application, the examining attorney must search the USPTO’s automated records to determine whether there are any conflicting applications. If there are conflicting applications, the examining attorney should **not** transfer the conflicting application to the examining attorney who acted on the first conflicting application. Instead, the examining attorney should simply examine the assigned application and issue an Office action that includes a notice to the applicant that there is a prior-filed application to register a mark that may be likely to cause confusion with the applicant’s mark. See TMEP §§1208 *et seq.* The actions of the examining attorney handling the later-filed application should be consistent with the actions of the examining attorney who handled the earlier-filed application, unless it would be clear error to act consistently. If necessary, the examining attorney should review the electronic record of the earlier-filed application before taking an action in the later-filed conflicting application.

### **703 Office Does Not Issue Duplicate Registrations**

The USPTO will not issue two or more identical registrations. Applications filed under §1 of the Trademark Act are considered identical if the only difference between them is that one is based on use in commerce under §1(a) and the other is based on intent-to-use under §1(b). However, an application filed under §1 and an application filed under §44 that are otherwise identical are *not* regarded as duplicate registrations, nor is an application under §66(a) of the Trademark Act regarded as a duplicate of an application filed under §1 or §44.

If two applications would result in registrations that are exact duplicates, the USPTO will permit only one application to mature into registration, and will refuse registration in the other application. If practicable, the USPTO will permit the applicant to choose which application should mature into registration.

When an application is a duplicate of a registration owned by the applicant, and USPTO records show that the registration is still active, the examining attorney must refuse registration. If the registration is subject to cancellation for failure to file an affidavit of continued use or excusable nonuse under 15 U.S.C. §1058, or due to

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

expire for failure to file a renewal application under 15 U.S.C. §1059, the examining attorney should suspend the application until the TRAM system is updated to show that the registration is cancelled or expired. See TMEP §1611 for information about how a registrant who has not timely filed a §8 affidavit or §9 renewal application may expedite the cancellation or expiration of its own registration.

A standard character drawing and a special form drawing of the same mark are not considered identical. Also, identifications that include some of the same goods or services but also different goods or services are not identical.

A mark in which the drawing is lined for color is considered a duplicate of a color drawing of the mark, if the colors are identical. If the applicant claims different shades of a color, the marks are not duplicates. See TMEP §§807.07 *et seq.* regarding color drawings.

If eligible, marks registered under the Acts of 1881, 1905 and 1920 may also be registered under the Act of 1946 (see §46(b) of the Trademark Act of 1946). If the mark and the goods or services in a registration issued under the 1946 Act are identical to the mark and goods or services in a registration issued under a prior Act, the registrations are not considered duplicates. See TMEP §§1601.04, 1601.05, 1602.02 and 1602.03 regarding registrations issued under prior Acts.

### **704 Initial Examination**

#### **704.01 Initial Examination Should be Complete**

*37 C.F.R. §2.61(a). Applications for registration, including amendments to allege use under §1(c) of the Act, and statements of use under §1(d) of the Act, will be examined and, if the applicant is found not entitled to registration for any reason, applicant will be notified and advised of the reasons therefor and of any formal requirements or objections.*

The initial examination of an application by the examining attorney should be a *complete* examination. A complete examination includes a search for conflicting marks and an examination of the written application, the drawing and any specimen(s), to determine whether the mark is eligible for the type of registration requested, whether amendment is necessary, and whether all required fees have been paid.

If, on initial examination, the examining attorney finds the mark in an application for registration on the Principal Register to be in condition for publication for opposition, the examining attorney will not issue an Office action. The examining attorney will approve the application for publication. Similarly, if the examining attorney finds the mark in an application for registration on the Supplemental Register to be in condition for registration, the examining attorney will approve the application for



## PROCEDURE FOR EXAMINING APPLICATIONS

registration. The Publication and Issue Section of the Office will send a notice of publication or certificate of registration to the applicant, in due course.

If the application is not in condition to be approved for publication or issue, the examining attorney will write, call or e-mail the applicant, informing the applicant of the reason(s) why the mark may not be registered and of the defect(s) that can be corrected or amended to make the application acceptable.

The examining attorney's first Office action should be complete, so the applicant will be advised of all requirements for amendment and all grounds for refusal, with the exception of use-related issues that are considered for the first time in the examination of an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d) in an intent-to-use application. See TMEP §§1102.01 and 1202 *et seq.* regarding use-related issues that are considered for the first time in the examination of an amendment to allege use or a statement of use. Every effort should be made to avoid piecemeal prosecution, because it prolongs the time needed to dispose of an application. See *also* TMEP §706 regarding new issues raised by the examining attorney after the first Office action.

Examining attorneys should also clearly explain all requirements. For example, if the identification of goods or services is indefinite, the examining attorney should explain to the applicant why the identification is not acceptable and, if possible, suggest an acceptable identification. See TMEP §§705 *et seq.* for further information about examining attorneys' Office actions.

### **704.02            Examining Attorney's Search**

If the examining attorney finds no conflicting marks, but must write to the applicant about other matters, the examining attorney must inform the applicant that no conflicting marks have been found. This is commonly called the "search clause."

If the examining attorney cannot make a proper search or cannot examine the application properly due to lack of adequate information, the examining attorney should specifically indicate what information is needed, request that it be furnished, and state that further action on the matter will be taken as soon as the information is received. See TMEP §814 regarding requirements for additional information.

### **704.03            Supervisory Examining Attorney May Indicate Action for Non-Signatory Examining Attorney**

When a non-signatory examining attorney examines an application, a supervisory examining attorney must thoroughly review the action. The usual procedure is for the non-signatory examining attorney to explain relevant information to the supervisory examining attorney, discussing any reference marks or other grounds for refusal, and any requirements or objections. The supervisory examining attorney may indicate the action to be taken.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 705 The Examining Attorney's Letter or Action

If an examining attorney determines that a mark is not entitled to registration, or that amendment is required, the examining attorney will notify the applicant in a written Office action, or by a telephone conversation that is normally followed by a written action. This constitutes the examining attorney's official action.

Written Office actions may be of a variety of styles, including: (1) an "examiner's amendment," in which the examining attorney formally makes amendments to the application (see TMEP §§707 *et seq.*); (2) a "priority action," setting forth requirements and/or reasons for refusal discussed by telephone with the applicant or the applicant's attorney (see TMEP §§708 *et seq.*); (3) a letter explaining bases for refusal and requirements; (4) an examiner's amendment combined with a priority action (see TMEP §708.05); or (5) a suspension notice (see TMEP §§716 *et seq.*). Office actions may be prepared through the use of standardized form paragraphs, or written specifically to address the particular facts. The examining attorney may send the Office action by regular mail, fax, or by e-mail, if the applicant has authorized e-mail communications. See TMEP §§304 *et seq.* regarding e-mail.

The USPTO encourages the use of examiner's amendments and priority actions, whenever appropriate.

#### 705.01 Language in Examining Attorney's Letter

The examining attorney should indicate the status of the application at the beginning of each letter.

In first actions, this may be done by stating that the examining attorney has reviewed the application and made the determinations that follow, or by using language such as "Upon examination of this application..." The examining attorney should acknowledge any document received before the first action by identifying the document and the date of its receipt.

In second or subsequent actions, examining attorneys should begin letters with a sentence such as, "This letter responds to the communication filed on [date]." Other papers received, such as supplemental amendments, affidavits, and new drawings, should also be acknowledged.

Refusals to register should be couched in the statutory language of the section of the Trademark Act that is the basis of the refusal, and the examining attorney should cite the appropriate section of the Act. For example, registration of a trademark should not be refused "because it is a surname," but "because it *consists of matter that is primarily merely a surname under §2(e)(4) of the Trademark Act.*"

Registration must be refused only as to the specific register (*i.e.*, Principal or Supplemental) for which registration is requested. However, when refusing registration on the Principal Register, the examining attorney should also state, to

## PROCEDURE FOR EXAMINING APPLICATIONS

the extent possible, whether the record indicates that an amendment to the Supplemental Register or to seek registration on the Principal Register under §2(f) may be appropriate.

The words “capable” and “incapable” should be reserved for the Supplemental Register.

Examining attorneys are encouraged to use form paragraphs to accelerate the preparation of Office actions and increase the uniformity of the substance and appearance of these actions. However, examining attorneys should use the form paragraphs only if they apply to a particular situation, and should expand on the form paragraphs when necessary to explain any requirements or refusals.

### **705.02 Examining Attorneys Should Not Volunteer Statements**

In Office actions, and e-mail and telephone communications, examining attorneys should not volunteer statements about applicants’ rights that are gratuitous and unnecessary to the examination of the matters presented in applications. The examining attorney’s responsibility is limited to evaluating the registrability of the mark presented in the application. See *In re American Physical Fitness Research Institute Inc.*, 181 USPQ 127 (TTAB 1974). See also TMEP §1801.

### **705.03 Citation of Reference Marks**

When refusing registration under 15 U.S.C. §1052(d) based on a likelihood of confusion with a previously registered mark, the examining attorney must give the registration number(s), attach a copy (or electronic equivalent) of each cited registration to the Office action, and place a copy of the cited registration in the record. The examining attorney should explain the reasons that the mark in each cited registration is grounds for refusal under §2(d).

If an applicant notifies the USPTO that the USPTO failed to attach a copy (or electronic equivalent) of a cited registration, the USPTO will remail the Office action with a new mailing date.

### **705.04 Reference to Matter in Printed Publications**

When the examining attorney refers to matter in a printed publication, the examining attorney should provide the citation for the publication, and include a copy of the relevant material with the Office action.

It is not necessary to send a photocopy of a published legal decision to an applicant. A citation is sufficient. See TMEP §705.05 regarding citation of decisions.

See TMEP §710.01(a) regarding evidence from a research data base.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 705.05 Citation of Decisions and Office Publications

When citing court or administrative decisions, the *United States Patents Quarterly* (USPQ or USPQ2d) citation should be given. If convenient, a parallel citation to the United States Reports (U.S.), Federal Reporter (F., F.2d, or F.3d) or Federal Supplement (F. Supp. or F. Supp.2d) should also be given. The court or tribunal (2d Cir., C.C.P.A., Fed. Cir., TTAB, etc.) and the date of the decision should always be given.

The examining attorney may cite sections of the *Trademark Manual of Examining Procedure* ("TMEP") or *Trademark Trial and Appeal Board Manual of Procedure* ("TBMP"). The abbreviations "TMEP" and "TBMP" are usually sufficient; however, if the person prosecuting the case appears to be unfamiliar with Office practice, the examining attorney should identify the Manuals by their full names in the first citation to the Manuals. It is not necessary to provide a copy of the relevant section(s) of the Manuals.

When the examining attorney cites a Director's order or notice, the examining attorney should provide the title and date of the notice, and the specific issue of the *Official Gazette* in which it may be found.

Unpublished decisions that are not available to the public should not be cited. Regarding citation of "unpublished" or "digest" decisions, the Trademark Trial and Appeal Board has stated as follows:

Upon reflection the Board has decided that citation of "unpublished" or "digest" Board decisions as precedent will no longer be allowed. In the future, the Board will disregard citation as precedent of any unpublished or digest decision. Even if a complete copy of the unpublished or digest decision is submitted, the Board will disregard citation as precedent thereof. An exception exists, of course, for those situations in which a party is asserting issues of claim preclusion, issue preclusion, judicial estoppel, law of the case or the like based on a decision of the Board rendered in a nonprecedential (*i.e.*, unpublished or digest) decision.

*General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1275 n.9 (TTAB 1992).

This policy applies to both *ex parte* and *inter partes* cases. Accordingly, examining attorneys should not cite unpublished or digest decisions as precedent in Office actions or appeal briefs, and should not send informational copies of unpublished decisions with Office actions.

### 705.06 Reviewing and Signing of Letters

The name, law office, telephone number, and e-mail address of the examining attorney who prepares the action will appear at the bottom of the action.

## PROCEDURE FOR EXAMINING APPLICATIONS

The examining attorney must review and sign the action. If the examining attorney does not have signatory authority, he or she should sign the action and refer it to the authorized signatory examining attorney, who will review and approve the action. Review by a reviewer should ordinarily be done within one working day after receipt from the non-signatory examining attorney.

### **705.07 Processing Outgoing Office Actions**

The date is placed on all copies of paper Office actions when they are being mailed. For outgoing e-mail communications, the date is applied automatically when the communication is released to the USPTO's electronic mail system.

The original action signed by the authorized examining attorney is placed in the record. One copy (or electronic equivalent) of any evidence that supports the examining attorney's action, and one copy of registered marks or pending applications cited as a bar to registration, should be placed in the record, and one copy should be sent to the applicant with the action.

### **705.08 Six-Month Response Clause**

Generally, the examining attorney's letter or Office action should include a "six-month response clause" notifying the applicant that the applicant must respond to the action within six months of the mailing date to avoid abandonment under 15 U.S.C. §1062(b). See TMEP §711 *et seq.* regarding the deadline for response to an Office action.

The examining attorney should *not* include a six-month response clause in an examiner's amendment (see TMEP §§707 *et seq.*), suspension notice (see TMEP §§716 *et seq.*), or in a situation where the time for response runs from the mailing date of a previous action (see TMEP §§711.01 and 715.03(c)).

### **706 New Matter Raised by Examining Attorney After First Action**

If in the first Office action the examining attorney inadvertently failed to refuse registration on a clearly applicable ground or to make a necessary requirement, the examining attorney must take appropriate action to correct the inadvertent error in a subsequent action. Examining attorneys should exercise great care to avoid these situations, and should take this step only when absolutely necessary. After the first action, supervisors (*e.g.*, supervisors reviewing the quality of the examining attorney's work) should not introduce any new reason for refusal that is not clearly justified under the Act or rules.

Since it is unusual to make a new refusal or requirement that could have been raised in the first action, an examining attorney who does make a new refusal or requirement should clearly explain why the refusal or requirement is necessary, and

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

apologize for the delay in raising the issue, if appropriate. See TMEP §711.02 regarding supplemental Office actions.

Sometimes the examining attorney must issue a new refusal or requirement because the applicant submits information that raises a new issue.

In a §66(a) application, the examining attorney cannot issue a new refusal more than 18 months after the date on which the IB forwards the request for extension of protection to the USPTO. See TMEP 1904.03(a).

See TMEP §1109.08 regarding application of the “clear-error” standard in the examination of statements of use under §1(d) of the Act.

### **707 Examiner’s Amendment**

An examiner’s amendment should be used whenever appropriate to expedite prosecution of an application. The examiner’s amendment is a communication to the applicant in which the examining attorney states that the application has been amended in a specified way. Except in the situations listed in TMEP §707.02, the amendment must be authorized by the applicant or the applicant’s attorney. Authorization is usually given in a telephone conversation, e-mail communication (if the applicant has authorized e-mail communications), or interview between the examining attorney and the applicant or the applicant’s attorney. See TMEP §§304 *et seq.* regarding e-mail.

The examining attorney may issue an examiner’s amendment whenever the required amendment does not have to be verified by the applicant. For example, in appropriate circumstances, an examiner’s amendment may be used to amend the identification of goods or services, enter a disclaimer, add the state of incorporation or change from the Principal to the Supplemental Register.

The following matters may **not** be changed by examiner’s amendment: the dates of use, if verification would be required (see TMEP §903.05); the mark on a special form drawing (see TMEP §807.04), if the changes would require the filing of a substitute special form drawing; and amendments that require the submission of substitute specimen(s) (see TMEP §904.09). An application cannot be expressly abandoned (see TMEP §718.01) by examiner’s amendment.

Examiner’s amendments are generally used when there are no statutory refusals. However, if there is a potential statutory refusal, and an amendment will obviate the refusal, the examining attorney may attempt to resolve the issues through an examiner’s amendment. For example, in appropriate cases, the applicant may overcome a surname refusal of a mark that is in use in commerce by amending the application to the Supplemental Register.

## PROCEDURE FOR EXAMINING APPLICATIONS

A non-signatory examining attorney must have proper authorization from the managing attorney, senior attorney, or a reviewing examining attorney before initiating an examiner's amendment.

See TMEP §707.03 regarding the form of an examiner's amendment.

A written response by the applicant is not required for an examiner's amendment. Applicants should **not** file correspondence confirming an examiner's amendment, because this will delay processing of the application.

If the applicant wishes to object to the examiner's amendment, this should be done immediately (preferably by phone, e-mail or fax), so that the objection can be considered before publication or issue. See TMEP §1402.07(e) regarding an applicant's objection to an examiner's amendment of the identification of goods or services on the ground that the examiner's amendment does not reflect the agreement between the applicant and the examining attorney.

Often an applicant will seek to respond to an outstanding Office action with an amendment or other response by telephone. The examining attorney is encouraged to enter an examiner's amendment if this amendment will immediately place the application in condition for publication for opposition, issuance of a registration, or suspension. See TMEP §§716 *et seq.* regarding suspension. However, an applicant or an applicant's attorney does not have a right to the entry of an examiner's amendment in response to an Office action. If the applicant does not agree to an amendment that the examining attorney believes will immediately place the application in condition for publication for opposition or issuance of a registration, the applicant must file a complete written response to the outstanding Office action.

See TMEP §708.05 regarding combined examiner's amendment/priority actions.

*NOTE:* In a §66(a) application, an examiner's amendment may *not* be issued on a first action, because the International Bureau of the World Intellectual Property Organization ("IB") will not accept such amendments. Examiner's amendments may be issued on second and subsequent actions. See TMEP §1904.02(e) regarding Office actions in §66(a) applications.

### **707.01            Approval of Examiner's Amendment by Applicant or Applicant's Attorney**

Ordinarily, the examining attorney may amend the application by examiner's amendment only after securing approval of the amendment from the applicant or the applicant's attorney by telephone or e-mail, or in person during an interview. See TMEP §707.02 regarding situations when an examiner's amendment is permitted without prior authorization by the applicant or the applicant's attorney.

The broad definition of "persons properly authorized to sign on behalf of an applicant" in 37 C.F.R. §2.33(a) (see TMEP §804.04) does not apply to examiner's

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

amendments. Only the applicant or the applicant's attorney can authorize an examiner's amendment. If the applicant has an attorney, the examining attorney must speak to the attorney of record. If the applicant is *pro se*, the examining attorney must speak to the individual applicant or to someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership). 37 C.F.R. §10.14(e). For joint applicants who are not represented by an attorney, each joint applicant must authorize the examiner's amendment.

A non-attorney who is authorized to verify facts on behalf of an applicant under 37 C.F.R. §2.33(a)(2) is *not* entitled to authorize an examiner's amendment unless he or she has legal authority to bind the applicant. See TMEP §§712.01 *et seq.* for guidelines on persons who have legal authority to bind various types of applicants.

If an examining attorney contacts an applicant and reaches agreement to issue an examiner's amendment, but later determines that an Office action must be issued instead to state a refusal or requirement, the examining attorney should telephone the applicant immediately to advise the applicant of the change of position.

Examining attorneys without partial signatory authority should generally advise applicants that issuance of the examiner's amendment is subject to approval by a supervisory attorney.

### **707.02                    Examiner's Amendment Without Prior Authorization by Applicant or Applicant's Attorney**

Examining attorneys have the discretion to amend applications by examiner's amendment without prior approval by the applicant or the applicant's attorney, in the following situations:

- (1) changes to international classification, either before or after publication (see *Groening v. Missouri Botanical Garden*, 59 USPQ2d 1601 (Comm'r Pats. 1999) regarding amendments to international classification after publication);
- (2) deletion of "TM," "SM," "©" or "®" from the drawing;
- (3) addition of a formal description of the mark where it is necessary (see TMEP §§808 *et seq.*) and where the record already contains an informal indication of what the mark comprises;

*Example* - The cover letter accompanying the application refers to the mark as a stylized golf ball design. If appropriate, the examining attorney could enter an amendment that "the mark consists of the stylized design of a golf ball."

- (4) amendment of the application to enter a standard character claim, when the record clearly indicates that the drawing is intended to be in standard character form (see TMEP §§807.03(a) and 807.03(g));



## PROCEDURE FOR EXAMINING APPLICATIONS

- (5) addition of lining and stippling statements, where the statement is necessary (see TMEP §808.01(d)), and where the significance of the lining or stippling is indicated by the specimen or other information of record;
- (6) correction of obvious misspellings in the identification of goods and services.

*Example* - The goods are recited as “T-shurtz.” The examining attorney could amend to “T-shirts.” However, “shirtz” could not be amended to “shirts” without calling the applicant, because “shirtz” (without the “T-” prefix) might also be a misspelling of “shorts.”

- (7) When an applicant fails to respond to a requirement to amend some terminology in an otherwise acceptable identification of goods/services, the examining attorney may issue an examiner’s amendment deleting the unacceptable terminology from the identification. See TMEP §§718.02(a) and 1402.13.

If the examining attorney must contact the applicant or the applicant’s attorney about other matters, or if the record contains any ambiguity as to the applicant’s intent, the examining attorney should advise the applicant that the above changes have been made.

A copy of the examiner’s amendment will be sent to the applicant or applicant’s attorney. Any applicant or applicant’s attorney who disagrees with any of these changes should contact the examining attorney immediately after receipt of the examiner’s amendment, preferably by phone, e-mail or fax.

### **707.03 Form of the Examiner’s Amendment**

An examiner’s amendment should include the following information: the name, telephone number and e-mail address of the examining attorney; the name of the person interviewed; the date of the interview; the actual amendment; and, if applicable, a statement to the effect that the amendment has been authorized by the applicant or the applicant’s attorney.

The examiner’s amendment should not include a six-month response clause, because a written response by the applicant is not required for an examiner’s amendment.

The examiner’s amendment should include a search clause (see TMEP §704.02) if it is a first action or if the applicant has not previously been advised of the results of a search.

The examining attorney should not state in the examiner’s amendment that the application is ready for publication or issue, because some unforeseen circumstance might require that further action be taken in the application.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 708 Priority Action

#### 708.01 Priority Action Defined

A “priority action” is an Office action that is issued following a telephone interview, personal interview, or e-mail communication in which the examining attorney and the applicant or applicant’s attorney discuss the various issues raised in an application, and the applicant agrees to take some action that will place the application in condition for publication or registration. The use of priority actions is encouraged to expedite examination.

A priority action should be issued according to the following procedure: (1) the examining attorney telephones or e-mails the applicant or applicant’s attorney, and requests that the applicant take some specific action, explaining the reasons; (2) the applicant or applicant’s attorney agrees to take the action; (3) the examining attorney prepares and signs a priority action indicating the requirements with which the applicant should comply; and (4) the Office sends a copy of the priority action to the applicant or applicant’s attorney.

If an applicant responds within two months of the mailing date of the priority action, the examining attorney will expedite examination of the response. If the applicant does not respond within two months, the applicant must still file a proper response within six months of the mailing date of the priority action to avoid abandonment. 15 U.S.C. §1062(b).

A priority action is sometimes appropriate where there is a potential statutory refusal, if the examining attorney believes that an amendment or explanation will obviate the refusal. See TMEP §708.04.

See TMEP §708.03 regarding the form of a priority action.

#### 708.02 Discussion of Issues and Agreements

The examining attorney must discuss the issues with the individual applicant, the applicant’s attorney, or a person with legal authority to bind a juristic applicant. The broad definition of “persons properly authorized to sign on behalf of an applicant” in 37 C.F.R. §2.33(a) (see TMEP §804.04) does not apply to priority actions. Priority actions are governed by 37 C.F.R. §10.14(e). Only the applicant or the applicant’s attorney can agree to a priority action. If the applicant has an attorney, the examining attorney must speak to the attorney of record. If the applicant is *pro se*, the examining attorney must speak to the individual applicant or to someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership). A non-attorney who is authorized to verify facts on behalf of an applicant under 37 C.F.R. §2.33(a)(2) is *not* entitled to authorize a priority action unless he or she has legal authority to bind the applicant. See TMEP §§712.01 *et seq.* for guidelines on persons who have legal authority to bind various types of applicants.

## PROCEDURE FOR EXAMINING APPLICATIONS

During the telephone conversation or other communication with the applicant or the applicant's attorney, the examining attorney should fully discuss all issues and requirements relating to the application, and should explain the reason for each requirement. The examining attorney should suggest appropriate language for amendments, where appropriate.

A priority action is *not* appropriate when the examining attorney leaves a voice mail or e-mail message for the applicant or the applicant's attorney, but the applicant or attorney does not call back or respond.

An agreement as to precisely how all issues will be resolved is not necessary. For example, the priority action may state that "the applicant will submit an acceptable identification of goods that specifies the common commercial names of the 'computer equipment.'" It is not necessary that there be an agreement that "the applicant will amend the identification of goods to read: computer keyboards, computer monitors and computer printers."

The priority action may state that the applicant will follow one of two alternative courses of action, for example, providing either an amended drawing or a new specimen.

### **708.03 Form of the Priority Action**

The priority action should reference the date of the telephone call, e-mail message or other communication, and the name and title (where appropriate) of the person who authorized the priority action. See TMEP §708.02 for information about who is authorized to agree to a priority action.

The priority action should also discuss all refusals and requirements, and reference all agreements reached during the communication between the examining attorney and the applicant. See TMEP §708.02 regarding agreements.

The examining attorney should discuss each issue separately, stating the reason for the requirement and/or citing the relevant sections of the statute, rules, and/or TMEP. In view of the initial discussion between the examining attorney and the applicant or applicant's attorney, the explanation of a requirement may be more abbreviated in a priority action than in a regular Office action. However, the essential nature of the requirement must be clearly stated in the priority action, because the action of the USPTO is based exclusively on the written record. 37 C.F.R. §2.191.

A priority action must include a six-month response clause (see TMEP §705.08) so that it is clear that the applicant must timely respond to the issues raised in the priority action to avoid abandonment of the application.

The priority action should include a search clause (see TMEP §704.02) if it is a first action, or if the applicant has not previously been advised of the results of a search.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

A priority action may be used for a final or nonfinal refusal or requirement. See TMEP §708.04 regarding refusal of registration in a priority action, and TMEP §§714 *et seq.* regarding final actions.

### **708.04 Refusal of Registration in Priority Action**

Priority actions are generally used when there are no statutory refusals. However, if there is a potential statutory refusal, and the examining attorney believes that an amendment or explanation will obviate the refusal, the examining attorney may attempt to resolve the issues through a priority action. An example would be a surname refusal where it is evident that the mark has been used in commerce for more than five years, and thus the refusal could be overcome by the submission of a claim of acquired distinctiveness under §2(f) of the Trademark Act. See TMEP §§1212 *et seq.* regarding §2(f).

When the applicant agrees to submit evidence to overcome a statutory refusal, the examining attorney should issue the refusal in the priority action, stating the basis for the refusal, citing the relevant sections of the statute and rules, and indicating the resolutions agreed upon.

If the priority action includes a final refusal, the priority action must clearly indicate that the refusal is FINAL, and should contain the supporting evidence necessary for a complete record on appeal. See TMEP §§714 *et seq.* regarding final actions.

### **708.05 Combined Examiner's Amendment/Priority Action**

An examining attorney may issue an Office action that combines an examiner's amendment and priority action. The action must include a six-month response clause (see TMEP §705.08) so that it is clear that the applicant must timely respond to the issues raised in the priority action to avoid abandonment of the application. The action must also include the subheadings "Priority Action" and "Examiner's Amendment" to facilitate processing in the law office. The action should be reported in the USPTO's automated TRAM system as a priority action.

### **709 Interviews**

A discussion between the applicant or applicant's attorney and the examining attorney in which the applicant presents matters for the examining attorney's consideration is considered an interview. An interview can be conducted in person, by telephone, or by e-mail (if the applicant has authorized e-mail communications). See TMEP §§304 *et seq.* regarding e-mail.

The application will not normally be processed out of turn as a result of the interview, and the interview does not extend the deadline for response to an outstanding Office action.

## PROCEDURE FOR EXAMINING APPLICATIONS

The examining attorney may not discuss *inter partes* questions with any of the interested parties. See TMEP §1801.

### **709.01 How Interviews are Conducted**

Personal interviews with examining attorneys concerning applications and other matters pending before the USPTO are permissible on any working day and must be in the office of the respective examining attorney, within office hours that the examining attorney may designate.

Personal interviews should be arranged in advance, preferably by fax, e-mail or telephone. This will ensure that the assigned examining attorney will be available for the interview at the scheduled time and will have an opportunity to review the application and be familiar with it. The unexpected appearance of an attorney or applicant requesting an interview without any previous notice to the examining attorney is not appropriate.

An interview should be conducted only when it could serve to develop and clarify specific issues and lead to a mutual understanding between the examining attorney and the applicant. Interviews should not extend beyond a reasonable time.

The examining attorney should not hesitate to state that matter presented for consideration during the interview requires further research, if this is the case. Furthermore, the examining attorney may conclude an interview when it appears that no common ground can be reached.

During an interview with a pro se applicant who is not familiar with Office procedure, the examining attorney may in his or her discretion make suggestions that will advance the prosecution of the application, but these interviews should not be allowed to become unduly long.

When an agreement is reached during an interview but it is not possible to resolve all issues through an examiner's amendment, the examining attorney should make a note to the file concerning the agreement and request that the applicant incorporate the agreement in its response.

Sometimes the examining attorney who conducted the interview is transferred, resigns or retires, and examination of the application is taken over by another examining attorney. If there is an indication in the record that an interview was held, the second examining attorney should endeavor to ascertain whether any agreements were reached during the interview. In the absence of clear error, the second examining attorney should take a position consistent with agreements previously reached.

Except in unusual situations, no interview on the merits is permitted after the brief on appeal is filed, or after an application has been forwarded for publication or issue.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **709.02            Persons Who May Represent Applicant in an Interview**

In general, interviews are not granted to persons who lack proper authority from the applicant or the attorney of record. See TMEP §§602 *et seq.* regarding persons who may represent an applicant before the USPTO in a trademark matter, and TMEP §§712.01 *et seq.* for information as to persons who have authority to bind various types of juristic applicants.

When an attorney claims to be the applicant's representative and requests an appointment for an interview, the examining attorney will comply with that request, even if the person requesting the interview is not the attorney of record. However, the examining attorney may request proof of the attorney's authority if there is any reason to suspect that the attorney is not, in fact, the applicant's representative. 37 C.F.R. §2.17(a).

For an interview with an examining attorney who does not have signatory authority, arrangements should be made for the presence of an examining attorney who does have such authority and who is familiar with the application, so that authoritative agreement may be reached, if possible, at the time of the interview.

USPTO employees are forbidden to engage in oral or written communication with a disbarred attorney regarding an application unless the disbarred attorney is the applicant.

Requests for interviews from third parties are inappropriate and should be directed to the Office of the Commissioner for Trademarks. See TMEP §1801.

### **709.03            Making Substance of Interview of Record**

The substance of an interview must always be made of record in the application, since the action of the USPTO is based exclusively on the written record. 37 C.F.R. §2.191. This should be done promptly after the interview while the matters discussed are fresh in the minds of the parties.

To ensure that any agreements reached at an interview will be followed, and to avoid subsequent misunderstanding, the examining attorney should include, in the "Notes-to-the-File" section of the record, a summary of the conclusions reached and the significance of any exhibits considered at an interview.

If possible, agreements reached in the interview may be incorporated in an examiner's amendment or priority action.

The applicant or the applicant's attorney may also make the substance of an interview part of the record by incorporating a summary of the interview in the applicant's response to the Office action. If there is any disagreement between the examining attorney and the applicant as to the substance of the interview, the written record governs. 37 C.F.R. §2.191.

## PROCEDURE FOR EXAMINING APPLICATIONS

### **709.04 Telephone Communications**

Use of the telephone is encouraged. Examining attorneys should initiate telephone interviews whenever possible to expedite prosecution of an application. Similarly, applicants and attorneys for applicants may telephone examining attorneys if they feel that a call will advance prosecution of an application.

All amendments and other papers filed in the USPTO should include the telephone number of the applicant or the applicant's attorney.

The examining attorney should return telephone calls within a reasonable time, normally the same working day and never later than the next working day.

Generally, the examining attorney who prepared the action, and not the supervisory or reviewing examining attorney, should be the person contacted in a telephone interview. However, a non-signatory examining attorney must secure proper authorization from the managing attorney, senior attorney or reviewing examining attorney before approving an amendment.

The action of the USPTO is based exclusively on the written record. 37 C.F.R. §2.191. Therefore, the examining attorney must use an examiner's amendment (see TMEP §§707 *et seq.*), priority action (see TMEP §§708 *et seq.*), memo to the file, or notation in the "Notes to the File" section of the record to make the substance of the call or the resolution of any issue part of the record. See TMEP §709.03.

### **709.05 Informal Submissions**

An applicant may conduct informal communications with an examining attorney regarding a particular application by fax, e-mail (see TMEP §§304 *et seq.*), or other means. Informal communications should be conducted only if they serve to develop and clarify specific issues and lead to a mutual understanding between the examining attorney and the applicant.

Informal communications must be made part of the record, because the USPTO uses them in decision making, and anything used in decision making must be made of record. 37 C.F.R. §2.191. When a communication is informal, the applicant should clearly identify it as such. If it is unclear whether a communication is an informal inquiry or a response to an Office action, the USPTO will process the communication as a response.

Filing an informal communication does not extend the deadline for response to an outstanding Office action.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **709.06 Interviews Prior to Filing Application**

No interviews are permitted before the filing of an application. If a party has general questions, he or she can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199. See TMEP §108.02.

USPTO employees cannot give advice on trademark law. It is inappropriate for USPTO personnel to give legal advice or to act as a counselor for individuals, or to recommend an attorney.

### **710 Evidence**

#### **710.01 Evidence Supporting Refusal or Requirement**

The examining attorney should support his or her action with relevant evidence whenever appropriate.

All evidence that the examining attorney relies on in making any requirement or refusal to register must be placed in the record and copies must be sent to the applicant.

In appropriate cases, the examining attorney may also present evidence that may appear contrary to the USPTO's position, with an appropriate explanation as to why this evidence was not considered controlling. In some cases, this may foreclose objections from an applicant and present a more complete picture if there is an appeal. *Cf. In re Federated Department Stores Inc.*, 3 USPQ2d 1541, 1542 n.2 (TTAB 1987).

#### **710.01(a) Evidence From Research Database**

If evidence is obtained from a research database, the record should include an indication of the specific search that was conducted. The record should indicate the libraries and/or files that were searched and the results. If the examining attorney does not review all of the documents the search locates, the record should indicate the number of documents that were reviewed. The printout (or electronic equivalent) that summarizes the search should be made a part of the record and will provide most of this information. Information not indicated on the printout, such as the number of documents viewed, should be stated in narrative in the Office action. The Office action should include a citation to the research service, indicating the service, the library and the file searched, and the date of the search (e.g., "LEXIS®, New and Business, All News, Jan. 5, 2005").

When evidence is obtained from a research database, the examining attorney does not have to make all stories of record. It is sufficient to include only a portion of the search results, as long as that portion is a representative sample of what the entire search revealed. *In re Vaughan Furniture Co. Inc.*, 24 USPQ2d 1068, 1069 n. 2



## PROCEDURE FOR EXAMINING APPLICATIONS

(TTAB 1992). See also *In re Federated Department Stores Inc.*, 3 USPQ2d 1541, 1542 n. 2 (TTAB 1987).

### **710.01(b) Internet Evidence**

Articles downloaded from the Internet are admissible as evidence of information available to the general public, and of the way in which a term is being used by the public. However, the weight given to this evidence must be carefully evaluated, because the source is often unknown. See *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1475-76 (TTAB 1999); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370-71 (TTAB 1998). When making this evidence part of the record, the examining attorney should provide complete information as to the source or context of the evidence. Any information that would aid a party in locating the document retrieved through Internet research should be included in the citation (e.g., the complete URL address of the website, the time and date the search was conducted, and the terms searched). This can often be done by printing out the pages and noting the date the printouts were run.

Evidence of actual use of a phrase by a website has far greater probative value than the summary results of a search for key words, which may indicate only that the words in a phrase appear separately in the website literature. *In re Fitch IBCA Inc.*, 64 USPQ2d 1058 (TTAB 2002).

When a document found on the Internet is not the original publication, then the examining attorney or Trademark Law Library staff should try to obtain a copy of the originally published document, if practicable. Electronic-only documents are considered to be original publications, and scanned images are considered to be copies of original publications. See notice at 64 Fed. Reg. 33056, 33063 (June 21, 1999).

### **710.01(c) Record Must Be Complete Prior to Appeal**

The record in any application must be complete prior to appeal. 37 C.F.R. §2.142(d). Accordingly, if an examining attorney or applicant attempts to introduce new evidence at the time of the appeal, the new evidence will generally be excluded from the record. TBMP §§1207 *et seq.* See *Rexall Drug Co. v. Manhattan Drug Co.*, 284 F.2d 391, 128 USPQ 114 (C.C.P.A. 1960); *In re Psygnosis Ltd.*, 51 USPQ2d 1594 (TTAB 1999). However, the Board may consider evidence submitted after appeal, despite its untimeliness, if the nonoffering party: (1) does not object to the evidence; and (2) discusses the evidence or otherwise treats it as being of record. See TBMP §1207.03 and cases cited therein. Therefore, examining attorneys and applicants should either consider or object to new evidence.

Whenever an examining attorney objects to evidence submitted by an applicant, the objection should be raised as soon as possible and continued in the examining

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

attorney's brief, or the Board may consider the objection to be waived. *In re Broyhill Furniture Industries, Inc.*, 60 USPQ2d 1511, 1513 n. 3 (TTAB 2001).

If the applicant or examining attorney wishes to introduce new evidence at the time of or during appeal, the party seeking to introduce the new evidence may request the Board to suspend the appeal and remand the case. See TMEP §§1504.05 *et seq.* and TBMP §1207.02 regarding requests for remand.

The Board may take judicial notice of definitions from printed dictionaries, even if they are not made of record by the applicant or examining attorney prior to appeal. *In re Dodd International, Inc.*, 222 USPQ 268 (TTAB 1983); *In re Cannon, Inc.*, 219 USPQ 820 (TTAB 1983); TBMP §1208.04. However, the better practice is to copy the relevant material to ensure that it is in the record. Definitions from online dictionaries and other Internet evidence must be made of record prior to appeal, so that the applicant will have the opportunity to check the reliability of the evidence and offer rebuttal evidence. *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999). The examining attorney should include a copy of the title page of the dictionary. *In re Gregory*, 70 USPQ2d 1792 (TTAB 2004) (Board declined to take judicial notice of dictionary definitions submitted with examining attorney's appeal brief, where neither the photocopied pages nor the examining attorney's brief specified the dictionaries from which the copies were made).

### **710.02 Evidence Indicating No Refusal or Requirement Necessary**

It is Office practice to indicate the results of a search for evidence when the examining attorney considers an issue and determines that no action will be taken on it. This information is helpful for internal review. The "Notes-to-the-File" section of the record should be used to reflect the results of a search for evidence in any case where the examining attorney determines that no action is required, but that inclusion of the results of the search would be useful in review and approval of the file. The examining attorney should simply note the parameters and results of the search conducted *without stating any opinions or conclusions*.

For instance, in the case of a search of telephone directories for surnames, the record should indicate only the directories investigated and the number of occurrences of the surname. Or, in the case of a search for the meaning of a term, the record should show the sources checked and whether the term was found. Examining attorneys should provide the same information indicated in TMEP §710.01(a) regarding searches of research databases in this type of case. Copies of relevant evidence may be placed in the record, if appropriate.

Examining attorneys should **not** provide any analysis, opinions, or conclusions regarding the evidence when the examining attorney determines that a refusal or requirement is not appropriate. The examining attorney should not place in the record copies of e-mail messages or other communications between the examining attorney and other USPTO personnel concerning the application. Also, the

## PROCEDURE FOR EXAMINING APPLICATIONS

examining attorney should not refer to any registration or pending application that was considered in a §2(d) search unless the examining attorney determines that there is a conflict and issues an Office action based on the application or registration. The examining attorney should not place copies of marks not cited under §2(d) in the record.

### **710.03 Evidence of Third-Party Registrations**

The Trademark Trial and Appeal Board does not take judicial notice of registrations, and the submission of a list of registrations does not make these registrations part of the record. *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). Furthermore, the submission of a copy of a commercial search report is not proper evidence of third-party registrations. *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983).

To make registrations of record, soft copies of the registrations or the complete electronic equivalent (*i.e.*, printouts or electronic copies of the registrations taken from the electronic search records of the USPTO) must be submitted. *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998); *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560 n.6 (TTAB 1996); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n. 3 (TTAB 1994); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992).

If the applicant submits improper evidence of third-party registrations, the examining attorney should object to the evidence in the next Office action, or the Board may consider the objection to be waived. See *In re Broyhill Furniture Industries, Inc.*, 60 USPQ2d 1511, 1513 n. 3 (TTAB 2001) (objection to evidence waived where it was not interposed in response to applicant's reliance on listing of third-party registrations in response to initial Office action). If the applicant files an appeal, the examining attorney should continue the objection to the evidence in his or her appeal brief.

See TMEP §1207.01(d)(iii) regarding the relevance of third-party registrations to a determination of likelihood of confusion under 15 U.S.C. §1052(d).

### **711 Deadline for Response to Office Action**

The statutory period for response to an examining attorney's Office action is six months. 15 U.S.C. §1062(b); 37 C.F.R. §2.62. The examining attorney has no discretion to shorten or extend this period. The applicant must file a response within six months of the mailing date of the Office action, unless the examining attorney has issued a supplemental action resetting the period for response. See TMEP §711.02 regarding supplemental Office actions.

To expedite processing, the Office recommends that responses to Office actions be filed through TEAS, at

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

See TMEP §310 for information about computing the response period; TMEP §§305.02 and 306.05 for certificate of mailing and certificate of facsimile transmission procedures to avoid lateness; and TMEP §§718.02 and 718.03 *et seq.* regarding abandonment for failure to respond to an Office action.

### **711.01 Time May Run from Previous Action**

In some situations the examining attorney's letter does not start the beginning of a statutory response period. For example, a notice that an applicant's response was incomplete (see TMEP §§718.03 *et seq.*), or a notice that an applicant's request for reconsideration of a final action fails to overcome a refusal or satisfy an outstanding requirement (see TMEP §§715.03(a) and (c)), does not begin a new response period. In all cases where the statutory response period runs from the date of a previous Office action, the examining attorney should include a statement to that effect in the Office action, and should omit the six-month response clause.

### **711.02 Supplemental Office Action Resetting Response Period**

Sometimes the examining attorney must issue a supplemental Office action that resets the period for response. If the examining attorney discovers after mailing an action that a refusal or requirement that should have been raised was overlooked, the examining attorney must issue a supplemental Office action addressing the issue and resetting the period for response. See TMEP §706. The examining attorney must also issue a supplemental Office action if a new issue arises after the mailing date of the Office action. For example, a new issue might arise during examination of an amendment to allege use. See TMEP §1104.09(h).

If the examining attorney issues a supplemental Office action, a new six-month response period will begin running from the mailing date of the supplemental action. 15 U.S.C. §1062(b). In a supplemental Office action, the examining attorney should indicate that the action is supplemental to the previous action, and should incorporate all outstanding issues by reference to the previous action. The examining attorney should also include the standard six-month response clause.

In a §66(a) application, the examining attorney cannot issue a new refusal more than 18 months after the date on which the IB forwards the request for extension of protection to the USPTO. See TMEP §1904.03(a).

See TMEP §§717 *et seq.* regarding remailing of Office actions.

### **712 Signature of Response to Office Action**

A response to an Office action must be signed by the applicant or by an attorney who is authorized to practice before the USPTO under 37 C.F.R. §10.14(e). See TMEP §§712.01 *et seq.* as to persons who can sign the response.

## PROCEDURE FOR EXAMINING APPLICATIONS

See TMEP §804.05 regarding signature of electronically-filed documents.

### **712.01 Persons Who Can Sign Response**

If the applicant has an attorney who is authorized to practice before the USPTO under 37 C.F.R. §10.14(e) (see TMEP §602), the attorney must sign the response. 37 C.F.R. §10.18(a).

If the applicant is not represented by an attorney who is authorized to practice before the USPTO, the response must be signed by someone with legal authority to bind the applicant (*e.g.*, a corporate officer or general partner of a partnership). A non-attorney who is authorized to verify facts on behalf of an applicant under 37 C.F.R. §2.33(a)(2) (see TMEP §804.04) is *not* entitled to sign responses to Office actions, or to authorize examiner's amendments and priority actions, unless he or she has legal authority to bind the applicant.

*Example:* A corporate manager might have the firsthand knowledge and implied authority to act on behalf of the applicant that are required to verify facts under 37 C.F.R. §2.33(a)(2), but not have legal authority to bind the applicant. See TMEP §712.01(a)(iv) regarding signature of responses filed by corporations.

Authorizing an amendment to an application, or responding to an Office action, constitutes representation of the applicant in a trademark matter. Under 5 U.S.C. §500(d) and 37 C.F.R. §10.14(e), non-attorneys may not represent a party in a trademark proceeding before the USPTO.

See TMEP §§712.01(a) *et seq.* for guidelines on persons who have legal authority to bind various types of applicants. Generally, the examining attorney should presume that a proper person signed the response unless there is evidence in the record indicating that the person was not authorized to sign.

If a response to an Office action is signed by an unauthorized person (*e.g.*, a foreign attorney who is not licensed to practice before the USPTO or a corporate employee who does not have legal authority to bind the applicant), the examining attorney should treat the response as incomplete, and require the applicant to submit a properly signed response. The response cannot be ratified by an examiner's amendment. See TMEP §712.03. See also TMEP §602.03 regarding the situation in which an examining attorney suspects that an individual who does not meet the requirements of 37 C.F.R. §10.14 is representing an applicant in the prosecution of a trademark application.

These same principles apply to authorizations of examiner's amendments and priority actions. If the applicant has a qualified attorney of record, the examining attorney must speak to the attorney. If the applicant is *pro se*, the examining attorney must speak to the individual applicant, or to someone with legal authority to bind a juristic applicant. See TMEP §§707.01 and 708.02.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **712.01(a) Guidelines on Who Should Sign Response to Office Action**

As noted in TMEP §712.01, if the applicant has an attorney, the attorney must sign the response. 37 C.F.R. §10.18(a). This section provides guidelines for determining who should sign a response to an Office action, or authorize an examiner's amendment or priority action on behalf of a juristic applicant who is not represented by an attorney. This section does not apply to verification of an application, or other verifications of facts by an applicant. See 37 C.F.R. §2.33(a) and TMEP §804.04 regarding persons who can verify facts on behalf of an applicant.

The examining attorney may presume that a proper person signed the response unless there is evidence in the record indicating that the person was not authorized to sign.

#### **712.01(a)(i) Signature By Joint Applicants**

A response to an Office action by joint applicants who are not represented by an attorney must be signed by each of the applicants, since they are individual parties and not a single entity.

#### **712.01(a)(ii) Signature By Partnership**

A response to an Office action by a partnership that is not represented by an attorney must be signed by a general partner of the applicant. Signature by all the general partners is not necessary.

In appropriate cases, a response by a partnership may be signed by an official other than a general partner, if the record contains an explanation or documentation indicating that the person signing the response is duly authorized to act for the partnership.

#### **712.01(a)(iii) Signature By Joint Venture**

A response to an Office action by a joint venture that is not represented by an attorney must be signed by each party to the venture. Although a joint venture has many attributes of a partnership, it is a special partnership, which is very limited in nature and scope. Generally, signature by each party to the joint venture is necessary.

In appropriate cases, a response by a joint venture may be signed by a general manager or other official rather than by each of the joint venturers, if the applicant states that the person who signed the response is duly authorized to act for the joint venture under relevant state law.

## PROCEDURE FOR EXAMINING APPLICATIONS

### **712.01(a)(iv) Signature By Corporation**

A response to an Office action by a corporation that is not represented by an attorney must be signed by a corporate officer. An officer is a person who holds an office established in the articles of incorporation or corporate bylaws.

The usual titles for officers are President, Vice-President, Secretary, Treasurer, Chief Executive Officer, Chief Operating Officer and Chief Financial Officer. Modifications of these basic titles are acceptable, such as Vice-President for Sales; Executive Vice-President; Assistant Treasurer; Vice-Chairman of the Board of Directors. In some organizations the Treasurer is called a Comptroller or Controller, and those terms are acceptable.

In Maine and Massachusetts the term "Clerk" identifies an officer of a corporation. The signature of the "Chairman" or "Chairman of the Board of Directors" is also acceptable, but not the signature of an individual director. The terms "Executive Secretary" and "Administrative Secretary" are acceptable, because they include the officer-title "Secretary."

There are some titles that are generally *not* accepted because they usually are not officers. For instance, a General Manager, or any other type of manager, is usually merely an employee, not an officer. The corporation cannot delegate authority to sign responses to someone who is not a corporate officer. *In re Textron, Inc.*, 183 USPQ 301 (Comm'r Pats. 1974).

If the applicant states that the person who signed the response is authorized to bind the applicant under the articles of incorporation or bylaws, the examining attorney should accept the signature.

### **712.01(a)(v) Signature By Foreign Companies and Corporations**

There are significant differences between the legal entities established under the laws of the United States and legal entities established and recognized under the laws of foreign countries, and the titles and duties of officers of foreign corporations and companies often differ from those in the United States. In the case of foreign entities that are in the nature of corporations, the USPTO will accept the signature of a person considered to be equivalent to an officer under the law of the foreign country.

In foreign countries, a person who holds the title "Manager" or "Director" is normally an officer or the equivalent of an officer.

The term "Procurist" is used in a number of countries to indicate an officer. For British companies, the terms "Registrar" and "Confidential Clerk" are the equivalent of officers.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If the applicant or the applicant's attorney states that the person who signed the response holds a position equivalent to that of an officer of a U.S. corporation, the USPTO will accept the signature.

See TMEP §803.03(i) regarding terms used to identify a foreign entity as applicant.

### **712.01(a)(vi) Signature By Unincorporated Association**

For organizations that are less formally organized than corporations (e.g. fraternal societies, unions, unincorporated associations and governmental bodies), the titles for officers are less standardized. These organizations frequently use more individualistic terms for titles than the terms customarily used by corporations, and the officer positions themselves may not be as clearly or as formally provided for as is the case with corporations. Regardless of how unfamiliar the title is or how informal the position seems to be, the USPTO will accept the signature if the signer has, within the framework of the particular organization, authority equivalent to that of an officer to act on behalf of the organization. Some titles that have been accepted are Director, National Director, National Commander, Permanent Chairman, International Sponsor, Supreme Ruler, Royal Impresario, Chairman of the Steering Committee.

### **712.01(a)(vii) Signature By Limited Liability Company**

A limited liability company has attributes of both a corporation and a partnership. See TMEP §803.03(h). Laws vary to some extent as to the authority conferred on various individuals associated with the limited liability company. Generally, a "manager" has authority equivalent to an officer in a corporation. Therefore, anyone identified as a manager, or equivalent, may sign a response to an Office action on behalf of a limited liability company that is not represented by an attorney. In addition, anyone with a corporate-officer-type title may sign. In some states the members, who are the owners, also have authority to act on behalf of the limited liability company.

### **712.02 Unsigned Response**

A response to an Office action must be signed by the applicant or the applicant's attorney. 37 C.F.R. §10.18; TMEP §712. The examining attorney should treat an unsigned response as an incomplete response, and should either call the applicant to obtain a ratification of the response, or issue an Office action granting the applicant additional time to perfect the response, pursuant to 37 C.F.R. §2.65(b). See TMEP §718.03(b). If the response does not include a verification that must be signed by applicant (see TMEP §§804 *et seq.*), the applicant may either ratify the response through an examiner's amendment, or submit a signed copy of the response. If the response includes a verification that must be signed by applicant, the applicant must submit a signed verification. A signed document can be submitted by fax (unless it is excluded by 37 C.F.R. §2.195(c)) or through TEAS



## PROCEDURE FOR EXAMINING APPLICATIONS

(using the response to Office action form). See TMEP §804.05 regarding signature of documents submitted through TEAS. The examining attorney should defer action on the merits of the response until the applicant either ratifies the response or files a properly signed response.

If the applicant fails to ratify the response or submit a properly signed response within the time granted under 37 C.F.R. §2.65(b), the examining attorney should hold the application abandoned for failure to file a complete response. See TMEP §718.03(a). In this situation, the applicant cannot file a petition to revive under 37 C.F.R. §2.66. The applicant's recourse is to file a petition to reverse the examining attorney's holding of abandonment under 37 C.F.R. §2.146. See TMEP §1713.

### **712.03 Response Signed by an Unauthorized Person**

A response to an Office action must be signed by the applicant or by an attorney who is qualified to practice before the USPTO under 37 C.F.R. §10.14. 37 C.F.R. §10.18; TMEP §712. When it appears that a response to an Office action was signed by an improper party (e.g., a foreign attorney who is not licensed to practice before the USPTO, or a corporate employee who does not have legal authority to bind the applicant), the examining attorney should treat the response as an incomplete response. The examining attorney should issue an Office action granting the applicant additional time to perfect the response, pursuant to 37 C.F.R. §2.65(b) (see TMEP §718.03(b)), and send the Office action directly to the applicant. The applicant must submit a response signed by someone with legal authority to bind the applicant (see TMEP §712.01), or by an attorney who is qualified to practice before the USPTO under 37 C.F.R. §10.14 (see TMEP §602). This should be done by fax (unless it is excluded by 37 C.F.R. §2.195(c)) or through TEAS (using the response to Office action form), if possible. See TMEP §804.05 regarding signature of documents submitted through TEAS. Where a response was signed by an unauthorized party, it is not acceptable for the applicant to ratify the response through an examiner's amendment. The examining attorney should defer action on the merits of the response until the applicant files a properly signed response.

If the applicant fails to submit a properly signed response within the time granted under 37 C.F.R. §2.65(b), the examining attorney should hold the application abandoned for failure to file a complete response. See TMEP §718.03(a). In this situation, the applicant cannot file a petition to revive under 37 C.F.R. §2.66. The applicant's recourse is to file a petition to reverse the examining attorney's holding of abandonment under 37 C.F.R. §2.146. See TMEP §1713.

### **713 Examination of Amendments and Responses to Office Actions**

*37 C.F.R. §2.63. Reexamination.*

*(a) After response by the applicant, the application will be reexamined or reconsidered. If registration is again refused or any formal requirement[s] is repeated,*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*but the examiner's action is not stated to be final, the applicant may respond again.*

*(b) After reexamination the applicant may respond by filing a timely petition to the Director for relief from a formal requirement if: (1) The requirement is repeated, but the examiner's action is not made final, and the subject matter of the requirement is appropriate for petition to the Director (see §2.146(b)); or (2) the examiner's action is made final and such action is limited to subject matter appropriate for petition to the Director. If the petition is denied, the applicant shall have until six months from the date of the Office action which repeated the requirement or made it final or thirty days from the date of the decision on the petition, whichever date is later, to comply with the requirement. A formal requirement which is the subject of a petition decided by the Director may not subsequently be the subject of an appeal to the Trademark Trial and Appeal Board.*

The examining attorney will consider the applicant's response and will determine whether the mark may be approved for publication or registration. The examining attorney must carefully consider all arguments, comments, and amendments made or proposed by the applicant.

If the applicant's response has put the application in condition for approval for publication for opposition or registration on the Supplemental Register, the examining attorney will forward the application for publication or registration, as appropriate.

If the applicant's response has not put the application in condition for publication or registration, the examining attorney will issue an Office action, or call or e-mail the applicant, depending on the circumstances. If the examining attorney's action is not stated to be final, the applicant may respond again, within six months of the mailing date. This procedure may be repeated until the examining attorney's action is made final or until the applicant fails to properly respond to the examining attorney's action. 15 U.S.C. §1062(b).

If the applicant's response does not present any new issues, and the applicant has had an opportunity to reply to all points raised by the examining attorney, the examining attorney's next action should be stated to be final. See TMEP §§714 *et seq.*

If the examining attorney has cited a prior-filed conflicting application, and the applicant responds by arguing that there is no likelihood of confusion, the examining attorney should suspend the application pending disposition of the conflicting application, if applicant's arguments are not persuasive. See TMEP §716.02(c) regarding suspension pending disposition of an earlier-filed conflicting application, TMEP §716.03 regarding the applicant's request to remove an application from suspension, and TMEP §§1208 *et seq.* regarding conflicting marks in pending applications.

## PROCEDURE FOR EXAMINING APPLICATIONS

### **713.01 Previous Action by Different Examining Attorney**

When assigned to act on an application that was previously handled by a different examining attorney, the examining attorney should not take an approach that is entirely different from that of the previous examining attorney unless it is clearly appropriate to do so.

### **713.02 Noting All Outstanding Requirements**

When acting on an amended application, the examining attorney should note all outstanding refusals and requirements in every Office action. The examining attorney should indicate whether particular refusals or requirements are withdrawn or whether the applicant's response is acceptable, where appropriate.

To prevent any misunderstanding, every refusal or requirement in the prior action that is still outstanding must be repeated or referred to. Even when suspending action on an application, the examining attorney should note all outstanding refusals or requirements.

### **713.03 Response to Applicant's Arguments**

When the applicant submits arguments attempting to overcome a refusal or requirement, the examining attorney should respond to the applicant's arguments.

### **714 Final Action**

*37 C.F.R. §2.64. Final action.*

*(a) On the first or any subsequent reexamination or reconsideration the refusal of the registration or the insistence upon a requirement may be stated to be final, whereupon applicant's response is limited to an appeal, or to a compliance with any requirement, or to a petition to the Director if permitted by §2.63(b).*

*(b) During the period between a final action and expiration of the time for filing an appeal, the applicant may request the examiner to reconsider the final action. The filing of a request for reconsideration will not extend the time for filing an appeal or petitioning the Director, but normally the examiner will reply to a request for reconsideration before the end of the six-month period if the request is filed within three months after the date of the final action. Amendments accompanying requests for reconsideration after final action will be entered if they comply with the rules of practice in trademark cases and the Act of 1946.*

*(c)(1) If an applicant in an application under §1(b) of the Act files an amendment to allege use under §2.76 during the six-month response period after issuance of a final action, the examiner shall examine the amendment. The filing of such an amendment will not extend the time for filing an appeal or petitioning the Director.*

*(2) If the amendment to allege use under §2.76 is acceptable in all respects, the applicant will be notified of its acceptance.*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*(3) If, as a result of the examination of the amendment to allege use under §2.76, the applicant is found not entitled to registration for any reason not previously stated, applicant will be notified and advised of the reasons and of any formal requirements or refusals. The Trademark Examining Attorney shall withdraw the final action previously issued and shall incorporate all unresolved refusals or requirements previously stated in the new non-final action.*

### **714.01 Not Permissible on First Action**

A first action by an examining attorney may not be made final. An applicant is entitled to at least one opportunity to reply to any issue raised by the examining attorney.

### **714.02 Not Permissible on Suspension**

A letter of suspension cannot be made final. See TMEP §§716 *et seq.* regarding suspension.

### **714.03 When Final Action is Appropriate**

Final action is appropriate when a clear issue has been developed between the examining attorney and the applicant, *i.e.*, the examining attorney has previously raised all outstanding issues and the applicant has had an opportunity to respond to them.

For a second action to be made final, all requirements or refusals must have been made in the first action. No requirement may be made final, even if it is a repeated requirement, unless the entire action is made final. Thus, if the examining attorney makes a new refusal or requirement in a second or subsequent action, a repeated refusal or requirement may not be made final.

In a §44(d) application, the examining attorney may not issue a final action until the applicant submits a copy of the foreign registration. When the application is otherwise in condition for final refusal, the examining attorney should suspend action on the application pending receipt of a copy of the foreign registration. The notice of suspension should indicate all outstanding refusals or requirements that will be made final upon receipt of the foreign registration if no new issues are raised. See TMEP §§716.02(b) and 1003.04.

Second actions should be final actions whenever possible. While an applicant is entitled to a full and fair hearing, it is in the interest of the public that prosecution be limited to as few actions as is consistent with proper examination. Neither the Act nor the rules of practice give an applicant the right to an extended prosecution.

## PROCEDURE FOR EXAMINING APPLICATIONS

See TMEP §§714.05 *et seq.* for further discussion of when an examining attorney should issue a nonfinal action rather than a final action, and TMEP §714.06 regarding final actions that are premature.

### **714.04 Form of the Final Action**

When making an action final, the examining attorney should restate any requirements or refusals that remain outstanding, and should cite the rule(s) and/or statute(s) that provide the basis for these refusals or requirements. The examining attorney should place all evidence in support of his or her refusal in the record at the time the final action is issued.

The final action should include a clear and unequivocal statement that the refusal or requirement is final. When there is more than one ground set out as the basis for the final action, the action may conclude with a paragraph containing wording such as “This action is made FINAL” or “This is a FINAL action,” which covers all grounds.

The final action should also mention any refusals or requirements that have been withdrawn.

The examining attorney should include a statement that the only proper response to a final action is an appeal (or a petition, if permitted under 37 C.F.R. §2.63(b)), or compliance with an outstanding requirement. 37 C.F.R. §2.64(a).

A final action must include a six-month response clause (see TMEP §705.08) so that it is clear that the applicant must file a timely response to avoid abandonment of the application.

### **714.05 Delineating New Issues Requiring Issuance of Nonfinal Action**

It is sometimes difficult to determine what constitutes a new issue requiring a new nonfinal action, rather than a final action, after receipt of a response. See TMEP §§714.05(a) through 714.05(c) regarding the propriety of issuing a final action in specific situations, and TMEP §715.03(b) regarding new issues presented in a request for reconsideration of an examining attorney’s final action.

In a §66(a) application, the examining attorney cannot issue a new refusal more than 18 months after date on which the IB forwards the request for extension of protection to the USPTO. See TMEP §1904.03(a).

#### **714.05(a) Unacceptable Amendment Proposed By Applicant**

Generally, an amendment that is unacceptable raises a new issue requiring a nonfinal action, unless the amendment is a direct response to a previous requirement.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If an amendment was not offered in direct response to a requirement, and the amendment is not acceptable, the examining attorney generally must issue a new, nonfinal action addressing the issues raised by the amendment and continuing all other refusals and requirements. The following are examples of amendments that would require a new nonfinal action:

- (1) Amendments to the drawing, unless the examining attorney had previously required that the drawing be amended;
- (2) Amendments to the Supplemental Register and amendments to assert acquired distinctiveness under 15 U.S.C. §1052(f), unless the amendment is irrelevant to an outstanding refusal (see TMEP §714.05(a)(i));
- (3) Amendments to disclaim the entire mark (see TMEP §1213.06);
- (4) Amendments to the drawing that materially alter the mark, if the examining attorney had required a new drawing because the original drawing was of poor quality that could not be reproduced, but had not previously raised the issue of material alteration. See TMEP §714.05(c) regarding advisory statements.

However, evidence or amendments that are merely cumulative and are not significantly different from material previously submitted do *not* raise a new issue that requires the examining attorney to issue a nonfinal action. See *In re GTE Education Services*, 34 USPQ2d 1478 (Comm'r Pats. 1994) (examining attorney properly determined that no new issue had been raised in request for reconsideration of final refusal based on inadequate specimens, where the substitute specimens submitted with the request were deficient for same reason as the original specimens). Generally, the examining attorney may issue a final action if the same refusal or requirement was made before.

### **714.05(a)(i) Amendment to Supplemental Register or Submission of Claim of Acquired Distinctiveness**

If registration is refused under §2(e)(1), §2(e)(2) or §2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(1), §1052(e)(2) or §1052(e)(4), or on grounds pertaining to other non-inherently distinctive subject matter (*e.g.*, product or container configurations (see TMEP §§1202.02(b)(i) and (ii)), color marks (see TMEP §§1202.05 *et seq.*), or marks that comprise matter that is purely ornamental (see TMEP §§1202.03 *et seq.*)), an amendment to the Supplemental Register or to claim acquired distinctiveness under 15 U.S.C. §1052(f) presents a new issue. This is true even if the examining attorney previously issued an advisory statement indicating that the examining attorney believed the mark to be unregistrable on the Supplemental Register or under §2(f).

If the examining attorney determines that the amendment does not overcome the refusal, the examining attorney should issue a nonfinal refusal of registration. See

## PROCEDURE FOR EXAMINING APPLICATIONS

TMEP §816.04 regarding refusal of registration after an amendment to the Supplemental Register, and TMEP §1212.02(h) regarding refusal of registration after an applicant submits a claim of acquired distinctiveness under §2(f).

However, if the amendment is irrelevant to an outstanding refusal, the examining attorney may issue a final refusal or requirement. For example, if registration is refused under §2(a) (see TMEP §1203 *et seq.*), §2(b) (see TMEP §1204), §2(d) (see TMEP §§1207 *et seq.*), §2(e)(3) (see TMEP §1210.01(b)) or §2(e)(5) (see TMEP §§1202.02(a) *et seq.*) of the Trademark Act, an amendment to the Supplemental Register or a claim of distinctiveness under §2(f) does *not* raise a new issue, and the examining attorney may issue a final refusal. See *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1696 (TTAB 1992) (amendment to the Supplemental Register in response to a refusal of registration under §2(a) does not raise a new issue). Likewise, in a request for extension of protection of an international registration to the United States under §66(a) of the Trademark Act, an amendment to the Supplemental Register does not raise a new issue: A mark in a §66(a) application cannot be registered on the Supplemental Register. Section 68(a)(4) of the Trademark Act, 15 U.S.C. §1141h(a)(4). Thus, an amendment to the Supplemental Register cannot overcome the refusal.

**Exception:** An amendment to the Supplemental Register in a §1(b) application for which no allegation of use has been filed does raise a new issue, because the examining attorney must refuse registration under §23 of the Trademark Act, 15 U.S.C. §1091, on the ground that the mark is not in lawful use in commerce. 37 C.F.R. §2.75(b); TMEP §1102.03. In this situation, if the applicant files a proper amendment to allege use or statement of use, the examining attorney will consider the amendment to the Supplemental Register.

See TMEP §715.03(b) regarding new issues presented in a request for reconsideration of an examining attorney's final action.

### **714.05(a)(ii) Amendment of Identification of Goods and Services**

If the applicant responds to a nonfinal Office action requiring an amendment to the identification of goods and services, and the examining attorney determines that the identification is still unacceptable, generally the examining attorney must issue a final requirement to amend the identification of goods and services. There are only two exceptions to this rule:

- (1) If the amended identification is broader in scope than the original identification, *and* the prior Office action failed to advise the applicant that amendments broadening the identification are prohibited under 37 C.F.R. §2.71(a), the examining attorney cannot issue a final Office action.
- (2) If the amended identification sets forth goods and services in multiple classes, but the applicant has not submitted all the requirements for a

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

multiple-class application (*e.g.*, specimens and fees for all classes), *and* the prior Office action failed to advise the applicant that the missing elements were required, the examining attorney cannot issue a final Office action. See TMEP §§1403 *et seq.* regarding multiple-class applications.

### **714.05(b) Section 2(d) Refusal Based on Prior-Filed Application That Has Matured Into Registration**

The examining attorney must issue a nonfinal action when first refusing registration under §2(d) of the Trademark Act, 15 U.S.C. §1052(d), even if the applicant had been advised of the existence of the prior-filed application before it matured into the registration on which the refusal is based.

In a §66(a) application, a nonfinal refusal under §2(d) of the Act may be issued more than 18 months after the date on which the IB forwards the request for extension of protection to the USPTO, provided that the USPTO had notified the IB of the conflicting application prior to expiration of the 18-month period.

### **714.05(c) Advisory Statement Cannot Serve as Foundation for Final Refusal or Requirement**

Except as provided in TMEP §714.05(a)(ii), an advisory statement in an Office action indicating that a refusal or requirement will be issued if specified circumstances arise cannot serve as the foundation for issuing a final requirement or refusal in the next action. To establish the foundation for issuing a final refusal or requirement in the next Office action, an initial requirement or refusal must relate to matter that is of record at the time of the action.

### **714.06 Applicant's Recourse When Final Action is Premature**

If an applicant believes that a refusal to register or a requirement has been made final prematurely, the applicant must raise the issue while the application is still pending before the examining attorney. It is not a ground for appeal to the Trademark Trial and Appeal Board. TBMP §1201.02. The applicant may raise the matter by filing a request for reconsideration with the examining attorney, or by contacting the managing attorney or senior attorney in the examining attorney's law office. If the examining attorney does not withdraw the finality, the applicant may file a petition to the Director under 37 C.F.R. §2.146. See TMEP Chapter 1700 regarding petitions.

If, on request for reconsideration, the examining attorney finds the final action to have been premature, the examining attorney should issue a new nonfinal action.



## PROCEDURE FOR EXAMINING APPLICATIONS

### **715 Action After Issuance of Final Action**

#### **715.01 Proper Response to Final Action**

An applicant must respond to a final action within six months of the mailing date. 15 U.S.C. §1062(b); 37 C.F.R. §2.62.

In general, the only proper response to a final action is an appeal (or a petition, if permitted under 37 C.F.R. §2.63(b)(2)), or compliance with an outstanding requirement. 37 C.F.R. §2.64(a).

After a final refusal to register on the Principal Register, an amendment requesting registration on the Supplemental Register or registration on the Principal Register under §2(f) of the Trademark Act may be a proper response in some circumstances. See TMEP §§714.05(a)(i), 816.04 and 1212.02(h).

#### **715.02 Action After Final Action**

Once an action has been properly made final, the examining attorney normally should not change his or her position. However, this does not mean that no amendment or argument will be considered after final action. An amendment that will place the application in condition for publication or issue, or will put the application in better form for appeal, may be accepted and entered. For example, an amendment requesting registration on the Supplemental Register or on the Principal Register under §2(f) may be a proper response to a final refusal of registration on the Principal Register in some circumstances. See TMEP §§714.05(a)(i), 816.04 and 1212.02(h).

If the applicant files a response that complies with all outstanding requirements and overcomes all outstanding refusals, the examining attorney should approve the application for publication or registration, as appropriate.

The applicant may request reconsideration after final action, within six months of the mailing date of the final action. However, the filing of a request for reconsideration does *not* extend the time for filing an appeal or other proper response to the final action. 37 C.F.R. §2.64(b).

See TMEP §716.06 regarding suspension after final action.

#### **715.03 Request for Reconsideration After Final Action**

Under 37 C.F.R. §2.64(b), the applicant may file a request for reconsideration before the deadline for filing an appeal.

However, the filing of a request for reconsideration does *not* extend the deadline for appeal. 37 C.F.R. §2.64(b); TMEP §715.03(c). Therefore, if an applicant files a request for reconsideration of a final action and wants to preserve the right to appeal if the request is unsuccessful, the applicant must file a notice of appeal (with the fee

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

required by 37 C.F.R. §2.6) before the expiration of the six-month period for response to the final action, or the application will be abandoned. See TMEP §715.04 for information about processing a request for reconsideration filed with a notice of appeal.

The examining attorney should construe any paper filed after final action that contains new amendments, new evidence, or new arguments as a request for reconsideration, and should issue a written action granting or denying the request. See TMEP §715.03(a).

### **715.03(a) Examining Attorney's Action After Request for Reconsideration**

When responding to a request for reconsideration, the examining attorney must issue a written action that advises the applicant of the status of the application.

If the examining attorney determines that no new issues have been raised in the request for reconsideration, the examining attorney should deny the request. The examining attorney should issue a written action acknowledging the request for reconsideration, restating the final refusal, and advising the applicant that the time for appeal runs from the mailing date of the final Office action. The USPTO cannot extend the statutory deadline for filing an appeal. 15 U.S.C. §1062(b); 37 C.F.R. §2.142(a).

An Office action denying a request for reconsideration should *not* include a six-month response clause (see TMEP §705.08). If the six-month period for response to the final action has expired, and the applicant has not filed a notice of appeal, the examining attorney should state in the Office action that the application is abandoned.

If there is time remaining in the response period, the examining attorney should advise the applicant that the applicant has the remainder of the response period to comply with any outstanding requirement and/or to appeal. See TMEP §715.03(b) regarding the examining attorney's action when the request for reconsideration raises a new issue, and TMEP §715.04 regarding a request for reconsideration filed in conjunction with an appeal.

In an Office action denying the applicant's request for reconsideration, the examining attorney may introduce additional evidence directed to the issue(s) for which reconsideration is sought. TBMP §1207.04.

If the request for reconsideration convinces the examining attorney that a refusal or requirement is not appropriate, the examining attorney may withdraw the refusal or requirement and approve the application for publication or registration, if otherwise in condition for such action. The examining attorney should inform the applicant of any action that renders the appeal moot. This may be done by telephone, with an appropriate note to the file.

## PROCEDURE FOR EXAMINING APPLICATIONS

If, in a request for reconsideration, the applicant makes a good faith, but incomplete, attempt to comply with all outstanding requirements and to overcome all outstanding refusals, the examining attorney has the discretion under 37 C.F.R. §2.65(b) to give the applicant additional time to resolve the matters that remain outstanding. See TMEP §718.03(b). This should be done *only* if the record indicates that the applicant can place the application in condition for approval by completing the response. In this situation, if the examining attorney believes that an examiner's amendment (see TMEP §§707 *et seq.*) will immediately put the application into condition for publication or registration, the examining attorney may issue the examiner's amendment. If the examining attorney grants the applicant additional time to complete a response under 37 C.F.R. §2.65(b), this does *not* extend the deadline for appeal. 15 U.S.C. §1062(b); 37 C.F.R. §2.142(a).

If the examining attorney denies the request for reconsideration and holds the application abandoned, the applicant may file a petition to the Director under 37 C.F.R. §2.146 to reverse the examining attorney's holding of abandonment. However, the Director will reverse the examining attorney's action on petition only if there is clear error or abuse of discretion. See TMEP §1713. The unintentional delay standard of 37 C.F.R. §2.66 does not apply in this situation. See TMEP §1714.01(f)(ii).

### **715.03(b) Examining Attorney Must Issue New Nonfinal Action If New Issue Presented in Request for Reconsideration**

If the request for reconsideration includes an amendment that presents a new issue, the examining attorney must issue a nonfinal action. For example, in the case of an amendment that asserts a claim of acquired distinctiveness under §2(f) for the first time, or an amendment to the Supplemental Register for the first time, but fails to place the application in condition for approval, a nonfinal action may be appropriate. See TMEP §714.05(a)(i).

When the examining attorney issues a *nonfinal* action after review of the applicant's request for reconsideration, the Office action should explain that the applicant must respond to all requirements or refusals within six months of the mailing date of the action, but that the applicant should not file an appeal because an appeal would be premature under 15 U.S.C. §1070 and 37 C.F.R. §2.141.

Evidence or amendments that are merely cumulative and are not significantly different from material previously submitted do *not* raise a new issue that requires the examining attorney to issue a nonfinal action. *In re GTE Education Services*, 34 USPQ2d 1478 (Comm'r Pats. 1994) (examining attorney properly determined that no new issue had been raised in request for reconsideration of final refusal based on inadequate specimens, where the substitute specimens submitted with the request were deficient for the same reason as original specimens).

Submission of new arguments in response to the same refusal or requirement does not raise a new issue that requires the examining attorney to issue a nonfinal action.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Generally, if the same refusal or requirement was made before, the examining attorney does not have to issue a new final or nonfinal action.

See TMEP §§714.05 *et seq.* for further information about delineating new issues that require issuance of a nonfinal action.

When an application has been suspended after final action, and the grounds for refusal remain operative after the application is removed from suspension and no new issues have been raised, the examining attorney must issue a new *final* action. See TMEP §716.06.

In a §66(a) application, the examining attorney cannot issue a new refusal more than 18 months after the date the IB forwards the request for extension of protection to the USPTO. See TMEP §1904.03(a).

### **715.03(c) Time for Appeal Runs from Mailing Date of Final Action if No New Issue Is Presented and Requirement(s) or Refusal(s) Is Not Withdrawn**

Filing a request for reconsideration does not stay the time for responding to a final refusal. 15 U.S.C. §1062(b); 37 C.F.R. §2.142(a). If the examining attorney denies the applicant's request for reconsideration, the deadline for appeal runs from the mailing date of the final action. If this deadline has expired and the applicant has not filed a notice of appeal, the application is abandoned. The applicant may not file a petition to revive under 37 C.F.R. §2.66. See TMEP §1714.01(f)(ii).

### **715.04 Request for Reconsideration Filed In Conjunction With Notice of Appeal**

If the applicant files a notice of appeal with a request for reconsideration, the application should be referred to the Trademark Trial and Appeal Board for processing of the appeal. The Board will acknowledge the appeal, suspend further proceedings with respect to the appeal (including the applicant's time to file an appeal brief), and remand the application to the examining attorney for review of the request for reconsideration. TBMP §1204.

If, after suspension of the Board proceeding and remand, the examining attorney approves the application for publication (or for registration on the Supplemental Register), the appeal is moot. The examining attorney should notify the applicant that the refusal or requirement is withdrawn, and that the application is being approved for publication or registration. This may be done by telephone, with an appropriate note to the file.

See TMEP §§1501 *et seq.* and TBMP Chapter 1200 for further information about *ex parte* appeals.

## PROCEDURE FOR EXAMINING APPLICATIONS

### 716 Suspension of Action by Office

37 C.F.R. §2.67. *Suspension of action by the Patent and Trademark Office.*

*Action by the Patent and Trademark Office may be suspended for a reasonable time for good and sufficient cause. The fact that a proceeding is pending before the Patent and Trademark Office or a court which is relevant to the issue of registrability of the applicant's mark, or the fact that the basis for registration is, under the provisions of Section 44(e) of the Act, registration of the mark in a foreign country and the foreign application is still pending, will be considered prima facie good and sufficient cause. An applicant's request for a suspension of action under this section filed within the 6-month response period (see §2.62) may be considered responsive to the previous Office action. The first suspension is within the discretion of the Examiner of Trademarks and any subsequent suspension must be approved by the Director.*

The term "suspension of action" means suspending action *by the examining attorney*. It does not mean suspending or extending an applicant's time to respond. The Trademark Act requires that an applicant respond within six months of an examining attorney's Office action, and the examining attorney has no discretion to suspend or extend the time for the applicant's response. 15 U.S.C. §1062(b).

The examining attorney should suspend an application only after all issues have been resolved or are in condition for final action, except the matter on which suspension is based.

#### 716.01 Form of Suspension Notice

In a suspension notice, the examining attorney must specifically state that action is suspended and must omit any reference to a six-month response period. The examining attorney should also inform the applicant of the status of the application, *i.e.*, that the mark appears to be otherwise entitled to be approved for publication or issue, or that the application is in condition for a final action.

If the application is in condition for a final action but for the matter necessitating suspension, the notice of suspension should clearly indicate which refusal(s) or requirement(s) will be made final when the application is removed from suspension. When the application is removed from suspension, the examining attorney should promptly issue a final action, assuming that no new issues have arisen.

#### 716.02 Circumstances Under Which Action May Be Suspended

Under 37 C.F.R. §2.67, an examining attorney has the discretion to suspend an application "for good and sufficient cause." The most common reasons for suspension of an application are discussed below.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

As a general rule, the USPTO will not suspend an application to give an applicant time to secure a consent agreement.

Any request to stay a deadline for responding to an Office action pending disposition of a petition to the Director should be directed to the Commissioner for Trademarks. If such a request is sent to the examining attorney, the examining attorney should forward it to the Office of the Commissioner for Trademarks. The examining attorney should *not* suspend action on an application pending a decision on petition. See 37 C.F.R. §2.146(g); TMEP §1705.06.

### **716.02(a) Applicant's Petition to Cancel Cited Registration**

If the examining attorney refuses registration under §2(d) of the Trademark Act in view of the mark in a prior registration, the applicant may file a petition to cancel the registration under 15 U.S.C. §1064 and, within a proper response period, inform the examining attorney that the petition to cancel has been filed. This will constitute a proper response to the §2(d) refusal, and may be done by phone, if there are no other outstanding issues that require a written response. The examining attorney will then suspend further action until the termination of the cancellation proceeding, if the application is otherwise in condition for approval or final refusal. The applicant should provide the number of the cancellation proceeding, if available; however, if the applicant does not provide the cancellation number, the examining attorney may ascertain it from Office records.

The examining attorney should suspend only if the applicant states that the cancellation proceeding has already been filed or is being filed concurrently with the response to the Office action.

Although the examining attorney will determine the status of the cancellation proceeding through a routine status check (see TMEP §716.04), the applicant may call or e-mail to advise the examining attorney when the proceeding is terminated, in order to avoid any possible delay in removing the application from suspension.

See TMEP §716.02(e) regarding suspension pending cancellation of a cited registration under §8 of the Act or expiration of a cited registration for failure to renew under §9 of the Act.

### **716.02(b) Submission of Copy of Foreign Registration in §44(d) Application**

When an applicant who claims the benefit of a prior foreign application under 15 U.S.C. §1126(d) is required to submit a copy of a foreign registration, the applicant may respond to the requirement by stating that the foreign application is still pending. The examining attorney should then suspend further action pending receipt of a copy of the foreign certificate, if the application is otherwise in condition for approval or final refusal. See TMEP §1003.04.

## PROCEDURE FOR EXAMINING APPLICATIONS

If an applicant claims §44(d) in addition to another basis, before suspending the application, the examining attorney must inquire whether the applicant wishes to retain §44(e) as a second basis for registration (based on the foreign registration that will issue from the application on which the applicant relied for priority). This inquiry should be made in the first Office action, or by telephone if no Office action is issued. If the examining attorney is unable to reach the applicant by telephone, the examining attorney should issue an Office action requiring a copy of the foreign registration, advising applicant that it may retain the priority filing date even if it does not perfect the §44(e) basis, and inquiring as to whether the applicant wishes to retain §44(e) as a second basis for registration. See 37 C.F.R. §§2.35(b)(3) and (4) and TMEP §§806.02(f) and 806.04(b).

If the applicant responds that it does want to assert a dual basis for registration and the application is otherwise in condition for publication or final refusal, then the examining attorney should suspend further action pending receipt of a copy of the foreign registration.

During the suspension period, the examining attorney will issue an Office action approximately every six months after suspension to inquire as to the status of the foreign application. If the applicant does not respond to the inquiry, the application will be abandoned. See TMEP §716.05.

The examining attorney may suspend pending receipt of a copy of a foreign registration only in a §44(d) application. In a §44(e) application, the examining attorney will not suspend the application pending submission of a copy of the foreign registration unless the applicant establishes that it cannot obtain a copy of the foreign registration due to extraordinary circumstances (*e.g.*, war or natural disaster). TMEP §1004.01. However, the examining attorney may suspend a §44(e) application pending receipt of proof of renewal of the foreign registration. TMEP §1004.01(a).

### **716.02(c) Conflicting Marks in Pending Applications**

When there are conflicting marks in pending applications, action on the application with the later effective filing date will be suspended (after examination on all other issues is concluded or the application is in condition for a final action) until the mark in the conflicting application with the earlier effective filing date is either registered or abandoned. 37 C.F.R. §2.83(c). See TMEP §§1208 *et seq.* for more information about conflicting marks in pending applications.

If the examining attorney has cited a prior-filed pending application, the applicant may respond by arguing that there is no likelihood of confusion between the marks. If the examining attorney is not persuaded by the applicant's arguments, the examining attorney should suspend the later-filed application pending disposition of the conflicting application. The suspension notice should include a statement that the applicant's arguments were not persuasive. It is not necessary to address the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

merits of the applicant's arguments prior to the initial suspension. See TMEP §716.03 regarding the applicant's request to remove an application from suspension.

If the examining attorney discovers that a prior-filed pending application was abandoned, but that a petition to revive is pending, the examining attorney should suspend the later-filed application pending disposition of the petition to revive. If the petition to revive is granted, the later-filed application will remain suspended until the mark in the earlier-filed application is registered or the earlier-filed application is again abandoned.

When an application is suspended pending the disposition of more than one earlier-filed conflicting application, and one of the conflicting applications matures into registration, the examining attorney will normally not issue a refusal of registration until the remaining conflicting application(s) are registered or abandoned, in order to avoid issuing piecemeal refusals. However, if deemed appropriate, the examining attorney does have the discretion to issue a refusal of registration under §2(d) in this situation.

### **716.02(d) *Inter Partes* or Court Proceeding**

When an examining attorney learns that a proceeding relevant to the registrability of an applicant's mark is pending before the Trademark Trial and Appeal Board or a court, the examining attorney should call the proceeding to the applicant's attention. If the applicant is not a party to the *inter partes* or court proceeding, the examining attorney must explain why the proceeding is relevant to the registrability of the applicant's mark. If the examining attorney believes the proceeding may result in a decision that supports a refusal of registration of the applicant's mark, the examining attorney must issue the refusal and give the applicant an opportunity to respond before suspending the application.

An applicant may request suspension because a proceeding relevant to the registrability of the applicant's mark is pending before the Office or a court. The applicant must submit a copy of the relevant pleadings, the docket number of the proceeding, and a written explanation of why the proceeding is relevant to the registrability of the mark. Normally, a court proceeding is not considered relevant to the registrability of a mark unless the remedy requested in the proceeding is cancellation, abandonment, or amendment of a relevant application or registration. However, when resolution of the court action requires the court to consider questions of Office policy or procedure, the examining attorney should not assume that the court would prefer to decide such questions absent the Office's decision in the consideration of an application. In these instances, action on an application should generally not be suspended. It is important to review the relevant pleadings, including the complaint and answer, before determining whether suspension is appropriate. The Office of the Solicitor may be consulted if there is a question as to whether suspension of the application is appropriate.



## PROCEDURE FOR EXAMINING APPLICATIONS

Before an application is suspended, the applicant must respond to all outstanding issues raised in the examining attorney's Office action that are not related to the proceeding. The examining attorney should not suspend the application unless all matters not related to the proceeding are resolved or in condition for final action.

See TMEP §716.02(a) regarding suspension pending disposition of an applicant's petition to cancel a cited registration under 15 U.S.C. §1064, and TMEP §716.03 regarding the applicant's request to remove an application from suspension.

### **716.02(e) Suspension Pending Cancellation or Expiration of Cited Registration**

When the applicant submits a timely affidavit or declaration of continued use or excusable nonuse under 15 U.S.C. §1058 ("§8 affidavit") and/or an application for renewal under 15 U.S.C. §1059, the USPTO's automated records are updated to indicate receipt of the paper and the action taken on the paper. The USPTO's automated records are updated three months after the grace period expires to indicate that a registration is cancelled or expired if:

- (1) No §8 affidavit has been filed before the end of the six-month grace period following the sixth year after the date of registration or publication under §12(c) of the Trademark Act, 15 U.S.C. §1062(c); or
- (2) No §8 affidavit has been filed before the end of the six-month grace period following the expiration of the previous term of registration; or
- (3) No §9 renewal application has been filed before the end of the six-month grace period following the expiration of the previous term of registration.

See TMEP §§1602 *et seq.* regarding the duration of a registration, TMEP §1604.04 regarding the due dates for §8 affidavits, and TMEP §1606.03 regarding the due dates for §9 renewal applications.

The USPTO waits until three months *after* the expiration of the grace period for filing the §8 affidavit or renewal application before updating its records to show that the registration is cancelled or expired, to avoid inadvertent cancellation or expiration of a registration due to a delay in matching a timely filed §8 affidavit or renewal application with the registration file.

The examining attorney must confirm the status of the cited registration to ensure that it is still active before issuing any refusal of registration under Trademark Act §2(d), or filing a brief on appeal of a §2(d) refusal.

If the examining attorney is ready to issue a *nonfinal* refusal of registration under §2(d), and TRAM shows that the registration is still active, the examining attorney must issue the refusal even if the grace period for filing a §8 affidavit and/or a §9 renewal application for the cited registration has passed and TRAM does not indicate that the registrant has filed a §8 affidavit and/or renewal application. The

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

examining attorney should not suspend the application, but should advise the applicant that the grace period for filing the §8 affidavit or renewal application has passed and that it appears that the registration may be subject to cancellation under §8 or expiration under §9.

If the examining attorney is ready to issue a *final* refusal of registration under §2(d), but the grace period for filing a §8 affidavit and/or a §9 renewal application for the cited registration has passed, the examining attorney should not issue a final refusal until the USPTO's automated records indicate that the registrant has filed the §8 affidavit or renewal application, and the USPTO has accepted the §8 affidavit or granted renewal. Instead, the examining attorney should suspend action for six months pending final disposition of the cited registration.

If the examining attorney is ready to write an appeal brief, but the grace period for filing a §8 affidavit and/or a §9 renewal application for the cited registration has passed, the examining attorney should request a remand so the application can be suspended pending final disposition of the cited registration. The Board will issue an order suspending the appeal and remanding the case to the examining attorney. If the cited registration is cancelled or expires, the examining attorney should withdraw the §2(d) refusal and notify the applicant that it has been withdrawn. If an appropriate affidavit or renewal application is filed for the cited registration, the examining attorney should notify the Board and return the file to the Board; the Board will resume proceedings and reset the time for filing the examining attorney's appeal brief. Similarly, if the cited registration is cancelled or expires, but the §2(d) refusal is only one of the issues on appeal, the examining attorney should notify the Board of the status of the cited registration and return the file to the Board. The Board will resume proceedings and reset the time for filing a brief. See TBMP §1213 regarding the suspension of an *ex parte* appeal pending cancellation of the cited registration under §8 or §9 of the Act.

The examining attorney cannot withdraw a refusal of registration under §2(d) until the TRAM system shows that the registration has actually been cancelled or expired.

See TMEP §1611 for information about how a registrant who has not timely filed a §8 affidavit or §9 renewal application may expedite the cancellation or expiration of its own registration.

### **716.03            Applicant's Request to Remove Application from Suspension**

If an examining attorney suspends action on an application, and the applicant believes the suspension is improper, the applicant may file a request to remove the application from suspension. The applicant should state the reasons for the belief that the suspension is improper and attach any relevant evidence.

If persuaded by the request, the examining attorney should remove the application from suspension, resume examination of the application, and take appropriate action.

## PROCEDURE FOR EXAMINING APPLICATIONS

If not persuaded by the request, the examining attorney should issue a new suspension action that addresses the applicant's arguments *and explains the reasons why the request is not granted*. The applicant's recourse is to file a petition to the Director to review the examining attorney's action continuing the suspension. The Director will reverse the examining attorney's action only if there is clear error or abuse of discretion. See TMEP Chapter 1700 for information about petitions.

### **716.04                   Suspended Docket Checked by Examining Attorney**

An examining attorney will review each suspended case in his or her docket at least every six months to determine whether continued suspension is appropriate. If the examining attorney determines that the application should remain suspended, he or she should perform the appropriate TRAM transaction to report the suspension check.

### **716.05                   Inquiry by Examining Attorney Regarding Suspended Application**

If the application has been suspended for six months or more, the examining attorney will issue an Office action inquiring as to the status of the matter on which suspension was based, unless the information is available to the examining attorney in the USPTO's databases. If the applicant does not respond to the Office action, the application will be abandoned.

For example, if action is suspended pending the receipt of a copy of a foreign registration, or pending the renewal of a foreign registration, the examining attorney will inquire every six months during the suspension period as to the status of the foreign application or registration. Similarly, for applications that are suspended pending the outcome of a civil action, the examining attorney will inquire every six months as to the status of the proceeding. If the foreign application or the civil action is still pending, a statement by the applicant to this effect is a proper response.

The examining attorney should *not* issue any inquiry about the status of a proceeding pending in the USPTO (*e.g.*, an *inter partes* proceeding).

### **716.06                   Suspension After Final Action**

If the examining attorney determines that action on an application should be suspended after issuance of a final refusal, the examining attorney must issue a suspension notice. This may occur, for example, when the applicant files a petition to cancel a cited registration. See TMEP §716.02(a). The examining attorney should not "withdraw the finality" of the refusal in order to suspend; however, in the suspension notice, the examining attorney should inform the applicant that the refusal of registration is continued but that it is not necessary to respond to the final refusal until the application is removed from suspension.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If the application is eventually removed from suspension and the grounds for refusal remain operative, the examining attorney should reissue the final refusal, and the applicant will have six months to respond to the final refusal. It is inappropriate to remove the case from suspension and immediately declare the application abandoned.

### **717                    Remailing of Office Action**

Sometimes an Office action must be remailed because the action has been returned by the United States Postal Service as undeliverable and/or because the applicant notifies the USPTO that the applicant did not receive the Office action. In these situations, the USPTO will not give the remailed correspondence a new mailing date unless the Office action was sent to the wrong address due to an Office error. If there was an Office error, the USPTO will remail the Office action with a new mailing date, and stamp it “Remailed.” If there was no Office error, the USPTO will send a copy of the action to the applicant, but will *not* remail the action with a new mailing date.

An “Office error in sending the Office action to the wrong address” means that the USPTO either entered the correspondence address incorrectly or failed to enter a proper notice of change of address filed *before* the mailing date of the action. The transmittal of a response on letterhead bearing a new address is *not* a proper notice of change of address. The applicant or applicant’s attorney must specifically instruct the USPTO to change the correspondence address. See TMEP §603.02(a).

### **717.01                Returned Office Action**

If an examining attorney’s Office action is returned to the Office because the United States Postal Service has not been able to deliver it, the SLIE in the law office will review the file to determine whether the correspondence address was entered correctly and/or whether the applicant has filed a notice of change of address.

If the Office action was sent to the wrong address due to an Office error (see TMEP §717), the Office action will be remailed with a new mailing date. However, if the Office action was sent to the correspondence address of record (see TMEP §§603 *et seq.*), the USPTO will try to obtain the correct address and forward the Office action, but the Office action will not be given a new mailing date, and the deadline for response will not be extended.

If the USPTO is ultimately unsuccessful in delivering or redelivering the Office action, the returned action and envelope should be scanned into the Trademark Image Capture and Retrieval System (“TICRS”). If no communication from the applicant is received within the period for response, the application will be abandoned.

## PROCEDURE FOR EXAMINING APPLICATIONS

If outgoing e-mail is returned as undeliverable, the USPTO will mail a paper copy to the correspondence address of record. See TMEP §§304 *et seq.* regarding e-mail.

See TMEP §403 for more information about returned correspondence.

### **717.02 Non-Receipt of Office Action**

If an applicant or applicant's attorney notifies the USPTO before the expiration of the response period that the applicant did not receive an action, the examining attorney must check to determine whether the action was properly addressed, *i.e.*, mailed to the correspondence address of record. See TMEP §§603 *et seq.*

If the Office action was mailed to the correspondence address of record, and there is time remaining in the response period, the examining attorney should send a copy of the action to the applicant, and should advise the applicant that the deadline for response runs from the original mailing date, and that a response must be received in the USPTO before this deadline to avoid abandonment. If the response period has expired, the examining attorney should advise the applicant that the application is abandoned, and that the applicant may file a petition to revive under 37 C.F.R. §2.66. See TMEP §§1714 *et seq.* regarding petitions to revive. In either situation, the examining attorney should make an appropriate note to the file.

If there is evidence in the file that the USPTO sent the Office action to the wrong address due to an Office error (see TMEP §717), the examining attorney will take the file to the SLIE, who will remail the Office action with a new mailing date. The deadline for response will run from the new mailing date. If the application had been abandoned, it will be reinstated. See TMEP §1712.01 regarding reinstatement of applications that are abandoned due to Office error.

### **718 Abandonment**

An abandoned application is an application for registration that is removed from the USPTO docket of pending applications because of express abandonment or because the applicant failed to take appropriate action within a specified response period.

#### **718.01 Express Abandonment by Applicant or Applicant's Attorney**

*37 C.F.R. §2.68. Express abandonment (withdrawal) of application.*

*An application may be expressly abandoned by filing in the Patent and Trademark Office a written statement of abandonment or withdrawal of the application signed by the applicant, or the attorney or other person representing the applicant. Except as provided in §2.135, the fact that an application has been expressly abandoned shall not, in any proceeding in the Patent and Trademark Office, affect any rights that the applicant may have in the mark which is the subject of the abandoned application.*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

To expedite processing, the Office recommends that letters of express abandonment be filed through TEAS, at <http://www.uspto.gov/teas/index.html>.

A letter expressly abandoning an application must be signed by the applicant or the applicant's attorney. An application cannot be expressly abandoned by examiner's amendment.

When an applicant files a letter of express abandonment that meets the requirements of 37 C.F.R. §2.68, the examining attorney should perform a transaction expressly abandoning the application in TRAM, effective as of the filing date of the letter of express abandonment. TRAM will generate a letter notifying the applicant that the application is abandoned.

If it is unclear whether a document is a letter of abandonment, the examining attorney should contact the applicant to inquire about his or her intention before abandoning the application.

If an applicant files an express abandonment of an application that is not the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board, and wants to withdraw the abandonment to resume prosecution of the application, the applicant must petition the Director under 37 C.F.R. §2.146(a)(3) to request withdrawal of the express abandonment, within two months of the effective date of abandonment. 37 C.F.R. §2.146(d). However, such a petition will be granted only in an extraordinary situation. *In re Glaxo Group Limited*, 33 USPQ2d 1535 (Comm'r Pats. 1993).

If an applicant whose application is the subject of an opposition proceeding files an express abandonment of the application after the commencement of the opposition proceeding, but before receipt of the Board's notice of the filing of the opposition, the Board will allow the applicant an opportunity to withdraw the abandonment because the abandonment, if not withdrawn, may result in entry of judgment against the applicant in the opposition. See TBMP §§218 and 602.01.

In a §66(a) application, an applicant may file a letter of express abandonment either with the USPTO or with the IB.

### **718.02 Failure by Applicant to Take Required Action During Statutory Period**

*15 U.S.C. §1062(b). If the applicant is found not entitled to registration, the examiner shall advise the applicant thereof and of the reason therefor. The applicant shall have a period of six months in which to reply or amend his application, which shall then be reexamined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of six months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, whereupon such time may be extended.*

## PROCEDURE FOR EXAMINING APPLICATIONS

Under 15 U.S.C. §1062(b) and 37 C.F.R. §2.65(a), an application becomes abandoned if the applicant fails to respond, or fails to respond completely, within the six-month statutory response period. See TMEP §§718.03 *et seq.* regarding incomplete responses.

The examining attorney has no authority to accept a late response. If an applicant files a late response, the examining attorney should immediately write to the applicant or applicant's attorney, stating that the response was untimely; that the application is abandoned; and that the applicant may file a petition to revive under 37 C.F.R. §2.66 if the failure to respond on time was unintentional. See TMEP §§1714 *et seq.* regarding petitions to revive.

See TMEP §718.02(a) regarding partial abandonment.

### **718.02(a) Partial Abandonment**

*General Rule.* Effective November 2, 2003, Trademark Rule 2.65(a), 37 C.F.R. §2.65(a), provides that if a refusal or requirement is expressly limited to certain goods/services, and the applicant fails to file a response to the refusal or requirement, the application shall be abandoned only as to those particular goods/services. The rule applies only to Office actions issued on or after November 2, 2003. See notice at 68 Fed. Reg. 55748 (Sept. 26, 2003).

Partial abandonment applies only where the Office action expressly states that a refusal or requirement is limited to only certain goods/services or certain class(es). If the Office action contains any requirement or refusal that applies to all the goods/services, and the applicant fails to respond, the entire application will be abandoned.

*Incomplete Response to Partial Refusal.* Partial abandonment may also occur when an applicant fails to file a complete response to a final refusal or final requirement that is expressly limited to only certain goods/services or certain class(es). If an applicant files an incomplete response to a nonfinal action that is limited to only certain goods/services or certain class(es), the examining attorney should generally issue a final action, making all outstanding requirements and refusals final. See TMEP §718.03 *et seq.* regarding incomplete responses. When an examining attorney holds an application abandoned for failure to file a complete response, the applicant's recourse is to file a petition the Director to reverse the holding. TMEP §1713.

*Failure to Respond to Partial Refusal or Requirement.* When an applicant fails to respond to a refusal or requirement that is expressly limited to only certain goods/services/class(es), the examining attorney should issue an examiner's amendment deleting (abandoning) the goods/services/classes to which the refusal or requirement pertained. The examiner's amendment should clearly set forth the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

changes that will be made to the identification of goods/services in the application. No prior authorization from the applicant or the applicant's attorney is needed to issue an examiner's amendment in this situation. If the failure to respond to the partial refusal or requirement was unintentional, the applicant may file a petition to revive the deleted goods/services/classes under 37 C.F.R. §2.66, within two months of the mailing date of the examiner's amendment. See TMEP §§1714 *et seq.* regarding petitions to revive.

*Use of Headings in Office Actions.* When issuing a partial refusal or requirement, the examining attorney is encouraged to use the heading "Partial Refusal" or "Partial Requirement," so it is clear in the record that the refusal or requirement applies only to certain goods/services or certain class(es).

*Requirements for Amendment of Identification of Goods/Services.* See TMEP §1402.13 regarding an examining attorney's requirement for amendment of an identification of goods/services that includes some terminology that is indefinite and some terminology that is acceptable, and processing of applications in which an applicant fails to respond to such a requirement.

### **718.03 Incomplete Response**

*Extract from 37 C.F.R. §2.65.*

*(a) If an applicant fails to respond, or to respond completely, within six months after the date an action is mailed, the application shall be deemed abandoned unless the refusal or requirement is expressly limited to only certain goods and/or services. If the refusal or requirement is expressly limited to only certain goods and/or services, the application will be abandoned only as to those particular goods and/or services. A timely petition to the Director pursuant to §§ 2.63(b) and 2.146, if appropriate, is a response that avoids abandonment of an application.*

*(b) When action by the applicant filed within the six-month response period is a bona fide attempt to advance the examination of the application and is substantially a complete response to the examiner's action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.*

Under 15 U.S.C. §1062(b) and 37 C.F.R. §2.65(a), an applicant must respond completely to each issue raised in the examining attorney's Office action to avoid abandonment. A response is incomplete if it: (1) does not address one or more of the requirements or refusals made in the Office action; (2) is unsigned; or (3) is signed by an unauthorized person.

*Unsigned Responses.* If a response is unsigned, the examining attorney must obtain a properly signed copy, or a ratification of the unsigned response, before acting on the merits of the response, regardless of whether the Office action was



## PROCEDURE FOR EXAMINING APPLICATIONS

final or nonfinal. The examining attorney should issue an Office action granting the applicant additional time to perfect the response, pursuant to 37 C.F.R. §2.65(b). See TMEP §718.03(b). The applicant must ratify the response through an examiner's amendment, or submit a properly signed copy of the response. See TMEP §712.02. If the applicant fails to ratify the response or submit a properly signed response within the time granted under 37 C.F.R. §2.65(b), the examining attorney should hold the application abandoned for failure to file a complete response. See TMEP §718.03(a).

*Responses Signed by Unauthorized Persons.* If a response is signed by an unauthorized party (e.g., a foreign attorney who is not licensed to practice before the USPTO, or a corporate employee who does not have legal authority to bind the applicant), the examining attorney must obtain a properly signed copy before acting on the merits of the response, regardless of whether the Office action was final or nonfinal. The examining attorney should issue an Office action granting the applicant additional time to perfect the response, pursuant to 37 C.F.R. §2.65(b) (see TMEP §718.03(b)), and send the Office action directly to the applicant. The applicant must submit a response signed by someone with legal authority to bind the applicant (see TMEP §712.01), or by an attorney who is qualified to practice under 37 C.F.R. §10.14 (see TMEP §602). Where a response was signed by an unauthorized party, it is not acceptable for the applicant to ratify the response through an examiner's amendment. See TMEP §712.03. If the applicant fails to submit a properly signed response within the time granted under 37 C.F.R. §2.65(b), the examining attorney should hold the application abandoned for failure to file a complete response. See TMEP §718.03(a).

*Properly Signed but Incomplete Responses to Nonfinal Actions.* When an applicant files an incomplete response to a non-final action (i.e., does not address one or more of the requirements or refusals made in the Office action), the examining attorney should not hold the application abandoned. Instead, the examining attorney has the discretion to (1) issue a final action, if the application is in condition for final action, or (2) grant the applicant additional time to complete the response, if the response meets the requirements of 37 C.F.R. §2.65(b) (see TMEP §718.03(b)). If the application is not in condition for final action, and the response does not meet the requirements of 37 C.F.R. §2.65(b), the examining attorney should issue another nonfinal action, explaining why the response was incomplete, and continuing all outstanding refusals and requirements.

A written disagreement with the examining attorney's refusal or requirement may be a complete response to a nonfinal action with respect to that refusal or requirement.

*Properly Signed but Incomplete Responses to Final Actions.* When an applicant files an incomplete response to a final action, the examining attorney has the discretion to (1) hold the application abandoned for failure to respond completely (see TMEP §718.03(a)), or (2) to grant the applicant additional time to perfect the response if the applicant meets the requirements of 37 C.F.R. §2.65(b) (see TMEP §718.03(b)). See TMEP §715.01 regarding a proper response to a final refusal, and

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

TMEP §715.03(a) regarding the examining attorney's response to an applicant's request for reconsideration of a final Office action.

*Non-Responsive Communications.* An inquiry, a request to extend the response period, or a communication on a matter unrelated to the preceding Office action, should be treated as a non-responsive communication, not as an incomplete response. See TMEP §719 for further information.

See TMEP §717.02 regarding the procedure for handling an applicant's claim that the applicant did not receive the Office action.

### **718.03(a) Holding of Abandonment for Failure to Respond Completely**

The examining attorney should not hold an application abandoned when an applicant files an incomplete response to a nonfinal action. See TMEP §718.03. However, the examining attorney may hold an application abandoned if the applicant files an incomplete response to a final action, and the time for responding to that action has expired. In such cases, the examining attorney should issue a written action, without a six-month response clause (see TMEP §705.08), stating that the application is abandoned, and explaining why. After mailing the action, the examining attorney should abandon the application for failure to file a complete response. See TMEP §718.03(c) regarding an applicant's request for reconsideration of an examining attorney's holding of abandonment for failure to file a complete response, and TMEP §1713 regarding a petition to the Director for review of the examining attorney's holding of abandonment for failure to file a complete response.

If the examining attorney acts on an incomplete response to a final action before the response period has expired, the examining attorney cannot abandon the application. Instead, the examining attorney should issue a written action, without a six-month response clause, explaining why the response is incomplete, and advising the applicant that to avoid abandonment, a proper response must be filed within the period for response to the previous Office action. If there are less than 30 days remaining in the response period, and the response meets the requirements of 37 C.F.R. §2.65(b), the examining attorney has discretion to give the applicant an additional 30 days to perfect the response. See TMEP §718.03(b).

### **718.03(b) Granting Additional Time to Perfect Response**

Under 37 C.F.R. §2.65(b), the examining attorney has discretion to give an applicant additional time to perfect the response if:

- (1) a response was filed within the six-month period;
- (2) the response was a bona fide attempt to advance the examination;

## PROCEDURE FOR EXAMINING APPLICATIONS

- (3) the response was a substantially complete response to the examining attorney's action; and
- (4) consideration of some matter or compliance with some requirement was inadvertently omitted.

If the examining attorney decides that the response meets all four criteria, he or she should write an action explaining why the response is incomplete and granting the applicant 30 days, or to the end of the response period set forth in the action, whichever is longer, to complete the response. The examining attorney should not include a six-month response clause in the action.

If the examining attorney grants the applicant additional time to complete a response under 37 C.F.R. §2.65(b), the time for filing an appeal to the Trademark Trial and Appeal Board (or a petition to the Director under 37 C.F.R. §2.63(b)) is not extended. The applicant must file a notice of appeal (or petition) within six months of the mailing date of the final action. 15 U.S.C. §1062(b); 37 C.F.R. §2.142(a).

If the applicant fails to complete the response within the time granted under 37 C.F.R. §2.65(b), the examining attorney should hold the application abandoned for failure to file a complete response. See TMEP §718.03(a). In this situation, the applicant cannot file a petition to revive under 37 C.F.R. §2.66. The applicant's recourse is to file a petition under 37 C.F.R. §2.146 to reverse the examining attorney's holding of abandonment. See TMEP §1713.

If an applicant does not receive an action granting additional time to complete a response, or if the applicant is unable to respond to the action due to some other extraordinary circumstance, the applicant may file a petition to the Director. If the petition is granted, the action will be remailed and the applicant will have 30 days from the date of the remailed action to perfect the response. This does *not* extend the time for appeal. 15 U.S.C. §1062(b); 37 C.F.R. §2.142(a).

### **718.03(c) Reconsideration of Holding of Abandonment**

If an examining attorney holds an application abandoned for failure to file a complete response, the applicant may file a request for reconsideration of the examining attorney's holding, arguing that the response was not incomplete. While the examining attorney has no authority to act on an application if no response was filed, the examining attorney does have the authority to reverse his or her holding as to whether or not a response received during the statutory period was a complete response. If the examining attorney reverses his or her holding of abandonment for failure to file a complete response, the TRAM System must be updated to withdraw the abandonment and show the correct status of the application.

The applicant may also contact the managing attorney or senior attorney and request review of the examining attorney's action. If the managing attorney or senior

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

attorney believes that the holding of abandonment was improper, he or she will direct the examining attorney to reverse the holding of abandonment.

If the examining attorney does not reverse the holding of abandonment, the applicant may petition the Director to reverse the holding. A petition to reverse a holding of abandonment is not the same as a petition to revive an abandoned application. The Director will reverse the examining attorney's holding of abandonment only if there is clear error or abuse of discretion. The "unintentional delay" standard does not apply. See TMEP §1713.

### **718.04 Failure to File Statement of Use**

Under 15 U.S.C. §1051(d)(4), an application under §1(b) of the Act is abandoned if the applicant fails to timely file a statement of use or request for an extension of time to file a statement of use. 37 C.F.R. §§2.65(c) and 2.88(h); TMEP §§1108.01 and 1109.04.

The ITU Unit will abandon the application if the applicant fails to file a statement of use or request for an extension of time to file a statement of use within six months of the mailing date of the notice of allowance, or within a previously granted extension period. The USPTO will send a computer-generated notice of abandonment to the applicant.

If the failure to timely file the statement of use or extension request was unintentional, the applicant may file a petition to revive under 15 U.S.C. §1051(d)(4) and 37 C.F.R. §2.66. See TMEP §§1714 *et seq.*

### **718.05 Failure to Perfect Appeal**

An application may become abandoned because of withdrawal of, or failure to prosecute, an appeal to the Trademark Trial and Appeal Board. 15 U.S.C. §1062(b); TBMP §1203.02(a); TMEP §1501.

An application may also become abandoned because of failure to perfect an appeal, or dismissal of an appeal, to the Court of Appeals for the Federal Circuit or civil court.

### **718.06 Notice by Office of Abandonment for Failure to Receive a Response**

If no response is received by the USPTO within six months of the mailing date of an Office action, the application is sent to the examining attorney to be abandoned. The examining attorney should check the record to ensure that there is no response and that the Office action was sent to the correspondence address of record. See TMEP §§603 *et seq.* See TMEP §§717 *et seq.* regarding the remailing of an Office action that was sent to the wrong address due to an Office error.

## PROCEDURE FOR EXAMINING APPLICATIONS

An application is considered to be abandoned as of the day after the date on which a response was due, although the examining attorney performs the TRAM transaction that reports the abandonment at a later date. The USPTO sends a computer-generated notice of abandonment to the correspondence address listed in the application file.

Applications that are abandoned after *ex parte* appeals or *inter partes* proceedings are considered abandoned as of the date of the action by the Board that caused the application to abandon (e.g., affirming the examining attorney's refusal or sustaining an opposition). However, the TRAM transaction reporting the abandonment is not performed until a month after expiration of the period for appeal from the Board's decision.

### **718.07            Ordering Abandoned Application Files**

The USPTO destroys abandoned application files and cancelled or expired registration files two years after they become abandoned, cancelled or expired.

Where necessary, USPTO personnel may order abandoned application files through the file ordering system on the USPTO's computer network. See TMEP §109.01 regarding electronic image files that are available to the public on the USPTO website, and TMEP §109.02 regarding the ordering of paper application files by the public.

Paper files should be returned promptly when no longer needed.

Some abandoned application files may be viewed through TICRS, on the premises of the USPTO, or through the Trademark Document Retrieval ("TDR") portal on the USPTO website at <http://www.uspto.gov>.

### **718.08            Revival or Reinstatement of Abandoned Application - New Search Required**

When an abandoned application is revived or reinstated, the examining attorney must conduct a new search of USPTO records for conflicting marks. If the search shows that a later-filed conflicting application has been approved for publication, the examining attorney should request jurisdiction and suspend the later-filed application pending disposition of the earlier-filed (revived) application. 37 C.F.R. §2.83(c); TMEP §§1208.02(c) and 1504.04(a).

If the new search shows that a later-filed conflicting application has been approved for registration, the examining attorney should withdraw the application from issue (if possible) and suspend it. However, if a later-filed conflicting application is already registered, the USPTO is without authority to cancel the registration. The examining attorney must refuse registration of the earlier-filed (revived) application under 15 U.S.C. §1052(d). In this situation, an applicant has the option of filing a petition to cancel the registration under Section 14 of the Trademark Act, 15 U.S.C. §1064.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

See TMEP §§1714 *et seq.* regarding petitions to revive, TMEP §1712.01 regarding reinstatement of applications abandoned due to Office error, and TMEP §1713 regarding petitions to reverse a holding of abandonment.

### **719 Non-Responsive Communications**

An inquiry, a request to extend the response period, or a communication on a matter unrelated to the outstanding Office action, should be treated as a “non-responsive communication,” not as an incomplete response to an outstanding Office action. If the applicant files a non-responsive communication while an Office action is outstanding, the examining attorney should send the applicant a letter acknowledging receipt of the communication, noting that the communication is non-responsive, and advising the applicant that a response to the outstanding Office action must be received within six months of the mailing date to avoid abandonment. The examining attorney should perform the TRAM transaction indicating that an acknowledgment of receipt of a non-responsive communication has been sent to the applicant. If no response to the Office action is received within six months of the mailing date, the application must be abandoned for failure to respond.

### **720 Fraud Upon the Office**

If an examining attorney suspects the possibility of fraud upon the Office in the *ex parte* examination of a trademark application, the following procedure must be followed.

- (1) The examining attorney must bring the matter to the attention of the managing attorney in his or her law office.
- (2) If the managing attorney concurs with the examining attorney as to the possibility of fraud upon the Office, the managing attorney will bring the matter to the attention of the Administrator for Trademark Policy and Procedure.
- (3) If the Administrator believes that the matter warrants further action, he or she will make an appropriate recommendation to the Commissioner for Trademarks.

Under no circumstances should any Office communication pertaining to fraud be made, either orally or in writing, by anyone in the Trademark Examining Operation, except as set forth in paragraphs 1 and 2 above.

These issues are ultimately referred to the Office of Enrollment and Discipline.

# Chapter 800

## Application Requirements

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### **801 Types of Applications**

- 801.01 Single or Combined Application
  - 801.01(a) Single (Single-Class) Application
  - 801.01(b) Combined (Multiple-Class) Application
- 801.02 Principal Register or Supplemental Register
  - 801.02(a) Act of 1946, Principal Register
  - 801.02(b) Act of 1946, Supplemental Register

### **802 Application Form**

### **803 Applicant**

- 803.01 Who May Apply
- 803.02 Name of Applicant
  - 803.02(a) Individual
  - 803.02(b) Partnership, Joint Venture or Other “Firm”
  - 803.02(c) Corporation and Association
- 803.03 Legal Entity of Applicant
  - 803.03(a) Individual or Sole Proprietorship
  - 803.03(b) Partnership, Joint Venture or Other “Firm”
  - 803.03(c) Corporation and Association
  - 803.03(d) Joint Applicants
  - 803.03(e) Trusts, Conservatorships and Estates
    - 803.03(e)(i) Business Trusts
  - 803.03(f) Governmental Bodies and Universities
  - 803.03(g) Banking Institutions
  - 803.03(h) Limited Liability Companies

## **TRADEMARK MANUAL OF EXAMINING PROCEDURE**

803.03(i) Common Terms Designating Entity of Foreign Applicants

803.03(j) Federally Recognized Indian Tribe

803.04 Citizenship of Applicant

803.05 Address of Applicant

803.06 Applicant May Not Be Changed

### **804 Verification and Signature**

804.01 Form and Wording of Verification in §1 or §44 Application

804.01(a) Verification, with Oath

804.01(a)(i) Verification Made in Foreign Country

804.01(b) Declaration in Lieu of Oath

804.02 Averments Required in Verification of Application for Registration - §1 or §44 Application

804.03 Time Between Execution and Filing of Papers - §1 or §44 Application

804.04 Persons Authorized to Sign Verification or Declaration

804.05 Signature of Electronically Transmitted Documents

804.06 Verification of §66(a) Application

### **805 Identification and Classification of Goods and Services**

### **806 Filing Basis**

806.01 Requirements for Establishing a Basis

806.01(a) Use in Commerce - §1(a)

806.01(b) Intent-to-Use - §1(b)

806.01(c) Foreign Priority - §44(d)

806.01(d) Foreign Registration — §44(e)

806.01(e) Extension of Protection of International Registration - §66(a)

806.02 Multiple Bases

806.02(a) Procedure for Asserting More Than One Basis

806.02(b) Applicant May File Under Both §1(a) and §1(b) in a Single Application

806.02(c) Examination of Specimens of Use in a Multi-Basis Application



## APPLICATION REQUIREMENTS

- 806.02(d) Abandonment of Multi-Basis Applications
- 806.02(e) Allegation of Bona Fide Intention to Use Mark in Commerce Even if Application is Based on Both §44 and §1
- 806.02(f) Section 44(d) Combined With Other Bases
- 806.02(g) Not Necessary to Repeat Allegation of Bona Fide Intention to Use Mark in Commerce in Multi-Basis Application
- 806.03 Amendments to Add or Substitute a Basis
  - 806.03(a) When Basis Can be Changed
  - 806.03(b) Applicant May Add or Substitute a §44(d) Basis Only Within Six-Month Priority Period
  - 806.03(c) Amendment From §1(a) to §1(b)
  - 806.03(d) Amendment From §44 to §1(b)
  - 806.03(e) Allegation of Use Required to Amend From §1(b) to §1(a)
  - 806.03(f) Use in Commerce as of Application Filing Date Required to Add or Substitute §1(a) as a Basis in §44 Application
  - 806.03(g) Amendment From §1(b) to §44
  - 806.03(h) Effect of Substitution of Basis on Application Filing Date
  - 806.03(i) Verification of Amendment Required
  - 806.03(j) Petition to Amend Basis After Publication - §1 or §44 Application
    - 806.03(j)(i) Amending the Basis of a §1(b) Application After Publication But Before Issuance of Notice of Allowance
    - 806.03(j)(ii) Amending the Basis of a §1(b) Application Between Issuance of Notice of Allowance and Filing of Statement of Use
  - 806.03(k) Basis Cannot be Changed in §66(a) Application
- 806.04 Deleting a Basis
  - 806.04(a) Deletion of §1(b) Basis After Publication or Issuance of the Notice of Allowance
  - 806.04(b) Retention of §44(d) Priority Filing Date Without Perfecting §44(e) Basis
- 806.05 Review of Basis Prior to Publication or Issue

## 807 Drawing

- 807.01 Drawing Must Show Only One Mark

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- 807.02 Drawing Must Be Limited to Mark
- 807.03 Standard Character Drawings
  - 807.03(a) Requirements for Standard Character Drawings
  - 807.03(b) List of Standard Characters
  - 807.03(c) Drawings Containing Both a Standard Character Claim and Designs or Other Elements
  - 807.03(d) Changing From Special Form Elements to Standard Characters, or the Reverse, May be a Material Alteration
  - 807.03(e) Standard Character Drawing and Specimen of Use
  - 807.03(f) Standard Character Drawing and Foreign Registration
  - 807.03(g) Drawings in “Typed” Format With No Standard Character Claim
  - 807.03(h) Drawings Where The Format Is Unclear
  - 807.03(i) Drawings in Applications Filed Before November 2, 2003
- 807.04 Special Form Drawings
  - 807.04(a) Characteristics of Special Form Drawings
  - 807.04(b) When Special Form Drawing is Required
- 807.05 Electronically Submitted Drawings
  - 807.05(a) Standard Character Drawings Submitted Electronically
    - 807.05(a)(i) Long Marks in Standard Character Drawings
  - 807.05(b) Special Form Drawings Submitted Electronically
  - 807.05(c) Requirements for Digitized Images
- 807.06 Paper Drawings
  - 807.06(a) Type of Paper and Size of Mark
  - 807.06(b) Long Marks in Standard Character or Typed Drawings
  - 807.06(c) Separate Drawing Page Preferred
- 807.07 Color in the Mark
  - 807.07(a) Requirements for Color Drawings
    - 807.07(a)(i) Color Must Be Claimed as a Feature of the Mark
    - 807.07(a)(ii) Applicant Must Name and Describe Colors

## **APPLICATION REQUIREMENTS**

- 807.07(b) Color Drawings Filed Without a Color Claim
- 807.07(c) Color Drawings Filed With an Incorrect Color Claim
- 807.07(d) Black and White Drawings and Color Claims
- 807.07(e) Gray Tones in Drawings
- 807.07(f) Drawings in Applications Filed Before November 2, 2003
- 807.08 Broken Lines to Show Placement
- 807.09 "Drawing" of Sound, Scent, or Non-Visual Mark
- 807.10 Three Dimensional Marks
- 807.11 Marks With Motion
- 807.12 Mark on Drawing Must Agree with Mark on Specimen or Foreign Registration
  - 807.12(a) Applications Under §1 of the Trademark Act
  - 807.12(b) Applications Under §44 of the Trademark Act
  - 807.12(c) Applications Under §66(a) of the Trademark Act
  - 807.12(d) Mutilation or Incomplete Representation of Mark
  - 807.12(e) Compound Word Marks and Telescoped Marks
- 807.13 Amendment of Mark
  - 807.13(a) Amendment of Mark in Applications Under §§1 and 44
  - 807.13(b) Mark in §66(a) Application Cannot be Amended
- 807.14 Material Alteration of Mark
  - 807.14(a) Removal or Deletion of Matter from Drawing
  - 807.14(b) Addition or Deletion of Previously Registered Matter
  - 807.14(c) Amendments to Correct "Internal Inconsistencies"
  - 807.14(d) Material Alteration: Case References
- 807.15 Substitute Drawings
- 807.16 Amendment of Drawings by the Office
- 807.17 Procedures for Processing Unacceptable Amendments to Drawings
- 807.18 Mark Drawing Code
- 807.19 Use of Old Drawing in New Application

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **808 Description of Mark**

808.01 Guidelines for Requiring Description

808.01(a) Letters and Numerals

808.01(b) Designs or Figurative Elements

808.01(c) Meaning of Term in Mark

808.01(d) Lining and Stippling Statements for Drawings

808.02 Description Must Be Accurate and Concise

808.03 Printing Description of Mark

### **809 Translation and Transliteration of Non-English Wording in Mark**

809.01 Equivalency in Translation

809.02 Printing of Translations and Transliterations

### **810 Filing Fee**

810.01 Collection of Fees for Multiple Classes

810.02 Refunds

### **811 Designation of Domestic Representative**

### **812 Identification of Prior Registrations of Applicant**

812.01 Proving Ownership of Prior Registrations

### **813 Consent to Register by Living Individual Depicted in Mark**

### **814 Requesting Additional Information**

### **815 Supplemental Register, Application Filed on**

815.01 Marks Eligible for Principal Register Not Registrable on Supplemental Register

815.02 Elements Required

815.03 Examining Attorney Approves Mark for Issue

815.04 Filing on Supplemental Register is Not an Admission That the Mark Has Not Acquired Distinctiveness

815.05 Basis for Refusal of Registration of Matter That is Incapable

### **816 Supplemental Register, Amending Application to**

816.01 How to Amend

## APPLICATION REQUIREMENTS

- 816.02 Effective Filing Date
- 816.03 Amendment to Different Register
- 816.04 Amendment After Refusal
- 816.05 Amendment After Decision on Appeal

### **817 Preparation of Case for Publication or Registration**

### **818 Application Checklist**

#### **801 Types of Applications**

The term “type of application” refers to the kind of application by which registration is requested, *e.g.*, whether the application is a single-class application or a multiple-class application, or whether registration is sought on the Principal Register or on the Supplemental Register.

See TMEP Chapter 1300 regarding the examination of applications for different types of marks.

##### **801.01 Single or Combined Application**

###### **801.01(a) Single (Single-Class) Application**

A single-class application limits the goods or services for which registration is sought to goods or services in one of the classes in the classification schedules. The application may recite more than one item if the items recited are all classified in one class. See TMEP §§1401 *et seq.* for additional information about classification.

###### **801.01(b) Combined (Multiple-Class) Application**

A combined or multiple-class application is an application to register the mark for items classified in two or more classes. The applicant must pay a filing fee for each class. The class numbers and corresponding goods or services must be listed separately, from the lowest to the highest number.

See TMEP §§1403 *et seq.* for further information about combined applications.

##### **801.02 Principal Register or Supplemental Register**

###### **801.02(a) Act of 1946, Principal Register**

The primary provision for registration in the Trademark Act of 1946 is for registration on the Principal Register (15 U.S.C. §§1051 through 1072). When a mark has been registered on the Principal Register, the mark is entitled to all the rights provided by

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

the Act. The advantages of owning a registration on the Principal Register include the following:

- Constructive notice to the public of the registrant's claim of ownership of the mark (15 U.S.C. §1072);
- A legal presumption of the registrant's ownership of the mark and the registrant's exclusive right to use the mark nationwide on or in connection with the goods/services listed in the registration (15 U.S.C. §§1057(b) and 1115(a));
- A date of constructive use of the mark as of the filing date of the application (15 U.S.C. §1057(c); TMEP §201.02.);
- The ability to bring an action concerning the mark in federal court (15 U.S.C. §1121);
- The ability to file the U.S. registration with the U.S. Customs Service to prevent importation of infringing foreign goods (15 U.S.C. §1124);
- The registrant's exclusive right to use a mark in commerce on or in connection with the goods or services covered by the registration can become "incontestable," subject to certain statutory defenses (15 U.S.C. §§1065 and 1115(b)); and
- The use of the U.S. registration as a basis to obtain registration in foreign countries.

If the applicant seeks registration on the Principal Register, the application should state that registration is requested on the Principal Register. However, if the applicant does not specify a register, the United States Patent and Trademark Office ("USPTO") will presume that the applicant seeks registration on the Principal Register.

### **801.02(b) Act of 1946, Supplemental Register**

Certain marks that are not eligible for registration on the Principal Register, but are capable of distinguishing an applicant's goods or services, may be registered on the Supplemental Register. Sections 23 through 28 of the Trademark Act, 15 U.S.C. §§1091 through 1096, provide for registration on the Supplemental Register. This is a continuation of the register provided for in the Act of March 19, 1920. Marks registered on the Supplemental Register are excluded from receiving the advantages of certain sections of the Act of 1946. The excluded sections are listed in §26 of the Act, 15 U.S.C. §1094.

If the applicant seeks registration on the Supplemental Register, the application should state that registration is requested on the Supplemental Register. If no register is specified, the USPTO will presume that the applicant seeks registration on the Principal Register.

See TMEP §§815 and 816 *et seq.* regarding examination procedure relating to the Supplemental Register.

## APPLICATION REQUIREMENTS

An applicant may not seek registration on both the Principal and the Supplemental Register in the same application. If an applicant requests registration on both the Principal and the Supplemental Register in the same application, the examining attorney must require that the applicant amend to specify only one register, or file a request to divide under 37 C.F.R. §2.87.

A mark in an application under §66(a) of the Trademark Act, 15 U.S.C. §1141f(a), based on a request for extension of protection of an international registration to the United States, cannot be registered on the Supplemental Register. 15 U.S.C. §1141h(a)(4); 37 C.F.R. §§2.47(c) and 2.75(c).

### **802 Application Form**

Applications under §66(a) of the Trademark Act will be sent to the USPTO electronically by the International Bureau of the World Intellectual Property Organization (“IB”).

The USPTO prefers that applicants file applications under §1 or §44 of the Trademark Act through the Trademark Electronic Application System (“TEAS”), available at <http://www.uspto.gov>, or on the USPTO’s pre-printed scannable form. The applicant may obtain the USPTO’s form by calling the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199.

Trademark applications may not be filed by facsimile (“fax”) transmission. 37 C.F.R. §2.195(d)(1); TMEP §306.01.

The USPTO strongly discourages self-created forms, but will accept them if they meet the requirements for receipt of a filing date set forth in 37 C.F.R. §2.21(a) (see TMEP §202). If a self-created form is used, the application should be on letter size (*i.e.*, 8½ inches (21.6 cm.) by 11 inches (27.9 cm.)) paper, typewritten, double spaced, with margins of at least 1½ inches (3.8 cm.) at the left and top of the pages. The application should be written on only one side of the paper.

The application must be in the English language. 37 C.F.R. §2.32(a).

The USPTO does not generally require the submission of original documents, so the applicant may file a copy of a signed application. 37 C.F.R. §2.193(c)(1)(ii); TMEP §302.01.

### **803 Applicant**

#### **803.01 Who May Apply**

An application to register a mark must be filed by the owner of the mark or, in the case of an intent-to-use application under 15 U.S.C. §1051(b), by the person who is entitled to use the mark in commerce. Normally the owner of a mark is the person who applies the mark to goods that he or she produces, or uses the mark in the sale

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

or advertising of services that he or she performs. See TMEP §§1201 *et seq.* regarding ownership, and TMEP §§501 and 502 *et seq.* regarding changes of ownership.

If an applicant is not the owner of (or entitled to use) the mark at the time the application is filed, the application is void and cannot be amended to specify the correct party as the applicant, because the applicant did not have a right that could be assigned. 37 C.F.R. §2.71(d). See TMEP §803.06 and cases cited therein.

Applicants may be natural persons or juristic persons. Juristic persons include corporations, partnerships, joint ventures, unions, associations and other organizations capable of suing and being sued in a court of law. 15 U.S.C. §1127. An operating division, or the like, that is merely an organizational unit of a company and not a legal entity that can sue and be sued, may not own or apply to register a mark. See TMEP §1201.02(d).

Nations, states, municipalities, and other related types of bodies operating with governmental authorization may apply to register marks that they own. See *NASA v. Record Chemical Co. Inc.*, 185 USPQ 563 (TTAB 1975); *In re U.S. Department of the Interior*, 142 USPQ 506 (TTAB 1964).

The question of whether an application can be filed in the name of a minor depends on state law. If the minor can validly enter into binding legal obligations in the state in which he or she is domiciled, then the application may be filed in the name of the minor. Otherwise, the application should be filed in the name of a parent or legal guardian, clearly setting forth their status as a parent or legal guardian. If the record indicates that an application has been filed in the name of a minor, the examining attorney should inquire as to whether the person can validly enter into binding legal obligations under the law of the state in which he or she is domiciled, and require correction of the entity statement, if necessary.

See TMEP Chapter 500 regarding assignments, name changes, and issuance of a registration in the name of an assignee or in an applicant's new name.

See *also* TMEP §§1002 *et seq.* regarding eligibility to file an application under §44 of the Trademark Act, 15 U.S.C. §1126, and TMEP §1901 regarding eligibility to file a request for an extension of protection of an international registration to the United States under §66(a) of the Act, 15 U.S.C. §1141f(a).

### **803.02 Name of Applicant**

The name of the applicant should be set out in its correct legal form. For example, a corporate applicant should be identified by the name set forth in the articles of incorporation.

If the applicant's legal name includes the assumed name under which it does business, an assumed name designation should be used to connect the actual name



## APPLICATION REQUIREMENTS

with the assumed name. Assumed name designations include “d.b.a.” (doing business as), “a.k.a.” (also known as), and “t.a.” (trading as). The particular assumed name designation used is optional. Only the abbreviation of the assumed name designation will be printed in the *Official Gazette* and on the certificate of registration. If an applicant gives the assumed name designation in full, the abbreviation will automatically be used for printing purposes.

### **803.02(a) Individual**

If the applicant is an individual person who is doing business under an assumed business name, the individual’s name should be set forth, followed by an assumed name designation (e.g., d.b.a., a.k.a., or t.a.) and by the assumed business name.

If an individual indicates that he or she is doing business under a corporate designation (e.g., Corporation, Corp., Incorporated, Inc., Limited, Ltd.), the USPTO will presume that relevant state law permits such a practice. The assumed name will be printed on the registration certificate.

If the record is ambiguous as to whether a corporation or an individual owns the mark, the examining attorney must require the applicant to clarify the record regarding ownership. However, in view of the broad definition of a “person properly authorized to sign on behalf of an applicant” in 37 C.F.R. §2.33(a) (see TMEP §804.04), the fact that the title of the person signing an application refers to a different entity is not in itself considered an ambiguity that would warrant an inquiry as to who owns the mark.

See TMEP §803.03(a) for information about identifying an individual applicant’s entity.

See TMEP §§803.06 and 1201.02(c) regarding Office policies regarding correction of an applicant’s name and entity.

### **803.02(b) Partnership, Joint Venture or Other “Firm”**

If a partnership, joint venture, or other “firm” has been organized under a particular business name, the application should be filed in that name. If the partnership or firm has not been organized under a business name, then the names of the members should be listed as though they composed a company name. If a partnership or joint venture is doing business under an assumed name, this may be indicated, using an assumed name designation. See TMEP §803.02 regarding assumed name designations.

See TMEP §803.03(b) for information about identifying a partnership or joint venture as a legal entity.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **803.02(c) Corporation and Association**

If the applicant is a corporation, the official corporate name must be set out as the applicant's name. Listing an assumed business name is optional. The name of a division of the applicant should *not* be included in or along with the applicant's name. If the applicant wishes to indicate in the application that actual use of the mark is being made by a division of the applicant, the applicant may provide a statement that "the applicant, *through its division* [specify name of division], is using the mark in commerce." This statement should not appear in the preamble in conjunction with the listing of the applicant's name, and will not be printed on the registration certificate.

In unusual situations, one corporation may also be doing business under another name, even another corporate name. This sometimes happens, for example, when one corporation buys out another. In the unusual situation where a corporate applicant provides a DBA that includes a corporate designation (*e.g.*, Corporation, Corp., Incorporated, Inc., Limited, Ltd.) in addition to its official corporate name, the USPTO will presume that relevant state law permits such a practice. The DBA will be printed on the registration certificate.

Associations should be identified by the full, official name of the association.

See TMEP §803.03(c) for information about identifying a corporation or association as a legal entity.

### **803.03 Legal Entity of Applicant**

Immediately after the applicant's name, the application should set out the applicant's form of business, or legal entity, such as partnership, joint venture, corporation, or association. The words "company" and "firm" are indefinite for purposes of designating an applicant's legal entity, because those words do not identify a particular type of legal entity in the United States. (However, the word "company" is acceptable to identify entities organized under the laws of foreign countries that are equivalent or analogous to United States corporations or associations. See TMEP §803.03(i).)

Whether the Office will accept the identification of an applicant's entity depends on whether that entity is recognized by the applicant's state of domicile.

If other material in the record shows a different type of entity than is set out in the written application, the examining attorney should ask for an explanation, and require amendment if necessary. However, in view of the broad definition of a "person properly authorized to sign on behalf of an applicant" in 37 C.F.R. §2.33(a) (see TMEP §804.04), no explanation is usually required merely because the person signing a declaration has a title that refers to a different type of entity. See TMEP §§803.06 and 1201.02(c) regarding Office policies governing correction of an applicant's name.

## APPLICATION REQUIREMENTS

### **803.03(a) Individual or Sole Proprietorship**

For an individual, it is not necessary to specify “individual,” but it is acceptable to do so. The applicant may state that he or she is doing business under a specified assumed company name. TMEP §803.02.

An applicant may identify itself as a sole proprietorship. If an applicant does so, the applicant must also indicate the state where the sole proprietorship is organized, in addition to the name and citizenship of the sole proprietor.

If the application specifically identifies the applicant as a sole proprietorship and indicates the state of organization of the sole proprietorship and the name and citizenship of the sole proprietor, the USPTO will accept the characterization of the entity without further action. On the other hand, if the application refers to a sole proprietorship but lacks some of the necessary information or is ambiguous as to whether the applicant should be identified as a sole proprietorship or as an individual, the examining attorney must require appropriate clarification of the entity type.

### **803.03(b) Partnership, Joint Venture or Other “Firm”**

The application of a partnership or a joint venture, after setting forth the applicant’s name and entity, should specify the state or country under whose laws the partnership or joint venture is organized. 37 C.F.R. §2.32(a)(3)(ii). In addition, the applicant should set forth the names, legal entities, and national citizenship (or the state or country of organization) of all general partners or active members that compose the partnership or joint venture. 37 C.F.R. §2.32(a)(3)(iii). These requirements apply to both general and limited partnerships. They also apply to a partnership that is a general partner in a larger partnership. Limited partners or silent or inactive partners need not be listed. The following format should be used:

“ \_\_\_\_\_, a (partnership, joint venture) organized under the laws of \_\_\_\_\_, composed of \_\_\_\_\_.”

In the case of a partnership consisting of ten or more general partners, if the partnership agreement provides for the continuing existence of the partnership in the event of the addition or departure of specific partners, the Office will require that the applicant provide the names, legal entities, and national citizenship (or the state or country of organization) of the principal partners only. If the principal partners exceed ten, the applicant need list only the first ten principal partners. If there is no class of principal partners, the applicant may list any ten general partners.

Upon death or dissolution of a partner or other change in the members that compose a partnership, that legal entity ceases to exist and any subsequent arrangement constitutes a new entity, unless the partnership agreement provides for continuation of the partnership in the event of changes in partners. This same principle also applies to joint ventures. See TMEP Chapter 500 regarding changes of ownership.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The term “firm” is not an acceptable designation of the applicant’s entity because it does not have a universally understood meaning. The examining attorney should require a definite term such as “partnership” or “joint venture” when it is necessary to identify these entities.

### **803.03(c) Corporation and Association**

In the United States, the term “corporation” is proper for juristic entities that are incorporated under the laws of the various states or under special federal statutes. Likewise, “association” is a proper term for juristic entities organized under state laws or federal statutes that govern this form of organization. The term “company” is indefinite for describing a United States entity because it does not have a specific meaning as indicating a particular type of entity, but is acceptable to identify entities organized under the laws of foreign countries that are equivalent or analogous to United States corporations or associations. See TMEP §803.03(i) regarding foreign companies.

In addition to specifying that an applicant is a corporation, the application must specify the applicant’s state or country of incorporation. It is customary to follow the applicant’s name by the words “a corporation of the state (or country) of . . . .” This also applies to a nonprofit or tax-exempt corporation. If no state or country of incorporation is given for an applicant corporation, or the incorrect state or country of incorporation is given, this defect may be corrected by amendment. The amendment does not have to be verified.

For an association, the application must specify the state or country under whose laws the applicant is organized or exists. The applicant should also indicate whether the association is incorporated or unincorporated. If a corporation or association exists by virtue of a specific state or federal statute, this should be stated. Verification is not required.

### **803.03(d) Joint Applicants**

An application may be filed in the name of joint applicants or joint owners. *Ex parte Pacific Intermountain Express Co.*, 111 USPQ 187 (Comm’r Pats. 1956); *Ex parte Edward Taylor and Isabelle Stone Taylor doing business as Baby’s Spray-Tray Co.*, 18 USPQ 292 (Comm’r Pats. 1933).

An application by joint applicants must be verified by all the applicants, since they are individual parties and not a single entity. However, if only one of the joint applicants signs the verification, the Office will presume that he or she is signing on behalf of all the joint applicants, and will not require an additional verification or declaration unless there is evidence in the record indicating that the party who signed the application was not in fact authorized to sign on behalf of all the joint applicants under 37 C.F.R. §2.33(a). See TMEP §804.04 regarding persons authorized to sign a verification on behalf of an applicant, and TMEP §712.01(a)(i)

## APPLICATION REQUIREMENTS

regarding the proper party to sign a response to an Office action filed by joint applicants who are not represented by an attorney.

Joint applicants are not the same as a joint venture. A joint venture is a single applicant, in the same way that a partnership is a single applicant. See TMEP §803.03(b) regarding joint ventures.

### **803.03(e) Trusts, Conservatorships and Estates**

If a trust is the owner of a mark in an application, the examining attorney must ensure that the trustee(s) is identified as the applicant. Thus, the examining attorney should require that the trust's application be captioned as follows:

The Trustees of the XYZ Trust, a California trust, the trustees comprising John Doe, a U.S. citizen, and the ABC Corporation, a Delaware corporation.

The application must first refer to the trustee(s) as the applicant and indicate the name of the trust, if any. Then the state under whose laws the trust exists must be set forth. Finally, the names and citizenship of the individual trustees must be listed.

The same format generally applies to conservatorships and estates as follows:

The Conservator of Mary Jones, a New York conservatorship, the conservator comprising James Abel, a U.S. citizen.

The Executors of the John Smith estate, a New York estate, the executors comprising Mary Smith and James Smith, U.S. citizens.

### **803.03(e)(i) Business Trusts**

Most states recognize an entity commonly identified as a "business trust," "Massachusetts trust," or "common-law trust." A business trust has attributes of both a corporation and a partnership. Many states have codified laws recognizing and regulating business trusts; other states apply common law. The Office must accept the entity designation "business trust," or any appropriate variation provided for under relevant state law.

The business trust is created under the instructions of the instrument of trust. Generally, the "trustee" has authority equivalent to an officer in a corporation. Laws vary to some extent as to the authority conferred on various individuals associated with the business trust.

The application must first refer to the trustee(s) as the applicant and indicate the name of the trust, if any. The state under whose laws the trust exists, and the names and citizenship (or state of incorporation or organization) of the individual

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

trustees, must also be set forth. Accordingly, the examining attorney should require that the business trust's application be captioned as follows:

The Trustees of the DDT Trust, a California business trust, the trustees comprising Sue Smith, a U.S. citizen, and the PDQ Corporation, a Delaware corporation.

For the purpose of service of process, the business trust is essentially like a corporation. Therefore, it is not necessary to identify the beneficiaries or equitable owners of the business trust in identifying the entity.

### **803.03(f) Governmental Bodies and Universities**

It is difficult to establish any rigid guidelines for designating the entity of a governmental body. Due to the variety in the form of these entities, the examining attorney must consider each case on an individual basis. The following are just a few examples of acceptable governmental entities.

Department of the Air Force, an agency of the United States.

Maryland State Lottery Agency, an agency of the State of Maryland.

City of Richmond, Virginia, a municipal corporation organized under the laws of the Commonwealth of Virginia.

These examples are not exhaustive of the entity designations that are acceptable.

The structure of educational institutions varies significantly. The following are examples of acceptable university entities:

Board of Regents, University of Texas System, a Texas governing body.

University of New Hampshire, a nonprofit corporation of New Hampshire.

Again, these examples are not exhaustive of the entity designations that are acceptable.

### **803.03(g) Banking Institutions**

The nature of banking institutions is strictly regulated and, thus, there are a limited number of types of banking entities. Some banking institutions are federally chartered while others are organized under state law. The following are examples of acceptable descriptions of banking institutions:

First American Bank of Virginia, a Virginia corporation.

## APPLICATION REQUIREMENTS

Pathway Financial, a federally chartered savings and loan association.

This is not an exhaustive listing of acceptable entity designations.

### **803.03(h) Limited Liability Companies**

Most of the states have amended their laws to recognize an entity commonly identified as a “limited liability company.” The entity has attributes of both a corporation and a partnership. Therefore, the Office must accept the entity designation “limited liability company,” or any appropriate variation provided for under relevant state law. The applicant should indicate the state under whose laws the limited liability company is established. For the purpose of service of process, the limited liability company is like a corporation. Therefore, it is not necessary to list the “members” or owners of the limited liability company when identifying the entity.

See TMEP §712.01(a)(vii) regarding the proper party to sign a response to an Office action filed by a limited liability company that is not represented by an attorney.

### **803.03(i) Common Terms Designating Entity of Foreign Applicants**

In designating the legal entity of foreign applicants, acceptable terminology is not always the same as for United States applicants. The word “corporation” as used in the United States is not necessarily equivalent to juristic entities of foreign countries; the word “company” is sometimes more accurate. If the applicant is from the United Kingdom or another commonwealth country (e.g., Canada or Australia) and the term “company” is used, no inquiry is needed. In any other case, the examining attorney must clarify what type of entity is applying.

A statement of the accepted foreign designation (or an abbreviation therefor) of the legal entity of a foreign applicant is sufficient. The applicant may specify the legal entity by indicating the entity that would be its equivalent in the United States, but is not required to do so. The examining attorney should inquire further into the specific nature of a foreign legal entity if it is not clear that it is in fact a designation of legal entity in the particular country. The examining attorney may request a description of the nature of the foreign entity, if necessary.

Listed below are common terms used by several foreign countries to identify commercial entities.

#### *France*

A “Société anonyme” (S.A.) is a joint stock company whose capital is divided into shares. An S.A. is similar to a corporation.

A “Société a responsabilité limitée” (S.A.R.L.) is a limited liability company. The S.A.R.L. is analogous to a small closely held American corporation.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

A “Société en nom collectif” is a general partnership. Each partner represents the firm and their liability is unlimited.

A “Société en commandite simple” is a special partnership very similar to an American limited partnership.

A “Société en commandite par actions” is a special partnership by shares and occupies a position between a limited partnership (société en commandite simple) and corporation (société anonyme).

A Société par actions simplifiée (SAS) is a simplified stock company with limited liability, which has the legal status of a corporation, with a more flexible structure for management and administration than the S.A.

### *Germany*

The “Aktiengesellschaft” (A.G.) is a joint stock company, which can also be loosely described as a corporation.

The “Gesellschaft mit beschränkter Haftung” (G.m.b.H.) is a company with limited liability.

The “Kommanditgesellschaft” (K.G.) is a limited partnership whose entity survives even though the partners might change. It is not necessary to list the names of the partners.

The “Offene Handelsgesellschaft” (O.H.G.) is a type of German partnership that is comparable to a United States partnership. Thus, all relevant information with respect to the partnership must be provided.

German law permits a business to be conducted by an individual with the assets of the business held by the “company” in the name of the company, not by the proprietor as an individual. This form of business is generally referred to as a “Firma.” However, “Firma” is a broad term that may also connote other situations and the examining attorney should ascertain, if there is any doubt, that a sole proprietorship form of business is intended when the term “Firma” is used.

The “Stiftung” is a foundation having some attributes of a corporation but being more in the nature of a trust. It is governed by a Board of Management, two members of which are denominated Mandatory and Deputy Mandatory. See *Carl Zeiss Stiftung v. VEB Carl Zeiss Jena*, 433 F.2d 686, 167 USPQ 641, 642 n.6 (2d Cir. 1970), cert. denied, 403 U.S. 905, 170 USPQ 1 (1971).

### *Italy*

A “Societa per azioni” is analogous to an American corporation.



## APPLICATION REQUIREMENTS

A “Societa a responsabilita limitata” is the equivalent of a joint stock company with limited liability.

A “Societa in nome collettivo” is a general partnership whose members have unlimited liability for all its obligations.

A “Societa semplice” is a simple partnership. This form of partnership need not be made public as long as there is an agreement between the partners.

“Societa cooperativa” is a cooperative society. This type of entity may be incorporated with either limited or unlimited liability, but the society’s name must bear a qualification as to whether it is a limited or unlimited cooperative.

### *Japan*

A “Kabushiki Kaisha” most closely resembles a United States joint stock corporation. This type of entity is incorporated and will issue shares.

A “Yugen Kaisha” is similar to a United States closely held corporation. It is a small corporation that may not surpass certain specified capitalization or numbers of members.

A “Gomer Kaisha” is an entity that is established by formal legal documents. However, all members are jointly and severally liable for the obligations of the firm in the event of bankruptcy, similar to a United States partnership.

A “Goshi Kaisha” is similar to the “Gomer Kaisha” listed above. It differs to the extent that members may have either unlimited or limited liability for the corporate obligations.

### *Spain*

A “Sociedad regular colectiva” is a regular collective company and is similar to an American partnership.

A “Sociedad de responsabilidad limitada” is a limited liability company and may be identified as a joint stock company with limited liability.

A “Sociedad anonima” is a joint stock corporation and may be identified as a corporation.

### *United Kingdom and Other Commonwealth Countries*

The word “company” is commonly used in the United Kingdom to identify juristic entities (similar to United States corporations) organized under the law of that country, and thus the word “company” is an acceptable entity designation for applicants from that country.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The same is true for other Commonwealth countries, such as Canada and Australia.

There are two types of limited liability companies in Great Britain: (1) public limited companies, which would be indicated by using “PLC,” “plc” or “Public Limited Company;” and (2) private limited companies that use the designation “Limited” or “Ltd.” A public limited company in Wales uses the designation “Cwmni & Cyfyngedig Cyhoeddus” or “CCC.”

### **803.03(j) Federally Recognized Indian Tribe**

A federally recognized Indian tribe, organized under the laws of the United States, is an acceptable designation of an applicant’s entity.

### **803.04 Citizenship of Applicant**

Under 37 C.F.R. §2.32(a)(3), an application for registration must specify the applicant’s citizenship or the state or nation under whose laws the applicant is organized. If ambiguous terms such as “American” are used, the examining attorney must require the applicant to clarify the record by setting forth the required information with greater specificity (e.g., “United States”).

An individual applicant should set forth the country of which he or she is a citizen. Current citizenship information must be provided; a statement indicating that the applicant has applied for citizenship in any country is not relevant or acceptable. If an individual is not a citizen of any country, a statement to this effect is acceptable.

If an applicant asserts dual citizenship, the applicant must choose which citizenship will be printed in the *Official Gazette* and on the registration certificate. It is Office policy to print only one country of citizenship for each person in the *Official Gazette* and on the registration certificate, and the automated records of the Office will indicate only one country of citizenship for each person.

For a corporation, the application must set forth the state or country of incorporation. 37 C.F.R. §2.32(a)(3)(ii).

For an association, the application must set forth the state or country under whose laws the association is organized or incorporated. 37 C.F.R. §2.32(a)(3)(ii).

For a partnership or other firm, the application must set forth the state or country under which the partnership is organized, and provide citizenship information for each general partner in the partnership or active member in the firm. 37 C.F.R. §2.32(a)(3)(iii). This requirement also applies to a partnership that is a general partner in a larger partnership. See TMEP §803.03(b) for the proper format for identifying a partnership.

For joint applicants or a joint venture, the application should set forth the citizenship or state or country of organization of each party.

## APPLICATION REQUIREMENTS

### 803.05 Address of Applicant

The written application must specify the applicant's address. 37 C.F.R. §2.32(a)(4). Addresses should include United States post office ZIP code numbers or their foreign equivalents. The applicant's address may include a post office box.

For an individual, the application must set forth either the business address or the residence address.

If the application sets out more than one address, the applicant should designate the address to be included on the registration certificate.

For a partnership or other firm, only the address of the business need be set forth -- not the addresses of the partners or members.

For a corporation or association, the business address should be set forth. If the corporation's business address is not in its state of incorporation, the applicant should set out the address where the applicant is domiciled.

For joint applicants, the application should include addresses for each party.

The application must also include an address for correspondence concerning the application. See 37 C.F.R. §§2.18 and 2.21(a)(2). This is referred to as the correspondence address. See TMEP §§603 *et seq.*

### 803.06 Applicant May Not Be Changed

While an application can be amended to correct an inadvertent error in the manner in which an applicant's name is set forth (see TMEP §1201.02(c)), an application cannot be amended to substitute another entity as the applicant. If the application was filed in the name of a party who had no basis for his or her assertion of ownership of (or entitlement to use) the mark as of the filing date, the application is *void*, and registration must be refused. 37 C.F.R. §2.71(d); TMEP §1201.02(b). *Huang v. Tzu Wei Chen Food Co. Ltd.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988); *American Forests v. Sanders*, 54 USPQ2d 1860 (TTAB 1999), *aff'd*, 232 F.3d 907 (Fed. Cir. 2000); *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689 (TTAB 1991); *In re Lettmann*, 183 USPQ 369 (TTAB 1974); *Dunleavy v. Koepfel Steel Products, Inc.*, 114 USPQ 43 (Comm'r Pats. 1957), *aff'd*, 328 F.2d 939, 140 USPQ 582 (C.C.P.A. 1964); *Richardson Corp. v. Richardson*, 51 USPQ 144 (Comm'r Pats. 1941); *Celanese Corporation of America v. Edwin Crutcher*, 35 USPQ 98 (Comm'r Pats. 1937). The Office will not refund the application filing fee in such a case.

A void application cannot be cured by amendment or assignment. The true owner may file another application (including a filing fee) in its name or, if the applicant who is refused later becomes the owner of the mark, he or she may file another application (including a filing fee) at that time.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

See TMEP §1201.02(c) for examples of correctable and non-correctable errors in identifying the applicant, and TMEP §1201.02(e) and TMEP Chapter 500 regarding the situation in which the true owner of a mark files an application and transfers ownership to another party *after* the filing date.

### **804 Verification and Signature**

An application must include a statement that is verified by the applicant. 15 U.S.C. §§1051(a)(3) and 1051(b)(3); 37 C.F.R. §2.32(b).

In applications under application under §1 or §44 of the Trademark Act, a signed verification is not required for receipt of an application filing date under 37 C.F.R. §2.21(a). If the initial application does not include a proper verified statement, the examining attorney must require the applicant to submit a verified statement that relates back to the original filing date. See TMEP §§804.01 *et seq.* regarding the form of the oath or declaration, TMEP §804.02 regarding the essential allegations required to verify an application for registration of a mark, and TMEP §804.04 regarding persons properly authorized to sign a verification on behalf of an applicant.

In §66(a) applications, the verified statement is part of the international registration on file at the IB. 37 C.F.R. §2.33(e). See TMEP §804.06.

#### **804.01 Form and Wording of Verification in §1 or §44 Application**

The format of the verification in an application under §1 or §44 of the Trademark Act may be: (1) the classical form for verifying, which includes an oath (jurat) (see TMEP §804.01(a)); or (2) a declaration under 37 C.F.R. §2.20 or 28 U.S.C. §1746 instead of an oath (see TMEP §804.01(b)).

##### **804.01(a) Verification, with Oath**

The verification is placed at the end of the application. It should first set forth the venue; followed by the signer's name (or the words "the undersigned"); then the necessary statements (TMEP §804.02); concluding with signature. After the signature there should be the jurat for the officer administering the oath, and an indication of the officer's authority (such as notarial seal).

The form of the verification depends on the law of the jurisdiction where the document is executed, so variations of the above form are acceptable. If there is a question as to the validity of the verification, the examining attorney should ask the applicant if the verification complies with the laws of the applicant's jurisdiction. See TMEP §804.01(a)(i) regarding verifications made in a foreign country.

If the verification is notarized but does not include the notarial seal, the examining attorney must require a substitute affidavit or declaration under 37 C.F.R. §2.20.

## APPLICATION REQUIREMENTS

If the verification is notarized but has not been dated, the applicant must submit either a statement from the notary public attesting to the date of signature and notarization, or a substitute affidavit or declaration under 37 C.F.R. §2.20.

### **804.01(a)(i) Verification Made in Foreign Country**

Verification (with oath) made in a foreign country may be made (1) before any diplomatic or consular officer of the United States, or (2) before any official authorized to administer oaths in the foreign country. In those foreign countries that are members of The Hague Convention Abolishing the Requirement of Legislation for Foreign Public Documents, a document verified before a foreign official should bear or have appended to it an apostille (*i.e.*, a certificate issued by an official of the member country).

Member countries, territories, and Departments in Europe participating in this Convention are: Anquilla, Antigua & Barbuda, Argentina, Armenia, Australia, Austria, Bahamas, Bailiwick of Guernsey, Barbados, Belarus, Belgium, Belize, Bermuda, Bosnia & Herzegovina, Botswana, British Antarctic, British Guiana (Guyana), British Soloman Islands, Cayman, Croatia, Cyprus, Dominica, El Salvador, Falkland Islands, Figi, Finland, France, French Guiana, Germany, Gibraltar, Gilbert & Ellice Islands (Kiribati), Greece, Grenada, Guadeloupe, Hong Kong, Hungary, Israel, Italy, Japan, Latvia, Lesotho, Liechtenstein, Lithuania, Luxembourg, Macedonia, Malawi, Malta, Marshall Islands, Martinique, Mauritius, Mexico, Montserrat, Netherlands, New Hebrides (Vanuatu), Norway, Panama, Portugal, Reunion, Saint Christopher & Nevis, Saint Helena, Saint Lucia, Saint Vincent, San Marino, Seychelles, Slovenia, South Africa, Southern Rhodesia (Zimbabwe), Spain, Suriname, Swaziland, Switzerland, The Isle of Man Jersey, Tonga, Turkey, Turks & Caicos, United Kingdom & Northern Ireland, and the Virgin Islands.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

An apostille must be square shaped with sides at least 9 centimeters long. The following is the prescribed form for an apostille:

<b>APOSTILLE</b>	
<b>(Convention de La Haye du Oct. 5, 1961)</b>	
1.	<b>Country:</b> _____
2.	<b>This public document</b>
3.	<b>has been signed by</b> _____
3.	<b>acting in capacity of</b> _____
4.	<b>bears the seal/stamp of</b> _____
<b>CERTIFIED</b>	
5.	<b>at</b> _____
6.	<b>the</b> _____
7.	<b>by</b> _____
8.	<b>No.</b> _____
9.	<b>Seal/stamp:</b> _____
10.	<b>Signature:</b> _____

See notice at 1013 TMOG 3 (December 1, 1981).

If a verification is made before a foreign official in a country that is not a member of the Hague Convention, the foreign official's authority must be proved by a certificate of a diplomatic or consular officer of the United States. 15 U.S.C. §1061.

Declarations under 37 C.F.R. §2.20 and 28 U.S.C. §1746 by foreign persons do not have to be made before a U.S. diplomatic or consular officer, or before a foreign official authorized to administer oaths. A declaration under 28 U.S.C. §1746 that is executed outside the United States must allege that "I declare (or certify, verify, or state) under penalty of perjury under the laws of the United States of America that the foregoing is true and correct." See TMEP §804.01(b).

See <http://www.state.gov/www/authenticate/index.html> for updated information about the Hague Convention.

## APPLICATION REQUIREMENTS

### 804.01(b) Declaration in Lieu of Oath

Under 35 U.S.C. §25, the Office is authorized to accept a declaration under 37 C.F.R. §2.20 or 28 U.S.C. §1746 instead of an oath. These declarations can be used whenever the Act or rules require that a document be verified or under oath.

When the language of 37 C.F.R. §2.20 or 28 U.S.C. §1746 is used with a document, the document is said to have been subscribed to (signed) by a written declaration rather than verified by oath (jurat).

When a declaration is used in lieu of an oath, the party must include in place of the oath (jurat) the statement that "all statements made of his or her own knowledge are true and all statements made on information and belief are believed to be true." Preferably, this language is placed at the end of the document.

In addition, the declaration must warn the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. §1001). 35 U.S.C. §25(b). Rule 2.20 requires that the warning contain the additional language that such statements may jeopardize the validity of the application (or document) or any registration resulting therefrom. A declaration under 37 C.F.R. §2.20 should read as follows:

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

\_\_\_\_\_  
(Signature)

\_\_\_\_\_  
(Print or Type Name and Position)

\_\_\_\_\_  
(Date)

Instead of using the language of 37 C.F.R. §2.20, an applicant may use the language of 28 U.S.C. §1746, which provides as follows:

Wherever, under any law of the United States or under any rule, regulation, order, or requirement made pursuant to law, any matter is required or permitted to be supported, evidenced, established, or proved by the sworn declaration, verification, certificate, statement, oath, or affidavit, in writing of the person making the same (other than a deposition, or an oath of office, or an oath required to be taken

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

before a specific official other than a notary public), such matter may, with like force and effect, be supported, evidenced, established, or proved by the unsworn declaration, certificate, verification, or statement, in writing of such person which is subscribed by him, as true under penalty of perjury, and dated, in substantially the following form:

- (1) If executed outside the United States, its territories, possessions, or commonwealths: “I declare (or certify, verify, or state) under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on (date).  
(Signature)”.
- (2) If executed within the United States, its territories, possessions, or commonwealths: “I declare (or certify, verify, or state) under penalty of perjury that the foregoing is true and correct. Executed on (date).  
(Signature)”.

*NOTE: Title 35 of the United States Code pertains specifically to the United States Patent and Trademark Office and, therefore, is preferred to 28 U.S.C. §1746, which is a statute of general application relating to verification on penalty of perjury.*

A declaration that does not attest to an awareness of the penalty for perjury is unacceptable. 35 U.S.C. §25. *In re Hoffmann-La Roche Inc.*, 25 USPQ2d 1539 (Comm’r Pats. 1992), *overruled on other grounds* 47 USPQ2d 1762, 1763 (1997) (failure to include a statement attesting to an awareness of the penalty for perjury, which is the very essence of an oath, is not a “minor defect” that can be provisionally accepted under 35 U.S.C. §26); *In re Stromsholmens Mekaniska Verkstad AB*, 228 USPQ 968 (TTAB 1986); *In re Laboratories Goupil, S.A.*, 197 USPQ 689 (Comm’r Pats. 1977).

If a declaration under 37 C.F.R. §2.20 or 28 U.S.C. §1746 is not dated, the examining attorney should require the applicant to state the date on which the declaration was signed. This statement does not have to be verified, and may be entered through a note to the file.

See TMEP §804.02 regarding the essential allegations required to verify an application for registration of a mark.

### **804.02                   Averments Required in Verification of Application for Registration - §1 or §44 Application**

The requirements for the verified statement in applications under application under §1 or §44 of the Trademark Act are set forth in §§1(a)(3), 1(b)(3) and 44 of the Trademark Act, 15 U.S.C. §§1051(a)(3), 1051(b)(3) and 1126, and 37 C.F.R. §§2.33



## APPLICATION REQUIREMENTS

and 2.34. These allegations are required regardless of whether the verification is in the form of an oath (TMEP §804.01(a)) or a declaration (TMEP §804.01(b)). See TMEP §804.06 regarding the requirements for verification of a §66(a) application.

*Truth of Facts Recited.* Under 15 U.S.C. §§1051(a)(3)(B) and 1051(b)(3)(C), the verification of an application for registration must include an allegation that “to the best of the verifier’s knowledge and belief, the facts recited in the application are accurate.” The language in 37 C.F.R. §2.20 that “all statements made of [the verifier’s] own knowledge are true, and all statements made on information and belief are believed to be true” satisfies this requirement.

*Use in Commerce.* If the filing basis is §1(a), the applicant must submit a verified statement that the mark is in use in commerce on or in connection with the goods or services listed in the application. If the verification is not filed with the original application, the verified statement must allege that the mark was in use in commerce on or in connection with the goods or services *as of the application filing date*. 37 C.F.R. §2.34(a)(1)(i).

*Bona Fide Intention to Use in Commerce.* If the filing basis is §1(b), §44(d), or §44(e), the applicant must submit a verified statement that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. 15 U.S.C. §§1051(b)(3)(B), 1126(d)(2) and 1126(e). If the verification is not filed with the original application, the verified statement must allege that the applicant had a bona fide intention to use the mark in commerce on or in connection with the goods or services *as of the application filing date*. 37 C.F.R. §§2.34(a)(2), 2.34(a)(3)(i) and 2.34(a)(4)(ii).

*Ownership or Entitlement to Use.* In an application based on §1(a), the verified statement must allege that the verifier *believes the applicant to be the owner of the mark* and that no one else, to the best of his or her knowledge and belief, has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of the other person, to cause confusion or mistake, or to deceive. 15 U.S.C. §1051(a)(3)(A); 37 C.F.R. §2.33(b)(1).

In an application based on §1(b) or §44, the verified statement must allege that the verifier *believes the applicant to be entitled to use the mark in commerce* and that no one else, to the best of his or her knowledge and belief, has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of the other person, to cause confusion or mistake, or to deceive. See 15 U.S.C. §1051(b)(3)(A); 37 C.F.R. §2.33(b)(2).

While the correct language for an application filed under §1(b) or §44 is “entitled to use,” if a §1(b) or §44 applicant files a verification stating that the applicant is the owner of the mark, the Office will accept the verification, and will not require a substitute verification stating that the applicant is entitled to use the mark.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*Concurrent Use.* The verification for concurrent use should be modified to indicate an exception, that no one else *except as specified in the application* has the right to use the mark. 15 U.S.C. §1051(a)(3)(D). See TMEP §§1207.04 *et seq.* regarding concurrent use registration.

Related-company use does not require stating an exception, because the statement that no one else has the right to use the mark refers only to adverse users and not to licensed or permitted use. See TMEP §§1201.03 *et seq.* regarding use by related companies.

### ***Affirmative, Unequivocal Averments Required***

The verification must include affirmative, unequivocal averments that meet the requirements of the Act and the rules. Statements to the effect that “the undersigned [person signing the declaration] has been informed that the applicant is using [or has a bona fide intention to use] the mark in commerce...” are unacceptable.

### ***Substitute Verification***

If the verified statement does not include all the necessary averments, the examining attorney will require a substitute or supplemental affidavit or declaration under 37 C.F.R. §2.20.

## **804.03 Time Between Execution and Filing of Papers - §1 or §44 Application**

### ***Papers Must Be Filed Within a Reasonable Time After Execution***

All applications and papers must be filed within a reasonable time after their execution. Under 37 C.F.R. §2.33(c), if the verified statement supporting an application for registration is not filed within a reasonable time after it is signed, the Office will require the applicant to submit a substitute affidavit or declaration under 37 C.F.R. §2.20 of the applicant’s continued use or bona fide intention to use the mark in commerce. Re-execution is also required where allegations of use and requests for extensions of time to file a statement of use are not filed within a reasonable time after the date of execution. 37 C.F.R. §§2.76(i), 2.88(k), and 2.89(h); TMEP §§1104.09(b), 1108.02(b) and 1109.11(c).

The Office considers one year between execution and filing as reasonable for all applicants and all papers. No new verification should be required if the paper is filed within one year of execution. If an application, allegation of use, or request for extension of time to file a statement of use is filed more than one year after its execution, the examining attorney will require that the applicant submit re-executed papers or a statement that is verified or includes a declaration under 37 C.F.R.

## APPLICATION REQUIREMENTS

§2.20, of the applicant's continued use or bona fide intent to use the mark in commerce, as appropriate.

### ***Papers Cannot Be Filed Before They Are Executed***

If an applicant files an application that is signed and lists a date of execution that is subsequent to the application filing date, the examining attorney will inquire as to the actual date on which the application was signed. However, where an application is executed in a foreign country located across the international date line, the fact that an application shows a date of execution as of the day after the application filing date is not inconsistent with its having been executed before filing. No inquiry is required in this limited situation.

### **804.04 Persons Authorized to Sign Verification or Declaration**

*Extract from 37 C.F.R. §2.33(a). The application must include a statement that is signed and verified (sworn to) or supported by a declaration under §2.20 by a person properly authorized to sign on behalf of the applicant. A person who is properly authorized to sign on behalf of the applicant is:*

*(1) a person with legal authority to bind the applicant; or*

*(2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant; or*

*(3) an attorney as defined in §10.1(c) of this chapter who has an actual or implied written or verbal power of attorney from the applicant.*

Effective October 30, 1999, the Trademark Act does not specify the appropriate person to verify facts on behalf of an applicant. The definition of a "person properly authorized to sign on behalf of an applicant" is set forth in 37 C.F.R. §2.33(a). This definition applies to applications for registration, amendments to allege use, statements of use, requests for extensions of time to file statements of use, affidavits of continued use or excusable nonuse under 15 U.S.C. §1058, affidavits of incontestability under 15 U.S.C. §1065; and combined filings under 15 U.S.C. §§1058 and 1059. 37 C.F.R. §§2.76(b)(1), 2.88(b)(1), 2.89(b)(3), and 2.161(b). It also applies to declarations supporting amendments to dates of use, use of substitute specimens, claims of acquired distinctiveness under 15 U.S.C. §1052(f), amendments changing the basis for filing, requests for amendment or correction of registrations under 15 U.S.C. §1057, and designations of domestic representative.

Generally, the Office does not question the authority of the person who signs a verification, unless there is an inconsistency in the record as to the signatory's authority to sign. The Office presumes that papers are properly signed. In view of the broad definition of a "person properly authorized to sign on behalf of an

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

applicant” in 37 C.F.R. §2.33(a), the fact that an application is signed by someone whose title refers to a different entity is not considered an inconsistency that warrants an inquiry as to whether the verification was properly signed.

*Example:* If an application is filed by “ABC Company, Inc.,” and the verification is signed by an officer of “XYZ Company, Inc.,” the Office will presume that XYZ Company, Inc. is a related company properly authorized to sign on behalf of ABC Company, Inc. The Office will not ask the applicant to explain how the person has authority to sign.

It is not necessary to set forth the title of the person signing the verification or to state the relationship between the applicant and the person who signed the verification.

If the person signing the verification is identified as a different person than the individual named as the applicant, or as representing a different legal entity than the juristic applicant, the Office will not question whether the proper party is listed as the applicant.

*Example:* If the applicant is Mary Smith, an individual, and the application is signed by John Smith, the Office will not question whether the proper party is listed as applicant.

*Example:* If the applicant is John Smith, an individual, and the application is signed by John Smith, President, XYZ, Inc., the Office will not question whether the proper party is listed as applicant.

If an attorney signs a verification on behalf of an applicant, the Office will not require a power of attorney or other documentation stating that the attorney is authorized to sign.

This policy applies to both individual applicants and juristic applicants.

The broad definition of a “person properly authorized to sign on behalf of an applicant” in 37 C.F.R. §2.33(a) applies *only* to verifications of facts by the applicant and designations of domestic representatives. It does *not* apply to powers of attorney, revocations of powers of attorney, responses to Office actions, or consent agreements.

A non-attorney who is authorized to verify facts on behalf of an applicant under 37 C.F.R. §2.33(a) is *not* necessarily entitled to sign responses to Office actions, or to authorize examiner’s amendments and priority actions. Authorizing an amendment to an application, or submitting legal arguments in response to an examining attorney’s requirement or refusal of registration, constitutes representation of the applicant in a trademark matter. Under 5 U.S.C. §500(d) and 37 C.F.R. §10.14(e), non-attorneys may not represent a party in a trademark proceeding before the USPTO. See TMEP §§712 *et seq.* regarding signature of responses to Office actions.

## APPLICATION REQUIREMENTS

In applications under §66(a) of the Act, the verified statement is part of the international registration on file at the IB. 37 C.F.R. §2.33(e). The IB will have established that the international registration includes a properly signed declaration before it sends the request for extension of protection to the USPTO. The examining attorney should not issue any inquiry regarding the authority of the signatory to verify the application. If the applicant needs to file a request for correction of the declaration, the request should be filed with the IB. However, if the applicant voluntarily files a substitute declaration with the USPTO, it will be examined according to the same standards used for examining any other declaration.

### 804.05 Signature of Electronically Transmitted Documents

In a document filed through TEAS or the Electronic System for Trademark Trials and Appeals (“ESTTA”), the party filing the document does not apply a conventional signature. Instead, the filer does one of the following:

- (1) The filer enters a “symbol” that the filer has adopted as a signature. The USPTO will accept *any* combination of letters, numbers, spaces and/or punctuation marks as a valid signature if it is placed between two forward slash (“/”) symbols. 37 C.F.R. §§2.33(d) and 2.193(c)(1)(iii). Examples of acceptable signatures include */john doe/*, */drll/*, and */544-4925/*; or
- (2) The document is completed online, printed in text form, and given or sent to the signatory. The signatory signs the document in the traditional pen-and-ink manner. An image file of the signed document is then transmitted electronically through TEAS or ESTTA. This method of signature is used primarily by attorneys who complete a document online, print it, and mail or fax it to the client for signature in text form. The client signs the document and returns it to the attorney. The attorney scans the returned document to create a .jpg image file, and files the document through TEAS or ESTTA with the .jpg attachment.

These principles apply to the signature of all documents filed electronically, *e.g.*, amendments to allege use, statements of use, requests for extension of time to file a statement of use, responses to Office action, affidavits of continued use or excusable nonuse under 15 U.S.C. §1058, affidavits or declarations of incontestability under 15 U.S.C. §1065; combined filings under 15 U.S.C. §§1058 and 1059, petitions for cancellation under 15 U.S.C. §1064, notices of opposition and requests for extensions of time to oppose under 15 U.S.C. §1063.

The Trademark Trial and Appeal Board has held that an electronic signature on an electronic transmission pertains to all the attachments to the transmission. *PPG Industries, Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926 (TTAB 2005).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If the signatory's name is not set forth in a TEAS document, the examining attorney should require that it be stated for the record. The examining attorney can enter this information through a note to the file.

See TMEP §301 for more information about electronic filing.

### **804.06 Verification of §66(a) Application**

In applications under §66(a) of the Act, the request for extension of protection to the United States must include a declaration that the applicant has a bona fide intention to use the mark in commerce that can be controlled by the United States Congress. The declaration must include a statement that the person making the declaration believes applicant to be entitled to use the mark in commerce; and that to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive. 15 U.S.C. §1141(5). The declaration must be signed by: (1) a person with legal authority to bind the applicant; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant; or (3) an attorney as defined in 37 C.F.R. §10.1 who is authorized to practice before the USPTO who has an actual written or verbal power of attorney or an implied power of attorney from the applicant. 37 C.F.R. §2.33(a).

The verified statement in a §66(a) application is part of the international registration on file at the IB. 37 C.F.R. §2.33(e). The IB will have established that the international registration includes this declaration before it sends the request for extension of protection to the USPTO. The examining attorney should not issue any inquiry regarding the verification of the application. If the applicant needs to file a request for correction of the declaration, the request should be filed with the IB. However, if the applicant voluntarily files a substitute declaration with the USPTO, it will be examined according to the same standards used for examining any other declaration.

### **805 Identification and Classification of Goods and Services**

An application must include a list of the particular goods or services on or in connection with which the applicant uses or intends to use the mark. 37 C.F.R. §2.32(a)(6). See TMEP §§1402 *et seq.* for more information about identifying goods and services in an application.

The applicant should designate the international class number(s) that are appropriate for the identified goods or services, if this information is known. 37 C.F.R. §2.32(a)(7). See TMEP §§1401 *et seq.* for more information about classification.

## APPLICATION REQUIREMENTS

### 806 Filing Basis

A filing basis is the statutory basis for filing an application to obtain registration of a mark in the United States. An applicant must specify and meet the requirements of one or more filing bases before the mark will be approved for publication for opposition or registration on the Supplemental Register. 37 C.F.R. §2.32(a)(5). There are five filing bases: (1) use of a mark in commerce under §1(a) of the Trademark Act, 15 U.S.C. §1051(a); (2) bona fide intention to use a mark in commerce under §1(b) of the Act, 15 U.S.C. §1051(b); (3) a claim of priority, based on an earlier-filed foreign application under §44(d) of the Act, 15 U.S.C. §1126(d); (4) ownership of a registration for the mark in the applicant's country of origin under §44(e) of the Act, 15 U.S.C. §1126(e); and (5) extension of protection of an international registration to the United States, under §66(a) of the Act, 15 U.S.C. §1141f(a). 37 C.F.R. §2.34.

An applicant is not required to specify the basis for filing to receive a filing date. If a §1 or §44 application does not specify a basis, the examining attorney must require in the first Office action that the applicant specify the basis for filing and submit all the elements required for that basis. If the applicant timely responds to the first Office action, but fails to specify a basis for filing, or fails to submit all the elements required for a particular basis, the examining attorney will issue a final Office action, if the application is otherwise in condition for final action.

In a §66(a) application, the basis for filing will have been established in the international registration on file at the IB.

See 37 C.F.R. §2.34 and TMEP §§806.01 *et seq.* for a list of the requirements for each basis.

#### 806.01 Requirements for Establishing a Basis

The requirements for establishing a basis are set forth in TMEP §§806.01(a) through 806.01(e). If these requirements are not met in the original application, the examining attorney will require the applicant to comply with them in the first Office action.

##### 806.01(a) Use in Commerce - §1(a)

Under 15 U.S.C. §1051(a) and 37 C.F.R. §2.34(a)(1), to establish a basis under §1(a) of the Trademark Act, the applicant must:

- (1) Submit a verified statement that the mark is in use in commerce on or in connection with the goods or services listed in the application. 15 U.S.C. §1051(a)(3)(C). If this verified statement is not filed with the initial application, the verified statement must also state that the mark was in

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- use in commerce on or in connection with the goods or services listed in the application *as of the application filing date* (37 C.F.R. §2.34(a)(1)(i));
- (2) Specify the date of the applicant's first use of the mark anywhere on or in connection with the goods or services (37 C.F.R. §2.34(a)(1)(ii); TMEP §903.01);
  - (3) Specify the date of the applicant's first use of the mark in commerce as a trademark or service mark (37 C.F.R. §2.34(a)(1)(iii); TMEP §903.02); and
  - (4) Submit one specimen for each class, showing how the applicant actually uses the mark in commerce (37 C.F.R. §§2.34(a)(1)(iv) and 2.56; TMEP §§904 *et seq.*).

The Trademark Act defines “commerce” as commerce which may lawfully be regulated by Congress, and “use in commerce” as the bona fide use of a mark in the ordinary course of trade. 15 U.S.C. §1127; 37 C.F.R. §2.34(c). See TMEP §§901 *et seq.*

An applicant may claim both use in commerce under §1(a) of the Act and intent-to-use under §1(b) of the Act as a filing basis in the same application, but may not assert both §1(a) and §1(b) for the identical goods or services. 37 C.F.R. §2.34(b)(1); TMEP §806.02(b).

An applicant may not claim a §1(a) basis unless the mark was in use in commerce on or in connection with *all* the goods or services covered by the §1(a) basis as of the application filing date. 37 C.F.R. §2.34(a)(1)(i). *Cf. E.I. du Pont de Nemours & Co. v. Sunlyra International, Inc.*, 35 USPQ2d 1787, 1791 (TTAB 1995).

If the applicant claims use in commerce in addition to another filing basis, but does not specify which goods or services are covered by which basis, the Office may defer examination of the specimen(s) until the applicant identifies the goods or services for which use is claimed. TMEP §806.02(c).

### **806.01(b) Intent-to-Use - §1(b)**

In an application based on 15 U.S.C. §1051(b), the applicant must submit a verified statement that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. 15 U.S.C. §1051(b)(3)(B). If the verified statement is not filed with the initial application, the verified statement must also state that the applicant had a bona fide intention to use the mark in commerce on or in connection with the goods or services *as of the filing date of the application*. 37 C.F.R. §2.34(a)(2).

Prior to registration, the applicant must file an allegation of use (*i.e.*, either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d)) that states that the applicant is using the mark in commerce on or in connection with the goods or services; includes dates of use and a filing fee for



## APPLICATION REQUIREMENTS

each class; and includes one specimen evidencing such use for each class. See 37 C.F.R. §2.76 and TMEP §§1104 *et seq.* regarding amendments to allege use, and 37 C.F.R. §2.88 and TMEP §§1109 *et seq.* regarding statements of use.

Once an applicant claims a §1(b) basis for any or all of the goods or services, the applicant may not amend the application to seek registration under §1(a) of the Act for those goods or services unless the applicant files an allegation of use under §1(c) or §1(d) of the Act. 37 C.F.R. §2.35(b)(8).

See TMEP Chapter 1100 for additional information about intent-to-use applications.

### **806.01(c) Foreign Priority - §44(d)**

Under 15 U.S.C. §1126(d) and 37 C.F.R. §2.34(a)(4), the requirements for receipt of a priority filing date based on a previously-filed foreign application are:

- (1) The applicant must file a claim of priority within six months of the filing date of the foreign application. 37 C.F.R. §§2.34(a)(4)(i) and 2.35(b)(5).
- (2) The applicant must: (a) specify the filing date, serial number and country of the first regularly filed foreign application; or (b) state that the application is based upon a subsequent regularly filed application in the same foreign country, and that any prior-filed application has been withdrawn, abandoned or otherwise disposed of, without having been laid open to public inspection and without having any rights outstanding, and has not served as a basis for claiming a right of priority. 37 C.F.R. §§2.34(a)(4)(i)(A) and (B).
- (3) The applicant must verify that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. 15 U.S.C. §1126(d)(2). This allegation is required even if use in commerce is asserted in the application. TMEP §806.02(e). If the verified statement is not filed with the initial application, the verified statement must also state that the applicant had a bona fide intention to use the mark in commerce *as of the filing date of the application*. 37 C.F.R. §2.34(a)(4)(ii).

The scope of the goods/services covered by the §44 basis in the United States application cannot exceed the scope of the goods/services in the foreign application or registration. 37 C.F.R. §2.32(a)(6); TMEP §1402.01(b).

Section 44(d) of the Act provides a basis for receipt of a priority filing date, but not a basis for publication or registration. Before the application can be approved for publication, or for registration on the Supplemental Register, the applicant must establish a basis under §1(a), §1(b), or §44(e) of the Act. 37 C.F.R. §2.34(a)(4)(iii); TMEP §1003.03. If the applicant claims a §1(b) basis, the applicant must file an allegation of use (*i.e.*, either an amendment to allege use under 15 U.S.C. §1051(c)

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

or a statement of use under 15 U.S.C. §1051(d)) before the mark can be registered. See TMEP §806.01(b) regarding the requirements for a §1(b) basis.

If an applicant properly claims a §44(d) basis in addition to another basis, the applicant may retain the priority filing date without perfecting the §44(e) basis. 37 C.F.R. §§2.35(b)(3) and (4). See TMEP §806.04(b) regarding processing an amendment electing not to perfect a §44(e) basis, and TMEP §806.02(f) regarding the examination of applications that claim §44(d) in addition to another basis.

See TMEP §§1003 *et seq.* for further information about §44(d) applications.

### **806.01(d) Foreign Registration — §44(e)**

Under 15 U.S.C. §1126(e) and 37 C.F.R. §2.34(a)(3), the requirements for establishing a basis for registration under §44(e), relying on a registration granted by the applicant's country of origin, are:

- (1) The applicant must submit a true copy, a photocopy, a certification, or a certified copy of the registration in the applicant's country of origin. 37 C.F.R. §2.34(a)(3)(ii); TMEP §§1004.01 and 1004.01(b).
- (2) The application must include the applicant's verified statement that it has a bona fide intention to use the mark in commerce on or in connection with the identified goods or services. 15 U.S.C. §1126(e). This allegation is required even if use in commerce is asserted in the application. TMEP §806.02(e). If the verified statement is not filed with the initial application, the verified statement must also state that the applicant had a bona fide intention to use the mark in commerce *as of the application filing date*. 37 C.F.R. §2.34(a)(3)(i).
- (3) The applicant's country of origin must either be a party to a convention or treaty relating to trademarks to which the United States is also a party, or extend reciprocal registration rights to nationals of the United States by law. See TMEP §§1002 *et seq.*

The scope of the goods covered by the §44 basis in the United States application cannot exceed the scope of the goods or services in the foreign registration. 37 C.F.R. §2.32(a)(6); TMEP §1402.01(b).

An application may be based on more than one foreign registration. If the applicant amends an application to rely on a different foreign registration, this is considered a change in basis. TMEP §1004.02. See TMEP §§806.03 *et seq.* regarding amendments to add or substitute a basis.

See TMEP §1004 *et seq.* for further information about §44(e) applications.

## APPLICATION REQUIREMENTS

### **806.01(e) Extension of Protection of International Registration - §66(a)**

Section 66(a) of the Act provides for a request for extension of protection of an international registration to the United States. See 37 C.F.R. §2.34(a)(5). The request must include a declaration of bona fide intention to use the mark in commerce that is verified by the applicant for, or holder of, the international registration. The verified statement is part of the international registration on file at the IB. 37 C.F.R. §2.33(e). The IB will have established that the international registration includes this declaration before it sends the request for extension of protection to the USPTO. The examining attorney should not review the international registration to determine whether there is a proper declaration of intent to use, or issue any inquiry regarding the initial verification of the application. However, if the applicant voluntarily files a substitute declaration with the USPTO, it will be examined according to the same standards used for examining any other declaration. See TMEP §804.06.

A §66(a) applicant cannot change the basis or claim more than one basis. 37 C.F.R. §§2.34(b)(3) and 2.35(a). See TMEP §1904.09 regarding the limited circumstances under which a §66(a) application can be transformed into an application under §1 or §44.

Under 15 U.S.C. §1141g and Madrid Protocol Article 4(2), the §66(a) applicant may claim a right of priority within the meaning of Article 4 of the Paris Convention if:

- (1) The request for extension of protection contains a claim of priority;
- (2) The request for extension of protection specifies the filing date, serial number and the country of the application that forms the basis for the claim of priority; *and*
- (3) The date of international registration or the date of the recordal of the subsequent designation requesting an extension of protection to the United States is not later than 6 months after the date of the first regular national filing (within the meaning of Article 4(A)(3) of the Paris Convention) or a subsequent application (within the meaning of Article 4(C)(4) of the Paris Convention).

### **806.02 Multiple Bases**

#### **806.02(a) Procedure for Asserting More Than One Basis**

In a §66(a) application, the applicant cannot claim more than one basis. 37 C.F.R. §2.34(b)(3).

In an application under §1 or §44 of the Trademark Act, the applicant may claim more than one basis, if the applicant satisfies all requirements for each basis claimed. 37 C.F.R. §2.34(b)(1). The applicant must clearly indicate that more than one basis is claimed, and must separately list each basis, followed by the goods or

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

services to which that basis applies. If some or all of the goods or services are covered by more than one basis, this must be stated. 37 C.F.R. §§2.34(b)(2) and 2.35(b)(6).

*Example:* Based on use - SHIRTS AND COATS, in Class 25; Based on intent to use - DRESSES, in Class 25.

The applicant may assert different bases for different classes, and may also assert different bases as to different goods or services within a class.

The applicant may claim a §44 basis in addition to *either* a §1(a) or a §1(b) basis for the same goods or services. However, the applicant may not assert both a §1(a) and §1(b) basis for the identical goods or services. 37 C.F.R. §2.34(b)(1).

### **806.02(b) Applicant May File Under Both §1(a) and §1(b) in a Single Application**

An applicant may rely on both §1(a) and §1(b) in a single application. The applicant may not assert both a §1(a) and §1(b) basis for the identical goods or services in a single application, but the applicant may assert a §1(a) basis for some of the goods or services and a §1(b) basis for other goods or services. This can occur in either a single or multi-class application. 37 C.F.R. §2.34(b)(1).

When the applicant asserts both §1(a) and §1(b) as bases for registration in the same application, the Office will publish the mark for opposition and will issue a notice of allowance (*see* TMEP §§1106 *et seq.*) if there is no successful opposition. The goods/services for which a §1(a) basis is asserted will remain in the application pending the filing and approval of a statement of use for the goods based on §1(b), unless the applicant files a request to divide. *See* TMEP §§1110 *et seq.* regarding requests to divide. If the applicant fails to timely file a statement of use or request for an extension of time to file a statement of use in response to a notice of allowance, the entire application will be abandoned, unless the applicant files a request to divide before the expiration of the deadline for filing the statement of use. TMEP §806.02(d).

### **806.02(c) Examination of Specimens of Use in a Multi-Basis Application**

If the applicant claims use in commerce in addition to another basis but does not specify which goods/services are covered by which basis, the Office may defer examination of the specimens until the applicant identifies the goods/services for which use is claimed. A proper examination of specimens requires consideration of the particular goods/services on or in connection with which the mark is used.

## APPLICATION REQUIREMENTS

### **806.02(d) Abandonment of Multi-Basis Applications**

If an applicant fails to respond to an Office action or notice of allowance pertaining to only one basis of a multi-basis application, the failure to respond will result in abandonment of the entire application, unless the applicant files a request to divide under 37 C.F.R. §2.87 and notifies the examining attorney that the request has been filed. See TMEP §§1110 *et seq.* regarding requests to divide. If the failure to respond was unintentional, the applicant may file a petition to revive. See TMEP §§1714 *et seq.* regarding petitions to revive.

### **806.02(e) Allegation of Bona Fide Intention to Use Mark in Commerce Even if Application is Based on Both §44 and §1**

Any application filed under §44(d) or §44(e) must include a verified statement that the applicant has a bona fide intention to use the mark in commerce even if §1(a) (use in commerce) is asserted as an additional filing basis. *Cf. In re Paul Wurth, S.A.*, 21 USPQ2d 1631 (Comm'r Pats. 1991).

If an application is based on both §1(b) and §44, it is not necessary to repeat the allegation that the applicant has a bona fide intention to use the mark in commerce.

### **806.02(f) Section 44(d) Combined With Other Bases**

If an applicant properly claims a §44(d) basis in addition to a §1 basis, the applicant may elect not to perfect a §44(e) basis and still retain the priority filing date. 37 C.F.R. §§2.35(b)(3) and (4).

If an applicant claims §44(d) in addition to another basis, the examining attorney must inquire whether the applicant wishes to retain §44(e) as a second basis for registration (based on the foreign registration that will issue from the application on which the applicant relied for priority). The examining attorney should advise the applicant that it may retain the priority filing date even if it does not perfect the §44(e) basis, and ask the applicant whether it wishes to perfect the §44(e) basis. This inquiry should be made in the first Office action, or by telephone if no Office action is issued. If the examining attorney is unable to reach the applicant by telephone, the examining attorney should issue an Office action requiring a copy of the foreign registration, advising applicant that it may retain the priority filing date even if it does not perfect the §44(e) basis, and inquiring as to whether the applicant wishes to retain §44(e) as a second basis for registration.

If the applicant does not intend to assert a dual basis for registration, this should be indicated in an examiner's amendment and the mark should be approved for publication or issuance of a registration on the Supplemental Register, if appropriate. See TMEP §806.04(b) regarding the processing of an application in which an applicant elects not to perfect a §44(e) basis.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If the applicant wishes to perfect the §44 basis, the examining attorney cannot approve the mark for publication for opposition or registration on the Supplemental Register until the applicant files a copy of the foreign registration. Therefore, if all issues are resolved or in condition for final action, the examining attorney must suspend action pending receipt of the foreign certificate. TMEP §1003.04.

### **806.02(g) Not Necessary to Repeat Allegation of Bona Fide Intention to Use Mark in Commerce in Multi-Basis Application**

If an application is based on both §1(b) and §44, it is not necessary to repeat the allegation that the applicant has a bona fide intention to use the mark in commerce. Therefore, when an applicant adds or substitutes §1(b) or §44 as a filing basis, it is not necessary to submit a new verification of the applicant's bona fide intention to use the mark in commerce if there is already one in the record with respect to the goods or services covered by the new basis.

### **806.03 Amendments to Add or Substitute a Basis**

#### **806.03(a) When Basis Can be Changed**

*Section 1 or §44 Application - Before Publication:* The applicant may add or substitute a basis before publication, provided that the applicant meets all requirements for the new basis. 37 C.F.R. §2.35(b)(1).

*Section 1 or §44 Application - After Publication:* In an application that is not the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board, if an applicant wants to add or substitute a basis after a mark has been published for opposition, the applicant must first petition the Director to allow the examining attorney to consider the amendment. If the Director grants the petition, and the examining attorney accepts the added or substituted basis, the mark must be republished. 37 C.F.R. §2.35(b)(2). See TMEP §§806.03(j) *et seq.* for further information. Amendment of an application that is the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board is governed by 37 C.F.R. §2.133(a). See *Trademark Trial and Appeal Board Manual of Procedure* ("TBMP") §514.

*Section 66(a) Application:* In a §66(a) application, the applicant cannot change the basis, unless the applicant meets the requirements for transformation under §70(c) of the Trademark Act and 37 C.F.R. §7.31. 37 C.F.R. §2.35(a); TMEP §806.03(k).

#### **806.03(b) Applicant May Add or Substitute a §44(d) Basis Only Within Six-Month Priority Period**

An applicant may add or substitute a §44(d) basis only during the six-month priority period following the filing date of the foreign application. 37 C.F.R. §2.35(b)(5). See TMEP §806.02(f) regarding §44(d) combined with another basis.

## APPLICATION REQUIREMENTS

### **806.03(c) Amendment From §1(a) to §1(b)**

If a §1(a) basis fails, either because the specimens are unacceptable or because the mark was not in use in commerce when the application was filed, the applicant may substitute §1(b) as a basis. The Office will presume that the applicant had a continuing valid basis, because the applicant had at least a bona fide intention to use the mark in commerce as of the application filing date. 37 C.F.R. §2.35(b)(3).

When amending from §1(a) to §1(b), the applicant must submit a verified statement that the applicant has had a bona fide intention to use the mark in commerce on or in connection with the goods/services since the application filing date. 15 U.S.C. §1051(b)(3)(B); 37 C.F.R. §2.34(a)(2).

See TMEP §806.03(j) regarding amendment of the basis after publication.

Once an applicant has filed a statement of use in a §1(b) application, the applicant may not withdraw the statement of use. 37 C.F.R. §2.88(g); TMEP §1109.17.

### **806.03(d) Amendment From §44 to §1(b)**

An applicant may amend the basis from §44 to §1(b). The USPTO will presume that the applicant had a continuing valid basis, because the applicant had a bona fide intention to use the mark in commerce as of the application filing date. 37 C.F.R. §2.35(b)(3). It is not necessary to submit a new verification of the applicant's bona fide intention to use the mark in commerce if such a verification is already in the record with respect to the goods/services covered by the new basis. See TMEP §806.03(i).

Applicant must clearly indicate whether it wants to (1) add the §1(b) basis and maintain the §44 basis, or (2) replace the §44 basis with the §1(b) basis.

In a §44(d) application, the applicant may substitute §1(b) as a basis and still retain the priority filing date. 37 C.F.R. §§2.35(b)(3) and (4); TMEP §806.03(h). If the applicant chooses to add the §1(b) basis and maintain the §44 basis, the examining attorney cannot approve the mark for publication until the applicant files a copy of the foreign registration. See TMEP §806.02(f).

See TMEP §806.03(j) regarding amendment of the basis after publication.

### **806.03(e) Allegation of Use Required to Amend From §1(b) to §1(a)**

An applicant who claims a §1(b) basis for any or all of the goods or services may not amend the application to seek registration under §1(a) of the Act for those goods or services unless the applicant files an allegation of use under §1(c) or §1(d) of the Trademark Act. 37 C.F.R. §2.35(b)(8). See TMEP §§1103, 1104, and 1109 *et seq.* regarding allegations of use.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **806.03(f) Use in Commerce as of Application Filing Date Required to Add or Substitute §1(a) as a Basis in §44 Application**

An applicant can add or substitute a basis only if the applicant meets all the requirements for the new basis. 37 C.F.R. §2.35(b)(1). Therefore, an applicant may not amend a §44 application to claim a §1(a) basis unless the applicant (1) verifies that the mark has been in use in commerce since the application filing date; (2) provides a specimen, with a verified statement that the specimen was in use in commerce as of the application filing date; and (3) supplies the date of first use anywhere and the date of first use in commerce of the mark. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(i), 2.34(a)(1)(ii), 2.34(a)(1)(iii), and 2.59(a); 2.71(c)(1); TMEP §§806.01(a), 806.03(i), 903.01, 903.02, 903.05, and 904.09.

If an applicant began using the mark in commerce *after* the application filing date, the applicant cannot add or substitute §1(a) as a basis. However, the applicant may add or substitute §1(b) as a basis, and concurrently file an amendment to allege use. See TMEP §806.03(d) regarding amendment of the basis from §44 to §1(b), and TMEP §§1104 *et seq.* regarding amendments to allege use.

### **806.03(g) Amendment From §1(b) to §44**

An applicant may amend the basis from §1(b) to §44. It is not necessary to submit a new verification of the applicant's bona fide intention to use the mark in commerce if such a verification is already in the record with respect to the goods/services covered by the new basis. See TMEP §806.03(i).

When an applicant adds §44(e) as a basis, the applicant must submit a copy of the foreign registration (and a translation, if necessary) with the amendment. 37 C.F.R. §2.34(a)(3)(ii); TMEP §§1004.01 and 1004.01(b).

The applicant may add §44(d) as a basis only within the six-month priority period following the filing date of the foreign application. 37 C.F.R. §2.35(b)(5). See TMEP §806.02(f) regarding §44(d) combined with another basis.

If the amendment is filed before publication, the applicant must clearly indicate whether it wants to (1) add the §44 basis and maintain the §1(b) basis, or (2) replace the §1(b) basis with the §44 basis. If the applicant chooses to add §44 and maintain the §1(b) basis, the application will proceed to publication with a dual basis. See TMEP §§806.03(j) *et seq.* regarding amendment of the basis after publication.

### **806.03(h) Effect of Substitution of Basis on Application Filing Date**

When the applicant substitutes one basis for another, the applicant will retain the original filing date, provided that the applicant has had a continuing valid basis for registration since the application filing date. Unless there is contradictory evidence



## APPLICATION REQUIREMENTS

in the record, the Office will presume that there was a continuing valid basis for registration. 37 C.F.R. §2.35(b)(3).

If the applicant properly asserts a §44(d) basis during the six-month priority period, the applicant will retain the priority filing date, no matter which basis for registration is established, provided that the applicant has had a continuing valid basis for registration. 37 C.F.R. §2.35(b)(3) and (4); TMEP §806.02(f).

If there is no continuing valid basis, the application is void, and registration will be refused. In this situation, the applicant cannot amend the filing date, and the Office will not refund the filing fee. See TMEP §205.

### **806.03(i) Verification of Amendment Required**

An applicant who adds or substitutes use in commerce under §1(a) as a basis must verify that the mark has been in use in commerce on or in connection with the goods/services covered by the §1(a) basis *since the filing date of the application*. 37 C.F.R. §2.34(a)(1)(i).

An applicant who adds or substitutes §1(b), §44(d), or §44(e) as a basis must verify that the applicant has had a bona fide intention to use the mark in commerce on or in connection with the goods/services listed in the application since the filing date of the application, unless a verified statement of the applicant's bona fide intention to use the mark in commerce has already been filed with respect to all the goods/services covered by the new basis. 37 C.F.R. §§2.34(a)(2), 2.34(a)(3)(i) and 2.34(a)(4)(ii).

*Example:* If a §44 application originally included a verified statement that the applicant had a bona fide intention to use the mark in commerce, it is not necessary to repeat this statement if the applicant later adds or substitutes a §1(b) basis for the goods/services covered by the §44 basis.

See TMEP §804.04 regarding persons who may sign a verification on behalf of an applicant under 37 C.F.R. §2.33(a).

### **806.03(j) Petition to Amend Basis After Publication - §1 or §44 Application**

In an application that is not the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board, if an applicant wants to add or substitute a basis after a mark has been published for opposition, the applicant must petition the Director to allow the examining attorney to consider the amendment. 37 C.F.R. §2.35(b)(2). Amendment of an application that is the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board is governed by 37 C.F.R. §2.133(a) (see TBMP §514).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

When granting a petition to amend the basis, the Director will restore jurisdiction to the examining attorney to consider the amendment, *except* in a §1(b) application in which the notice of allowance has issued. See TMEP §806.03(j)(ii) regarding amendment of the basis after issuance of a notice of allowance.)

If the examining attorney accepts the new basis, the mark must be republished. 37 C.F.R. §2.35(b)(2).

If the examining attorney does not accept the new basis, he or she will issue an Office action using standard examination procedures *except* in a §1(b) application in which a notice of allowance has issued and no statement of use has been filed. See TMEP §806.03(j)(ii) regarding amendments to the basis after issuance of a notice of allowance.

Any petition to change the basis must be filed before issuance of the registration. To avoid the possible issuance of a registration without consideration of the petition, an applicant should submit the petition no later than six weeks after publication.

The Director will not grant a petition to amend the basis after publication if the amendment could substantially delay prosecution of the application. For example, the Director will deny petitions to amend the basis after publication in the following situations:

- Once the Director has granted a petition to amend the basis after publication, the Director will not thereafter grant a second petition to amend the basis with respect to the same application.
- If an applicant had previously deleted a §1(b) basis after a notice of allowance had issued, the Director will not grant a petition to re-assert §1(b) as a basis for registration. This would require issuance of a new notice of allowance and could result in filing of a statement of use more than 36 months after issuance of the first notice of allowance, which is not permitted under §1(d) of the Act.

See TMEP §806.03(j)(i) regarding amendment of the basis in a §1(b) application between publication and issuance of a notice of allowance, and TMEP §806.03(j)(ii) regarding amendment of the basis after issuance of a notice of allowance.

### **806.03(j)(i) Amending the Basis of a §1(b) Application After Publication But Before Issuance of Notice of Allowance**

An applicant who wants to add a §44 basis to a §1(b) application after publication must petition the Director to allow the examining attorney to consider the amendment. 37 C.F.R. §2.35(b)(2); TMEP §806.03(j). The petition should indicate whether applicant wants to maintain the §1(b) basis. The applicant has three options:

- (1) Applicant may delete the §1(b) basis and substitute §44. If the Director grants the petition and the examining attorney accepts the §44 basis, the

## APPLICATION REQUIREMENTS

examining attorney will (1) ensure that the §1(b) basis is deleted from the Trademark Reporting and Monitoring (“TRAM”) System; and (2) approve the mark for republication. If registration of the mark is not successfully opposed, a registration will issue. If the examining attorney does not accept the §44 basis, the examining attorney will ensure that the §1(b) basis is deleted from TRAM; and (2) issue an Office action notifying the applicant of the reason(s). The applicant cannot later re-assert the §1(b) basis;

- (2) Applicant may add §44 and retain the §1(b) basis. If the Director grants the petition and the examining attorney accepts the §44 basis, the application will be republished with a dual basis and, if registration of the mark is not opposed, a notice of allowance will issue. If the examining attorney does not accept the §44 basis, the examining attorney will issue an Office action notifying the applicant of the reason(s). The applicant may elect to withdraw the amendment and proceed under §1(b); or
- (3) Applicant may add §44 and request that the §1(b) basis be deleted if the examining attorney accepts the §44 basis. If the Director grants the petition and the examining attorney accepts the §44 basis, the examining attorney will (1) ensure that the §1(b) basis is deleted from TRAM; and (2) approve the mark for republication. If the mark is not successfully opposed, a registration will issue. If the examining attorney does not accept the §44 basis, the examining attorney will issue an Office action notifying the applicant of the reason(s). The applicant may elect to withdraw the amendment and proceed under §1(b).

### **806.03(j)(ii) Amending the Basis of a §1(b) Application Between Issuance of Notice of Allowance and Filing of Statement of Use**

#### ***Amendments Adding or Substituting a §44 Basis***

An applicant who wants to add a §44 basis to a §1(b) application after publication must petition the Director to allow the examining attorney to consider the amendment. 37 C.F.R. §2.35(b)(2); TMEP §806.03(j). The petition should indicate whether applicant wants to delete the §1(b) basis. The applicant has three options:

- (1) The applicant may delete the §1(b) basis and substitute §44. If the petition is granted, the notice of allowance will be cancelled, the §1(b) basis will be deleted from the application, and the application will be sent to the examining attorney for examination of the §44 basis. If the examining attorney accepts the §44 basis, the mark will be republished and, if registration of the mark is not opposed, a registration will issue. If the examining attorney does not accept the new basis, the examining attorney will issue an Office action advising the applicant of the reasons. The applicant cannot re-assert the §1(b) basis;

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- (2) The applicant may add §44 and perfect the §1(b) basis by filing a statement of use with the petition. If the petition is granted, the examining attorney will examine the §44 basis during examination of the statement of use; or
- (3) An applicant does not have the option of adding §44 and maintaining a dual basis. However, the applicant may add a §44 basis and request that the §1(b) basis be deleted if the examining attorney accepts the §44 basis. If the Director grants the petition and the examining attorney accepts the §44 basis, the examining attorney will (1) ensure that the §1(b) basis is deleted from TRAM; and (2) approve the mark for republication. If the mark is not successfully opposed, a registration will issue. If the examining attorney does not accept the §44 basis, the §1(b) basis will be maintained. The examining attorney will call the applicant and notify the applicant that the §44 basis is unacceptable and that an Office action will issue during examination of the statement of use. An appropriate note to the file must be made. The application will then await the filing of the statement of use.

The Director will not grant a petition to add §44 and retain the §1(b) basis unless a statement of use is filed with the petition, because examination of the §44 basis could substantially delay prosecution of the application. If the examining attorney found the §44 basis unacceptable, the notice of allowance would have to be cancelled in order to issue an Office action. The notice of allowance cannot be cancelled or reissued in this situation, since this could result in the filing of a statement of use more than 36 months after issuance of the first notice of allowance.

### ***Amendments That Apply to Less Than All the Goods/Services***

The Director will not grant a petition to amend the basis if the amendment does not apply to all the goods/services covered by the §1(b) basis, unless the applicant concurrently files a request to divide out the goods/services to which the amendment applies. See TMEP §§1110 *et seq.* regarding requests to divide.

### **806.03(k) Basis Cannot be Changed in §66(a) Application**

In a §66(a) application, the applicant cannot change the basis, unless the applicant meets the requirements for transformation under §70(c) of the Trademark Act and 37 C.F.R. §7.31. 37 C.F.R. §2.35(a). See TMEP §1904.09 regarding transformation.

### **806.04 Deleting a Basis**

If an applicant claims more than one basis, the applicant may delete a basis at any time, before or after publication. 37 C.F.R. §2.35(b)(1). When the applicant deletes a basis, the applicant must also delete any goods or services covered solely by the deleted basis. 37 C.F.R. §2.35(b)(7).

## APPLICATION REQUIREMENTS

To expedite processing, the Office recommends that a request to delete a §1(b) basis from a multi-basis application be filed through TEAS, at <http://www.uspto.gov/teas/index.html>.

### **806.04(a) Deletion of §1(b) Basis After Publication or Issuance of the Notice of Allowance**

If an application is based on §1(b) in addition to another basis, the applicant may file a request to delete the §1(b) basis by amendment at any time. 37 C.F.R. §2.35(b)(1). No petition is required to delete the §1(b) basis after publication. To expedite processing, the Office recommends that any request to delete a §1(b) basis be filed through TEAS, at <http://www.uspto.gov/teas/index.html>.

If a notice of allowance has issued, the request must be filed within six months of the mailing date of the notice of allowance, or within a previously-granted extension of time to file a statement of use. If filed on paper, the request should be directed to the ITU Unit. The ITU Unit will cancel the notice of allowance, and take the necessary steps to delete the §1(b) basis and issue the registration.

If filed on paper before issuance of the notice of allowance, the request should be directed to the Photocomposition Coordinators in the Publication and Issue Section of the Office. They will delete the §1(b) basis, and issue the registration.

### **806.04(b) Retention of §44(d) Priority Filing Date Without Perfecting §44(e) Basis**

If an applicant properly claims a §44(d) basis in addition to another basis, the applicant may elect not to perfect a §44(e) basis and still retain the §44(d) priority filing date. 37 C.F.R. §§2.35(b)(3) and (4); TMEP §§806.01(c) and 806.02(f).

When a §44(d) applicant elects not to proceed to registration under §44(e), the Office does not delete the §44(d) filing basis from the TRAM database. Both the §44(d) filing basis and the other basis will remain in the TRAM database.

Sometimes a §44(d) applicant who elects not to perfect a §44(e) basis will file an amendment “deleting” the §44 basis. In this situation, the Office will presume that the applicant wants to retain the priority claim unless the applicant specifically states that it wants to delete the priority claim and instead rely on the actual filing date of the application in the USPTO.

If the applicant is not entitled to priority (e.g., because the United States application was not filed within six months of the foreign filing), the examining attorney should ensure that the priority claim is deleted from the TRAM database, and should conduct a new search of Office records for conflicting marks.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 806.05 Review of Basis Prior to Publication or Issue

If an application claims more than one basis, the examining attorney must ensure that the file clearly and accurately shows which goods are covered by which basis before approving the application for publication for opposition or registration on the Supplemental Register. If there are any errors, the examining attorney must ensure that the TRAM database is corrected.

### 807 Drawing

The drawing shows the mark sought to be registered. 37 C.F.R. §2.52. An applicant must submit a clear drawing with the original application in order to receive a filing date in any application for registration of a mark, except in applications for registration of sound, scent and other non-visual marks. See TMEP §807.09 regarding “drawings” in applications for registration of non-visual marks. The drawing is used to reproduce the mark in the *Trademark Official Gazette* and on the registration certificate.

The main purpose of the drawing is to provide notice of the nature of the mark sought to be registered. The drawing of a mark is promptly entered into the automated records of the USPTO and is available to the public through the Trademark Electronic Search System (“TESS”) and the Trademark Applications and Registrations Retrieval (“TARR”) database on the USPTO website at <http://tarr.uspto.gov/>. Timely public notification of the filing of applications is important because granting a filing date to an application potentially establishes a date of constructive use of the mark (see TMEP §201.02). Therefore, an application must include a clear drawing of the mark to receive a filing date. 37 C.F.R. §2.21(a)(3); TMEP §202.01.

Examining attorneys must require applicants to comply promptly with the drawing rules. Requests to defer drawing corrections until the application is approved for publication or registration should be denied.

There are two forms of drawings: “special form drawings,” and “standard character drawings.” See TMEP §§807.03 *et seq.* for information about standard character drawings, and TMEP §§807.04 *et seq.* for information about special form drawings. (*Note:* “Typed” drawings are acceptable for applications filed before November 2, 2003. See TMEP §807.03(i).)

The mark in the drawing must agree with the mark as used on the specimen in an application under §1 of the Trademark Act, 15 U.S.C. §1051; as applied for or registered in a foreign country in an application under §44, 15 U.S.C. §1126; or as it appears in the international registration in an application under §66(a), 15 U.S.C. §1141f(a). 37 C.F.R. §2.51; TMEP §§807.12 *et seq.* and 1011.01.

## APPLICATION REQUIREMENTS

### 807.01 Drawing Must Show Only One Mark

An application must be limited to only one mark. 15 U.S.C. §1051(a)(1); 37 C.F.R. §2.52.

Under 37 C.F.R. §2.21(a)(3), an applicant must submit “a clear drawing of the mark” to receive a filing date. An application that includes two or more drawings displaying materially different marks does not meet this requirement. Two marks are considered to be materially different if the substitution of one for the other would be a material alteration of the mark, within the meaning of 37 C.F.R. §2.72 (see TMEP §§807.14 *et seq.*).

Accordingly, if an applicant submits two or more drawing pages, the application is denied a filing date, because the applicant has not met the requirement for a clear drawing of the mark. See TMEP §202.01 for further information. However, if an applicant submits a separate drawing page (or a digitized image of a separate drawing page in a TEAS application) showing a mark, and a different mark appears in the written application, the application will receive a filing date, and the drawing page will control for purposes of determining what the mark is. The USPTO will disregard the mark in the written application. *In re L.G. Lavorazioni Grafite S.r.l.*, 61 USPQ2d 1063 (Dir USPTO 2001). See *Humanoids Group v. Rogan*, 375 F.3d 301, 71 USPQ2d 1745 (4<sup>th</sup> Cir. 2004).

The USPTO will not deny a filing date if the drawing shows spatially separate elements. If the applicant submits an application where the “drawing” is composed of multiple elements on a separate page, multiple elements on a single digitized image, or multiple elements in a separate area of the body of the application, the applicant has met the requirement of 37 C.F.R. §2.21(a)(3) for a clear drawing of the mark. The examining attorney must determine whether the matter presented for registration is a single mark projecting a unitary commercial impression. See TMEP §807.12(d) regarding “mutilation” or incomplete representation of the mark.

For example, when the drawing consists of a photocopy of the specimen showing spatially separate elements, the examining attorney must determine whether this constitutes more than one mark.

If the examining attorney determines that spatially separate elements constitute two or more different marks, the examining attorney should refuse registration under §§1 and 45 of the Trademark Act, 15 U.S.C. §§1051 and 1127, on the ground that the applicant seeks registration of more than one mark. See *In re Hayes*, 62 USPQ2d 1443 (TTAB 2002); *In re Elvis Presley Enterprises, Inc.*, 50 USPQ2d 1632 (TTAB 1999); *In re Walker-Home Petroleum, Inc.*, 229 USPQ 773 (TTAB 1985); *In re Jordan Industries, Inc.*, 210 USPQ 158 (TTAB 1980); *In re Audi NSU Auto Union AG*, 197 USPQ 649 (TTAB 1977); *In re Magic Muffler Service, Inc.*, 184 USPQ 125 (TTAB 1974); *In re Robertson Photo-Mechanix, Inc.*, 163 USPQ 298 (TTAB 1969).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

When registration is refused because the matter presented on the drawing does not constitute a single mark, the application filing fee will not be refunded. The applicant may amend the drawing if the amendment does not materially alter the mark, or may submit arguments that the matter on the drawing does in fact constitute a single mark. See TMEP §§807.14 *et seq.* regarding material alteration, and TMEP §807.14(a) regarding deletion of matter from the drawing.

If the mark is duplicated in some form on the drawing (e.g. a typed word and a stylized display of the same word), this is generally not considered to be two materially different marks, and deletion of one of the marks is permitted.

See TMEP §§1214 *et seq.* regarding the refusal of registration of a mark with a “phantom” element on the ground that it includes more than one mark in a single application.

See also *In re Upper Deck Co.*, 59 USPQ2d 1688 (TTAB 2001) (hologram used on trading cards in varying shapes, sizes, contents and positions constitutes more than one “device” as contemplated by §45 of the Trademark Act).

### **807.02 Drawing Must Be Limited to Mark**

The drawing allows the Office to properly code and index the mark for search purposes, indicates what the mark is, and provides a means for reproducing the mark in the *Official Gazette* and on the certificate of registration. Therefore, matter that appears on the specimen that is not part of the mark should not be placed on the drawing. Purely informational matter such as net weight, contents, or business addresses are generally not considered part of the mark.

Quotation marks and hyphens should not be included in the mark on a drawing unless they are a part of the mark. The drawing should not include extraneous matter such as the letters “TM,” “SM,” the copyright notice ©, or the federal registration notice ®. See TMEP §§906 *et seq.* regarding use of the federal registration notice.

See TMEP §807.14(a) regarding requirements for removal of matter from the drawing.

### **807.03 Standard Character Drawings**

*37 C.F.R. §2.52(a) Standard character (typed) drawing. Applicants who seek to register words, letters, numbers, or any combination thereof without claim to any particular font style, size, or color must submit a standard character drawing that shows the mark in black on a white background. An applicant may submit a standard character drawing if:*

*(1) The application includes a statement that the mark is in standard characters and no claim is made to any particular font style, size, or color;*



## APPLICATION REQUIREMENTS

- (2) *The mark does not include a design element;*
- (3) *All letters and words in the mark are depicted in Latin characters;*
- (4) *All numerals in the mark are depicted in Roman or Arabic numerals; and*
- (5) *The mark includes only common punctuation or diacritical marks.*

Effective November 2, 2003, Trademark Rule 2.52, 37 C.F.R. § 2.52, was amended to replace the term “typed” drawing with “standard character” drawing. Applicants who seek to register a mark without any claim as to the manner of display must submit a standard character drawing that complies with the requirements of 37 C.F.R. §2.52(a).

### **807.03(a) Requirements for Standard Character Drawings**

An applicant may submit a standard character drawing if:

- The mark does not include a design element;
- All letters and words in the mark are depicted in Latin characters;
- All numerals in the mark are depicted in Roman or Arabic numerals;
- The mark includes only common punctuation or diacritical marks; and
- No stylization of lettering and/or numbers is claimed in the mark.

37 C.F.R. §2.52(a).

In the drawing, the applicant may depict the mark in any font style; may use bold or italicized letters; and may use both uppercase and lowercase letters, all uppercase letters, or all lowercase letters. The applicant does not have to display the mark in all uppercase letters.

Superscripts, subscripts, exponents, or other characters that are not in the USPTO's standard character set (see TMEP §807.03(b)) are *not* permitted in standard character drawings. *In re AFG Industries Inc.*, 17 USPQ2d 1162 (TTAB 1990) (special form drawing required for raised numeral). The degree symbol is permitted.

Underlining is not permitted in a standard character drawing.

The drawing must be in black and white.

*Standard Character Claim Required.* An applicant who submits a standard character drawing must also submit the following standard character claim:

The mark consists of standard characters without claim to any particular font, style, size or color.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

This statement will appear in the *Official Gazette* and on the certificate of registration.

### **807.03(b) List of Standard Characters**

The Office has created a standard character set that lists letters, numerals, punctuation marks, and diacritical marks that may be used in a standard character drawing. The standard character set is available on the Office's website at <http://www.uspto.gov/teas/StandardCharacterSet.html>. If the applicant has claimed standard character format and the drawing includes elements that are not in the set, then the examining attorney must treat the drawing as a special form drawing, ensure that the mark drawing code is changed, and require the applicant to delete the standard character claim. See TMEP §807.18 concerning mark drawing codes.

In a §66(a) application, if the drawing includes elements that are not in the standard character set, the examining attorney must require deletion of the standard character claim even if the international registration indicates that the mark is in standard characters. See the IB's *Guide to International Registration*, Para. B.II.14.08 (2004).

### **807.03(c) Drawings Containing Both a Standard Character Claim and Designs or Other Elements**

If the application contains a standard character claim, but the mark includes a design element; or color; or a claim of a particular style or size of lettering; or other elements such that the mark does not meet the requirements of 37 C.F.R. §2.52(a), then the examining attorney must: (1) treat the drawing as a special form drawing; and (2) require that the applicant delete the standard character claim from the record. In addition, the examining attorney must ensure that the appropriate mark drawing code is entered into the TRAM database. See TMEP §807.18 concerning mark drawing codes.

### **807.03(d) Changing From Special Form Elements to Standard Characters, or the Reverse, May be a Material Alteration**

A special form drawing containing a design element, color, a claim to a particular style or size of lettering, or other distinctive elements cannot be amended to a standard character drawing unless the examining attorney determines that the amendment is non-material. 37 C.F.R. §2.72.

Conversely, a standard character drawing cannot be amended to a special form drawing containing a design element, color, or a claim to a distinctive style or size of lettering, unless the examining attorney determines that the amendment is non-material. 37 C.F.R. §2.72. See TMEP §§807.14 *et seq.* regarding material alteration.

## APPLICATION REQUIREMENTS

### **807.03(e) Standard Character Drawing and Specimen of Use**

If the applicant submits a claim of standard character format, the mark shown in the drawing does not necessarily have to appear in the same font style, size, or color as the mark shown on the specimen of use. However, the examining attorney must review the mark depicted on the specimen to determine whether a standard character claim is appropriate, or whether a special form drawing is required.

If the examining attorney determines that the standard characters are displayed in a distinctive manner that changes the meaning or overall commercial impression of the mark, the examining attorney must process the drawing as a special form drawing, and require the applicant to delete the standard character claim. As with all special form drawings, the mark on the drawing must be a substantially exact representation of the mark used on the specimen in an application under §1 of the Trademark Act. 37 C.F.R. §§2.51(a) and (b); TMEP §807.12(a).

The examining attorney may delete the standard character claim by examiner's amendment after obtaining approval from the applicant or applicant's attorney. When deleting a standard character claim, the examining attorney must ensure that the mark drawing code is changed. See TMEP §807.18 concerning mark drawing codes.

See TMEP §807.04(b) for further information as to when a special form drawing is required.

### **807.03(f) Standard Character Drawing and Foreign Registration**

In a §44 application, if the applicant claims standard characters, the examining attorney must ensure that the foreign registration also claims standard characters. 37 C.F.R. §2.51(c); TMEP §807.12(b).

If the foreign registration certificate does not indicate that the mark is in standard characters (or the equivalent), the examining attorney must inquire whether the foreign registration includes a claim that the mark is in standard characters. The applicant must either submit an affirmative statement that the foreign registration includes a claim that the mark is in standard characters (or the equivalent), or delete the standard character claim in the United States application. A statement that the foreign registration includes a claim that the mark is in standard characters may be entered through a Note to the File, if there are no other outstanding issues.

The examining attorney may delete the standard character claim by examiner's amendment after obtaining approval from the applicant or applicant's attorney. When deleting a standard character claim, the examining attorney must ensure that the mark drawing code is changed. See TMEP §807.18 concerning mark drawing codes.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **807.03(g) Drawings in “Typed” Format With No Standard Character Claim**

*Section 1 Applications.* If the application does not include a standard character claim, but the mark is shown in a format that would have been considered “typed” prior to November 2, 2003 (*i.e.*, the mark is shown in all capital letters, or the mark is specified as “typed” in the body of the application, on a separate drawing page, or on a cover letter filed with the application), the drawing will initially be coded and entered into the automated records of the USPTO as a special form drawing. However, the examining attorney shall treat the drawing of the mark as a standard character drawing, and ensure that a standard character claim is entered into the record.

If the application is ready to be published for opposition, the examining attorney should enter the standard character claim by examiner’s amendment. In this situation, no prior authorization from the applicant is required to add a claim by an examiner’s amendment. See TMEP §707.02. If an Office action is necessary, it must include a requirement that the applicant submit a standard character claim.

Once applicant submits a standard character statement, the examining attorney should ensure that the mark drawing code is changed to 4 (see TMEP §807.18).

*Section 44 Applications.* In a §44 application, the applicant cannot claim standard characters unless the foreign registration also claims standard characters. See TMEP §807.03(f).

*Section 66(a) Applications.* In a §66(a) application, the request for extension of protection forwarded by the IB will indicate whether there is a standard character claim in the international registration. If there is no standard character claim in the international registration, the applicant cannot add a standard character claim.

### **807.03(h) Drawings Where The Format Is Unclear**

*Section 1 Applications.* Where it is unclear from the record whether the submitted drawing was intended to be a standard character drawing, then the examining attorney must contact the applicant for clarification. For example, clarification is needed if the font style used in the mark on the drawing does not match the font style used on the specimen and there is no standard character claim in the application, or if the applicant files a paper application in which the mark is printed or written by hand. If the mark is intended to be in standard characters, then the examining attorney must require that the applicant amend the application to include the standard character claim. This may be done by examiner’s amendment. Once applicant submits this statement, the examining attorney should ensure that the mark drawing code is changed to 4 (see TMEP §807.18).

## APPLICATION REQUIREMENTS

*Section 44 Applications.* In a §44 application, the applicant cannot claim standard characters unless the foreign registration also claims standard characters. See TMEP §807.03(f).

*Section 66(a) Applications.* In a §66(a) application, the request for extension of protection forwarded by the IB will indicate whether there is a standard character claim in the international registration. If there is no standard character claim in the international registration, the applicant cannot add a standard character claim.

### **807.03(i) Drawings in Applications Filed Before November 2, 2003**

Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. The mark on a typed drawing had to be typed entirely in capital letters.

For applications filed before November 2, 2003, that are still pending after November 2, 2003, the applicant has the option of submitting a typed drawing in all uppercase letters under the old rules, or a standard character drawing under the new rules. If the drawing of record does not meet the requirements for a typed drawing under the old rules (e.g., the drawing shows the mark in both upper and lower case letters), the examining attorney must require a new drawing. In response, the applicant may submit either (1) a claim of standard characters to convert the drawing to a standard character drawing, or (2) a new drawing in all uppercase letters to comply with the old rules for typed drawings. The examining attorney may enter the standard character claim by an examiner’s amendment, if appropriate.

If the typed drawing in the application is acceptable under the old rules, no action by the examining attorney is required regarding the drawing. However, the applicant may voluntarily amend the typed drawing to a standard character drawing by submitting a claim of standard characters. Voluntary amendments are not permitted in the period between approval for publication and issuance of a registration or notice of allowance, or in the period between approval for registration and issuance of a registration.

If the applicant amends to a standard character drawing, either voluntarily or in response to the examining attorney’s requirement, the examining attorney must have Office records updated to change the mark drawing code to 4. See TMEP §807.18 concerning mark drawing codes. When amending a typed drawing to a standard character drawing, the examining attorney must also create a new drawing page, with the caption “DRAWING” at the top of the page, and have the new drawing page scanned.

### **807.04 Special Form Drawings**

*Extract From 37 C.F.R. §2.52(b). Special form drawing. Applicants who seek to register a mark that includes a two or three-dimensional design; color; and/or words, letters, or numbers or the combination thereof in a particular font style or size must*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*submit a special form drawing. The drawing must show the mark in black on a white background, unless the mark includes color.*

\* \* \* \* \*

### **807.04(a) Characteristics of Special Form Drawings**

A “special form drawing” is a drawing that presents a mark comprised, in whole or in part, of special characteristics such as elements of design or color, styles of lettering, or unusual forms of punctuation.

All special form drawings must be of a quality that will reproduce satisfactorily for scanning into the USPTO’s database. If the drawing is not of a quality that will reproduce satisfactorily for scanning and printing in the *Official Gazette* and on the certificate of registration, the examining attorney must require a new drawing. If there is any doubt as to whether the drawing is acceptable, the examining attorney should contact the Office of Trademark Program Control.

Pasted material, taped material, and correction fluid is not acceptable because it does not reproduce satisfactorily.

See TMEP §807.18 concerning mark drawing codes.

### **807.04(b) When Special Form Drawing is Required**

A special form drawing is required if words, letters or numerals are presented in a distinctive form that changes the meaning or overall commercial impression of the mark. *In re Morton Norwich Products, Inc.*, 221 USPQ 1023 (TTAB 1983); *In re United Services Life Ins. Co.*, 181 USPQ 655 (TTAB 1973); *In re Dartmouth Marketing Co., Inc.*, 154 USPQ 557 (TTAB 1967).

A special form drawing is required for marks that contain superscripts, subscripts, exponents, or other characters that are not in the USPTO’s standard character set. *In re AFG Industries Inc.*, 17 USPQ2d 1162 (TTAB 1990) (special form drawing required for raised numeral). See TMEP §807.03(b) regarding the USPTO’s standard character set.

The USPTO encourages the use of standard character drawings. As a general rule, an applicant may submit a standard character drawing when the word, letter, numeral, or combination thereof creates a distinct commercial impression apart from any stylization or design element appearing on the specimen. If a mark remains the same in essence and is recognizable regardless of the form or manner of display that is presented, displaying the mark in standard character format affords a quick and efficient way of showing the essence of the mark. *In re Oroweat Baking Co.*, 171 USPQ 168 (TTAB 1971) (requirement for special form drawing to register OROWEAT displayed with wheat designs in the letter “O” held improper); *In re*

## APPLICATION REQUIREMENTS

*Electronic Representatives Association*, 150 USPQ 476 (TTAB 1966) (special form drawing not required when acronym makes an impression apart from design).

When an application is for a mark in standard characters, the examining attorney should consider the manner in which the mark is used on the specimen and decide whether the mark includes an essential element or feature that cannot be produced by the use of standard characters. For example, if the mark comprises the prescription symbol Rx, a claim of standard characters would be inappropriate. See TMEP §807.12(a) regarding agreement between the mark on the drawing and the mark used on the specimen.

If the examining attorney determines that the mark in a standard character drawing should have been presented in special form, the applicant may submit a special form drawing if the amendment would not result in a material alteration of the mark. The applicant cannot substitute a special form drawing if the amendment would materially alter the mark. See 37 C.F.R. §2.72; TMEP §§807.14 *et seq.* If a standard character drawing is amended to a special form drawing, the examining attorney should ensure that the mark drawing code is changed. See TMEP §807.18 concerning mark drawing codes.

### **807.05 Electronically Submitted Drawings**

*37 C.F.R. §2.52(c). TEAS drawings. A drawing filed through TEAS must meet the requirements of §2.53.*

*37 C.F.R. §2.53. Requirements for drawings filed through the TEAS.*

*The drawing must meet the requirements of §2.52. In addition, in a TEAS submission, the drawing must meet the following requirements:*

*(a) Standard character drawings: If an applicant is filing a standard character drawing, the applicant must enter the mark in the appropriate field or attach a digitized image of the mark to the TEAS submission that meets the requirements of paragraph (c) of this section.*

*(b) Special form drawings: If an applicant is filing a special form drawing, the applicant must attach a digitized image of the mark to the TEAS submission that meets the requirements of paragraph (c) of this section.*

*(c) Requirements for digitized image: The image must be in .jpg format and scanned at no less than 300 dots per inch and no more than 350 dots per inch with a length and width of no less than 250 pixels and no more than 944 pixels. All lines must be clean, sharp and solid, not fine or crowded, and produce a high quality image when copied.*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The drawing in a TEAS application must meet the requirements of 37 C.F.R. §§2.52 and 2.53.

The Office has waived the requirement of 37 C.F.R. §2.53(c) that drawings have a length and width of no less than 250 pixels and no more than 944 pixels. See notice at 69 Fed. Reg. 59809 (Oct. 6, 2004). However, applicants are encouraged to continue to submit drawings with a length and width of no less than 250 pixels and no more than 944 pixels.

### **807.05(a) Standard Character Drawings Submitted Electronically**

If an applicant is filing a standard character drawing, the applicant must either enter the mark in the appropriate data field or attach a digitized image of the mark that meets the requirements of 37 C.F.R. §2.53(c). The applicant must also submit a standard character claim. 37 C.F.R. §2.52(a)(1); TMEP §807.03(a).

If a standard character drawing is filed through TEAS, the characters entered in the appropriate data field in the TEAS application or TEAS response form are automatically checked against the Office's standard character set. See TMEP §807.03(b) regarding the standard character set.

The standard character set includes two lists: supported characters and unsupported characters. An applicant may submit a standard character claim for a mark that includes characters in the "unsupported character" list; however, TEAS currently cannot create the required .jpg image file. Therefore, if any of the characters in the mark are not in the "supported character" list, the applicant must: (1) attach a digitized image that meets the requirements of 37 C.F.R. §2.53(c), (2) check the box on the form to claim that the mark consists of standard characters, and (3) enter the standard character statement by checking the appropriate box. In this situation, the examining attorney will determine whether the claim to standard characters is appropriate.

If all the characters in the mark are in the "supported character" list, the Office will create a digitized image that meets the requirements of 37 C.F.R. §2.53(c), and automatically generate the standard character statement. The application record will indicate that standard characters have been claimed and that the Office has created the image. If the Office created the digitized image, the examining attorney need not check the standard character drawing against the standard character set during examination.

If the Office did not create the digitized image, the examining attorney must check the standard characters in the drawing against the standard character set. If the characters are not in the set, the examining attorney must process the drawing as a special form drawing, require the applicant to delete the standard character claim, and ensure that the mark drawing code is changed. See TMEP §807.18 concerning mark drawing codes.



## APPLICATION REQUIREMENTS

### **807.05(a)(i) Long Marks in Standard Character Drawings**

As noted in TMEP §807.05(a), when an applicant is filing a standard character drawing, the applicant must either enter the mark in the appropriate data field or attach a digitized image of the mark that meets the requirements of 37 C.F.R. §2.53(c).

If the applicant enters a mark that exceeds 19 characters into the standard character word mark field, the USPTO's automated system will automatically break the mark, so that it fits into the *Official Gazette*; however, no break will be made in the middle of a recognized word. If the applicant has a preference as to where the mark will be broken, the applicant must attach a digitized image that meets the requirements of 37 C.F.R. §2.53(c). See TMEP §807.05(c) regarding the requirements for digitized images.

### **807.05(b) Special Form Drawings Submitted Electronically**

If the mark is in special form, the applicant must attach to the electronic submission a digitized image of the mark that meets the requirements of 37 C.F.R. §2.53(c). See TMEP §807.05(c).

### **807.05(c) Requirements for Digitized Images**

The image must be in .jpg format; scanned at no less than 300 dots per inch and no more than 350 dots per inch. All lines must be clean, sharp and solid, must not be fine or crowded, and must produce a high quality image. 37 C.F.R. §2.53(c). It is recommended that drawings have a length of no less than 250 pixels and no more than 944 pixels, and a width of no less than 250 pixels and no more than 944 pixels.

Mark images should have little or no white space appearing around the design of the mark. If scanning from a paper image of the mark, it may be necessary to cut out the mark and scan it with little or no surrounding white space. Failure to do this may cause the mark to appear very small in the Office's automated records, such that it may be difficult to recognize all words or design features of the mark. To ensure that there is a clear image of the mark in the automated records of the Office, examining attorneys and legal instruments examiners should view the mark on the Publication Review program available on the Office's internal computer network.

Where the mark is depicted in black and white, the image must include only the colors black and white. When scanning an image, the applicant should confirm that the settings on the scanner are set to create a black and white image file, not a color image file.

Mark images should not include extraneous matter such as the symbols TM or SM, or the registration notice ®. The image should be limited to the mark. See TMEP §807.02.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 807.06 Paper Drawings

37 C.F.R. §2.52(d). *Paper drawings. A paper drawing must meet the requirements of §2.54.*

37 C.F.R. §2.54. *Requirements for drawings submitted on paper.*

*The drawing must meet the requirements of §2.52. In addition, in a paper submission, the drawing should:*

(a) *Be on non-shiny white paper that is separate from the application;*

(b) *Be on paper that is 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long. One of the shorter sides of the sheet should be regarded as its top edge. The image must be no larger than 3.15 inches (8 cm) high by 3.15 inches (8 cm) wide;*

(c) *Include the caption "DRAWING PAGE" at the top of the drawing beginning one inch (2.5 cm.) from the top edge; and*

(d) *Depict the mark in black ink, or in color if color is claimed as a feature of the mark.*

(e) *Drawings must be typed or made with a pen or by a process that will provide high definition when copied. A photolithographic, printer's proof copy, or other high quality reproduction of the mark may be used. All lines must be clean, sharp and solid, and must not be fine or crowded.*

Paper drawings may be filed by mail or hand delivery. Drawings may *not* be submitted by facsimile transmission. 37 C.F.R. §2.195(d)(2).

The drawing must meet the requirements of 37 C.F.R. §§2.52 and 2.54.

#### 807.06(a) Type of Paper and Size of Mark

*Size of Mark.* The mark on the drawing should be no larger than 3.15 inches high by 3.15 inches wide (8 cm high by 8 cm wide). 37 C.F.R. §2.54(b).

The Office will create a digitized image of all drawings submitted on paper. The examining attorney must view the mark on the Publication Review program, available on the Office's internal computer network. If the display of the mark appears to be clear and accurate, the examining attorney will presume that the drawing meets the size requirements of the rule.

*Type of Paper and Recommended Format.* The drawing should:

- Be on non-shiny white paper that is separate from the application;

## APPLICATION REQUIREMENTS

- Be on paper that is 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long. One of the shorter sides of the sheet should be regarded as its top edge;
- Include the caption “DRAWING PAGE” at the top of the drawing beginning one inch (2.5 cm.) from the top edge; and
- Depict the mark in black ink, or in color if color is claimed as a feature of the mark.

37 C.F.R. §§2.54(a) through (d).

The drawing must be typed or made with ink or by a process that will provide high definition when scanned. A photolithographic, printer’s proof copy, or other high quality reproduction of the mark may be used. All lines must be clean, sharp and solid, and must not be fine or crowded. 37 C.F.R. §2.54(e).

### **807.06(b) Long Marks in Standard Character or Typed Drawings**

#### ***Standard Character Drawings***

Because all standard character drawings (see TMEP §807.03) are stored in USPTO systems as an image, a standard character drawing must meet the 3.15 inch (8 cm) by 3.15 inch (8 cm) requirement of 37 C.F.R. §2.54(b). If the mark is too long to meet this requirement, applicant must submit an image on which the mark is broken in an appropriate place. It is suggested that the applicant use 14 point type to ensure that the mark will be legible in the *Official Gazette* and on the certificate of registration.

If an applicant submits an image on which the mark exceeds the size requirements of 37 C.F.R. §2.54(b), the USPTO will reduce the image so that it will meet these requirements. See TMEP §807.06(a). This could cause the mark to appear very small. To ensure that the mark will be legible in the *Official Gazette* and on the certificate of registration, the examining attorney should view the mark on the Publication Review program available on the Office’s internal computer network. If the mark is not legible, the examining attorney should require a new drawing that meets the requirements of 37 C.F.R. §§2.52 and 2.54.

#### ***Typed Drawings In Applications Filed Before November 2, 2003***

If the mark on a typed drawing in an application filed before November 2, 2003 (see TMEP §807.03(i)), exceeds the width of a column in the *Official Gazette* (approximately 18 characters), the USPTO’s automated system will automatically break the mark, so that it fits into the *Official Gazette*. If the applicant has a preference as to where the mark will be broken, the applicant must submit a special form drawing.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **807.06(c) Separate Drawing Page Preferred**

The USPTO recommends that an applicant submit a drawing of the mark on a separate page from the written application. 37 C.F.R. §2.54(a). However, a separate drawing page is not mandatory. Instead of a drawing page, an applicant may include a drawing of the mark embedded in the application. The drawing might appear in the heading or in the body of the application.

If the applicant identifies a separate page as a drawing (e.g., by labeling it as a drawing, or providing a heading with the applicant's name, address and the subject goods/services), this will be the only drawing considered.

A mark depicted on the specimen or in the foreign registration certificate will not be considered a drawing.

If there is no separate drawing page, the examining attorney must review the application to determine what the mark is. If an embedded drawing meets the requirements of 37 C.F.R. §§2.51, 2.52 and 2.54, the examining attorney should accept it and not require a substitute drawing.

A separate drawing page is considered part of the written application, not a separate element. Dates of use, disclaimers, descriptions of the mark, identifications of goods/services, and other information that appears on the drawing are also considered part of the written application. This applies to substitute drawings as well as original drawings. If there is an inconsistency between the information on the drawing page and the information in the body of the application, the examining attorney must require clarification.

If an applicant submits a separate drawing page showing a mark, and a different mark appears in the written application, the drawing controls for purposes of determining what the mark is. See TMEP §807.01.

### **807.07 Color in the Mark**

*37 C.F.R. §2.52(b)(1). Color marks. If the mark includes color, the drawing must show the mark in color, and the applicant must name the color(s), describe where the color(s) appear on the mark, and submit a claim that the color(s) is a feature of the mark.*

If an applicant uses color in a mark, the applicant generally has the option of applying to register the mark either in black and white or in the color(s) shown on the specimen. If the applicant applies to register the mark in black and white, the applicant must submit a black and white drawing. If the applicant applies to register the mark in color, the applicant must submit a color drawing.

## APPLICATION REQUIREMENTS

See TMEP §§1202.05 *et seq.* regarding the registration of marks that consist solely of one or more colors used on particular objects.

### **807.07(a) Requirements for Color Drawings**

For applications filed on or after November 2, 2003, the Office does not accept black and white drawings with a color claim, or drawings that show color by use of lining patterns. 37 C.F.R. §2.52(b)(1).

Color drawings must be accompanied by the following: (1) a color claim naming the color(s) that are a feature of the mark; and (2) a separate statement describing where the color(s) appear on the mark. 37 C.F.R. §2.52(b)(1). A color drawing will not publish without both of these statements. See TMEP §807.07(a)(i) regarding the color claim, and TMEP §807.07(a)(ii) regarding the statement describing the color(s).

#### **807.07(a)(i) Color Must Be Claimed as a Feature of the Mark**

If an applicant submits a color drawing, the applicant must claim color as a feature of the mark. 37 C.F.R. §2.52(b)(1). A properly worded color claim would read as follows:

The color(s) *<name the color(s)>* are claimed as a feature of the mark.

If the color claim is unclear or ambiguous, the examining attorney must require clarification.

In an application filed on or after November 2, 2003, an applicant cannot file a color drawing with a statement that "no claim is made to color" or "color is not a feature of the mark." If this occurs, the examining attorney must require the applicant to claim color as a feature of the mark. The applicant may not substitute a black and white drawing unless the examining attorney determines that color is non-material.

#### **807.07(a)(ii) Applicant Must Name and Describe Colors**

If an applicant submits a color drawing, the applicant must name the colors and describe where they appear on the mark. 37 C.F.R. §2.52(b)(1). A properly worded description would read as follows:

The color(s) *<name the color(s)>* appear in *<specify portion of mark on which color(s) appear>*.

If the description is unclear or ambiguous, the examining attorney must require clarification.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

It is usually not necessary to indicate shades of a color, but the examining attorney has the discretion to require that the applicant indicate shades of a color, if necessary to accurately describe the mark.

The applicant may supplement the required written description of the color contained in a mark with a reference to a commercial color identification system. The Office does not endorse or recommend any one commercial color identification system. The written description of the mark must include a generic description of the color, in addition to the reference to the commercial color identification system.

See TMEP §1202.05(e) for additional information regarding the requirement for a written explanation of a mark consisting solely of color.

### **807.07(b) Color Drawings Filed Without a Color Claim**

If the applicant submits a color drawing but does not include a color claim in the written application, and if the color is a material element of the mark, the examining attorney must require the applicant to submit a color claim naming the color(s) that are a feature of the mark, and a separate statement describing where the color(s) appear on the mark.

In an application under §1 or §44, if the examining attorney determines that the color is a non-material element of the drawing, the applicant may be given the option of submitting a black and white drawing.

In an application under §66(a), the drawing of the mark must be a substantially exact representation of the mark as it appears in the international registration. 37 C.F.R. §2.51(d); TMEP §807.12(c). The IB will include a reproduction that is identical to the reproduction in the international registration when it forwards the request for extension of protection of the international registration to the United States. The mark in a §66(a) application cannot be amended. TMEP §807.13(b). Therefore, if the mark in the international registration is in color, the applicant may not substitute a black and white drawing. The applicant must submit a color claim.

### **807.07(c) Color Drawings Filed With an Incorrect Color Claim**

Where the color shown in the drawing page in a paper application, or in the digitized image of the drawing page in a TEAS application, is inconsistent with the color claimed in the written application (*e.g.*, the mark is shown in blue in the drawing, but the color claimed is orange), then the drawing controls. The color claim may be corrected to conform to the drawing. The drawing may not be corrected to conform to the color claim unless the examining attorney determines that the amendment is non-material.

## APPLICATION REQUIREMENTS

### **807.07(d) Black and White Drawings and Color Claims**

If an applicant submits a black and white drawing that is lined for color (see TMEP §808.01(d)), or if the applicant submits a black and white drawing with an application that includes a color claim, the examining attorney must require that applicant submit a color drawing, a color claim naming the color(s) that are a feature of the mark, and a separate statement describing where the color(s) appear on the mark. If, however, the examining attorney determines that the color is a non-material element of the drawing, the applicant may instead be given the option of submitting a black and white drawing that is not lined for color, or deleting the color claim in the written application, whichever is applicable.

If an applicant submits a black and white drawing that is not lined for color, and there is no color claim in the written application, generally the applicant cannot substitute a color drawing and claim color, unless the examining attorney determines that the color is a non-material element of the drawing.

### **807.07(e) Gray Tones in Drawings**

The Office now accepts drawings that contain the color gray, or stippling that produces gray tones. Unless an applicant claims the color gray, color will not be considered to be a feature of the mark and the drawing will be processed as a black and white drawing. If the applicant claims the color gray, the drawing will be processed like any other color drawing (see TMEP §§807.07(a) through (c)), and the color claim will be printed in the *Official Gazette* and on the certificate of registration.

If the drawing contains the color gray, or stippling that produces gray tones, and the record is unclear as to whether applicant is claiming color, the examining attorney must require the applicant to clarify the ambiguity. Even if the applicant is not claiming color, the Office will accept a drawing that contains gray tones or stippling. A mark with gray tones or stippling will not be considered a color drawing unless the applicant claims color.

When a mark contains stippling, it is generally not necessary to require a statement that the stippling represents shading or is a feature of the mark, unless the examining attorney believes such a statement is necessary to accurately describe the mark. See TMEP §808.01(d) regarding stippling statements.

### **807.07(f) Drawings in Applications Filed Before November 2, 2003**

In applications filed before November 2, 2003, if the drawing of record does not meet the requirements for claiming color under the old rules, the examining attorney must require a new drawing. In response, the applicant may submit either (1) a black and white drawing that meets the requirements for claiming color under the old rules, or (2) a color drawing with the required statements for claiming color under the new rules (TMEP §807.07(a)).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If the drawing in an application filed before November 2, 2003 is acceptable under the old rules, no action by the examining attorney is required. However, unless the application included a statement that color was not claimed as a feature of the mark (or that no claim was made to color), the applicant may voluntarily submit a color drawing under the new rules, with the requisite color claim and a separate description of the color(s) in the mark. Voluntary amendments are *not* permitted in the period between approval for publication and issuance of a registration or notice of allowance, or in the period between approval for registration and issuance of the registration.

Similarly, a registrant may substitute a color drawing for a black and white drawing in a registration where color is claimed, by filing a §7 request to amend the registration certificate. The request must include: (1) a color drawing; (2) a color claim; (3) a description of where the color appears in the mark; and (4) the fee required by 37 C.F.R. §2.6. See TMEP §1609.02(d).

### **807.08 Broken Lines to Show Placement**

*37 C.F.R. §2.52(b)(4). Broken lines to show placement. If necessary to adequately depict the commercial impression of the mark, the applicant may be required to submit a drawing that shows the placement of the mark by surrounding the mark with a proportionately accurate broken-line representation of the particular goods, packaging, or advertising on which the mark appears. The applicant must also use broken lines to show any other matter not claimed as part of the mark. For any drawing using broken lines to indicate placement of the mark, or matter not claimed as part of the mark, the applicant must describe the mark and explain the purpose of the broken lines.*

Occasionally the position of the mark on the goods, or on a label or container, may be a feature of the mark. If necessary to adequately depict the commercial impression of the mark, the examining attorney may require the applicant to submit a drawing that shows the placement of the mark by surrounding the mark with a proportionately accurate broken-line representation of the particular goods, packaging, or advertising on which the mark appears. The applicant must also use broken lines to show any other matter not claimed as part of the mark. For any drawing using broken lines to indicate placement of the mark, or matter not claimed as part of the mark, the applicant must include a written description of the mark, indicating that the matter shown by the dotted lines is not a part of the mark and that it serves only to show the position of the mark. 37 C.F.R. §2.52(b)(4).

The drawing should clearly define the matter the applicant claims as its mark. See *In re Water Gremlin Co.*, 635 F.2d 841, 208 USPQ 89 (C.C.P.A. 1980); *In re Famous Foods, Inc.*, 217 USPQ 177 (TTAB 1983).



## APPLICATION REQUIREMENTS

### 807.09 “Drawing” of Sound, Scent, or Non-Visual Mark

*37 C.F.R. §2.52(e). Sound, scent, and non-visual marks. An applicant is not required to submit a drawing if the mark consists only of a sound, a scent, or other completely non-visual matter. For these types of marks, the applicant must submit a detailed description of the mark.*

The applicant is not required to submit a drawing if the applicant’s mark consists *solely* of a sound, a scent, or other completely non-visual matter. For these types of marks, the applicant must submit a detailed written description of the mark that clearly explains the sound or scent. 37 C.F.R. §2.52(e).

In a paper application, the applicant should submit a page that indicates “NO DRAWING” in the place where the mark would otherwise appear. Likewise, in a TEAS application, the applicant should create a digitized image in .jpg format that meets the requirements of 37 C.F.R. §2.53(c) (see TMEP §807.05(c)), with the indication “NO DRAWING” in the place where the mark would otherwise appear. Then, in the description of the mark field (under “Additional Statements” in the TEAS form), the applicant must set forth a detailed written description of the mark.

Non-visual marks are coded under mark drawing code 6 in the automated search system.

If the mark is a composite comprising both visual and non-visual matter, the applicant must submit a drawing depicting the visual matter, and include a description of the non-visual matter.

If the mark comprises music or words set to music, the applicant may submit the musical score for the record. In a TEAS application, the musical score should be submitted in .wav format. However, a .wav file cannot be sent as an attachment to a TEAS filing, because all TEAS attachments must be in .jpg format. Therefore, the Office has developed a special procedure for handling .wav files. The .wav file must be sent after the application is filed, as an attachment to an e-mail message directed to [PrinTEAS@uspto.gov](mailto:PrinTEAS@uspto.gov), with clear instructions that the .wav file should be associated with “the application filed under Serial No. <specify>.” See TMEP §1202.15 regarding sound marks.

### 807.10 Three Dimensional Marks

*37 C.F.R. §2.52(b)(2). Three dimensional marks. If the mark has three-dimensional features, the drawing must depict a single rendition of the mark, and the applicant must indicate that the mark is three-dimensional.*

If the mark is three-dimensional, the drawing should present the mark in three dimensions. *In re Schaefer Marine, Inc.*, 223 USPQ 170, 175 n. 1 (TTAB 1984).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The applicant must include a description of the mark indicating that the mark is three-dimensional.

Under 37 C.F.R. §2.52(b)(2), the applicant must submit a drawing that depicts a single rendition of the mark. If the applicant believes that its mark cannot be adequately depicted in a single rendition, the applicant may file a petition under 37 C.F.R. §2.146 requesting that the rule be waived. See TMEP Chapter 1700 regarding petitions.

### **807.11 Marks With Motion**

*37 C.F.R. §2.52(b)(3). Motion marks. If the mark has motion, the drawing may depict a single point in the movement, or the drawing may depict up to five freeze frames showing various points in the movement, whichever best depicts the commercial impression of the mark. The applicant must also describe the mark.*

If the mark includes motion (*i.e.*, a repetitive motion of short duration) as a feature, the applicant may submit a drawing that depicts a single point in the movement, or the applicant may submit a square drawing that contains up to five freeze frames showing various points in the movement, whichever best depicts the commercial impression of the mark. The applicant must also submit a detailed written description of the mark. 37 C.F.R. §2.52(b)(3).

### **807.12 Mark on Drawing Must Agree with Mark on Specimen or Foreign Registration**

*37 C.F.R. §2.51 Drawing required.*

*(a) In an application under section 1(a) of the Act, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.*

*(b) In an application under section 1(b) of the Act, the drawing of the mark must be a substantially exact representation of the mark as intended to be used on or in connection with the goods and/or services specified in the application, and once an amendment to allege use under §2.76 or a statement of use under §2.88 has been filed, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.*

*(c) In an application under section 44 of the Act, the drawing of the mark must be a substantially exact representation of the mark as it appears in the drawing in the registration certificate of a mark duly registered in the applicant's country of origin.*

*(d) In an application under section 66(a) of the Act, the drawing of the mark must be a substantially exact representation of the mark as it appears in the international registration.*

## APPLICATION REQUIREMENTS

### **807.12(a) Applications Under §1 of the Trademark Act**

In an application filed under §1(a) of the Trademark Act, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods or services, as shown by the specimen. 37 C.F.R. §§2.51(a) and 2.72(a)(1).

In an application filed under §1(b) of the Act, the drawing of the mark must be a substantially exact representation of the mark as intended to be used on or in connection with the goods or services, *and* as actually used as shown by the specimen filed with the amendment to allege use or statement of use. 37 C.F.R. §§2.51(b) and 2.72(b)(1).

Extraneous matter shown on the specimen that is not part of the mark (*e.g.*, the symbols “TM” or “SM,” the registration notice ®, the top level domain indicator “.com,” or informational matter such as net weight or contents) need not be shown on the drawing. See TMEP §807.14(a) regarding deletion of non-distinctive matter.

When the mark on the drawing does not agree with the mark on the specimen, the applicant cannot amend the drawing if the amendment would materially alter the mark on the original drawing. 37 C.F.R. §§2.72(a) and (b); TMEP §§807.14 *et seq.*

See TMEP §1214.02 regarding the agreement of the mark on the drawing with the mark on the specimen in an application that seeks registration of a mark with a “phantom” or changeable element.

### **807.12(b) Applications Under §44 of the Trademark Act**

In a §44 application, the drawing of the mark must be “a substantially exact representation of the mark as it appears in the drawing in the registration certificate of the mark registered in the applicant’s country of origin.” 37 C.F.R. §§2.51(c) and 2.72(c)(1). The standard for determining whether the mark in the drawing agrees with the mark in the foreign registration is stricter than the standard used to determine whether a specimen supports use of a mark in an application under §1 of the Trademark Act. See TMEP §1011.01. The drawing in the United States application must display the entire mark as registered in the foreign country. The applicant may not limit the mark to part of the mark shown in the foreign registration, even if it creates a separate and distinct commercial impression.

*Exception:* Non-material informational matter that appears on the foreign registration, such as net weight or contents, or the federal registration notice, may be omitted or deleted from the drawing.

When the mark on the drawing does not agree with the mark on the foreign registration, the applicant cannot amend the drawing of the mark if the amendment

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

would materially alter the mark on the original drawing. 37 C.F.R. §2.72(c); TMEP §§807.14 *et seq.* and 1011.01.

See TMEP §1214.02 regarding the agreement of the mark on the drawing with the mark on the foreign registration in an application that seeks registration of a mark with a “phantom” or changeable element.

### **807.12(c) Applications Under §66(a) of the Trademark Act**

In an application under §66(a) of the Trademark Act, the drawing of the mark must be a substantially exact representation of the mark as it appears in the international registration. 37 C.F.R. §2.51(d). The IB will include a reproduction that is identical to the reproduction in the international registration when it forwards the request for extension of protection of the international registration to the United States. It is therefore unnecessary for the examining attorney to compare the drawing in the §66(a) application with the reproduction in the international registration. See TMEP §§1904 *et seq.* for further information about §66(a) applications. The mark in a §66(a) application cannot be amended. TMEP §807.13(b).

*Exception:* Non-material informational matter that appears on the international registration, such as net weight or contents, or the federal registration notice, may be omitted or deleted from the drawing.

### **807.12(d) Mutilation or Incomplete Representation of Mark**

In an application under §1 of the Trademark Act, the mark on the drawing must be a complete mark, as evidenced by the specimen. When the representation on a drawing does not constitute a complete mark, it is sometimes referred to as “mutilation.” This term indicates that essential and integral subject matter is missing from the drawing. An incomplete mark may not be registered.

However, in a §1 application, an applicant has some latitude in selecting the mark it wants to register. The mere fact that two or more elements form a composite mark does not necessarily mean that those elements are inseparable for registration purposes. An applicant may apply to register any element of a composite mark if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen.

The determinative factor is whether or not the subject matter in question makes a separate and distinct commercial impression apart from the other element(s). See *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988); *In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257 (C.C.P.A. 1950); *In re Miller Sports Inc.*, 51 USPQ2d 1059 (TTAB 1999); *In re Boyd Coffee Co.*, 25 USPQ2d 2052 (TTAB 1993); *In re Raychem Corp.*, 12 USPQ2d 1399 (TTAB 1989); *In re Sperouleas*, 227 USPQ 166 (TTAB 1985); *In re Volante International Holdings*, 196 USPQ 188 (TTAB 1977); *In re Library Restaurant, Inc.*, 194 USPQ 446 (TTAB 1977); *In re*

## APPLICATION REQUIREMENTS

*Semans*, 193 USPQ 727 (TTAB 1976); *In re Mango Records*, 189 USPQ 126 (TTAB 1975).

In a §44 application, the standard is stricter. TMEP §1011.01. The drawing in the United States application must display the entire mark as registered in the country of origin. The applicant may not register part of the mark in the foreign registration, even if it creates a distinct commercial impression.

In any application, if the mark is refused registration on the ground that the mark on the drawing does not agree with the mark as shown on the specimen or foreign registration, the applicant may not amend the drawing if the amendment would materially alter the mark on the original drawing. 37 C.F.R. §2.72; TMEP §§807.14 *et seq.*, and 1011.01.

This issue will not arise in a §66(a) application, because the IB includes a reproduction that is identical to the reproduction in the international registration when it forwards the request for extension of protection of the international registration to the United States. The mark in a §66(a) application cannot be amended. TMEP §807.13(b).

### **807.12(e) Compound Word Marks and Telescoped Marks**

Like any other drawing, a drawing of a compound word mark or telescoped mark must be a substantially exact representation of the mark as it appears on the specimen in a §1 application or on the foreign registration certificate in a §44 application.

A compound word mark is comprised of two or more distinct words, or words and syllables, that are represented as one word (*e.g.*, BOOKCHOICE, PROSHOT, MAXIMACHINE, PULSAIR). Often, each word or syllable in a compound word mark is displayed or highlighted by (1) capitalizing the first letter of each word or syllable (*e.g.*, TimeMaster), or (2) presenting the words or syllables in a different color, script or size (*e.g.*, RIBtype).

A compound word mark may be presented as one unitary term (*e.g.*, BOOKCHOICE) or as two words (*e.g.*, BOOK CHOICE) on the drawing. The examining attorney should determine whether the mark may be presented as separate words based on its commercial impression, taking into account any specimen(s) of record.

A telescoped mark is comprised of two or more words that share letters (*e.g.*, SUPERINSE). A telescoped word must be presented as a unitary term with the letters shared. The telescoped element may not be represented as two words, because the shared letter is an aspect of the commercial impression, (for example, SUPERINSE, not SUPE RINSE or SUPER RINSE).

See TMEP §§1213.05(a) *et seq.* regarding disclaimers in these types of marks.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 807.13 Amendment of Mark

37 C.F.R. §2.72.

*(a) In an application based on use in commerce under section 1(a) of the Act, the applicant may amend the description or drawing of the mark only if:*

*(1) The specimens originally filed, or substitute specimens filed under §2.59(a), support the proposed amendment; and*

*(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.*

*(b) In an application based on a bona fide intention to use a mark in commerce under section 1(b) of the Act, the applicant may amend the description or drawing of the mark only if:*

*(1) The specimens filed with an amendment to allege use or statement of use, or substitute specimens filed under §2.59(b), support the proposed amendment; and*

*(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.*

*(c) In an application based on a claim of priority under section 44(d) of the Act, or on a mark duly registered in the country of origin of the foreign applicant under section 44(e) of the Act, the applicant may amend the description or drawing of the mark only if:*

*(1) The description or drawing of the mark in the foreign registration certificate supports the amendment; and*

*(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.*

### 807.13(a) Amendment of Mark in Applications Under §§1 and 44

*Section 1(a) Application.* The mark in an application under §1(a) of the Trademark Act can be amended if the specimen supports the amendment and the amendment does not materially alter the mark. 37 C.F.R. §2.72(a). See TMEP §§904 *et seq.* regarding specimens, and TMEP §§807.14 *et seq.* regarding material alteration.

## APPLICATION REQUIREMENTS

*Section 1(b) Application.* The mark in an application under §1(b) of the Trademark Act can be amended if the specimen filed with an amendment to allege use or statement of use supports the amendment, and the amendment does not materially alter the mark. 37 C.F.R. §2.72(b). See TMEP §§904 *et seq.* regarding specimens, TMEP §§1104 *et seq.* regarding amendments to allege use, TMEP §§1109 *et seq.* regarding statements of use, and TMEP §§807.14 *et seq.* regarding material alteration.

*Section 44 Application.* The mark in an application under §44 of the Trademark Act can be amended if the mark in the foreign registration certificate supports the amendment, and the amendment does not materially alter the mark. 37 C.F.R. §2.72(c). See TMEP §1011.01 regarding the requirement that the mark on the drawing in a §44 application be a substantially exact representation of the mark as it appears in the foreign registration certificate, and TMEP §§807.14 *et seq.* regarding material alteration.

### **807.13(b) Mark in §66(a) Application Cannot be Amended**

The Madrid Protocol and the Common Regs. do not permit amendment of the mark in an international registration. If the holder of the international registration wants to change the mark in any way, even slightly, the holder must file a new international application. The IB's *Guide to International Registration*, Para. B.II.69.02 (2004), provides as follows:

[T]here is no provision for a mark that is recorded in the International Register to be amended in any way, either on renewal or at any other time. If the holder wishes to protect the mark in a form which differs, even slightly, from the mark as recorded, he must file a new international application. This is true even if the mark has been allowed to be changed in the basic application, the registration resulting from the basic application or the basic registration, as the case may be....

Accordingly, because an application under §66(a) of the Trademark Act is a part of the international registration, 37 C.F.R. §2.72 makes no provision for amendment of the mark in a §66(a) application, and the USPTO will not permit any such amendments. See notice at 68 FR 55748, 55756 (Sept. 26, 2003).

Similarly, after registration, a registrant cannot amend a mark in a registered extension of protection under §7 of the Trademark Act. TMEP §§1609.01(a) and 1609.02.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 807.14 Material Alteration of Mark

Trademark Rule 2.72, 37 C.F.R. §2.72, prohibits any amendment of the mark in an application under §1 or §44 of the Trademark Act that materially alters the mark on the drawing filed with the original application.

The test for determining whether an amendment is a material alteration is as follows:

The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark. The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it would be tantamount to a new mark appropriate for a new application.

*In re Hacot-Colombier*, 105 F.3d 616, 620, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997), quoting *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740,743-44 (TTAB 1983). This test applies to an amendment of the description of a mark as well as to an amendment of the mark on a drawing. *In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001).

Although the test refers to republication, it also applies to amendments to marks proposed before publication. Material alteration is the standard used for evaluating amendments to marks in all phases of prosecution, *i.e.*, before publication, after publication and after registration. See TMEP §§1609.02 *et seq.* regarding amendment of registered marks.

As a general rule, the addition of any element that would require a further search will constitute a material alteration. *In re Pierce Foods Corp.*, 230 USPQ 307 (TTAB 1986). However, while the question of whether a new search would be required is a factor to be considered in deciding whether an amendment would materially alter a mark, it is not necessarily the determining factor. *In re Who? Vision Systems, Inc.*, 57 USPQ2d 1211 (TTAB 2000); *In re Vienna Sausage Mfg. Co.*, 16 USPQ2d 2044 (TTAB 1990).

Each case must be decided on its own facts, and these general rules are subject to exceptions. The controlling question is always whether the old and new forms of the mark create essentially the same commercial impression.

See TMEP §807.14(a) regarding amendments to delete matter from a drawing, TMEP §807.14(b) regarding the addition or deletion of previously registered matter, and TMEP §§1215.08 *et seq.* regarding material alteration in marks comprised, in whole or in part, of domain names.



## APPLICATION REQUIREMENTS

### 807.14(a) Removal or Deletion of Matter from Drawing

An applicant may request deletions from the mark on the drawing, and the examining attorney may approve the request if he or she believes the deletions are appropriate and would not materially alter the mark. 37 C.F.R. §2.72.

Deletion of matter from the mark can result in a material alteration. See *In re Dillard Department Stores, Inc.*, 33 USPQ2d 1052 (Comm'r Pats. 1993) (proposed deletion of highly stylized display features of mark "IN•VEST•MENTS" held to be a material alteration of a registered mark). However, the deletion of nondistinctive matter may not constitute a material alteration. For example, the deletion of the generic name of the goods or services would not generally be considered a material alteration unless it was so integrated into the mark that the deletion would alter the commercial impression. In some circumstances, descriptive or other types of nondistinctive matter may be deleted if the overall commercial impression is not altered. Also, deletions of matter determined to be unregistrable under §§2(a) or 2(b) of the Act (see TMEP §§1203 and 1204) are sometimes permissible.

If a specimen shows that matter included on a drawing is not part of the mark, the examining attorney may require that such matter be deleted from the mark on the drawing, if the deletion would not materially alter the mark. See *In re Sazerac Co., Inc.*, 136 USPQ 607 (TTAB 1963) and cases cited therein.

The symbols "TM," "SM," and the registration notice ® should be deleted from the drawing.

Informational matter, such as net weight and volume statements, lists of contents, addresses and similar matter, should also be deleted from the mark unless it is truly part of a composite mark and the removal of this matter would alter the overall commercial impression. If unregistrable matter, including informational matter and the name of the goods, is incorporated in a composite mark in such a way that its removal would change the commercial impression of the mark or make it unlikely to be recognized, the matter may remain on the drawing and be disclaimed. See TMEP §1213.03(b) regarding disclaimer of such matter. However, this type of matter rarely is part of a composite mark.

See TMEP §807.14(b) regarding deletion of previously registered matter.

### 807.14(b) Addition or Deletion of Previously Registered Matter

*Addition.* An amendment adding an element that the applicant has previously registered for the same goods or services may be permitted. The rationale is that "[t]he addition of applicant's well-known registered mark to the mark sought to be registered ... is not a material change which would require republication of the mark." *Florasynth Laboratories Inc. v. Mülhens*, 122 USPQ 284 (Comm'r Pats. 1959) (addition of applicant's previously registered mark "4711" to the mark "ELAN" held not a material alteration). However, the addition of matter that the applicant has

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

previously registered for *different* goods or services is not permissible. *In re Hacot-Colombier*, 105 F.3d 616, 620, 41 USPQ2d 1523, 1527 (Fed. Cir. 1997); *In re Nationwide Industries Inc.*, 6 USPQ2d 1882, 1886 (TTAB 1988). An amendment adding previously registered matter is also unacceptable if it substantially alters the original mark. *In re John LaBatt Ltd.*, 26 USPQ2d 1077, 1078 (Comm'r Pats. 1992) (“Here, the applicant does not seek to merely add an element from one registration to another. Rather, the applicant seeks to eliminate its original mark, and substitute another. The exception to the material alteration rule clearly does not encompass cases where the original mark disappears.”).

*Deletion.* The question of whether a proposed amendment to *delete* previously registered matter from a mark is a material alteration should be determined without regard to whether the matter to be deleted is the subject of an existing registration.

### **807.14(c) Amendments to Correct “Internal Inconsistencies”**

The USPTO will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application. 37 C.F.R. §§2.72(a)(2), 2.72(b)(2) and 2.72(c)(2).

Prior to October 30, 1999, in certain limited circumstances, the USPTO would accept an amendment that corrected an “internal inconsistency” in an application as originally filed, without regard to the issue of material alteration. Because 37 C.F.R. §§2.72(b), (c) and (d) did not expressly prohibit an amendment that materially altered the mark on the original drawing, the USPTO would accept an amendment to correct an “internal inconsistency,” even if the amendment materially altered the mark on the original drawing. An application was considered “internally inconsistent” if the mark on the original drawing did not agree with the mark on the specimen in an application based on use, or with the mark on the foreign registration in an application based on §44 of the Act. *See In re ECCS Inc.*, 94 F.3d 1578, 39 USPQ2d 2001 (Fed. Cir. 1996); *In re Dekra e.V.*, 44 USPQ2d 1693 (TTAB 1997).

Effective October 30, 1999, 37 C.F.R. §2.72 was amended to expressly prohibit amendments that materially alter the mark on the drawing filed with the original application. Furthermore, 37 C.F.R. §2.52 was amended to state that the “drawing depicts the mark sought to be registered.” Accordingly, the USPTO no longer accepts amendments to cure “internal inconsistencies” if these amendments materially alter the mark on the original drawing. *In re Who? Vision Systems, Inc.*, 57 USPQ2d 1211 (TTAB 2000). *See also In re Tetrafluor Inc.*, 17 USPQ2d 1160 (Comm'r Pats. 1990) (examining attorney properly refused to accept amendment to “correct typographical error” that materially altered mark on original drawing page).

If an applicant submits a separate drawing page (or a digitized image of a separate drawing page) showing a mark, and a different mark appears in the written application, the drawing controls for purposes of determining what the mark is. The applicant may not amend the mark if the amendment is a material alteration of the

## APPLICATION REQUIREMENTS

mark on the drawing page. See TMEP §§202.01 and 807.01. *Humanoids Group v. Rogan*, 375 F.3d 301, 71 USPQ2d 1745 (4<sup>th</sup> Cir. 2004); *In re L.G. Lavorazioni Grafite S.r.l.*, 61 USPQ2d 1063 (Dir USPTO 2001).

For example, if the applicant submits a drawing page showing the word mark “ABC and design,” the applicant may not amend the application to delete the wording “and design,” and add a design feature to the letters “ABC.” However, the applicant may amend the drawing to “ABC.” *In re Meditech International Corp.*, 25 USPQ2d 1159 (TTAB 1990) (mark comprised of design of blue star found to be material alteration of typed words DESIGN OF BLUE STAR).

### **807.14(d) Material Alteration: Case References**

Proposed amendments to marks were held to be material alterations in the following decisions: *In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001) (amendment describing a mark as the color blue applied to an unlimited variety of objects found to be a material alteration of the mark on the original drawing, which depicted the color blue applied to a building); *In re Hacot-Colombier*, 105 F.3d 616, 41 USPQ2d 1523 (Fed. Cir. 1997) (proposed addition of house mark to conform to mark on foreign registration found to be material alteration of mark on drawing filed with original application); *In re Who? Vision Systems, Inc.*, 57 USPQ2d 1211 (TTAB 2000) (proposed amendment from TACILESENSE to TACTILESENSE found to be material alteration); *In re Meditech International Corp.*, 25 USPQ2d 1159, 1160 (TTAB 1990) (“[a] drawing consisting of a single blue star, as well as a drawing consisting of a number of blue stars, would both be considered material alterations vis-à-vis a drawing consisting of the typed words ‘DESIGN OF BLUE STAR’”); *In re Vienna Sausage Mfg. Co.*, 16 USPQ2d 2044 (TTAB 1990) (addition of wording “MR. SEYMOUR” to design mark held to be a material alteration); *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989) (proposed amendment to replace typed drawing of “THE WINE SOCIETY OF AMERICA” with a special form drawing including those words with a crown design and a banner design bearing the words “IN VINO VERITAS” held to be a material alteration); *In re Nationwide Industries Inc.*, 6 USPQ2d 1882 (TTAB 1988) (addition of house mark “SNAP” to product mark “RUST BUSTER” held a material alteration); *In re Pierce Foods Corp.*, 230 USPQ 307 (TTAB 1986) (addition of house mark “PIERCE” to “CHIK’N-BAKE” held a material alteration).

Proposed amendments to marks were found *not* to constitute a material alteration in the following cases: *In re Finlay Fine Jewelry Corp.*, 41 USPQ2d 1152 (TTAB 1996) (“NEW YORK JEWELRY OUTLET” not material alteration of “NY JEWELRY OUTLET”); *In re Larios S.A.*, 35 USPQ2d 1214 (TTAB 1995) (“VINO DE MALAGA LARIOS” and design not material alteration of “GRAN VINO MALAGA LARIOS” with similar design); *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740 (TTAB 1983) (amendment inverting the design portion of the mark held not a material alteration).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **807.15            Substitute Drawings**

When requiring a substitute drawing, the examining attorney must inform the applicant of the specific reason for rejecting the existing drawing and explain what type of amendment is needed to comply with the rules.

If the examining attorney requires a change in the drawing, the applicant must submit a substitute drawing, except in the limited circumstances discussed in TMEP §807.16 in which the USPTO will amend or correct a drawing. The USPTO will not return the original drawing to the applicant. 37 C.F.R. §2.25.

It is preferred that the applicant submit a substitute drawing on a separate drawing page (or a digitized image of a separate drawing page). However, the USPTO will accept a substitute drawing embedded in a response to an Office action, if the substitute drawing meets the requirements of 37 C.F.R. §§2.51 and 2.52.

When the applicant voluntarily submits a substitute drawing, the examining attorney must determine whether the substitute drawing is acceptable. See TMEP §807.17 regarding the procedures for processing unacceptable amendments to drawings.

When a substitute drawing is submitted and accepted, the original drawing is cancelled and the substitute drawing substituted. The examining attorney should ensure that the automated records of the Office reflect the amended mark, and have the TRAM database corrected, if necessary. The original drawing remains in the record.

The examining attorney should also ensure that the mark drawing code is changed, if necessary. See TMEP §807.18 concerning mark drawing codes.

### **807.16            Amendment of Drawings by the Office**

If the examining attorney requires correction of a standard character drawing, the applicant may submit a substitute drawing (see TMEP §807.15), or may request that the Office amend the drawing. If only a minor correction to a standard character drawing (such as deletion of the letters “TM”) is required, the examining attorney may correct the drawing on his or her own initiative, or may require the applicant to submit a substitute drawing.

When correcting a standard character drawing, the examining attorney must create a new drawing page, with the caption “DRAWING” at the top of the page, and have the new drawing page scanned. The examining attorney must also ensure that the word mark field in TRAM is corrected.

When the correction involves a special form drawing, the examining attorney will delete matter from the drawing only if the matter to be deleted is sufficiently separate from the matter that is to remain. If the matter to be deleted is not sufficiently separate from the matter that is to remain, the applicant must submit a substitute

## APPLICATION REQUIREMENTS

drawing. If the examining attorney deletes matter from the drawing, the examining attorney should ensure that the drawing is scanned, and that TRAM is corrected, if necessary.

The examining attorney should also ensure that the mark drawing code is changed, if necessary. See TMEP §807.18 concerning mark drawing codes.

### **807.17 Procedures for Processing Unacceptable Amendments to Drawings**

If an applicant submits an amendment to the drawing and the examining attorney determines that the amendment is unacceptable, the examining attorney should issue an action refusing to accept the amendment and advising the applicant that it will not be entered. The examining attorney should ensure that the unacceptable amendment has not been entered into the automated records of the Office.

If the applicant later submits arguments in support of acceptance of the amendment and the examining attorney determines that the amendment is still unacceptable, the examining attorney should issue a final refusal of the amendment, if the application is otherwise in condition for final action.

### **807.18 Mark Drawing Code**

*Standard Character Drawings.* Standard character drawings are coded in the Office's automated system as mark drawing code 4. Prior to November 2, 2003, typed drawings (see TMEP §807.03(i)) were coded as mark drawing code 1. Mark drawing code 1 is no longer available for applications filed on or after November 2, 2003. Applications that were filed before November 2, 2003, may be amended to mark drawing code 1, if appropriate for that drawing. Only mark drawing code 4 should be used for standard character drawings.

*Special Form Drawings.* Marks comprising only a design are coded as mark drawing code 2; marks comprising words plus a design are coded as mark drawing code 3; and marks comprising stylized letters and/or numerals with no design feature are coded as mark drawing code 5. All marks consisting of words, numerals and/or diacritical symbols for which no standard character claim (see TMEP §807.03(a)) has been submitted are coded as mark drawing code 5.

*Non-Visual Marks.* "Drawings" of non-visual marks (see TMEP §807.09) are coded as mark drawing code 6.

### **807.19 Use of Old Drawing in New Application**

*37 C.F.R. §2.26. Use of old drawing in new application. In an application filed in place of an abandoned or rejected application, or in an application for reregistration (§2.158), a new complete application is required, but the old drawing, if suitable, may*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*be used. The application must be accompanied by a request for the transfer of the drawing, and by a permanent photographic copy, or an order for such copy, of the drawing to be placed in the original file. A drawing so transferred, or to be transferred, cannot be amended.*

An old drawing cannot be transferred to a TEAS application.

In a paper application, a drawing from an abandoned application may be transferred to and used in a new application, if the file has not been destroyed. A drawing from a pending application may be transferred only if there is evidence in the application file that the application will become abandoned before the new application will mature into registration.

In a paper application, a drawing from an expired or cancelled registration may be transferred to and used in a new application, if the registration file has not been destroyed.

Transfers of drawings from files of active registrations are not permitted.

Transfers may be made only if the original mark is identical to the mark in the new application and if the drawing meets all requirements of 37 C.F.R. §§2.51 and 2.52.

To avoid the erroneous denial of a filing date, it is advisable at the time of filing to include a drawing page and, in the place where the mark would otherwise appear, a notation that the applicant requests transfer of a drawing under 37 C.F.R. §2.26 and the registration number or serial number of the file from which the applicant requests that the drawing be transferred.

The USPTO destroys abandoned paper application files and cancelled or expired paper registration files two years after they become abandoned, cancelled or expired. See TMEP §§109.02 and 718.07. Therefore, an applicant should not request transfer of a drawing from a file that has been abandoned, cancelled or expired for more than two years. If an applicant does request the transfer of a drawing from a file that has been destroyed, the application will be denied a filing date for failure to comply with 37 C.F.R. §2.21(a)(3) (clear drawing of the mark required for receipt of a filing date).

### **808 Description of Mark**

*37 C.F.R. §2.37. Description of mark. A description of the mark may be included in the application and must be included if required by the trademark examining attorney.*

*37 C.F.R. §2.52(b)(5). Description of mark. If a drawing cannot adequately depict all significant features of the mark, the applicant must also describe the mark.*

## APPLICATION REQUIREMENTS

### 808.01 Guidelines for Requiring Description

The examining attorney should require a description of the mark if:

- a significant element of a mark is unclear or ambiguous;
- the mark is three-dimensional, or a configuration of the goods or packaging (TMEP §§807.10 and 1202.02(d));
- the drawing includes broken lines to show placement or to indicate a portion of the product or packaging that is not part of the mark (TMEP §§807.08 and 1202.02(d));
- the mark includes color (TMEP §§807.07(a) and 1202.05(e));
- the mark includes motion (TMEP §807.11); or
- the mark is a sound, scent or non-visual mark.

The applicant may not amend the description of the mark if the amendment is a material alteration of the mark on the drawing or description filed with the original application. 37 C.F.R. §§2.72. *In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001). See TMEP §§807.14 *et seq.* regarding material alteration.

#### 808.01(a) Letters and Numerals

If a mark is composed of easily recognized letters or numerals, it is not necessary to include a description of the letters or numerals, even if they are presented in an unusual or stylized form. “Describing” letters or numerals merely as being “in stylized form” or as being a “fanciful representation” adds nothing that cannot be observed directly. On the other hand, if letters or numerals of a mark are displayed in a manner that makes it difficult to ascertain what they are, then the examining attorney should require a description.

#### 808.01(b) Designs or Figurative Elements

Designs or figurative elements generally do not require a description. Objects like trees, leaves and flowers, animals and people, buildings and scenery, manufactured products, etc., usually can be identified without explanation.

Marks with designs of symbols that are not well known should be described. Examples are symbols used in astrology; symbols representing mathematical, electrical or other scientific concepts; and legendary or historical symbols used to indicate ideas such as happiness, long life, etc. Designs that present an object in a way that makes it difficult to immediately identify the object should be described. Designs that represent an object that may not commonly be recognized (*e.g.*, a representation of an electrical transformer or a geiger counter) should also be described.

Geometric designs do not have to be described.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Vague descriptions of marks, such as “a design of a two-element circle,” should be avoided. Such wording does little to help explain the real nature of the design.

### **808.01(c) Meaning of Term in Mark**

If it is unclear to the examining attorney whether a term in a mark has meaning in the relevant industry, the examining attorney should make an inquiry of the applicant and should also conduct independent research. If the examining attorney determines that the term is arbitrary or fanciful, this may be indicated in notes to the file. A statement that a term has no meaning should *not* be entered as a description of the mark. If such a statement is entered as a description of the mark, the examining attorney must ensure that the statement is deleted from the description of the mark field in TRAM, and enter an appropriate note to the file. The document containing the information deleted from TRAM will remain of record for informational purposes. See TMEP §808.03 regarding printing of descriptions of the mark.

See TMEP §§809 *et seq.* regarding translation and transliteration of non-English wording and non-Latin characters.

### **808.01(d) Lining and Stippling Statements for Drawings**

*Current Practice.* For applications filed on or after November 2, 2003, the Office does not accept black and white drawings lined for color. 37 C.F.R. §2.52(b)(1); TMEP §807.07(a). Thus, the examining attorney should not require the applicant to enter a statement that the lining or stippling represents shading or is a feature of the mark, unless the examining attorney believes such a statement is necessary to accurately describe the mark.

See TMEP §§808.03 and 817 regarding printing of lining and stippling statements and other descriptions of the mark.

*Previous Practice.* Prior to October 30, 1999, an applicant who wanted to show color in a mark was required to use the Office’s color lining system. The color lining system required applicants to line their drawings using certain patterns designated for certain colors, and to provide a color lining statement describing where the colors appeared. The color lining system was deleted from the rule effective October 30, 1999; however, during a transitional period between October 30, 1999 and November 2, 2003, the Office continued to accept drawings that showed color by using this lining system. See notice at 64 Fed. Reg. 48900, 48903 (Sept. 8, 1999) and 1226 TMOG 103, 106 (Sept. 28, 1999). When an applicant submitted a drawing that included lining that was a feature of the mark and was not intended to indicate color, the applicant was required to submit a statement to that effect, so the record would be clear as to what applicant was claiming as the mark. Similarly, when an applicant submitted a drawing that included stippling for shading purposes, the applicant was required to submit a statement to that effect.



## APPLICATION REQUIREMENTS

### **808.02 Description Must Be Accurate and Concise**

If a description of a mark is placed in the record, the description should state accurately what the mark comprises and should not create a misleading impression by either positive statement or omission.

A description cannot be used to restrict the likely public perception of a mark. A mark's meaning is based on the impression actually created by the mark in the minds of consumers, not on the impression that the applicant states the mark is intended to convey.

The description of the mark should be concise.

### **808.03 Printing Description of Mark**

All descriptions in the description of the mark field in the application record will automatically be printed in the *Official Gazette* and on the certificate of registration.

Accordingly, when an examining attorney determines that a description should not be printed because it is unnecessary, the examining attorney should ensure that the description is deleted from the TRAM database, and enter a note to the file that the description has been deleted. The document containing the information deleted from TRAM will remain of record for informational purposes.

If the description is unsatisfactory or harmful to be in the record, the examining attorney should require that the applicant delete or correct it. This may be done by examiner's amendment.

A statement that a term in a mark has no meaning in the relevant industry should not be printed. TMEP §808.01(c).

See TMEP §817 regarding preparation of an application for publication or issuance.

### **809 Translation and Transliteration of Non-English Wording in Mark**

An application to register a mark that includes non-English wording must include a statement translating the wording. 37 C.F.R. §2.32(a). Similarly, an application for a mark that comprises non-Latin characters must include a statement transliterating the characters. For this purpose, a transliteration is the phonetic spelling, in corresponding Latin characters, of the word(s) in the mark that are in non-Latin characters. A transliteration is required for a mark that comprises non-Latin characters even if the wording has no English translation. An example of a statement translating and transliterating a word in non-Latin characters is the following:

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The non-Latin characters in the mark transliterate to “Asahi,” and this means “Rising Sun.”

Knowledge of the meaning of non-English words in marks is necessary for proper examination, because a non-English term is regarded in the same way as its English equivalent in determining descriptiveness, requiring disclaimer, and citing marks under §2(d) of the Act (see TMEP §§1207.01(b)(vi) and 1209.03(g)). Therefore, if there is no translation in the record, the examining attorney should ascertain the meaning of non-English wording through sources such as foreign language dictionaries before searching the mark. The examining attorney may also consult the Translations Branch of the USPTO.

If an application for a mark comprising non-English wording or non-Latin characters does not include an accurate translation and/or transliteration, the examining attorney should require the applicant to submit a statement of translation/transliteration, under 37 C.F.R. §2.61(b). The examining attorney may propose a translation, if appropriate. If the applicant submits a translation that is unacceptable to the examining attorney, the examining attorney should require amendment. The translation can be amended by examiner’s amendment.

It is generally unnecessary to provide a translation of a foreign term if the term appears in an English dictionary (e.g., croissant, fiesta or flambé). However, if a term that appears in the English dictionary appears in a mark as part of a foreign idiomatic phrase or other unitary expression, a translation of the idiomatic phrase or unitary expression is required. It would be illogical to break the phrase into its individual word elements and to translate only the individual words that do not appear in the English dictionary. Such a translation would serve no useful purpose because it would not convey the true commercial impression of the phrase.

*Example:* If the mark included the phrase “la fiesta grande,” an appropriate translation would be “the great celebration” or possibly “the great fiesta.” It would be inappropriate to translate only “la” and “grande.” The ultimate goal is to provide a translation that reflects the true meaning of the non-English wording in the mark and that reflects the commercial impression made by the entire phrase. See TMEP §809.01 regarding equivalency in translation.

It is generally unnecessary to provide a translation of foreign articles or prepositions, such as “de,” “le,” “la” or “il,” when combined with English terms, because their meaning is generally understood and, in this context, they are being used to convey an impression different from their foreign meaning. For example, in the mark “LE CASE,” it is unnecessary to translate “LE.”

It is generally not necessary to translate words from dead or obscure languages. Cf. *General Cigar Co. Inc. v. G.D.M. Inc.*, 988 F. Supp. 647, 45 USPQ2d 1481 (S.D.N.Y. 1997) (applicant had no obligation to disclose to USPTO that the term COHIBA for cigars means “tobacco” in the language of the Taino Indians in the Dominican

## APPLICATION REQUIREMENTS

Republic, because cigar smokers in the United States would not be aware of such a meaning). See TMEP §§1207.01(b)(vi) and 1209.03(g) regarding the applicability of the doctrine of foreign equivalents to words from dead or obscure languages. The determination of whether a language is “dead” must be made on a case by case basis, based upon the meaning that the term would have to the relevant purchasing public.

*Example:* Latin is generally considered a dead language. However, if there is evidence that a Latin term is still in use by the relevant purchasing public (e.g., if the term appears in current dictionaries or news articles), then a Latin term is not considered dead. The same analysis should be applied to other uncommon languages.

When an application or certificate of registration includes a translation, both the non-English wording and the English translation will appear in the records of the Office. See TMEP §809.02 regarding the printing of the translation/transliteration statement in the *Official Gazette* and on the registration certificate.

### 809.01            **Equivalency in Translation**

The translation that should be relied upon in examination is the English meaning that has significance in the United States as the equivalent of the meaning in the non-English language. The following are examples of equivalency in translation:

- (1) “Chat Noir” - The exact equivalent in English is “black cat,” and this translation would undoubtedly be recognized by the purchasing public in this country. *Ex parte Odol-Werke Wien Gesellschaft M.B.H.*, 111 USPQ 286 (Comm’r Pats. 1956) (mark “Chat Noir” refused registration because the words “Black Cat” were already registered for related goods).
- (2) “Mais Oui” - The English equivalent of the phrase “mais oui” is “why, certainly,” or “why, of course,” and not “but yes.” *In re Societe Des Parfums Schiaparelli, S.A.*, 122 USPQ 349 (TTAB 1959). A satisfactory translation must be some normal English expression that will be the equivalent in meaning of the term “Mais Oui” in French.
- (3) “Schwarzkopf” - The term can be literally translated as “black head” but, even to German-speaking persons, the primary significance of “Schwarzkopf” is most likely that of a surname. Neither English nor foreign surnames should be translated. See TMEP §1211 regarding surnames.

If any question arises as to the proper translation of a mark, the examining attorney may consult the Translations Branch of the Office.

See TMEP §1207.01(b)(vi) regarding the use of the doctrine of foreign equivalents in determining likelihood of confusion under 15 U.S.C. §1052(d), and TMEP

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

§1209.03(g) regarding the doctrine of foreign equivalents in determining questions of descriptiveness under 15 U.S.C. §1052(e)(1).

### **809.02                    Printing of Translations and Transliterations**

Generally, non-English wording in a mark must be translated into English and the translation (and transliteration, if applicable) must be printed in the *Official Gazette* and on the registration certificate.

Sometimes translations that are not precise, or that give a variety of meanings, are placed in the record. While all possible translations, and discussions relative to meaning, are useful for informational purposes, not all such matter is appropriate for printing in the *Official Gazette* or on the certificate of registration. Only a translation that is the clear and exact equivalent (see TMEP §809.01) should be printed. This normally means only one translation, because the existence of a variety of alternative translations or general explanations usually indicates a lack of a clearly recognized equivalent meaning.

If an applicant submits a translation that is too verbose or vague to be appropriate for printing in the *Official Gazette* and on the registration certificate, the examining attorney must indicate which translation, if any, is to be printed. The transliteration of non-Latin characters, if any, should be included in the statement to be printed. If necessary, the examining attorney should rewrite the statement and ensure that the TRAM database is updated accordingly. Language such as the following should be used for printing purposes whenever possible:

“The English translation of \_\_\_\_\_ in the mark is \_\_\_\_\_,” or  
“The non-Latin characters in the mark transliterate to \_\_\_\_\_ and  
this means \_\_\_\_\_ in English.”

All information in the translation/transliteration fields in the application record will automatically be printed in the *Official Gazette* and on the certificate of registration. Accordingly, when an examining attorney determines that a translation or transliteration should be printed, the examining attorney should ensure that the translation or transliteration is entered into the TRAM database. When an examining attorney determines that a translation or transliteration should not be printed because it is unnecessary, the examining attorney should ensure that the translation or transliteration is deleted from the TRAM database, and enter a note to the file indicating that the translation has been deleted. The document containing the information deleted from TRAM will remain of record for informational purposes. See TMEP §817 regarding preparation of an application for publication or issuance.

### **810                         Filing Fee**

An application under §1 or §44 of the Trademark Act must include a filing fee for each class of goods or services. 15 U.S.C. §1051(a)(1) and (b)(1).

## APPLICATION REQUIREMENTS

The required filing fee for at least one class of goods or services must be received before an application can be given a filing date. 37 C.F.R. §2.21(a)(5).

The amount of the trademark application filing fee varies depending whether the application (or the amendment adding classes to an existing application) is filed through TEAS or on paper. It is less expensive to file through TEAS. 37 C.F.R. §2.6(a)(1). See notice at 70 Fed. Reg. 2952 (Jan. 19, 2005). The current fee schedule is available on the USPTO website at <http://www.uspto.gov>.

An applicant who amends an application to add classes is entitled to the lower fee if the applicant files the amendment through TEAS, either as a preliminary amendment or a response to an examining attorney's Office action. Applicant must pay the higher fee if the applicant files an amendment adding class(es) on paper or authorizes an examining attorney to add class(es) by examiner's amendment.

See TMEP §§405 *et seq.* regarding payment of fees to the USPTO. See *also* TMEP §§202.03(a) and 202.03(a)(i) regarding the processing of applications in which a check submitted as the application filing fee is returned unpaid, or an electronic funds transfer or credit card payment is refused or charged back by a financial institution.

The filing fee for a §66(a) application will be sent to the USPTO by the IB, pursuant to the provisions of the Madrid Protocol and the *Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to That Agreement* (April 1, 2004) ("Common Regs."). The examining attorney should not require additional fees during examination.

### **810.01 Collection of Fees for Multiple Classes**

A filing fee is required for each class in a multi-class application under §1 or §44 of the Trademark Act. 37 C.F.R. §2.86(a)(2). The USPTO has established the following policy to ensure the collection of application filing fees from all applicants on an equitable basis.

In an application under §1 or §44, if the applicant has specifically authorized the USPTO to charge any additional fees to a deposit account, the examining attorney should ask the legal instruments examiner ("LIE") to charge the fees, and proceed with examination of the application on the merits. If the applicant has not provided a specific authorization to charge an account, the examining attorney should attempt to contact the applicant by telephone to secure a written authorization to charge fees to a credit card or deposit account by fax. If this is successful, the examining attorney should have the LIE charge the necessary fees to the credit card or deposit account and proceed with examination. See TMEP §§810 and 1403.02(c) regarding the amount of the fee for adding classes to an application.

If an authorization to charge fees has not been provided and the examining attorney is unable to secure one, the examining attorney should issue a written Office action

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

noting the deficiency and requiring either payment of the fees or deletion of classes. In the action, the examining attorney should advise the applicant that action on the merits of the application is deferred pending receipt of the applicant's response to the action.

This policy applies to any application under §1 or §44 of the Trademark Act in which the applicant specifically delineates more than one class of goods or services and the applicant has paid the fee(s) for less than all the classes. The delineation may be by indicating class numbers or any other means demonstrating a clear intention to seek registration in multiple classes.

If the entire record indicates a good faith attempt to pay all relevant fees, the examining attorney should simply act on the merits of the application and require the additional fees. For example, it would be inappropriate to defer action in a *pro se* application or in other cases where the applicant has in good faith attempted to pay the appropriate fees. Before issuing a letter deferring action until additional fees are paid, the examining attorney should consult with the managing attorney or senior attorney.

The filing fee for a §66(a) application will be sent to the USPTO by the IB, pursuant to the provisions of the Madrid Protocol and the Common Regs. The examining attorney should not require additional fees during examination. The classification in a §66(a) application cannot be changed. See TMEP §1401.03(d) for further information.

### **810.02 Refunds**

Only money paid by mistake or in excess (when a fee is not required by the statute or rules, or is not required in the amount paid) may be refunded. A mere change of purpose after the payment of money does not entitle a party to a refund. For example, if an applicant deletes a class from an application, or withdraws an application, the applicant is not entitled to a refund. 37 C.F.R. §2.209.

The filing fee for an application that is denied a filing date will be refunded. After an application has been given a filing date and processed, the filing fee will normally not be returned. However, if an examining attorney erroneously requires a fee, the USPTO will refund any fee submitted in response to the erroneous requirement.

If the examining attorney determines that an applicant is entitled to a refund, he or she should take the file to the LIE to process the refund.

If the examining attorney is uncertain as to whether a refund is appropriate, he or she should discuss the situation with the managing attorney or senior attorney.

See TMEP §405.04 for additional information about processing refunds.

## APPLICATION REQUIREMENTS

### 811 Designation of Domestic Representative

Under 15 U.S.C. §§1051(e) and 1141h(d) and 37 C.F.R. §2.24, an applicant not domiciled in the United States may file a document designating the name and address of a person residing in the United States on whom may be served notices or process in proceedings affecting the mark. See TMEP §604 for further information. The USPTO encourages applicants who do not reside in the United States to designate domestic representatives. To expedite processing, the Office recommends that designations of domestic representative be filed through TEAS, at <http://www.uspto.gov/teas/index.html>.

### 812 Identification of Prior Registrations of Applicant

*37 C.F.R. §2.36. Identification of prior registrations. Prior registrations of the same or similar marks owned by the applicant should be identified in the application.*

Trademark Rule 2.36, 37 C.F.R. §2.36, states that prior registrations of the same or similar marks owned by the applicant should be identified in the application. The rule does not precisely define when an applicant should claim ownership of prior registration(s), and the examining attorney may exercise discretion in invoking the rule. The main purpose of the rule is to provide the examining attorney with information necessary for proper examination. The information does not have to be given in any specific form. The applicant's claim of ownership of prior registrations will be printed in the *Official Gazette* and on the registration certificate.

Normally, identification of a registration is necessary because the registration would, if not owned by the applicant, be a basis for refusal under §2(d) of the Act, 15 U.S.C. §1052(d). Occasionally it is desirable to ask an applicant to identify a particular registration as being owned by the applicant merely to provide relevant information.

It is not necessary to assert ownership of expired or cancelled registrations. If the applicant wants to include a reference to a cancelled or expired registration, the applicant should indicate that the applicant owns the *mark* disclosed in the cancelled or expired registration, because technically one does not "own" a registration that is not in force and effect. Claims of ownership of pending applications, expired or cancelled registrations, and registrations that are unrelated to an application will not be printed.

Before approving an application that includes a claim of ownership of prior registrations for publication or registration, the examining attorney must ensure that the registrations are active.

All information in the prior registration field in the application record in the TRAM database will automatically be printed in the *Official Gazette* and on the certificate of registration. Accordingly, when an examining attorney determines that a claim of ownership of a prior registration should not be printed (e.g., because the registration

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

is no longer active or is irrelevant to the registrability of the mark in the subject application), the examining attorney should ensure that the claim of ownership is deleted from the TRAM database, and enter a note to the file indicating that the claim has been deleted. The document containing the information deleted from TRAM will remain of record for informational purposes. See TMEP §817 regarding preparation of an application for publication or issuance.

If the applicant owns numerous prior registrations, it is not necessary to list them all. The applicant should identify the two or three registration numbers that are most relevant (due to the similarity of the marks and/or relatedness of the goods or services), e.g., “the applicant is the owner of Reg. Nos. \_\_\_\_\_ and others.”

### **812.01 Proving Ownership of Prior Registrations**

If an applicant includes a claim of ownership of a prior registration in the application as filed, the examining attorney should accept the claim without further proof of ownership and should not cite the registration as a reference under §2(d) of the Act.

If the applicant does not assert ownership of a pertinent registration in the application when it is filed, but the records of the USPTO indicate that the registration is owned by the applicant, the examining attorney does not have to cite the registration as a reference, but should call the registration to the applicant’s attention and ask the applicant to state that the applicant owns the registration, if accurate. This statement may be placed in the record through an examiner’s amendment.

The examining attorney should check the automated records of the Assignment Services Division of the Office to determine whether information contained in those records supports ownership of the registration in the applicant’s name.

Generally, the applicant has the burden of proving ownership of a registration. The USPTO’s automated search system may not reflect the recordation of changes of ownership in the Assignment Services Division. Therefore, if an applicant does not assert ownership of a pertinent registration in an application when it is filed, it is possible that the registration may be cited as a reference under §2(d) even though it is owned by the applicant. If so, the applicant must: (1) state for the record that the documents have been recorded in the Assignment Services Division for a registration based on an application under §1 or §44 of the Trademark Act, or with the IB for a registered extension of protection of an international registration under §69 of the Trademark Act; (2) submit copies of documents evidencing the chain of title; or (3) submit an explanation, supported by an affidavit or declaration under 37 C.F.R. §2.20, of the chain of title (specifying each party in the chain, the nature of each conveyance, and the relevant dates). See TMEP §§502 *et seq.*



## APPLICATION REQUIREMENTS

### 813 Consent to Register by Living Individual Depicted in Mark

See TMEP §1206 concerning refusal of registration under §2(c) of the Trademark Act, 15 U.S.C. §1052(c), when a mark in an application comprises the name, portrait or signature of a living individual whose consent to register such name or likeness is not of record.

If a mark comprises a name or likeness that could *reasonably* be perceived as that of a living individual, the examining attorney must inquire whether the name or likeness is that of a specific living individual and must advise the applicant that, if so, the individual's written consent to register the name or likeness must be submitted. The purpose of the inquiry is to avoid the unauthorized registration of an individual's name or likeness. Consent is required for registration of a pseudonym, stage name or nickname if the name identifies a specific living individual. On the other hand, the examining attorney should not make an inquiry when it is clear that the matter identifies a fictitious character (*e.g.*, a name or likeness that is obviously that of a cartoon character).

If a name or likeness that could reasonably be perceived as that of a living individual is not that of a specific living individual, a statement to that effect should be printed in the *Official Gazette* and on the registration certificate. The statement should read as follows:

“\_\_\_\_\_ does not identify a living individual.”

If a mark comprises the name or likeness of a living individual and consent to register is of record, the following statement should be printed in the *Official Gazette* and on the registration certificate:

“\_\_\_\_\_ identifies a living individual whose consent is of record.”

The individual does not have to express his or her consent in this exact terminology. However, once consent is in the record, the examining attorney should enter the exact statement noted above in the record. A negative statement (advising that a name or likeness that could reasonably be considered to identify a specific living individual does not do so) should also be entered.

The statement of consent to registration of the name or likeness of a living individual must be personally signed by the individual whose name or likeness appears in the mark.

If the applicant is an individual and the mark is comprised, in whole or in part, of his or her name or likeness, consent to register is implicit if the individual whose name or likeness appears in the mark signs the application, either personally or through an authorized signatory. No inquiry should be made and no statement should be entered. See TMEP 1206.03(b) regarding implied consent.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Often, the applicant is a corporation whose corporate name includes a name that appears to be that of an individual, and the mark includes that name as well. For example, where the applicant is John Smith, Inc. and the mark is JOHN SMITH, consent to register the name “John Smith” must be obtained from the individual. If, however, the application is signed by the person whose name appears in the mark, either personally or through an authorized signatory, consent to register is implied. The examining attorney should make no further inquiry in that case. The examining attorney must ensure that the consent statement noted above is entered into the TRAM database.

If an applicant submits an unsolicited statement that a particular name or portrait does not identify a living individual, the statement will be printed in the *Official Gazette* and on the registration certificate only if an inquiry on this issue would have been necessary, *i.e.*, if the name or portrait might *reasonably* be perceived as that of a specific living individual.

All statements in the TRAM database as to whether a mark comprises the name, portrait or signature of a living individual whose consent is of record will automatically be printed in the *Official Gazette* and on the certificate of registration. Accordingly, when an examining attorney determines that such a statement should not be printed, the examining attorney should ensure that the statement is deleted from the database, and enter a note to the file indicating that the statement has been deleted. The document containing the information deleted from TRAM will remain of record for informational purposes. See TMEP §817 regarding preparation of an application for publication or issuance.

### **814 Requesting Additional Information**

Sometimes it is necessary for the examining attorney to request additional information from an applicant in order to examine the application properly. *In re Air Products and Chemicals, Inc.*, 192 USPQ 157 (TTAB 1976); 37 C.F.R. §2.61(b). If the applicant does not comply with a requirement for information, registration may be refused.

If the applicant does not comply with the examining attorney’s request for information, the requirement should be repeated and, if appropriate, made final. See *In re DTI Partnership LLP*, 67 USPQ2d 1699 (TTAB 2003) (§2(e)(1) refusal moot, since failure to comply with requirement for information is sufficient basis, in itself, for refusal); *In re SPX Corp.*, 63 USPQ2d 1592 (TTAB 2002) (registration properly refused where applicant ignores request for information); *In re Page*, 51 USPQ2d 1660 (TTAB 1999) (intent-to-use applicant’s failure to comply with requirement for information as to the intended use of the mark constitutes grounds for refusal); *In re Babies Beat Inc.*, 13 USPQ2d 1729, 1731 (TTAB 1990) (registration properly refused where applicant failed to comply with examining attorney’s request for copies of patent applications and other patent information).

## APPLICATION REQUIREMENTS

The examining attorney may request literature, exhibits, and general information concerning circumstances surrounding the mark and, if applicable, its use or intended use. Requests for information that is not public knowledge, but is peculiarly within the knowledge of the applicant or available to the applicant, are particularly appropriate. The examining attorney should explain why the information is needed, if the reason is not obvious.

If applicant wants to provide information from its website in response to the examining attorney's request for information, applicant should print out the information and supply it to the examining attorney. A mere statement that information about the goods or services is available on applicant's website is an inappropriate response to the examining attorney's request for information, and insufficient to make the relevant information of record. *In re Planalytics, Inc.*, 70 USPQ2d 1453 (TTAB 2004).

If applicant does not believe it has relevant information, applicant should submit a statement to this effect.

If the requested information is confidential, or if for a valid reason the applicant does not want to have the information become part of a public record, the applicant should explain those circumstances. Placing confidential information in a file is not required. Sometimes an explanation will suffice, or material may be shown to the examining attorney without formal filing. Usually a way can be found to give the necessary information to the examining attorney without imposing an undue burden on the applicant.

### **815 Supplemental Register, Application Filed on**

Sections 23 through 28 of the Trademark Act, 15 U.S.C. §§1091 through 1096, provide for registration on the Supplemental Register. Certain marks that are not eligible for registration on the Principal Register, but are capable of distinguishing an applicant's goods or services, may be registered on the Supplemental Register. Marks registered on the Supplemental Register are excluded from receiving the advantages of certain sections of the Act of 1946. The excluded sections are listed in 15 U.S.C. §1094.

If the applicant seeks registration on the Supplemental Register, the application should state that registration is requested on the Supplemental Register. If no register is specified, the USPTO will presume that the applicant seeks registration on the Principal Register.

A mark in an application under §66(a) of the Trademark Act, 15 U.S.C. §1141f(a), based on a request for extension of protection of an international registration to the United States, cannot be registered on the Supplemental Register. 15 U.S.C. §1141h(a)(4); 37 C.F.R. §§2.47(c) and 2.75(c).

See TMEP §§816 *et seq.* regarding amendments to the Supplemental Register.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **815.01 Marks Eligible for Principal Register Not Registrable on Supplemental Register**

A mark that is clearly eligible for the Principal Register may not be registered on the Supplemental Register. An application requesting registration on the Supplemental Register must be amended to the Principal Register, or refused registration if the mark is registrable on the Principal Register. *Daggett & Ramsdell, Inc. v. I. Posner, Inc.*, 115 USPQ 96 (Comm'r Pats. 1957).

### **815.02 Elements Required**

An application requesting registration on the Supplemental Register should state that the applicant requests registration on the Supplemental Register. If no register is specified, the USPTO will assume that the applicant is requesting registration on the Principal Register.

In an application under §1(a) or §1(b), the mark must be in lawful use in commerce on or in connection with the goods/services before the mark can register. 15 U.S.C. §1091(a). Under 37 C.F.R. §2.47(d), an intent-to-use applicant may not seek registration on the Supplemental Register until the applicant has timely filed either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d) that meets minimum filing requirements. (See 37 C.F.R. §2.76(e) and TMEP §1104.01 regarding the minimum filing requirements for an amendment to allege use, and 37 C.F.R. §2.88(e) and TMEP §1109.01 regarding the minimum filing requirements for a statement of use.) When the applicant amends to the Supplemental Register after filing an acceptable amendment to allege use or statement of use, the effective filing date of the application is the date on which the applicant filed the amendment to allege use or statement of use. 37 C.F.R. §2.75(b). See TMEP §§816.02 and 1102.03.

If an applicant submits a §1(b) application requesting registration on the Supplemental Register for which no allegation of use has been filed, the examining attorney must refuse registration under §23 of the Act on the ground that the mark is not in lawful use in commerce. The examining attorney will withdraw the refusal if the applicant submits an acceptable allegation of use. As noted above, the effective filing date of the application will be the date on which the applicant filed the allegation of use.

If the application is based solely on §44, the applicant may seek registration on the Supplemental Register without alleging lawful use in commerce and without alleging use anywhere in the world. 15 U.S.C. §1126(e); 37 C.F.R. §2.47(b); TMEP §1009. However, the §44 applicant must verify that the applicant has a bona fide intention to use the mark in commerce. 15 U.S.C. §§1126(d) and (e); 37 C.F.R. §§2.34(a)(3)(i) and 2.34(a)(4)(ii).

## APPLICATION REQUIREMENTS

### **815.03 Examining Attorney Approves Mark for Issue**

Upon approval of the mark for registration, the examining attorney will indicate in the record that the mark has been “Approved for Supplemental Registration” rather than that the mark has been approved for publication. Marks on the Supplemental Register are not published for opposition, but are issued as registered marks on the date that they are printed in the *Official Gazette*.

Applications on the Supplemental Register are not subject to opposition under 15 U.S.C. §1063, but are subject to cancellation under 15 U.S.C. §1064. 15 U.S.C. §1092.

### **815.04 Filing on Supplemental Register is Not an Admission That the Mark Has Not Acquired Distinctiveness**

Under 15 U.S.C. §1095, registration of a mark on the Supplemental Register does not constitute an admission that the mark has not acquired distinctiveness.

### **815.05 Basis for Refusal of Registration of Matter That is Incapable**

When the examining attorney refuses registration on the Supplemental Register on the ground that the proposed mark is incapable of distinguishing the applicant’s goods or services, the examining attorney should cite §§23(c) and 45 of the Trademark Act, 15 U.S.C. §§1091(c) and 1127, as a basis for refusal. See *In re Controls Corp. of America*, 46 USPQ2d 1308, 1309 n. 2 (TTAB 1998).

### **816 Supplemental Register, Amending Application to**

#### **816.01 How to Amend**

If an application meets the requirements noted in TMEP §815.02, the application may be amended by requesting that the words “Principal Register” be changed to “Supplemental Register.”

An application under §66(a) of the Trademark Act, 15 U.S.C. §1141f(a), based on a request for extension of protection of an international registration to the United States, cannot be amended to the Supplemental Register. Section 68(a)(4) of the Act, 15 U.S.C. §1141h(a)(4); 37 C.F.R. §§2.47(d) and 2.75(c).

#### **816.02 Effective Filing Date**

##### ***Intent-to-Use Applications***

As noted in TMEP §815.02, an intent-to-use applicant may file an amendment to the Supplemental Register only after the applicant has begun using the mark and filed an amendment to allege use under §1(c) or statement of use under §1(d) that meets

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

minimum filing requirements. 37 C.F.R. §2.47(d). In such a case, the effective filing date of the application is the date on which the applicant met the minimum filing requirements for the amendment to allege use or statement of use. 37 C.F.R. §2.75(b); TMEP §1102.03. See 37 C.F.R. §2.76(e) and TMEP §1104.01 regarding the minimum filing requirements for an amendment to allege use, and 37 C.F.R. §2.88(e) and TMEP §1109.01 regarding the minimum filing requirements for a statement of use. The examining attorney should examine the amendment to allege use or statement of use before taking any action on the amendment to the Supplemental Register.

### ***Applications Filed Before November 16, 1989***

Prior to November 16, 1989, one year's lawful use of the mark in commerce was required to apply for registration on the Supplemental Register. Effective November 16, 1989, an applicant may apply for registration on the Supplemental Register at any time after commencing use of the mark in commerce.

An applicant may amend a pending application to request registration on the Supplemental Register at any time after use of the mark has commenced, even if the original application for the Principal Register was filed before November 16, 1989. However, if the application was filed before November 16, 1989, the date of the amendment to the Supplemental Register becomes the effective filing date of the application if: (1) the applicant had not used the mark in commerce for one year before the application filing date; and (2) the applicant amends to the Supplemental Register on or after November 16, 1989.

See TMEP §§206 *et seq.* regarding effective filing date.

### **816.03           Amendment to Different Register**

There is no restriction on the number of times an applicant may amend from one register to another. Normally, however, one amendment is sufficient, and subsequent amendments should be avoided except for unusual circumstances.

### **816.04           Amendment After Refusal**

In an application under §1 or §44 of the Trademark Act, the applicant may amend to the Supplemental Register after a refusal to register on the Principal Register, including a final refusal. If the final refusal was under §2(e)(1), §2(e)(2) or §2(e)(4) of the Trademark Act, or on grounds pertaining to other non-inherently distinctive subject matter, amendment to the Supplemental Register is procedurally an acceptable response. See 37 C.F.R. §2.75.

The applicant may argue the merits of the examining attorney's refusal of registration on the Principal Register and, in the alternative, request registration on the Supplemental Register. Similarly, the applicant may seek registration on the

## APPLICATION REQUIREMENTS

Principal Register under §2(f) and, in the alternative, on the Supplemental Register. See TMEP §1212.02(c).

An amendment to the Supplemental Register after refusal presents a new issue requiring consideration by the examining attorney, unless the amendment is irrelevant to the outstanding refusal. See TMEP §714.05(a)(i). If the examining attorney determines that the proposed mark is incapable of identifying and distinguishing the applicant's goods or services, the examining attorney should issue a nonfinal refusal of registration on the Supplemental Register, under §23 of the Trademark Act, 15 U.S.C. §1091. See TMEP §714.05(a)(i).

A mark in an application under §66(a) of the Trademark Act, 15 U.S.C. §1141f(a), based on a request for extension of protection of an international registration to the United States, cannot be amended the Supplemental Register. Section 68(a)(4) of the Act, 15 U.S.C. §1141h(a)(4); 37 C.F.R. §§2.47(c) and 2.75(c).

### **816.05 Amendment After Decision on Appeal**

An applicant may not amend to the Supplemental Register after the Trademark Trial and Appeal Board has affirmed a refusal of registration on the Principal Register. After having elected one of the remedies available for contesting the basis for the refusal, namely, appeal rather than amendment to the Supplemental Register, and having pursued the remedy to a conclusion, the applicant may not return to its previous position and pursue another remedy for the same refusal anew. In the following cases, the Office refused to grant petitions to reopen prosecution and return jurisdiction to the examining attorney to consider an amendment to the Supplemental Register after decision on appeal: *Ex parte Simoniz Co.*, 161 USPQ 365 (Comm'r Pats. 1969); *Ex parte Helene Curtis Industries, Inc.*, 134 USPQ 73 (Comm'r Pats. 1962); *Ex parte Sightmaster Corp.*, 95 USPQ 43 (Comm'r Pats. 1951). See also TMEP §1501.06 and cases cited therein.

The applicant may, in such a circumstance, file a new application requesting registration on the Supplemental Register.

### **817 Preparation of Case for Publication or Registration**

When a case is ready to be approved for publication or registration, the examining attorney must carefully review the application file to ensure the accuracy of the information contained therein and to ensure that all information that should be printed in the *Official Gazette* and on the certificate of registration has been properly entered into the TRAM database. The type of information that should be printed includes:

- (1) Disclaimer statements (TMEP §§1213 *et seq.*);
- (2) Notations of acquired distinctiveness, *i.e.*, “2(f)” or “2(f) in part as to . . .,” as appropriate (TMEP §§1212 *et seq.*);

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- (3) Lining and/or stippling statements (TMEP §808.01(d));
- (4) Consent to register a name or portrait and statements that a name or portrait does not identify a living individual (TMEP §813);
- (5) Translations of non-English wording and transliterations of non-Latin characters in the mark (TMEP §809.02);
- (6) Ownership of related United States registrations (TMEP §812);
- (7) Description of mark statements (TMEP §808); and
- (8) Use in another form (TMEP §903.08).

All statements in the TRAM database relating to the above-listed items will automatically be printed in the *Official Gazette* and on the registration certificate. Therefore, examining attorneys should ensure that information about these items that should *not* be printed (*e.g.*, claims of ownership of unrelated U.S. registrations, statements such as disclaimers that have been amended and are no longer valid, or unnecessary §2(f) statements) is deleted from the TRAM database. Images of the documents containing the information deleted from TRAM will remain of record for informational purposes. If an applicant provides information by phone that should not be printed (*e.g.*, a statement that a particular term has no meaning in the relevant industry), then the examining attorney should enter a note to the file detailing the information that will not be entered into the database.

In addition, the examining attorney should check to ensure the accuracy of the following critical data elements:

- (1) The mark;
- (2) The register for which application is made;
- (3) The identification of goods and/or services;
- (4) International classification;
- (5) Filing date;
- (6) Dates of use for each class, if applicable;
- (7) Foreign application and registration data, if applicable;
- (8) Whether §1(b) of the Act is a basis for registration;
- (9) In a multi-basis application, which goods are covered by which basis; and
- (10) In concurrent use cases, information as to the proposed geographic limitation.

If any of the above items are not accurately entered into the TRAM database, the examining attorney should ensure that the necessary correction(s) are made.

If there has been an assignment, the examining attorney should check the records of the Assignment Services Division of the Office to ensure that there is a clear chain of



## APPLICATION REQUIREMENTS

title, and ensure that the change of ownership is entered into the TRAM database, if necessary. See TMEP §§502.02(a) and 502.02(c).

### 818 Application Checklist

This section may be used to determine whether materials submitted as a trademark application are complete and to ensure that appropriate requirements and refusals are made. See 37 C.F.R. §2.21 and TMEP §202 regarding the elements that must be received before the USPTO will grant a filing date to an application.

An application for trademark registration must include the following:

- (1) a clear drawing of the mark (37 C.F.R. §§2.21(a)(3), 2.51 through 2.54; TMEP §§202.01 and 807 *et seq.*);
- (2) a verified statement signed by a person properly authorized to sign on behalf of the applicant (15 U.S.C. §§1051(a)(3) and (b)(3); 37 C.F.R. §2.33; TMEP §§804 *et seq.*);
- (3) a written application that includes the following:
  - (a) the date on which the application was signed;
  - (b) the applicant's name, and DBA designation if appropriate (37 C.F.R. §2.32(a)(2); TMEP §§803.02 *et seq.*);
  - (c) the applicant's legal entity (TMEP §§803.03 *et seq.*);
  - (d) the country of which the applicant is a citizen, or the state or country of incorporation or organization of a juristic applicant (15 U.S.C. §§1051(a)(2) and (b)(2); 37 C.F.R. §§2.32(a)(3)(i) and (ii); TMEP §803.04);
  - (e) if the applicant is a partnership, the names of the applicant's general partners and their citizenship (or state or country of incorporation or organization) (37 C.F.R. §2.32(a)(3)(iii); TMEP §803.04);
  - (f) the applicant's domicile and post office address (15 U.S.C. §§1051(a)(2) and (b)(2); 37 C.F.R. §2.32(a)(4); TMEP §803.05);
  - (g) a statement that the applicant has adopted and is using the mark in a §1(a) application, or has a bona fide intent to use the mark in commerce in an application under §1(b) or §44 (15 U.S.C. §§1051(a)(3)(C), 1051(b)(3)(B), 1126(d)(2) and 1126(e); 37 C.F.R. §§2.33(b)(1) and (2));
  - (h) an identification of the goods/services (15 U.S.C. §§1051(a)(2) and (b)(2); 37 C.F.R. §2.32(a)(6); TMEP §§1402 *et seq.*);

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- (i) the class(es) of the goods/services, if known to the applicant (37 C.F.R. §2.32(a)(7); TMEP §§1401 *et seq.*);
- (j) the dates when the mark was first used and first used in commerce with the goods/services in each class, in an application under §1(a) (15 U.S.C. §1051(a)(2); 37 C.F.R. §2.34(a)(1)(ii) and (iii); TMEP §§903 *et seq.*);
- (k) a statement that the mark is being used by a related company or companies, in a §1(a) application where use of the mark is only by one or more related companies and inures to the applicant's benefit (37 C.F.R. §2.38; TMEP §901.05);
- (l) if the applicant claims priority under §44(d), a claim of the benefit of the applicant's first-filed foreign application in a treaty country within the preceding six months, specifying the filing date, country and serial number of such application (15 U.S.C. §1126(d); 37 C.F.R. §2.34(a)(4); TMEP §§1003 *et seq.*);
- (m) a basis for filing (37 C.F.R. §§2.32(a)(5) and 2.34; TMEP §§806 *et seq.*);
- (n) an averment by the person making the verification that he or she believes the applicant to be the owner of the mark sought to be registered in an application under §1(a), or to be entitled to use the mark in commerce in a §1(b) or §44 application (15 U.S.C. §1051(a)(3)(A) and 1051(b)(3)(A); 37 C.F.R. §§2.33(b)(1) and (2); TMEP §804.02);
- (o) an averment that the mark is in use in commerce in a §1(a) application (37 C.F.R. §§2.33(b)(1) and 2.34(a)(1)(i); TMEP §901);
- (p) an averment that, to the best of the verifier's knowledge and belief, no other person, firm, corporation, or association has the right to use such mark in commerce either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods of the other person, to cause confusion, or to cause mistake, or to deceive (15 U.S.C. §§1051(a)(3)(D) and (b)(3)(D); 37 C.F.R. §§2.33(b)(1) and (2); TMEP §804.02);
- (q) a description of the mark, if appropriate (37 C.F.R. §2.37 and 2.52(b)(5); TMEP §§808 *et seq.*);
- (r) if the mark has color, a color claim naming the colors that are a feature of the mark, and a separate statement describing where the color(s) appear on the mark. (37 C.F.R. §2.52(b)(1); TMEP §807.07(a) *et seq.*);

## APPLICATION REQUIREMENTS

- (s) a translation of non-English wording and transliteration of non-Latin characters in the mark, if any (TMEP §§809 *et seq.*);
  - (t) a statement that identifies any living individual whose name or likeness the mark comprises and indicates that his or her consent is of record, or a statement that the name or portrait does not identify a living individual, if appropriate (15 U.S.C. §1052(c); TMEP §813);
  - (u) a claim of the applicant's ownership of prior registrations of the same or similar marks, if any (37 C.F.R. §2.36; TMEP §812); and
  - (v) if the applicant seeks to register the mark in standard characters, a statement that "The mark consists of standard characters without claim to any particular font, style, size or color" (TMEP §807.03(a)).
- (3) a designation of a domestic representative is encouraged, if the applicant is not domiciled in the United States (15 U.S.C. §1051(e); 37 C.F.R. §2.24; TMEP §604);
  - (4) a filing fee for each class of goods/services (15 U.S.C. §§1051(a)(1) and 1051(b)(1); 37 C.F.R. §2.6(a)(1); TMEP §§810 *et seq.*);
  - (5) a true copy, a photocopy, a certification, or a certified copy of the registration in the applicant's country of origin, and a translation of the foreign registration if it is not in English, in a §44(e) application (15 U.S.C. §1126(e); 37 C.F.R. §2.34(a)(3)(ii); TMEP §§1004.01 *et seq.*); and
  - (6) one specimen for each class, in a §1(a) application (15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), and 2.86(a)(3); TMEP §§904 *et seq.*).

See 15 U.S.C. §§1051(a)(3)(D) and 1052(d), 37 C.F.R. §2.99, and TMEP §§1207.04 *et seq.* regarding requirements for applications for concurrent use registration.

See 37 C.F.R. §2.44 and TMEP §§1303 *et seq.* regarding the requirements for collective trademark and collective service mark applications; 37 C.F.R. §2.44 and TMEP §§1304 *et seq.* regarding collective membership mark applications, and 37 C.F.R. §2.45 and TMEP §§1306 *et seq.* regarding certification mark applications.

The following are substantive grounds for refusal. Registration may be refused on the ground that:

- (1) the applicant is not the owner of the mark (see 15 U.S.C. §1051; TMEP §1201);
- (2) the subject matter for which registration is sought does not function as a mark (see 15 U.S.C. §§1051, 1052, 1053 and 1127) because, for example, the proposed mark:
  - (a) is used solely as a trade name (see TMEP §1202.01);

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- (b) is functional, *i.e.*, consists of a utilitarian design feature of the goods or their packaging (15 U.S.C. §1052(e)(5); TMEP §1202.02(a) *et seq.*);
  - (c) is a nondistinctive configuration of the goods or their packaging (TMEP §§1202.02(b) *et seq.*);
  - (d) is mere ornamentation (see TMEP §§1202.03 *et seq.*);
  - (e) is the generic name for the goods or services (TMEP §§1209.01(c) *et seq.*);
- (3) the proposed mark comprises immoral or scandalous matter (15 U.S.C. §1052(a); TMEP §1203.01);
  - (4) the proposed mark is deceptive (15 U.S.C. §1052(a); TMEP §§1203.02 *et seq.*);
  - (5) the proposed mark comprises matter that may disparage or falsely suggest a connection with persons, institutions, beliefs, or national symbols, or bring them into contempt or disrepute (15 U.S.C. §1052(a); TMEP §§1203.03 *et seq.*);
  - (6) the proposed mark comprises the flag, coat of arms or other insignia of the United States or any State, municipality, or foreign nation (15 U.S.C. §1052(b); TMEP §1204);
  - (7) the applicant's use of the mark is or would be unlawful because it is prohibited by statute (TMEP §§1205 *et seq.*);
  - (8) the proposed mark comprises a name, portrait or signature identifying a particular living individual without the individual's written consent, or the name, portrait or signature of a deceased president of the United States during his widow's life, without written consent of the widow (15 U.S.C. §1052(c); TMEP §§1206 *et seq.*);
  - (9) the proposed mark so resembles a previously registered mark as to be likely, when used with the applicant's goods and/or services, to cause confusion or mistake, or to deceive (15 U.S.C. §1052(d); TMEP §§1207 *et seq.*);
  - (10) the proposed mark is merely descriptive or deceptively misdescriptive of the applicant's goods and/or services (15 U.S.C. §1052(e)(1); TMEP §§1209 *et seq.*);
  - (11) the proposed mark is primarily geographically descriptive of the applicant's goods and/or services (15 U.S.C. §1052(e)(2); TMEP §1210.01(a));
  - (12) the proposed mark is primarily geographically deceptively misdescriptive of the applicant's goods and/or services (15 U.S.C. §1052(e)(3); TMEP §1210.01(b)); or

## APPLICATION REQUIREMENTS

(13) the proposed mark is primarily merely a surname (15 U.S.C. §1052(e)(4); TMEP §§1211 *et seq.*).

An applicant may submit a claim and proof of distinctiveness of the mark or a portion of the mark, under §2(f). See 15 U.S.C. §§1052(f); TMEP §1212 *et seq.*

A mark that is capable of distinguishing the applicant's goods or services may be registrable on the Supplemental Register, in an application under §1 or §44 of the Trademark Act. See 15 U.S.C. §§1091 through 1096; TMEP §§815 *et seq.*

The examining attorney will require a disclaimer of an unregistrable component of an otherwise registrable mark. See 15 U.S.C. §1056; TMEP §§1213 *et seq.*

# Chapter 900

## Use in Commerce

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### **901 Use in Commerce**

- 901.01 Definitions
- 901.02 Bona Fide Use in the Ordinary Course of Trade
- 901.03 Commerce That May Be Lawfully Regulated By Congress
- 901.04 Inquiry Regarding Use in Commerce
- 901.05 Use Only by Related Company

### **902 Allegations of Use for §1(b) Applications**

### **903 Dates of Use**

- 903.01 Date of First Use Anywhere
- 903.02 Date of First Use in Commerce
- 903.03 Type of Commerce
- 903.04 Relation Between the Two Dates of Use
- 903.05 Amending Dates of Use
- 903.06 First Use by Predecessor or Related Company
- 903.07 Indefinite Dates of Use
  - 903.07(a) Apparent Discrepancies Between Dates of Use and Date of Execution
- 903.08 Dates of Use in Another Form
- 903.09 More than One Item of Goods or Services

### **904 Specimens**

- 904.01 Number of Specimens
  - 904.01(a) More than One Item Specified in a Class
  - 904.01(b) In Combined or Multiple-Class Applications
- 904.02 Physical Form of Specimens
  - 904.02(a) Electronically Filed Specimens

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- 904.02(b) Paper Specimens
- 904.02(c) Specimens for Marks Comprising Color
- 904.02(d) Marks Used on Publications
- 904.03 Bulky Specimens
- 904.04 Material Appropriate as Specimens for Trademarks
  - 904.04(a) Labels and Tags
  - 904.04(b) Stampings
  - 904.04(c) Commercial Packaging
  - 904.04(d) Specimens for Trademarks Identifying Computer Programs, Movies or Video Tapes
- 904.05 Material Not Appropriate as Specimens for Trademarks
- 904.06 Displays as Specimens for Trademarks
  - 904.06(a) Catalogs as Specimens for Trademarks
  - 904.06(b) Electronic Displays as Specimens for Trademarks
- 904.07 Package Inserts as Specimens for Trademarks
- 904.08 Facsimiles as Specimens
- 904.09 Affidavit Supporting Substitute Specimens
- 904.10 Translation of Matter on Specimens
- 904.11 Requirements for Substitute Specimens and Statutory Refusals

### **905 Method of Use**

### **906 Federal Registration Notice**

- 906.01 Foreign Countries That Use Registration Symbol ®
- 906.02 Improper Use of Registration Symbol
- 906.03 Informing Applicant of Apparent Improper Use
- 906.04 Fraud

### **907 Compliance with Other Statutes**

## APPLICATIONS BASED ON USE OR INTENT TO USE IN COMMERCE

### 901 Use in Commerce

In an application based on use in commerce under 15 U.S.C. §1051(a) or “intent-to-use” under 15 U.S.C. §1051(b), the applicant must actually use the mark in commerce on or in connection with all of the specified goods/services prior to registration. See 37 C.F.R. §§2.34(a)(1)(i), 2.76(b)(1)(ii) and 2.88(b)(1)(ii).

In a §1(a) application, the applicant must use the mark in commerce on or in connection with all the goods and services listed in the application on or before the filing date of the application. The application must include a verified statement (*i.e.*, a statement supported by an affidavit or declaration under 37 C.F.R. §2.20) that the mark is in use in commerce. If the verification is not filed with the original application, the verified statement must allege that the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date. 37 C.F.R. §2.34(a)(1)(i). See TMEP §§804 *et seq.* regarding verification.

In a §1(b) application, the applicant typically begins use in commerce after the filing date. See TMEP §902.

The use requirement applies when in addition to asserting use under §1(a) or a bona fide intent to use under §1(b), the applicant also asserts the benefit of a foreign application under §44(d), or a foreign registration under §44(e), as a second basis for filing. See TMEP §§806.02 *et seq.* regarding filing on more than one basis.

Applicants relying *solely* on a foreign registration as the basis for registration under §44(e) of the Trademark Act are not required to assert actual use of the mark prior to registration in the United States. TMEP §1009. See *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909 (TTAB 1984). However, to retain a valid registration, the registrant must file an affidavit or declaration of use of the mark in commerce under 15 U.S.C. §1058 at the appropriate times, and establish use in commerce or excusable nonuse. See TMEP §§1604 *et seq.* regarding the affidavit or declaration of continued use or excusable nonuse.

Similarly, applicants requesting an extension of protection of an international registration to the United States under §66(a) of the Trademark Act are not required to assert actual use of the mark prior to registration in the United States. However, to retain a valid registration, the registrant must file an affidavit or declaration of use of the mark in commerce under 15 U.S.C. §1141k at the appropriate times, and establish use in commerce or excusable nonuse.

#### 901.01 Definitions

The power of the federal government to register marks comes from the commerce clause of the Constitution. Section 1 of the Trademark Act, 15 U.S.C. §1051, permits application for registration of “a trademark used in commerce” (15 U.S.C.



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

§1051(a)) or of a trademark that a person has a bona fide intention to use in commerce (15 U.S.C. §1051(b)).

Section 45 of the Trademark Act, 15 U.S.C. §1127, defines “commerce” as “all commerce which may lawfully be regulated by Congress.” Section 45 defines “use in commerce” as follows:

The term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this Act, a mark shall be deemed to be in use in commerce--

- (1) on goods when--
  - (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and
  - (B) the goods are sold or transported in commerce, and
- (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

### **901.02 Bona Fide Use in the Ordinary Course of Trade**

The definition of use in commerce (TMEP §901.01) was amended by the Trademark Law Revision Act of 1988 (TLRA), Public Law 100-667, 102 Stat. 3935, to add the phrase “the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.” The primary purpose of the amendment was to eliminate the practice of “token use,” or use made solely to reserve rights in a mark.

Some factors that may be important in determining compliance with the statutory requirement for a “bona fide use of a mark in the ordinary course of trade” are: (1) the amount of use; (2) the nature or quality of the transaction; and (3) what is typical use within a particular industry.

The legislative history of the TLRA makes it clear that the meaning of “use in the ordinary course of trade” will vary from one industry to another. The report of the House Judiciary Committee stated that:

While use made merely to reserve a right in a mark will not meet this standard, the Committee recognizes that “the ordinary course of trade” varies from industry to industry. Thus, for example, it might be in the ordinary course of trade for an industry that sells expensive or seasonal

## APPLICATIONS BASED ON USE OR INTENT TO USE IN COMMERCE

products to make infrequent sales. Similarly, a pharmaceutical company that markets a drug to treat a rare disease will make correspondingly few sales in the ordinary course of its trade; the company's shipment to clinical investigators during the Federal approval process will also be in its ordinary course of trade....

H.R. Rep. No. 1028, 100th Cong. 2d Sess. 15 (1988).

The report of the Senate Judiciary Committee stated:

The committee intends that the revised definition of "use in commerce" be interpreted flexibly so as to encompass various genuine, but less traditional, trademark uses, such as those made in test markets, infrequent sales of large or expensive items, or ongoing shipments of a new drug to clinical investigators by a company awaiting FDA approval....

S. Rep. No. 515, 100th Cong. 2d Sess. 44-45 (1988). See also *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1774 n. 8 (TTAB 1994), *aff'd*, 108 F.3d 1392 (Fed. Cir. 1997) (Table).

### **901.03 Commerce That May Be Lawfully Regulated By Congress**

The scope of federal trademark jurisdiction is commerce that may be regulated by the United States Congress. Types of commerce encompassed in this definition are interstate, territorial, and between the United States and a foreign country.

"Territorial commerce" is commerce within a territory of the United States (e.g., Guam, Puerto Rico, American Samoa, the United States Virgin Islands) or between the United States and a territory of the United States.

A purely intrastate use does not provide a basis for federal registration. However, if intrastate use directly affects a type of commerce that Congress may regulate, this constitutes use in commerce within the meaning of the Act. See *Larry Harmon Pictures Corp. v. Williams Restaurant Corp.*, 929 F.2d 662, 18 USPQ2d 1292 (Fed. Cir. 1991), *cert. denied* 502 U.S. 823 (1991) (mark used to identify restaurant services rendered at a single-location restaurant serving interstate travelers is in "use in commerce"); *In re Silenus Wines, Inc.*, 557 F.2d 806, 194 USPQ 261 (C.C.P.A. 1977) (intrastate sale of imported wines by importer constitutes "use in commerce," where goods bearing labels supplied by applicant were shipped to applicant in United States); *In re Gastown, Inc.*, 326 F.2d 780, 140 USPQ 216 (C.C.P.A. 1964) (automotive service station located in one state was rendering services "in commerce" because services were available to customers travelling interstate on federal highways); *U.S. Shoe Corp. v. J. Riggs West, Inc.*, 221 USPQ 1020, 1022 (TTAB 1984) (billiard parlor services satisfy the "use in commerce" requirements, where the record showed that applicant's billiard parlor services were

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

advertised in both Kansas and New York”); *In re G.J. Sherrard Co.*, 150 USPQ 311 (TTAB 1966) (hotel located in only one state has valid use of its service mark in commerce because it has out-of-state guests, has offices in many states, and advertises in national magazines); *In re Federated Department Stores, Inc.*, 137 USPQ 670 (TTAB 1963) (mark used to identify retail department store services located in one state, where the mark was used on credit cards issued to out-of-state residents, and on catalogs and advertisements shipped to out-of-state customers).

Offering services via the Internet has been held to constitute use in commerce, since the services are available to a national and international audience who must use interstate telephone lines to access a website. See *Planned Parenthood Federation of America, Inc. v. Bucci*, 42 USPQ2d 1430 (S.D.N.Y. 1997), *aff'd*, 152 F.3d 920 (2d Cir. 1998) (Table), *cert. denied*, 525 U.S. 834 (1998).

In some cases, services such as restaurant and hotel services have been deemed to be rendered in commerce because they are activities that have been found to be within the scope of the 1964 Civil Rights Act, which, like the Trademark Act, is predicated on the commerce clause. See *In re Ponderosa Motor Inns, Inc.*, 156 USPQ 474 (TTAB 1968); *In re Smith Oil Corp.*, 156 USPQ 62 (TTAB 1967).

Use of a mark in a foreign country does not give rise to rights in the United States if the goods or services are not sold or rendered in the United States. *Buti v. Imprensa Perosa S.R.L.*, 139 F.3d 98, 45 USPQ2d 1985 (2d Cir. 1998); *Mother's Restaurants Inc. v. Mother's Bakery, Inc.*, 498 F. Supp. 847, 210 USPQ 207 (W.D.N.Y. 1980); *Linville v. Rivard*, 41 USPQ2d 1731 (TTAB 1996), *aff'd*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998).

### 901.04 Inquiry Regarding Use in Commerce

It is the responsibility of the applicant and the applicant's attorney to determine whether an assertion of use in commerce is supported by the relevant factual situation. The validity of an applicant's assertion of use in commerce generally does not arise in *ex parte* examination. The examining attorney will normally accept the applicant's verified claim of use in commerce without investigation into whether the use referred to constitutes “use in commerce.”

If, however, the application record contains evidence or information indicating that the mark may not be in use in commerce that “may lawfully be regulated by Congress,” the examining attorney must ask the applicant whether there is use in commerce that may lawfully be regulated by Congress and require a satisfactory explanation or showing of such use.

When necessary, the examining attorney may also require additional product or sales literature concerning the use of the mark to permit full consideration of the issue. 37 C.F.R. §2.61(b); TMEP §814.

## APPLICATIONS BASED ON USE OR INTENT TO USE IN COMMERCE

### 901.05 Use Only by Related Company

If the applicant is not itself using the mark in commerce but the mark is being used by one or more related companies whose use inures to the applicant's benefit (15 U.S.C. §§1055 and 1127), this must be stated in the application or allegation of use. 37 C.F.R. §2.38(b); TMEP §1201.03(a). See TMEP §903.06 regarding first use by a predecessor in title or related company.

See TMEP §§1201.03 *et seq.* regarding use by related companies.

### 902 Allegations of Use for §1(b) Applications

Section 1(b) of the Trademark Act permits the filing of an application to register a mark on the basis of the applicant's bona fide intention to use the mark in commerce for the identified goods or services. Before registration, the applicant must file an allegation of use of the mark in commerce, *i.e.*, either an amendment to allege use under 15 U.S.C. §1051(c), or a statement of use under 15 U.S.C. §1051(d).

See TMEP §§1104 *et seq.* regarding amendments to allege use, TMEP §§1109 *et seq.* regarding statements of use, and TMEP §§1108 *et seq.* regarding requests for extensions of time to file a statement of use.

### 903 Dates of Use

When asserting use of a mark in commerce, an applicant must specify the date of first use anywhere and the date of first use in commerce, either in an original application under §1(a) of the Trademark Act, or in an amendment to allege use or statement of use in an application under §1(b). The dates of use must be verified, *i.e.*, supported by an affidavit or declaration under 37 C.F.R. §2.20. See TMEP §§804 *et seq.* regarding verification.

An applicant filing under §1(b) is not required to state dates of use in the original application, but must include dates of use in an amendment to allege use under §1(c) or statement of use under §1(d).

A §1(b) applicant may assert dates of use that are earlier than the filing date of the application in an amendment to allege use or statement of use.

#### 903.01 Date of First Use Anywhere

The date of first use anywhere is the date when the goods were first sold or transported or the services first rendered under the mark, if such use is bona fide and in the ordinary course of trade. See 15 U.S.C. §1127 (definition of "use" within the definition of "abandonment of mark"). For every applicant, whether foreign or domestic, the date of first use of a mark is the date of the first use anywhere, in the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

United States or elsewhere, regardless of whether the nature of the use was local or national, intrastate or interstate, or of another type.

### **903.02 Date of First Use in Commerce**

The date of first use in commerce is the date when the goods were first sold or transported, or the services first rendered, under the mark in a type of commerce that may be lawfully regulated by Congress, if such use is bona fide and in the ordinary course of trade. See TMEP §901.01 for definitions of “commerce” and “use in commerce,” and TMEP §903.03 regarding types of commerce.

A date of first use in commerce is not required to receive a filing date in an application based on use in commerce under §1(a) of the Act. If the application does not include a date of first use in commerce, the examining attorney will require that the applicant state the date of first use in commerce, supported by an affidavit or declaration under 37 C.F.R. §2.20. 37 C.F.R. §§2.34(a)(1)(iii) and 2.71(c).

In a §1(a) application, the applicant may not specify a date of use that is later than the filing date of the application. If an applicant who filed under §1(a) did not use the mark in commerce before the application filing date, the applicant may amend the basis to §1(b). See TMEP §§806.03 *et seq.* regarding amendments to the basis.

An applicant may not file an application on the basis of use of a mark in commerce if such use has been discontinued.

### **903.03 Type of Commerce**

Types of commerce that may be regulated by the United States Congress are interstate, territorial, and commerce between the United States and a foreign country. See TMEP §901.03.

An applicant is not required to specify the type of commerce in which the mark is used in an application based on §1(a) of the Act, or an amendment to allege use or statement of use in an application under §1(b). The Office presumes that an applicant who states that the mark is in use in commerce is stating that the mark is in use in a type of commerce that Congress can regulate, unless there is contradictory evidence in the record.

If the applicant’s statement regarding use indicates use in a type of commerce that cannot be regulated by Congress (e.g., “intrastate commerce” or “foreign commerce”), the examining attorney must advise the applicant that it appears that the mark is not in use in a type of commerce that can be regulated by Congress and must require that the applicant either submit a verified statement that “the mark is in use in commerce that can be regulated by Congress,” or amend the basis of the application to a bona fide intention to use the mark in commerce under §1(b) of the Act if permitted by 37 C.F.R. §2.35. See TMEP §806.03(c) regarding amendment of the basis from §1(a) to §1(b).

## APPLICATIONS BASED ON USE OR INTENT TO USE IN COMMERCE

The term “foreign” is not acceptable to specify the type of commerce in which a mark is used, because it does not clearly indicate that the mark is in use in a type of commerce that Congress can lawfully regulate. Unless the “foreign commerce” involves the United States, Congress would not have the power to regulate it.

### 903.04 Relation Between the Two Dates of Use

The application or allegation of use must specify both the date of first use anywhere and the date of first use in commerce. If the first use made by the applicant was in commerce that may be regulated by Congress, the date of first use and the date of first use in commerce will be the same date.

The date of first use anywhere will always be either earlier than or the same as the date of first use in commerce. If the date of first use anywhere specified in an application or allegation of use is later than the date of first use in commerce, the examining attorney will require clarification.

The requirement that an applicant specify the date of first use anywhere as well as the date of first use in commerce applies to foreign applicants as well as domestic applicants in applications under §§1(a) and 1(b) of the Act. *In re Sevi S.p.A.*, 1 USPQ2d 1671 (TTAB 1986).

### 903.05 Amending Dates of Use

Any amendment of the dates must be supported by an affidavit, or by a declaration under 37 C.F.R. §2.20, by the applicant. 37 C.F.R. §2.71(c). The affidavit or declaration must be signed by someone properly authorized to sign on behalf of the applicant under 37 C.F.R. §2.33(a). See TMEP §804.04.

In an application under §1(a) of the Trademark Act, the applicant may not amend to specify a date of use that is later than the filing date of the application. 37 C.F.R. §2.71(c)(1). If an applicant who filed under §1(a) did not use the mark in commerce before the application filing date, the applicant may amend the basis to §1(b). See TMEP §§806.03 *et seq.* regarding amendments to the basis.

In an application under §1(b) of the Act in which an amendment to allege use is filed, the applicant may not amend the dates of use to recite dates of use that are subsequent to the filing of the amendment to allege use. However, the applicant may withdraw the amendment to allege use. 37 C.F.R. §2.76(h).

In an application under §1(b), after the applicant files a statement of use, the applicant may not amend to recite dates of use that are subsequent to the expiration of the statutory deadline for filing a statement of use (*i.e.*, within six months of the mailing date of the notice of allowance or before the expiration of an extension of time for filing a statement of use). 37 C.F.R. §2.71(c)(2). If a §1(b) applicant did not use the mark in commerce before the expiration of the deadline for filing a statement

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

of use, the applicant may *not* withdraw the statement of use. 37 C.F.R. §2.88(g); TMEP §1109.17.

A multi-class application must include dates of use for each class. If a single-class application containing dates of use is amended to a multiple-class application, the dates-of-use clause must be amended to reflect dates of use for each class. See 37 C.F.R. §2.86(a)(3); TMEP §1403.01. A supporting affidavit or declaration is not necessary if the dates of use alleged in the original application or in an earlier-filed amendment to allege use or statement of use apply to all classes.

If a single-class application is amended to a multiple-class application, but the applicant does not set forth dates of use for the added classes, the examining attorney should inquire as to whether the dates of use apply to all classes and require an amendment, if necessary.

A supporting affidavit or declaration is required for any *change* to the dates of use. 37 C.F.R. §2.71(c). However, if the applicant has properly verified the date of first use in commerce and, for whatever reason, seeks to amend the date of first use anywhere to the same date as the date of first use in commerce, a verified statement is not required if the originally specified date of first use anywhere is *earlier* than the date of first use in commerce. This is not considered a *change* to the dates of use, because the applicant has already sworn to a date of first use in commerce that necessarily requires, and logically includes, first use of the mark anywhere. Thus, the applicant has, in fact, already verified in its original application or allegation of use that the date of first use of the mark anywhere is at least as early as the date of first use of the mark in commerce. Such an amendment may be entered by examiner's amendment.

When the date of first use anywhere is *later* than the date of first use in commerce, an unverified amendment is inappropriate because the validity of the verification is called into question by the impossibility of first use anywhere being later than the first use in commerce.

Compare the following examples.

- (1) First use anywhere: March 6, 1985

First use in commerce: February 10, 1985

An amendment of the date of first use anywhere to February 10, 1985, must be verified, because the validity of the date of first use in commerce is called into question by the fact that the applicant has specified a later date of first use anywhere.

- (2) First use anywhere: March 6, 1985

First use in commerce: April 10, 1985

## APPLICATIONS BASED ON USE OR INTENT TO USE IN COMMERCE

An unverified amendment of the date of first use anywhere to April 10, 1985, is acceptable, because first use in commerce logically includes first use anywhere.

- (3) First use anywhere: March 1985

First use in commerce: March 10, 1985

An unverified amendment of the date of first use anywhere to March 10, 1985, is acceptable because the information in the record is not contradictory on its face. There is only an apparent contradiction resulting from the way in which the Office construes the information when an applicant provides only the month and year (*i.e.*, as indicating the last day of the month - see TMEP §903.07 regarding indefinite dates of use).

This policy is not applicable to the converse. That is, an amendment to the date of first use in commerce to conform to the date of first use anywhere is a *change* (because first use anywhere does not necessarily include first use in commerce) and must be verified.

### **903.06 First Use by Predecessor or Related Company**

If the first use anywhere or the first use in commerce was by a predecessor in title to the applicant, or by a related company of the applicant (see 15 U.S.C. §§1055 and 1127), the dates of use clause should state that the use on this date was by the applicant's predecessor in title, or by a related company of the applicant, as the case may be. See 37 C.F.R. §2.38(a). It is generally not necessary to give the name of the predecessor in title or the related company.

See TMEP §§901.05 and 1201.03 *et seq.* regarding current use by a party other than the applicant.

### **903.07 Indefinite Dates of Use**

In specifying the dates of first use, the applicant should give dates that are as definite as possible.

The only date that will be recognized for Office proceedings is the latest definite date specified by the applicant. However, the applicant may use indefinite terms in describing dates if the applicant considers it necessary due to uncertainty as to the particular date. Although terms such as "at least as early as," "prior to," "before," "on or about" and "in" are acceptable for the record, these terms are not printed in the *Official Gazette* or on the certificate of registration.

When a month and year are given without a specified day, the date presumed for purposes of examination is the last day of the month. When only a year is given, the



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

date presumed for purposes of examination is the last day of the year. Some examples are as follows:

- “Prior to January 1, 1955” is treated as December 31, 1954.
- “Before February 1961” is treated as January 31, 1961.
- “On or about June 18, 1987” is treated as June 18, 1987.
- “1990” is treated as December 31, 1990.
- “In November 1991” is treated as November 30, 1991.
- “In the 1920s” is treated as December 31, 1929.

When an applicant alleges only a year prefaced by vague or ambiguous language such as “in the Spring of,” the Office will construe the date as the last day of that year unless the applicant amends to specify a particular date or a particular month of the specified year.

When an applicant’s date of first use in commerce is more specific than its date of first use anywhere, the above presumption can result in an unacceptable dates-of-use clause in which the date of first use in commerce precedes the date of first use anywhere. For example:

First use anywhere: 1991

First use in commerce: January 15, 1991

Usual presumption of first use anywhere: December 31, 1991 (which results in a logical inconsistency).

Therefore, when the above presumption would be applicable, and the result is a date of first use in commerce that precedes the date of first use anywhere, the examining attorney should contact the applicant by telephone, if appropriate, for authorization to amend the date of first use anywhere to the same date as the date of the first use in commerce. As noted in TMEP §903.05, this may be done by examiner’s amendment.

Indefinite phraseology of the type described above is not considered to be misleading, because it does give notice that, when called upon to do so, the applicant may undertake to prove a date earlier than the one stated.

The presumed dates discussed above are *not* entered into the automated records of the Office, or printed in the *Official Gazette* or on the certificate of registration. Instead, only the information provided by the applicant is printed. Thus, if the applicant states that the mark was first used “at least as early as January of 1994,” the date printed is “1/0/1994.” If applicant states that the mark was first used “sometime in 1965,” the date printed is “0/0/1965.”

## APPLICATIONS BASED ON USE OR INTENT TO USE IN COMMERCE

In an *inter partes* proceeding, a date of use must be established by appropriate evidence unless the party to the proceeding is entitled to rely on a date by virtue of ownership of a registration or filing of an application. 37 C.F.R. §2.122(b)(2); *Trademark Trial and Appeal Board Manual of Procedure* (“TBMP”) §704.04.

See TMEP §903.07(a) regarding apparent discrepancies between dates of use and execution dates.

### **903.07(a) Apparent Discrepancies Between Dates of Use and Date of Execution**

If an application, amendment to allege use under 15 U.S.C. §1051(c), or statement of use under 15 U.S.C. §1051(d) specifies a date of first use only by the year, or by the month and the year, and the date would be interpreted under TMEP §903.07 as later than the date on which the application or allegation of use was *signed*, the Office will presume that the date specified is the date of the signing of the application or allegation of use. In this case, it is not necessary to amend the application to indicate the date of use more specifically. Amendment is still required, however, if the date specified would be interpreted as later than the *filing date* of the application or allegation of use.

If an application, amendment to allege use under 15 U.S.C. §1051(c), or statement of use under 15 U.S.C. §1051(d) specifies the date of signature only by the year, or by the month and the year, and the date would be interpreted under TMEP §903.07 as later than the date(s) of first use, the Office will presume that the date of signature was on or after the date of first use.

### **903.08 Dates of Use in Another Form**

If the mark in the application is a composite mark, the applicant may specify dates of first use of a separable element of the composite mark. These dates will be printed on the certificate of registration for general information. However, the applicant must also specify the dates of first use of the entire composite mark for which registration is being sought.

### **903.09 More than One Item of Goods or Services**

If more than one item of goods or services is specified in a particular class, the date of first use anywhere and date of first use in commerce do not have to pertain to every item in the class. It might be that the mark, although in use on all of the items at the time the application or allegation of use was filed, was first used on various items on differing dates, so that it would be cumbersome to designate the dates for all items individually. See *Sunshine Biscuits, Inc. v. Berke Bakeries, Inc.*, 106 USPQ 222 (PO Ex. Ch. 1955); *Ex parte Wayne Pump Co.*, 88 USPQ 437 (PO Ex. Ch. 1951).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

There must be at least one specified item in a class to which the specified dates pertain. 37 C.F.R. §§2.34(a)(1)(iii) and 2.34(a)(1)(iv), 2.76(c) and 2.88(c). Where the dates of use do not pertain to all items, the particular item to which they do pertain should be designated.

Where the dates of use do not pertain to every item in the class, and the identification of goods or services is amended to delete the item(s) to which the dates of use pertain, the applicant must amend the dates-of-use clause to specify the dates that apply to an item that remains in the identification, and this item should be designated. See TMEP §903.05 regarding amendments to dates of use.

If more than one item of goods or services is specified in a particular class, the Office will presume that the dates of use apply to all the goods or services, unless the applicant states otherwise.

Where more than one date is specified for a particular class, the earliest date will be printed in the *Official Gazette* and, if a registration issues, on the certificate of registration.

### **904 Specimens**

Specimens provide part of the basis for examination because they show the manner in which the mark is seen by the public. Specimens also provide supporting evidence of facts recited in the application.

An application for registration under §1(a) of the Trademark Act must include one specimen showing use of the mark as used on or in connection with the goods, or in the sale or advertising of the services in commerce. 15 U.S.C. §1051(a)(1); 37 C.F.R. §2.56(a). If an application under §1(a) is filed without a specimen, the examining attorney will require that the applicant submit one specimen for each class, with an affidavit or declaration under 37 C.F.R. §2.20 stating that the specimen was in use in commerce on the filing date of the application.

In an application for registration under §1(b) of the Trademark Act, no specimen is required at the time the application is filed. However, before registration the applicant must file an amendment to allege use or statement of use of the mark in commerce that includes one specimen showing use of the mark in commerce on or in connection with the goods, or in the sale or advertising of the services. 37 C.F.R. §§2.56(a), 2.76(b)(2), and 2.88(b)(2).

If the nature of the specimen is unclear, the applicant must explain what it is and how it is used.

A specimen showing use of the mark is not required in an application based solely on §44 or §66(a) of the Trademark Act, 15 U.S.C. §1126 or §1141f(a). While a §44 or §66(a) applicant must assert a bona fide intent to use the mark in commerce, the applicant is not required to assert actual use in commerce prior to registration.

## APPLICATIONS BASED ON USE OR INTENT TO USE IN COMMERCE

*Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909 (TTAB 1984); TMEP §§1009 and 1904.01(d).

See TMEP §1202.15 regarding sound marks.

### **904.01            Number of Specimens**

One specimen for each class is required in an application for registration under §1(a) of the Trademark Act, or in an amendment to allege use or statement of use in an application under §1(b) of the Act. An applicant may choose to submit more than one specimen per class, but this is not required.

The Office previously required three specimens so that an interested party, such as a potential opposer, could permanently remove a specimen from an application file, yet not leave the file without a specimen. However, multiple copies of specimens are not necessary, because the public may make photocopies of the specimen. The Office no longer permits specimens to be removed from files. This ensures that there is a complete record of the submissions made by the applicant. See notice at 64 Fed. Reg. 48900, 48901 (Sept. 8, 1999) and 1226 TMOG 103 (Sept. 28, 1999).

### **904.01(a)            More than One Item Specified in a Class**

If more than one item of goods, or more than one service, is specified in an application in one class, it is usually not necessary to have a specimen for each product or service. However, if the range of items is very wide or contains unrelated articles, the examining attorney may request additional specimen(s) under 37 C.F.R. §2.61(b). See TMEP §1402.03 regarding broad identifications, TMEP §1402.03(b) regarding house marks, and TMEP §1402.03(c) regarding marks for “a full line of” a genre of products.

### **904.01(b)            In Combined or Multiple-Class Applications**

A combined (or multiple-class) application is a request to register the same mark for goods and/or services in multiple classes in a single application. There must be one specimen of the mark for each class.

See TMEP §§1403 *et seq.* regarding examination of multiple-class applications.

### **904.02            Physical Form of Specimens**

#### **904.02(a)            Electronically Filed Specimens**

In an electronically filed application or allegation of use, the applicant must submit a digitized image of the specimen in .jpg format. 37 C.F.R. §2.56(d)(4).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Sometimes there is no visible specimen in the record due to a technical problem. In this situation, the examining attorney should ask the applicant to submit by mail or fax: (1) the specimen (or a facsimile) that was attached to the original TEAS submission; and (2) a statement by the person who transmitted the original TEAS submission with the specimen that the specimen being submitted by mail or fax is a true copy of the specimen originally filed through TEAS. This statement does not have to be verified. Alternatively, the owner may submit a new specimen, together with an affidavit or declaration of use of the substitute specimen. See TMEP §904.09 regarding the requirements for an affidavit or declaration supporting use of substitute specimens.

This also applies to specimens filed with affidavits of use under 15 U.S.C. §1058 of the Trademark Act.

If the nature of an electronically filed specimen is unclear, the applicant should explain what it is and how it is used.

In an application for registration of a sound mark that comprises music or words set to music, the applicant may submit the musical score as a specimen, in .wav format. Since all TEAS attachments must be in .jpg format, a .wav file cannot be sent as an attachment to a TEAS filing. Therefore, the Office has developed a special procedure for handling .wav files. The .wav file must be sent after the application is filed, as an attachment to an e-mail message directed to [TEAS@uspto.gov](mailto:TEAS@uspto.gov), with clear instructions that the .wav file should be associated with “the application filed under Serial No. <specify>.” See TMEP §1202.15 regarding sound marks.

### **904.02(b) Paper Specimens**

A specimen of use must be flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. 37 C.F.R. §2.56(d)(1).

When the applicant cannot supply an actual specimen meeting these size requirements due to the nature or manner of use of the mark, the applicant should file a photograph or other acceptable reproduction that is a suitable size and clearly shows how the mark is used. See TMEP §904.08 regarding facsimiles as specimens.

Specimens of value should not be filed.

Once filed, specimens remain part of the record and will not be returned to the applicant. 37 C.F.R. §2.25.

### **904.02(c) Specimens for Marks Comprising Color**

If color is a feature of the mark, the specimen must show use of the color. If the applicant submits a specimen that is not in color or not in the appropriate color, the

## APPLICATIONS BASED ON USE OR INTENT TO USE IN COMMERCE

examining attorney will require the applicant to file a substitute specimen that shows use of the appropriate color(s). See TMEP §904.09 regarding substitute specimens.

See *also* TMEP §1202.05(f) regarding specimens showing use of marks that consist *solely* of color.

### **904.02(d) Marks Used on Publications**

An application for registration of a mark for publications is treated the same as any other application with respect to specimen requirements. The Office does not require a complete copy of the publication or a title page in every case. However, the examining attorney may require a copy of the publication under 37 C.F.R. §2.61(b) if he or she believes it is necessary for the proper examination. For example, a copy of the publication might be necessary to determine whether a mark is merely descriptive of the goods.

### **904.03 Bulky Specimens**

A specimen of use must be flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. 37 C.F.R. §2.56(d)(1). If an applicant submits a specimen that exceeds these size requirements (a “bulky specimen”), the Office will create a facsimile of the specimen that meets the size requirements of the rule, and destroy the original bulky specimen. 37 C.F.R. §2.56(d)(2).

If the copy of the specimen created by the Office does not adequately depict the mark, the examining attorney will require a substitute specimen that meets the size requirements of the rule, and an affidavit or declaration verifying the use of the substitute specimen. See TMEP §904.09 regarding affidavits supporting substitute specimens.

The Office will accept specimens consisting of videotapes, audiotapes, compact discs, computer diskettes, and similar materials if there are no non-bulky alternatives, and the submission is the only means available for showing use of the mark. 37 C.F.R. §2.56(d)(3). Equipment for viewing or listening to these materials is available in the Office.

During examination, an examining attorney has the discretion to request additional information in the form of bulky materials, under 37 C.F.R. §2.61(b). For example, if the mark is a configuration of the goods or of the container for the goods, the examining attorney may require one actual product or container. Or the examining attorney might require a complete copy of a publication in order to determine whether a mark is merely descriptive of the goods. See TMEP §904.02(d) regarding marks used on publications.

In specific cases, when the examining attorney has required bulky materials, or where the applicant has submitted bulky exhibits during an interview, these bulky

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

materials may be entered into the record. However, the examining attorney should encourage the applicant to submit a photograph of the bulky specimens or evidence for the record.

### **904.04 Material Appropriate as Specimens for Trademarks**

For a trademark application under §1(a) of the Trademark Act or an amendment to allege use or statement of use in an application under §1(b) of the Act, the specimen must show the mark as used on or in connection with the goods in commerce. A trademark specimen should be a label, tag, or container for the goods, or a display associated with the goods. 37 C.F.R. §2.56(b)(1). A photocopy or other reproduction of a specimen of the mark as actually used on or in connection with the goods is acceptable. 37 C.F.R. §2.56(c).

The Office may accept another document related to the goods or the sale of the goods when it is not possible to place the mark on the goods, packaging, or displays associated with the goods. 15 U.S.C. §1127 (definition of “use in commerce”); 37 C.F.R. §2.56(b)(1). This provision is not intended as a general alternative to submitting labels, tags, containers or displays associated with the goods; it applies *only* to situations when the nature of the goods makes use on these items impracticable. A mere assertion of impracticability may not suffice to establish that such use is impracticable; rather, the record must indicate that the goods are in fact of such a nature. For example, it may be impracticable to place the mark on the goods or packaging for the goods if the goods are natural gas, grain that is sold in bulk, or chemicals that are transported only in tanker cars.

A photocopy of the drawing required by 37 C.F.R. §2.51 is not a proper specimen. 37 C.F.R. §2.56(c). Similarly, the specimen may not be a “picture” of the mark, such as an artist’s drawing or a printer’s proof that merely illustrates what the mark looks like and is not actually used on or in connection with the goods in commerce.

See TMEP §§1301.04 *et seq.* regarding service mark specimens, TMEP §1304.09(c) regarding collective membership mark specimens, TMEP §1303.02(b) regarding collective mark specimens, and TMEP §1306.06(c) regarding certification mark specimens.

#### **904.04(a) Labels and Tags**

In most cases, where the trademark is applied to the goods or the containers for the goods by means of labels, a label is an acceptable specimen.

Shipping or mailing labels may be accepted if they are affixed to the goods or to the containers for the goods and if proper trademark usage is shown. *Electronic Communications, Inc. v. Electronic Components for Industry Co.*, 443 F.2d 487, 170 USPQ 118 (8th Cir. 1971), *cert. denied* 404 U.S. 833 (1971); *In re A.S. Beck Shoe Corp.*, 161 USPQ 168 (TTAB 1969). They are not acceptable if the mark as shown

## APPLICATIONS BASED ON USE OR INTENT TO USE IN COMMERCE

is merely used as a trade name and not as a trademark. An example of this is the use of the term solely as a return address. *Bookbinder's Sea Food House, Inc. v. Bookbinder's Restaurant, Inc.*, 118 USPQ 318 (Comm'r Pats. 1958); *I. & B. Cohen Bomzon & Co., Inc. v. Biltmore Industries, Inc.*, 22 USPQ 257 (Comm'r Pats. 1934). See TMEP §1202.01 regarding trade name refusals.

In connection with labels whose appearance suggests that they are only for temporary use, the examining attorney may consider it necessary to make further inquiry under 37 C.F.R. §2.61(b) in order to properly examine the application. A response to the inquiry may include additional specimens if labels of a more permanent nature have by that time been adopted. *House of Worsted-Tex, Inc. v. Deering Milliken & Co., Inc.*, 102 USPQ 446 (Comm'r Pats. 1954), *aff'd*, 233 F.2d 333, 110 USPQ 44 (C.C.P.A. 1956).

### **904.04(b) Stampings**

Stamping a trademark on the goods, on the container, or on tags or labels attached to the goods or containers, is a proper method of trademark affixation. See *In re Crucible Steel Co. of America*, 150 USPQ 757 (TTAB 1966). The trademark may be imprinted in the body of the goods, as with metal stamping; it may be applied by a rubber stamp; or it may be inked on by using a stencil or template.

When a trademark is used in this manner, facsimiles comprising sheets of paper or other materials on which impressions of the trademark are stamped or stencilled are normally acceptable as specimens (see TMEP §904.08 regarding facsimile specimens).

When the specimen consists of a stamp on paper, the applicant must explain the nature of the specimen and how it is used.

### **904.04(c) Commercial Packaging**

The terminology "applied to the containers for the goods" means applied to any type of commercial packaging that is normal for the particular goods as they move in trade. Thus, a showing of the trademark on the normal commercial package for the particular goods is an acceptable specimen. For example, gasoline pumps are normal containers or "packaging" for gasoline.

A specimen showing use of the trademark on a vehicle in which the goods are marketed to the relevant purchasers may constitute use of the mark on a container for the goods, if this is the normal mode of use of a mark for the particular goods. *In re E.A. Miller & Sons Packing Co., Inc.*, 225 USPQ 592 (TTAB 1985). *But see In re Lyndale Farm*, 186 F.2d 723, 88 USPQ 377 (C.C.P.A. 1951).



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **904.04(d) Specimens for Trademarks Identifying Computer Programs, Movies or Video Tapes**

The computer program, video tape, and movie industries have adopted the practice of applying trademarks that are visible only when the goods, *i.e.*, programs or movies, are displayed on a screen (perhaps, for example, on the first several frames of a movie).

An acceptable specimen might be a photograph of a display screen projecting the identifying trademark of a computer program, or a photograph of a frame(s) of a movie or video tape bearing the mark. It is not necessary that purchasers see the mark prior to purchasing the goods, so long as the mark is applied to the goods or their containers, or to a display associated with the goods, and the goods are sold or transported in commerce. *In re Brown Jordan Co.*, 219 USPQ 375 (TTAB 1983) (stamping the mark after purchase of the goods, on a tag attached to the goods that are later transported in commerce, held sufficient).

For downloadable computer software, an applicant may submit a specimen that shows use of the mark on an Internet website. Such a specimen is acceptable only if it provides sufficient information to enable the user to download the software from the website. If the website simply advertises the software without providing a way to download it, the specimen is unacceptable. See TMEP §904.06(b) regarding electronic displays as specimens for trademarks.

### **904.05 Material Not Appropriate as Specimens for Trademarks**

Advertising material is generally not acceptable as a specimen for goods. Any material whose function is merely to tell the prospective purchaser about the goods, or to promote the sale of the goods, is unacceptable to support trademark use. Similarly, informational inserts are generally not acceptable to show trademark use. *In re MediaShare Corp.*, 43 USPQ2d 1304 (TTAB 1997); *In re Schiapparelli Searle*, 26 USPQ2d 1520 (TTAB 1993); *In re Drilco Industrial Inc.*, 15 USPQ2d 1671 (TTAB 1990); *In re ITT Rayonier Inc.*, 208 USPQ 86 (TTAB 1980); *In re Bright of America, Inc.*, 205 USPQ 63 (TTAB 1979). However, an instruction sheet may be an acceptable specimen. *In re Ultraflight Inc.*, 221 USPQ 903 (TTAB 1984). See TMEP §904.07 regarding package inserts.

The following types of items are generally considered advertising, and unless they comprise point-of-sale material, are not acceptable as specimens of use on goods: advertising circulars and brochures; price lists; announcements; publicity releases; listings in trade directories; and business cards. Moreover, material used by the applicant to conduct its internal business is unacceptable as a specimen of use on goods. These materials include all papers whose sole function is to carry out the applicant's business dealings, such as invoices, bill heads, waybills, warranties and business stationery. See *In re Chicago Rawhide Mfg. Co.*, 455 F.2d 563, 173 USPQ 8 (C.C.P.A. 1972); *In re Bright of America, supra*; *Varian Associates v. IMAC Corp.*,

## APPLICATIONS BASED ON USE OR INTENT TO USE IN COMMERCE

160 USPQ 283 (N.D. Ill. 1968); *Upco Co. v. Speed Crete of La., Inc.*, 154 USPQ 555 (TTAB 1967); *Dynacolor Corp. v. Beckman & Whitley, Inc.*, 134 USPQ 410 (TTAB 1962); *Pendleton Woolen Mills v. Eloesser-Heynemann Co.*, 133 USPQ 211 (TTAB 1962); *Boss Co. v. Homemaker Rugs, Inc.*, 117 USPQ 255 (N.D. Ill. 1958). As to display of trademarks on company uniforms, see *In re McDonald's Corp.*, 199 USPQ 702 (TTAB 1978); *Toro Manufacturing Corp. v. John B. Stetson Co.*, 161 USPQ 749 (TTAB 1969).

Bags and other packaging materials bearing the name of a retail store and used by the store merely for packaging items of sold merchandise are not acceptable to show trademark use of the store name for the products sold by the store (e.g., bags at cash register). When used in this manner, the name merely identifies the store. See *In re Pennsylvania Fashion Factory, Inc.*, 198 USPQ 568 (TTAB 1978), *aff'd*, 588 F.2d 1343, 200 USPQ 140 (C.C.P.A. 1978).

### 904.06 Displays as Specimens for Trademarks

A display must be associated directly with the goods offered for sale. It must bear the trademark prominently. However, it is not necessary that the display be in close proximity to the goods. See *In re Marriott Corp.*, 459 F.2d 525, 173 USPQ 799 (C.C.P.A. 1972); *Lands' End Inc. v. Manbeck*, 797 F. Supp. 511, 24 USPQ2d 1314 (E.D. Va. 1992).

Displays associated with the goods essentially comprise point-of-sale material, such as banners, shelf-talkers, window displays, menus and similar devices.

These items must be designed to catch the attention of purchasers and prospective purchasers as an inducement to make a sale. Further, the display must predominantly display the trademark in question and associate it with, or relate it to, the goods. The display must be related to the sale of the goods so that an association of the two is inevitable. See *In re Bright of America, Inc.*, 205 USPQ 63 (TTAB 1979), and cases cited therein. See also *In re ITT Rayonier Inc.*, 208 USPQ 86 (TTAB 1980). Cf. *In re Shipley Co. Inc.*, 230 USPQ 691 (TTAB 1986); *In re Jones*, 216 USPQ 328 (TTAB 1982).

Folders and brochures that describe goods and their characteristics or serve as advertising literature are not per se "displays." *In re Schiapparelli Searle*, 26 USPQ2d 1520 (TTAB 1993); *In re Drilco Industrial Inc.*, 15 USPQ2d 1671 (TTAB 1990). In order to rely on such materials as specimens, an applicant must submit evidence of point-of-sale presentation. See *In re Ancha Electronics Inc.*, 1 USPQ2d 1318 (TTAB 1986); *In re Columbia Chase Corp.*, 215 USPQ 478 (TTAB 1982). See TMEP §904.06(a) regarding the criteria by which a catalog or other advertising may constitute a display associated with the goods.

An infomercial was held to be a display associated with the goods, where the goods were shown either immediately before or immediately after the trademark was

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

displayed, and the information on how to order the goods was given within a reasonable time after the goods were shown. The Board found that the infomercial created an association between the trademark and the goods, and the test for constituting a display associated with the goods was therefore satisfied. *In re Hydron Technologies, Inc.*, 51 USPQ2d 1531 (TTAB 1999).

### **904.06(a) Catalogs as Specimens for Trademarks**

In appropriate cases, catalog specimens are acceptable specimens of trademark use. *Lands' End Inc. v. Manbeck*, 797 F. Supp. 511, 24 USPQ2d 1314 (E.D. Va. 1992). In that case, the applicant had applied to register "KETCH" for purses. The specimen was a catalog page that included a picture of the goods and, below the picture, the mark and a description of the goods. The Court stated, "The alleged trademark 'KETCH' appears prominently in large bold lettering on the display of purses in the Lands' End specimen in a manner which closely associates the term with the purses." 24 USPQ2d at 1315.

The Court determined that the catalog was not mere advertising and that it met the relevant criteria for displays associated with the goods. The Court evaluated the catalog specimen as follows:

A customer can identify a listing and make a decision to purchase by filling out the sales form and sending it in or by calling in a purchase by phone. A customer can easily associate the product with the word "KETCH" in the display.... The point of sale nature of this display, when combined with the prominent display of the alleged mark with the product, leads this court to conclude that this mark constitutes a display associated with the goods.  
24 USPQ2d at 1316.

Accordingly, examining attorneys should accept any catalog or similar specimen as a display associated with the goods, provided: (1) it includes a picture of the relevant goods; (2) it shows the mark sufficiently near the picture of the goods to associate the mark with the goods; *and* (3) it includes the information necessary to order the goods, (e.g., an order form, or a phone number, mailing address, or e-mail address for placing orders). Any form of advertising that satisfies these criteria should be construed as a display associated with the goods.

The mere inclusion of a phone number, Internet address and/or mailing address on an advertisement describing the product is not sufficient. There must be an offer to accept orders or instructions on how to place an order. *In re MediaShare Corp.*, 43 USPQ2d 1304 (TTAB 1997) (fact sheet brochures held not to qualify as a catalog under *Lands' End*, where the specimen failed to show the mark near a picture of the goods, and included no information as to how to order the goods). It is not necessary that the specimen list the price of the goods.

## APPLICATIONS BASED ON USE OR INTENT TO USE IN COMMERCE

### **904.06(b) Electronic Displays as Specimens for Trademarks**

A website page that displays a product, and provides a means of ordering the product, can constitute a “display associated with the goods,” as long as the mark appears on the web page in a manner in which the mark is associated with the goods, and the web page provides a means for ordering the goods. The Trademark Trial and Appeal Board has held that web pages that display goods and their trademarks and provide for online ordering of such goods are, in fact, electronic displays which are associated with the goods. Such uses are not merely advertising, because in addition to showing the goods, they provide a link for ordering the goods. In effect, the website is an electronic retail store, and the web page is a shelf-talker or banner which encourages the consumer to buy the product. A consumer using the link on the web page to purchase the goods is the equivalent of a consumer seeing a shelf-talker and taking the item to the cashier in a store to purchase it. The web page is thus a point of sale display by which an actual sale is made. *In re Dell Inc.*, 71 USPQ2d 1725 (TTAB 2004).

### **904.07 Package Inserts as Specimens for Trademarks**

If material inserted in a package with the goods is merely advertising material, then it is not acceptable as a specimen of use on or in connection with the goods. Material that is only advertising does not necessarily cease to be advertising because it is placed inside a package.

Materials such as invoices, announcements, order forms, bills of lading, leaflets, brochures, printed advertising material, circulars, publicity releases, and the like, are not acceptable specimens to show use on goods. See *In re Bright of America, Inc.*, 205 USPQ 63 (TTAB 1979).

However, if printed matter included with the goods functions as a part of the goods, such as a manual that is part of a kit for assembling the product, then placement of the mark on that printed matter does show use on the goods. *In re Ultraflight Inc.*, 221 USPQ 903, 906 (TTAB 1984) (“We believe the instruction manual is as much a part of applicant’s goods as are the various parts that are used to build the gliders. Application of the mark to the manual of assembly instructions, then, must be considered affixation to the goods.”).

### **904.08 Facsimiles as Specimens**

Actual specimens are preferred if they are available and not “bulky” (see TMEP 904.03 regarding bulky specimens). However, a photograph, photocopy or other reproduction of a specimen of the mark as used on or in connection with the goods, or in the sale or advertising of the services, is acceptable. 37 C.F.R. §2.56(c). The applicant should submit facsimiles if actual specimens exceed the size requirements of 37 C.F.R. §2.56(d)(1).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Facsimiles should show the whole article to which the mark is applied, or enough of the article so that the nature of the article can be identified. The mark and all other pertinent written matter on the article should be clear and legible. It is permissible to show the complete article in one photograph and the written matter in another, so that the written matter will be legible, or to show different views of an article either in a single photograph or in separate photographs.

If color is a feature of the mark, the applicant should submit facsimiles made by color photography, or by any process that reproduces in color. See TMEP §904.02(c).

Product photographs appearing on folders or brochures that show the trademark on the goods are acceptable facsimiles.

If necessary, the examining attorney may require one actual specimen for examination purposes, under 37 C.F.R. §2.61(b).

A copy or reproduction of the drawing is not an acceptable specimen. 37 C.F.R. §2.56(c).

### **904.09            Affidavit Supporting Substitute Specimens**

If the specimen is unacceptable, the examining attorney will require a substitute specimen. Generally, when submitting a substitute specimen, the applicant must include an affidavit or declaration under 37 C.F.R. §2.20 verifying that the substitute specimen is in use in commerce. Similarly, when submitting an additional specimen in support of a multiple class application that is not identical to the specimen originally filed, the applicant must include an affidavit or declaration under 37 C.F.R. §2.20 verifying that the new specimen is in use in commerce.

In an application under §1(a) of the Trademark Act, the affidavit or declaration must state that the substitute or additional specimen was in use in commerce at least as early as the application filing date. 37 C.F.R. §2.59(a). If the applicant cannot provide an acceptable substitute specimen, supported by an affidavit or declaration of use in commerce as of the filing date of the application, the applicant may amend the basis to §1(b). See TMEP §§806.03 *et seq.* regarding amendments to the basis.

In an application under §1(b) of the Act, a substitute or additional specimen filed after an amendment to allege use under §1(c) of the Act must be supported by an affidavit or declaration under 37 C.F.R. §2.20 stating that applicant used the substitute specimen in commerce on or in connection with the goods/services prior to filing the amendment to allege use. 37 C.F.R. §2.59(b)(1). When a substitute specimen is filed after a statement of use under §1(d) of the Act, the applicant must verify that the substitute or additional specimen was in use in commerce before the expiration of the deadline for filing a statement of use (*i.e.*, within six months of the mailing date of the notice of allowance or before the expiration of an extension of time for filing a statement of use). 37 C.F.R. §2.59(b)(2).

## APPLICATIONS BASED ON USE OR INTENT TO USE IN COMMERCE

If the dates of use change as the result of the submission of new specimen(s), the applicant must amend the dates of use with a proper affidavit or declaration under 37 C.F.R. §2.20. See 37 C.F.R. §2.71(c); TMEP §903.05.

In some situations, however, an affidavit or declaration of use of substitute specimens is not necessary. For instance, if the specimen originally filed is cut from a larger object, it is not necessary to provide an affidavit or declaration when a sample (or a photograph) of the complete object is submitted to corroborate the original specimen. In these circumstances, the additional specimen is supplemental, and the examining attorney may consider the original specimens to have been satisfactory. Similarly, if the applicant submits a specimen that is temporary in nature (see TMEP §904.04(a)), no verification is necessary if the applicant submits a more permanent specimen.

### **904.10 Translation of Matter on Specimens**

If there is matter printed on a specimen that is not in English, the examining attorney may require that the applicant submit a translation of this matter to permit proper examination. 37 C.F.R. §2.61(b). If the examining attorney determines that a translation is necessary, he or she should limit the requirement in an appropriate manner to avoid placing an unnecessary burden on the applicant.

### **904.11 Requirements for Substitute Specimens and Statutory Refusals**

If the deficiency in a specimen amounts to failure to use the subject matter as a trademark and/or service mark, the examining attorney should issue a refusal of registration on the ground that the subject matter does not function as a mark, in addition to requiring a substitute specimen. The statutory basis for refusal is 15 U.S.C. §§1051, 1052 and 1127 for trademarks, or 15 U.S.C. §§1051, 1053 and 1127 for service marks. See TMEP §§1202 *et seq.* regarding matter that does not function as a trademark, and TMEP §§1301.02 *et seq.* regarding matter that does not function as a service mark.

### **905 Method of Use**

The applicant is not required to specify the method or intended method of use of a mark, in an application under §1(a) or §1(b) of the Act, or in an allegation of use under §1(c) or §1(d) of the Act. However, the examining attorney has the discretion under 37 C.F.R. §2.61(b) to inquire as to the method or intended method of use of the mark if this information is needed to properly examine the application. See TMEP §814. See also *In re Page*, 51 USPQ2d 1660, 1665 (TTAB 1999).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 906 Federal Registration Notice

The owner of a mark registered in the United States Patent and Trademark Office may give notice that the mark is registered by displaying with the mark the words “Registered in United States Patent and Trademark Office,” the abbreviation “Reg. U.S. Pat. & Tm. Off.,” or the letter R enclosed within a circle, ®. 15 U.S.C. §1111.

The registration symbol should be used only on or in connection with the goods or services that are listed in the registration.

The federal registration symbol may not be used with marks that are not actually registered in the United States Patent and Trademark Office. Even if an application is pending, the registration symbol may not be used until the mark is registered.

Registration in a state of the United States does not entitle a person to use the federal registration notice. *Du-Dad Lure Co. v. Creme Lure Co.*, 143 USPQ 358 (TTAB 1964).

A party may use terms such as “trademark,” “trademark applied for,” “TM” and “SM” regardless of whether a mark is registered. These are not official or statutory symbols of federal registration.

#### 906.01 Foreign Countries That Use Registration Symbol ®

Several countries in addition to the United States recognize use of the symbol ® to designate registration. When a foreign applicant’s use of the symbol on the specimens is based on a registration in a foreign country, the use is appropriate.

The following foreign countries use the ® symbol to indicate that a mark is registered in their country:

- Belgium
- China (People’s Republic)
- Costa Rica
- Denmark
- Ecuador
- Germany
- Guatemala
- Hungary
- Luxembourg

## APPLICATIONS BASED ON USE OR INTENT TO USE IN COMMERCE

- Netherlands
- Nicaragua
- Poland
- Sweden

### 906.02 Improper Use of Registration Symbol

Improper use of a federal registration symbol that is deliberate and intended to deceive or mislead the public is fraud. See TMEP §906.04. However, misunderstandings about use of federal registration symbols are more frequent than occurrences of actual fraudulent intent. Common reasons for improper use of the federal registration symbol that are not regarded as indicating fraud are:

- Mistake as to the requirements for giving notice (Confusion often occurs between notice of *trademark* registration, which may not be given until after registration, and notice of claim of *copyright*, which must be given before publication by placing the notice © on material when it is first published);
- Inadvertence in not giving instructions (or adequate instructions) to the printer, or misunderstanding or voluntary action by the printer;
- The mistaken belief that a state registration gives a right to use a registration symbol specified in the Trademark Act (see *Du-Dad Lure Co. v. Creme Lure Co.*, 143 USPQ 358 (TTAB 1964));
- Registration of a portion of the mark (see *Coca-Cola Co. v. Victor Syrup Corp.*, 218 F.2d 596, 104 USPQ 275 (C.C.P.A. 1954));
- Registration of the mark for other goods (see *Duffy-Mott Co., Inc. v. Cumberland Packing Co.*, 424 F.2d 1095, 165 USPQ 422 (C.C.P.A. 1970), *aff'g* 154 USPQ 498 (TTAB 1967); *Meditron Co. v. Meditronic, Inc.*, 137 USPQ 157 (TTAB 1963));
- A recently expired or cancelled registration of the subject mark (see *Rieser Co., Inc. v. Munsingwear, Inc.*, 128 USPQ 452 (TTAB 1961));
- Another mark to which the symbol relates on the same label (see *S.C. Johnson & Son, Inc. v. Gold Seal Co.*, 90 USPQ 373 (Comm'r Pats. 1951)).

See also *Sauquoit Paper Co., Inc. v. Weistock*, 46 F.2d 586, 8 USPQ 349 (C.C.P.A. 1931); *Dunleavy Co. v. Koepfel Metal Furniture Corp.*, 134 USPQ 450 (TTAB 1962),



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*aff'd*, 328 F.2d 939, 140 USPQ 582 (C.C.P.A. 1964); *Radiant Mfg. Corp. v. Da-Lite Screen Co.*, 128 USPQ 132 (TTAB 1961); *Tobacco By-Products & Chemical Corp. v. Smith*, 106 USPQ 293 (Comm'r Pats. 1955), *modified* 243 F.2d 188, 113 USPQ 339 (C.C.P.A. 1957).

### **906.03 Informing Applicant of Apparent Improper Use**

If a specimen in an application shows a federal registration symbol used with the mark that is the subject of the application, or with any portion of this mark, the examining attorney should determine from the Office records whether or not such matter is registered. If it is not, and if the symbol does not appear to indicate registration in a foreign country (see TMEP §906.01), the examining attorney should point out to the applicant that the records of the Office do not show that the mark with which the symbol is used on the specimens is registered and that the registration symbol may not be used until a mark is registered in the Office. The examining attorney should not require any explanation or comment from the applicant concerning the use of the symbol in relation to the mark.

### **906.04 Fraud**

Improper use of the federal registration symbol, ®, that is deliberate and intends to deceive or mislead the public or the Office is fraud. See *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); *Wells Fargo & Co. v. Lundeen & Associates*, 20 USPQ2d 1156 (TTAB 1991).

The examining attorney shall not issue a refusal of registration based on fraud. If it appears to the examining attorney that fraud on the Office has been committed, the examining attorney should follow the procedures outlined in TMEP §720.

### **907 Compliance with Other Statutes**

*37 C.F.R. §2.69. Compliance with other laws. When the sale or transportation of any product for which registration of a trademark is sought is regulated under an Act of Congress, the Patent and Trademark Office may make appropriate inquiry as to compliance with such Act for the sole purpose of determining lawfulness of the commerce recited in the application.*

Use of a mark in commerce must be lawful use to be the basis for federal registration of the mark. Under 37 C.F.R. §2.69, the Office may inquire about compliance with federal laws to confirm that the applicant's use of the mark in commerce is lawful. However, the Office does not inquire whether use in commerce is lawful unless the record shows a clear violation of law, such as the sale or transportation of a controlled substance. The Office presumes that an applicant's use of the mark in commerce is lawful.

## APPLICATIONS BASED ON USE OR INTENT TO USE IN COMMERCE

The examining attorney should inquire about compliance with federal laws or refuse registration based on the absence of lawful use in commerce when a court or the responsible federal agency has issued a finding of noncompliance under the relevant statute or where there has been a per se violation of the relevant statute. *Cf. Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045 (TTAB 1988); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80 (TTAB 1984).

For the purpose of determining whether to issue an inquiry, the Office will not regard apparent technical violations, such as labeling irregularities on specimens, as violations. For example, if a package fails to show all required labeling information, the examining attorney should not take any action. Likewise, the Office does not routinely solicit information regarding label approval under the Federal Alcohol Administration Act or similar acts.

See TMEP §1205 regarding refusal of registration of matter that is protected by a statute or convention.

# Chapter 1000

## Applications Under Section 44

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### **1001 Section 44 Applications - General**

### **1002 Eligible Applicants Under §44**

- 1002.01 Eligible Applicants Under §44(e)
- 1002.02 Eligible Applicants Under §44(d)
- 1002.03 Establishing Entitlement Under a Treaty
- 1002.04 Establishing Country of Origin
- 1002.05 United States Applicants

### **1003 Section 44(d) - Priority Filing Date Based on a Foreign Application**

- 1003.01 The “First-Filed” Requirement
- 1003.02 Priority Claim Must Be Filed Within Six Months of Foreign Filing
- 1003.03 Basis for Registration Required
- 1003.04 Suspension Awaiting a Foreign Registration
- 1003.05 Section 44(d) and Priority for Publication
- 1003.06 Applicants May File Under Both §44(d) and §44(e)
- 1003.07 Application May be Based on More Than One Foreign Application
- 1003.08 Abandonment of the Foreign Application

### **1004 Applications Based on Foreign Registrations under §44(e)**

- 1004.01 Copy of Foreign Registration Required
  - 1004.01(a) Status of the Foreign Registration
  - 1004.01(b) Translation of the Foreign Registration
- 1004.02 Application May be Based on More Than One Foreign Registration

### **1005 Ownership of the Foreign Application or Registration**

### **1006 Assignment of §44 Applications**

### **1007 Standards for Registration Under Section 44**

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1008 Bona Fide Intention to Use the Mark in Commerce**

### **1009 Allegation of Use and Specimen of Use Not Required Prior to Registration**

### **1010 Proof of Acquired Distinctiveness in §44 Applications**

### **1011 Drawings**

1011.01 Substantially Exact Representation of Mark in Foreign Registration

1011.02 One Mark Per Application

1011.03 Amendment of Drawing

### **1012 Identification of Goods and Services**

### **1013 Designation of Domestic Representative by Applicants Not Domiciled in the United States**

### **1014 Section 44 Applications for the Supplemental Register**

### **1015 Section 44 Registration Independent of Underlying Foreign Registration**

### **1016 International Registration As Basis for §44 Application**

## **1001 Section 44 Applications - General**

The United States has assumed certain obligations from agreements adopted at the Paris Convention for the Protection of Industrial Property of 1883 and subsequent revisions to these agreements. The United States is also a member of the Inter-American Convention for Trademarks and Commercial Protection (also known as the “Pan-American Convention”), the Buenos Aires Convention for the Protection of Trade Marks and Commercial Names, the World Trade Organization, and certain other treaties and agreements. See TMEP 1002.03 and Appendix B of this Manual for additional information about treaties and international agreements.

Section 44 of the Trademark Act, 15 U.S.C. §1126, implements these agreements. Section 44 applications fall into two basic categories: (1) United States applications relying on foreign applications to secure a priority filing date in the United States under §44(d); and (2) United States applications relying on ownership of foreign registrations as a basis for registration in the United States under §44(e). See TMEP §§1003 *et seq.* regarding §44(d), and TMEP §§1004 *et seq.* regarding §44(e).

Section 44(d) of the Act provides only a basis for receipt of a priority filing date, *not* a basis for publication or registration. See TMEP §1003.03.

## APPLICATIONS UNDER SECTION 44

An applicant may file an application based solely on §44, or may claim §44 in addition to §1(a) or §1(b) as a filing basis. An applicant who claims more than one basis must comply with all application requirements applicable to each basis asserted. 37 C.F.R. §2.34. See TMEP §§806.02 *et seq.* regarding multi-basis applications.

In an application based solely on §44, the applicant must submit a verified statement that the applicant has a bona fide intention to use the mark in commerce, but use in commerce is not required prior to registration. TMEP §1009.

In limited circumstances, applicants domiciled in the United States may be entitled to file under §44, if they meet the requirements of the Act. See TMEP §1002.05.

See TMEP Chapter 1900 regarding international registration under the Madrid Protocol.

### **1002 Eligible Applicants Under §44**

#### **1002.01 Eligible Applicants Under §44(e)**

To be eligible for registration under §44(e), an applicant must meet the following requirements:

- (1) The applicant's country of origin must either be a party to a treaty or agreement with the United States that provides for registration based on ownership of a foreign registration, or extends reciprocal registration rights to nationals of the United States (15 U.S.C. §1126(b)); and
- (2) The applicant must be the owner of a valid registration *in the applicant's country of origin* (15 U.S.C. §1126(c) and (e)).

See TMEP §1002.04 regarding the applicant's country of origin, and TMEP §1002.03 and Appendix B for information about how to determine whether a particular country is a party to a treaty or agreement, or provides reciprocal registration rights to United States nationals.

If an applicant does not meet the above requirements, the examining attorney must refuse registration under §44(e). The applicant may amend the application to claim §1(a) or §1(b) as a basis. See TMEP §§806.03 *et seq.* regarding amendment of the basis.

An applicant domiciled in the United States cannot obtain registration under §44(e) unless the applicant is the owner of a registration from an eligible country other than the United States *and* the applicant can establish that the foreign country is the applicant's country of origin. See TMEP §1002.05.

See TMEP §§1004 *et seq.* for additional information about the requirements for registration under §44(e).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1002.02 Eligible Applicants Under §44(d)

To be eligible for a priority filing date under §44(d), an applicant must meet the following requirements:

- (1) The applicant's country of origin must be a party to an international treaty or agreement with the United States that provides a right of priority, or must extend reciprocal rights to priority to United States nationals; and
- (2) The foreign application that is the basis for the priority claim must be filed in a country that is a party to a treaty or agreement with the United States that provides a right of priority, or must extend reciprocal rights to priority to United States nationals.

15 U.S.C. §§1126(b) and (d).

See TMEP §1002.04 regarding the applicant's country of origin, and TMEP §1002.03 and Appendix B for information about how to determine whether a particular country is a party to an international treaty or agreement that provides a right of priority to United States nationals.

If an applicant does not meet these requirements, the examining attorney must refuse registration under §44 and advise the applicant that it is not entitled to priority. The applicant may amend the application to claim another basis. See TMEP §§806.03 *et seq.* regarding amendment of the basis. The examining attorney should ensure that the priority claim is deleted from the TRAM database, and conduct a new search of Office records for conflicting marks.

To obtain a priority filing date under §44(d), the foreign application does *not* have to be filed in the applicant's country of origin. However, to obtain registration under §44(e) based on the foreign registration that will issue from the application on which the applicant relies for priority, the applicant must establish that the country in which the application was filed is its country of origin. TMEP §1002.01. Therefore, if the applicant files under §44(d) and identifies an application from a treaty country other than the country in which the applicant is domiciled, the examining attorney should advise the applicant that if the applicant intends to rely on the registration issuing from the identified foreign application as its basis for registration, the applicant must establish that the country where the foreign application was filed is its country of origin.

It is important to keep in mind that while §44(d) provides a basis for filing and a priority filing date, it does not provide a basis for publication or registration. A party who files under §44(d) must establish a basis for registration. 37 C.F.R. §2.34(a)(4)(iii); TMEP §1003.03. For example, a French corporation may rely on a first-filed application in Canada for its priority claim under §44(d), regardless of whether Canada is the applicant's country of origin. However, before the mark can be published for opposition in the United States the French corporation must do one of the following: (1) establish Canada as its country of origin and rely on the

## APPLICATIONS UNDER SECTION 44

prospective Canadian registration as its basis for registration in the United States (see TMEP §§1002.01 and 1002.04); (2) assert use in commerce under §1(a) and/or a bona fide intention to use in commerce under §1(b) as its basis for publication in the United States; or (3) rely on a registration in France as its basis for registration in the United States.

An applicant domiciled in the United States may claim priority under §44(d) based on ownership of an application *in a treaty country other than the United States*. See TMEP §1002.05.

See TMEP §§1003 *et seq.* for additional information about the requirements for obtaining a priority filing date under §44.

### 1002.03 Establishing Entitlement Under a Treaty

In a §44 application, the examining attorney must confirm that (1) both the applicant's country of origin and the country where the applicant has filed the application or obtained registration are parties to a treaty or agreement with the United States (or that they extend reciprocal rights to United States nationals by law), *and* (2) the specific benefit that the applicant is claiming under §44 (*i.e.*, the right to a priority filing date under §44(d) and/or the right to registration under §44(e)) is provided for under the treaty or agreement. See TMEP §§1002.01 and TMEP §1002.02.

To determine whether a particular country has a treaty with the United States that provides for the benefit that the applicant is claiming under §44, examining attorneys should consult Appendix B of this manual. Appendix B lists the members of the Paris Convention, Inter-American Convention, Buenos Aires Convention, World Trade Organization, European Community and certain countries entitled to reciprocal treatment under other international agreements, as well as websites where examining attorneys can obtain updated information about these treaties or agreements.

If a qualified applicant filed an application or obtained a registration in a country that is a member of the Paris Convention, Inter-American Convention, World Trade Organization or European Community, the applicant can claim the benefits of *either* §44(d) or §44(e), if the applicant meets the requirements of those sections. A qualified applicant may also file under either §44(e) or §44(d) based on an application filed or registration obtained in Taiwan. On the other hand, if the applicant filed an application or obtained a registration in a country that is a member of the Buenos Aires Convention, the applicant may seek registration under §44(e), but may *not* obtain a priority filing date under §44(d). See Appendix B for additional information.

In the case of agreements not covered in Appendix B, an applicant can establish its eligibility for the benefits of §44 by providing evidence of statutes or agreements establishing reciprocity between the United States and the relevant country.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Examining attorneys may also consult sources such as *Trademarks Throughout the World* and *World Trademark Law and Practice*, available to Office employees in the Trademark Law Library, for information about the trademarks laws of foreign countries.

See TMEP §1002.01 for information about how the examining attorney should handle an application in which the applicant is not entitled to registration under §44(e), and TMEP §1002.02 for information about how the examining attorney should handle an application in which the applicant is not entitled to priority under §44(d).

### **1002.04            Establishing Country of Origin**

To obtain registration under §44(e), the applicant must be the owner of a valid registration from the applicant's country of origin. TMEP §1002.01. To obtain a priority filing date under §44(d), the applicant's country of origin must be a treaty country, but the foreign application that is the basis for the priority claim does not have to be filed in the applicant's country of origin. TMEP §1002.02.

Section §44(c) of the Trademark Act defines the applicant's country of origin as "the country in which he has a bona fide and effective industrial or commercial establishment, or if he has not such an establishment, the country in which he is domiciled, or if he has not a domicile in any of the countries described in paragraph (b) of this section, the country of which he is a national." Under this definition, an applicant can have more than one country of origin.

If a §44 applicant is domiciled or incorporated in the relevant country, the examining attorney should presume that the country is the applicant's country of origin, and should not issue any inquiry about the applicant's country of origin.

If a §44(e) applicant is not domiciled or incorporated in the relevant country (or if a §44(d) applicant is not domiciled or incorporated in a treaty country), the examining attorney should require the applicant to establish that the country is its country of origin. Normally, a statement by the applicant or the applicant's attorney that the applicant has a bona fide and effective industrial or commercial establishment in the relevant country will be sufficient to establish that the country is the applicant's country of origin. This statement does not have to be verified. However, if there is any evidence in the record that contradicts the applicant's assertion that it has a bona fide and effective industrial or commercial establishment in the relevant country, the examining attorney has the discretion to require the applicant to set forth the specific circumstances that establish that the applicant maintains a bona fide and effective industrial or commercial establishment in the country. Relevant factors include the presence of production facilities, business offices and personnel. The presence of an applicant's wholly-owned subsidiary in a country does not, by itself, establish country of origin. *In re Aktiebolaget Electrolux*, 182 USPQ 255 (TTAB 1974). See also *Ex parte Blum*, 138 USPQ 316 (Comm'r Pats. 1963).



## APPLICATIONS UNDER SECTION 44

The United States, by definition, is not a country that has a treaty with the United States. Therefore, the term “country of origin” in §§44(b) and (c) means some country other than the United States. *In re Fisons Ltd.*, 197 USPQ 888 (TTAB 1978). See TMEP §1002.05.

See TMEP §1002.01 for information about how the examining attorney should handle an application in which the applicant is not entitled to registration under §44(e), and TMEP §1002.02 for information about how the examining attorney should handle an application in which the applicant is not entitled to priority under §44(d).

### 1002.05 United States Applicants

Section 44(b) of the Trademark Act provides that, “Any person whose country of origin is a party to any convention or treaty relating to trademarks, trade or commercial names, or the repression of unfair competition to which the United States is also a party, or extends reciprocal rights to nationals of the United States by law, shall be entitled to the benefits of this section....”

Section 44(i) of the Act provides that “[c]itizens or residents of the United States shall have the same benefits as are granted by this section to persons granted by this section to persons described in subsection [44(b)].” However, §44(i) does not provide an independent basis for a United States applicant to register a mark under §44(e). *In re Pony International Inc.*, 1 USPQ2d 1076 (Comm’r Pats. 1986).

The United States, by definition, is not a country that has a treaty with the United States. Therefore, the term “country of origin” in §44(b) means some country other than the United States, and the term “person” in §44(b) means a person who can claim a country of origin other than the United States. *In re Fisons Ltd.*, 197 USPQ 888 (TTAB 1978).

An applicant domiciled in the United States may claim priority under §44(d) based on ownership of an application in a treaty country *other than the United States*, even if the other country is not the applicant’s country of origin. See *In re ETA Systems Inc.*, 2 USPQ2d 1367 (TTAB 1987), *dec. withdrawn on other grounds* (TTAB, November 28, 1988); *In re International Barrier Corp.*, 231 USPQ 310 (TTAB 1986). See TMEP §1002.02.

However, an applicant domiciled in the United States may not obtain registration under §44(e) unless the applicant is the owner of a registration from an eligible country other than the United States *and* the applicant can establish that the foreign country is the applicant’s country of origin. *In re International Barrier Corp.*, *supra*; *In re Fisons*, *supra*. See TMEP §1002.01.

For example, a Texas corporation may assert a priority claim under §44(d) based on ownership of an application in Mexico, regardless of whether Mexico is its country of origin. However, this applicant must also assert a valid basis for registration (see

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

TMEP §1003.03). The applicant may do so by asserting use in commerce under §1(a) and/or a bona fide intention to use in commerce under §1(b) as its basis for publication. The applicant cannot obtain registration in the United States under §44(e) unless the applicant establishes that Mexico is one of its countries of origin.

See TMEP §1002.04 regarding the applicant's country of origin, and TMEP §1002.03 and Appendix B for information about how to determine whether a particular country is a party to an international treaty or agreement that provides for priority and/or registration based on ownership of a foreign registration.

See *also* TMEP §1002.01 for information about how the examining attorney should handle an application in which the applicant is not entitled to registration under §44(e), and TMEP §1002.02 for information about how the examining attorney should handle an application in which the applicant is not entitled to priority under §44(d).

### **1003                      Section 44(d) - Priority Filing Date Based on a Foreign Application**

Section 44(d) of the Trademark Act, 15 U.S.C. §1126(d), grants a priority filing date to qualified applicants (see TMEP §1002.02) who have filed an application in a treaty country as defined by §44(b) (see TMEP §1002.03). If a qualified applicant files the United States application claiming §44(d) priority within six months of filing the first application to register the mark in a treaty country, the United States application will receive an effective filing date as of the filing date of the foreign application.

The requirements for receipt of a priority filing date under §44(d) are:

- (1) The applicant must file a claim of priority within six months of the filing date of the first-filed foreign application. 15 U.S.C. §1126(d)(1); 37 C.F.R. §§2.34(a)(4)(i) and 2.35(b)(5); TMEP §§1003.01 and 1003.02.
- (2) The applicant must: (a) specify the filing date and country of the first regularly filed foreign application; or (b) state that the application is based upon a subsequent regularly filed application in the same foreign country, and that any prior-filed application has been withdrawn, abandoned or otherwise disposed of, without having been laid open to public inspection and without having any rights outstanding, and has not served as a basis for claiming a right of priority. 15 U.S.C. §1126(d); 37 C.F.R. §§2.34(a)(4)(i)(A) and (B).
- (3) The applicant must verify that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. 15 U.S.C. §1126(d)(2). If the verified statement is not filed with the initial application, the verified statement must allege that the applicant has had a bona fide intention to use the mark in commerce since the filing date of the application. 37 C.F.R. §2.34(a)(4)(ii).

## APPLICATIONS UNDER SECTION 44

- (4) Both the applicant's country of origin and the country where the foreign application is filed must be a party to an international treaty or agreement with the United States that provides a right of priority, or must extend reciprocal rights to priority to United States nationals. 15 U.S.C. §1126(b) and (d); TMEP §§1002.02, 1002.03 and 1002.04.
- (5) The scope of the goods covered by the §44(d) basis cannot exceed the scope of the goods or services in the foreign application. 37 C.F.R. §2.32(a)(6); TMEP §1402.01(b).
- (6) The applicant must specify the serial number of the foreign application. 37 C.F.R. §2.34(a)(4)(i)(A); Paris Convention Article 4(D)(5).

If the applicant is not domiciled in the United States, the applicant may designate a domestic representative, *i.e.*, a person residing in the United States on whom may be served notices or process in proceedings affecting the mark. 15 U.S.C. §1051(e); TMEP §604. This can be done through the Trademark Electronic Application System ("TEAS"), at <http://www.uspto.gov/teas/index.html>.

The priority filing date also constitutes a constructive date of first use in the United States under 15 U.S.C. §1057(c) (see TMEP §201.02), if the application matures into a registration. See *SCM Corp. v. Langis Foods Ltd.*, 539 F.2d 196, 190 USPQ 288 (D.C. Cir. 1976).

Section 44(d) of the Act provides only a basis for receipt of a priority filing date, *not* a basis for publication or registration. See TMEP §1003.03.

In a §44(d) application, both the actual date the application was received in the Office and the priority date will appear in the TRAM database.

### **1003.01            The "First-Filed" Requirement**

The application relied on under §44(d) must be the applicant's first application in a treaty country for the same mark and for the same goods or services. If the foreign country denominates an application in the foreign country as "An Application to Extend the Wares" or in some similar fashion, but the application is, in substance, the equivalent of a new application in the United States, the foreign application will be considered the first-filed for the purpose of meeting the requirements of §44(d) in the United States. However, the goods or services must be different from those covered by any previous application for the mark in a treaty country.

The §44(d) priority claim may be based upon a subsequently-filed application in the same foreign country, if the first-filed application was withdrawn, abandoned or otherwise disposed of without having any rights outstanding, and did not serve as a basis for claiming a right of priority.

The Office will presume that the application identified as the basis for the priority claim was the first-filed, unless there is contradictory evidence in the record.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If the examining attorney determines that the application relied on was not the first-filed, the examining attorney must refuse registration under §44 and advise the applicant that it is not entitled to priority. The applicant may amend the application to claim another basis. See TMEP §§806.03 *et seq.* regarding amendment of the basis. The examining attorney should ensure that the priority claim is deleted from the TRAM database, and should conduct a new search of Office records for conflicting marks.

### **1003.02            Priority Claim Must Be Filed Within Six Months of Foreign Filing**

An applicant must file a claim of priority within six months after the filing date of the foreign application. 15 U.S.C. §1126(d)(1); 37 C.F.R. §§2.34(a)(4)(i) and 2.35(b)(5). The applicant can submit the priority claim after the filing date of the United States application, as long as it is within six months of the foreign filing.

*Example:* If an eligible applicant files in France on December 6, 2004, and in the United States on January 12, 2005, the applicant can add a priority claim to the United States application on or before June 6, 2005, if the applicant meets the requirements of §44(d). The applicant cannot add a priority claim to the United States application after June 6, 2005.

If an applicant claims priority under §44(d), but does not specify the filing date of the foreign application, the examining attorney must require that the applicant specify the date of the foreign filing.

If the applicant submits a claim of priority more than six months after the date of the foreign filing, the examining attorney must refuse registration under §44 and advise the applicant that it is not entitled to priority. 15 U.S.C. §1126(d); 37 C.F.R. §§2.34(a)(4)(i) and 2.35(b)(5). The applicant may amend the application to claim another basis. See TMEP §§806.03 *et seq.* regarding amendment of the basis. The examining attorney should ensure that the priority claim is deleted from the TRAM database, and should conduct a new search of Office records for conflicting marks.

If the priority period ends on a Saturday, Sunday or Federal holiday within the District of Columbia, the priority claim may be filed on the following day that is not a Saturday, Sunday or a Federal holiday within the District of Columbia. Paris Convention Article 4(C)(3); 35 U.S.C. §21(b); 37 C.F.R. §2.196.

### **1003.03            Basis for Registration Required**

Section 44(d) of the Act provides a basis for receipt of a priority filing date, but not a basis for publication or registration. Before the application can be approved for publication, or for registration on the Supplemental Register, the applicant must establish a basis under §1(a), §1(b), or §44(e) of the Act. 37 C.F.R. §2.34(a)(4)(iii). If the applicant claims a §1(b) basis, the applicant must file an allegation of use (*i.e.*,

## APPLICATIONS UNDER SECTION 44

either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d)) before the mark can be registered. See TMEP §806.01(b) regarding the requirements for a §1(b) basis.

The Office will generally presume that the applicant is asserting §44(e) as a basis for registration (based on the foreign registration that will issue from the application that the applicant relied on for priority) in an application that includes a proper claim of priority under §44(d). Unless the applicant specifically indicates that it is claiming more than one basis, the Office will presume that §44(e) is the only basis being asserted. See TMEP §1002.02 regarding applications that are entitled to a priority filing date under §44(d), but are not entitled to registration under §44(e), because the foreign application was filed in a treaty country that is not the applicant's country of origin.

See TMEP §§1004 *et seq.* regarding the requirements for registration under §44(e).

A §44(d) applicant may not assert a basis under §66(a) of the Trademark Act, based on an extension of protection of an international registration to the United States. 37 C.F.R. §§2.34(b)(3) and 2.35(a).

### **1003.04            Suspension Awaiting a Foreign Registration**

#### ***Suspension Required When Application in Condition for Approval or Final Refusal***

In a §44(d) application, if a copy of the foreign registration has not been submitted at the time of filing in the United States, the examining attorney will require submission of a copy of the foreign registration before approving the United States application for publication, or for registration on the Supplemental Register.

If, on initial examination of the application, there are no other issues or requirements outstanding, the examining attorney will suspend action on the application pending receipt of a copy of the foreign registration.

If the examining attorney must issue any refusals or requirements, the examining attorney will take appropriate action to place the application in condition for either approval or for final action on all other issues, and will then suspend further action pending receipt of a copy of the foreign registration. In the notice of suspension, the examining attorney should reference any continued refusals or requirements. See TMEP §716.01.

#### ***Inquiry Required Before Suspension of Multi-Basis Applications***

If an applicant claiming priority under §44(d) asserts more than one basis for registration, before suspending the application, the examining attorney must inquire whether the applicant wishes to retain §44(e) as a second basis for registration

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

(based on the foreign registration that will issue from the application on which the applicant relied for priority) before suspending the application. This inquiry should be made in the first Office action, or by telephone if no Office action is issued. If the examining attorney is unable to reach the applicant by telephone, the examining attorney should issue an Office action requiring a copy of the foreign registration, advising applicant that it may retain the priority filing date even if it does not perfect the §44(e) basis, and inquiring as to whether the applicant wishes to retain §44(e) as a second basis for registration. The applicant may elect not to perfect a §44(e) basis and still retain the priority filing date. 37 C.F.R. §§2.35(b)(3) and (4); TMEP §806.04(b).

### ***Periodic Inquiries Issued as to Status of Foreign Application***

Examining attorneys issue inquiries as to the status of the foreign application in applications that have been suspended for more than six months. See TMEP §716.05. If the applicant does not respond to this inquiry within six months of the mailing date, the application will be abandoned.

If the applicant is still unable to furnish a copy of the foreign registration at the time of the inquiry, the applicant should advise the examining attorney of this fact. This may be done by telephone. The examining attorney will issue a new notice of suspension.

### **1003.05 Section 44(d) and Priority for Publication**

To determine priority for publication under 37 C.F.R. §2.83, an application filed in the United States under §44(d) will be treated as if it were filed in the United States on the same date as the filing in the foreign country. The §44(d) application will receive priority over any application filed after the §44(d) applicant's priority filing date that might otherwise be a possible bar to registration under §2(d) of the Trademark Act due to a likelihood of confusion. See TMEP §§1208 *et seq.* regarding conflicting marks in pending applications.

In some cases, another United States application filed after the §44(d) applicant's priority date may proceed to publication or registration because the §44(d) applicant had not yet filed in the United States when the examining attorney searched the Office records for conflicting marks. If the Office learns that a §44(d) application is entitled to priority over another pending application before the other mark registers, the Office will take appropriate action to give the §44(d) application the priority to which it is entitled.

If an examining attorney discovers a conflicting application entitled to priority under §44(d) after taking action in a case, the examining attorney should issue a supplemental action correcting the situation. If the mark has been published, the examining attorney must request jurisdiction before issuing the action, unless a

## APPLICATIONS UNDER SECTION 44

notice of allowance has issued. See TMEP §§1504.01 and 1504.04(a) regarding the examining attorney's jurisdiction.

However, if the conflicting mark has already registered, the Office does not have the authority to cancel the registration *sua sponte*. The §44(d) applicant must take action to enforce its priority rights, *e.g.*, by filing a petition to cancel the registration with the Trademark Trial and Appeal Board.

### **1003.06 Applicants May File Under Both §44(d) and §44(e)**

In some cases, a §44 applicant may have already received, before filing in the United States Patent and Trademark Office, a foreign registration as a result of the same foreign application upon which the applicant relies for a §44(d) priority claim. This may occur in countries that do not examine applications prior to registration. In this situation, the applicant may file under both §44(d) and §44(e).

An applicant may also claim priority under §44(d) based upon a foreign application, and proceed to registration under §44(e) based upon a different foreign registration.

### **1003.07 Application May be Based on More Than One Foreign Application**

An applicant may file an application in the United States based on more than one foreign application for different goods or services, or for different classes, if the applicant meets the requirements of §44(d) with respect to each foreign application on which the United States application is based. The applicant must specify which goods or services, or which classes, are covered by which foreign application.

### **1003.08 Abandonment of the Foreign Application**

If the foreign application relied on under §44(d) is abandoned during the prosecution of the United States application, the applicant may amend the application to rely on another basis. See TMEP §§806.03 *et seq.* If the applicant met the requirements of §44(d) on the filing date of the United States application, the applicant will retain the priority filing date even if the foreign application is abandoned. 37 C.F.R. §2.35(b)(4).

In this situation, the Office will presume that the applicant had a continuing valid basis because the applicant had at least a bona fide intention to use the mark in commerce as of the application filing date, unless there is contradictory evidence in the record. See 37 C.F.R. §2.35(b)(3) and TMEP §806.03(h).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1004 Applications Based on Foreign Registrations under §44(e)

If a qualified applicant (see TMEP §1002.01) owns a valid registration from the applicant's country of origin, the applicant may base its United States application on that foreign registration under §44(e).

A §44(e) application must meet the following requirements:

- (1) The applicant must be the owner of a valid registration in the applicant's country of origin. 15 U.S.C. §§1126(c) and (e). See TMEP §§1002.01 and 1002.04 regarding country of origin.
- (2) The applicant's country of origin must be a party to a treaty or agreement with the United States that provides for registration based on ownership of a foreign registration, or extends reciprocal registration rights to nationals of the United States. 15 U.S.C. §1126(b). See TMEP §§1002.03, 1002.04 and 1002.05.
- (3) The applicant must submit a true copy, a photocopy, a certification, or a certified copy of the registration in the applicant's country of origin. 15 U.S.C. §1126(e); 37 C.F.R. §2.34(a)(3)(ii); TMEP §1004.01.
- (4) The applicant must verify that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. 15 U.S.C. §1126(e). If the verified statement is not filed with the initial application, the verified statement must allege that the applicant has had a bona fide intention to use the mark in commerce since the application filing date. 37 C.F.R. §2.34(a)(3)(i).
- (5) The scope of the goods covered by the §44(e) basis cannot exceed the scope of the goods or services in the foreign registration. 37 C.F.R. §2.32(a)(6); TMEP §1402.01(b).

If the applicant is not domiciled in the United States, the applicant is encouraged to designate a domestic representative, *i.e.*, a person residing in the United States on whom may be served notices or process in proceedings affecting the mark. 15 U.S.C. §1051(e); TMEP §604. This can be done through TEAS, at This can be done through TEAS, at <http://www.uspto.gov/teas/index.html>.

Applicant may not file an application under §44(e) before the registration in the applicant's country of origin has issued. An applicant can file under §44(d) within six months after the filing date of an application in the applicant's country of origin (see TMEP §§1003 *et seq.*). However, once this six-month priority period has passed, an applicant cannot file an application in the United States based on the pending application.



## APPLICATIONS UNDER SECTION 44

### 1004.01 Copy of Foreign Registration Required

Section 44(e) of the Trademark Act, 15 U.S.C. §1126(e), requires “a true copy, a photocopy, a certification, or a certified copy of the registration in the country of origin of the applicant.” If a copy of the foreign registration is not included with the application as filed, the examining attorney will require submission of a copy of the foreign registration in the first Office action. The copy must show the name of the owner, the mark, and the goods or services for which the mark is registered.

If an applicant files more than one application in the United States based on the same foreign registration, the applicant must file a copy of the foreign registration for each of the United States applications.

In a §44(e) application, the examining attorney will not suspend the application pending submission of a copy of the foreign registration, unless the applicant establishes that it cannot obtain a copy of the foreign registration due to extraordinary circumstances (e.g., war or natural disaster). However, the examining attorney may suspend the application pending receipt of proof of renewal of the foreign registration (see TMEP §1004.01(a)).

#### 1004.01(a) Status of the Foreign Registration

The foreign registration must be in force at the time the United States issues the registration based on that foreign registration. *In re Societe D'Exploitation de la Marque Le Fouquet's*, 67 USPQ2d 1784 (TTAB 2003); *Marie Claire Album S.A. v. Kruger GmbH & Co. KG*, 29 USPQ2d 1792 (TTAB 1993); *Fioravanti v. Fioravanti Corrado S.R.L.*, 230 USPQ 36 (TTAB 1986), *recon denied* 1 USPQ2d 1304 (TTAB 1986). Appendix B of this manual lists the terms of registration in various foreign countries.

If the record indicates that the foreign registration will expire before the United States registration will issue, the examining attorney must require that an applicant submit a copy of the foreign registration that shows that the foreign registration has been renewed and will be in force at the time the registration issues in the United States. 37 C.F.R. §2.34(a)(3)(iii). If the applicant states that renewal is pending in the foreign country, the examining attorney should suspend the application pending receipt of proof of renewal.

If an applicant submits a certified copy or certification of the foreign registration that is certified by the foreign government agency that issued the foreign registration, the examining attorney should inquire concerning renewal only if the certified copy of the foreign registration indicates that the registration will expire *after* the date on which the foreign government agency issued the certified copy or certification of the foreign registration. For example, if a certified copy of a foreign registration was issued by the trademark agency in the foreign country on January 5, 2005, and the certified copy indicates that the registration expired on June 1, 2004, no inquiry is necessary. The Office presumes that the foreign country would not have issued a certified copy

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

of the registration unless the registration had been renewed. This applies *only* to a certified copy or certification issued *by the foreign trademark agency*. If the copy of the registration is not certified by the foreign trademark agency, and the record indicates that the foreign registration will expire before the United States registration will issue, the examining attorney must require that the applicant submit a copy of the foreign registration showing that the registration has been renewed.

If the examining attorney determines that the foreign registration is not in force, the examining attorney will refuse registration under §44(e). The applicant may amend the application to claim another basis. See TMEP §§806.03 *et seq.* regarding amendments to the basis.

For information about recent changes in the term of registration in a foreign country, examining attorneys may consult sources such as *Trademarks Throughout the World* (J. M. Politi) and *World Trademark Law and Practice* (Ethan Horwitz), available to Office employees in the Trademark Law Library.

### **1004.01(b) Translation of the Foreign Registration**

If the foreign registration is not in English, the applicant must provide a translation. 37 C.F.R. §2.34(a)(3)(ii). The translator should sign the translation, but does not have to swear to the translation.

### **1004.02 Application May be Based on More Than One Foreign Registration**

An application may be based on more than one foreign registration. The applicant must meet all requirements of the Act and rules for each foreign registration upon which the application is based, and must specify which goods/services are covered by which foreign registration.

If a §44 applicant amends an application to rely on a different foreign registration, this is considered a change in basis. See TMEP §§806.03 *et seq.* regarding amendments to add or substitute a basis.

### **1005 Ownership of the Foreign Application or Registration**

#### ***Section 44 Claimed in Original Application***

If an applicant claims §44 as a filing basis in the original application, or if the applicant omits the basis from the original application and subsequently amends the application to claim §44 as the sole basis, the applicant must be the owner of the foreign application or registration on the filing date of the United States application. See *In re De Luxe, N.V.*, 990 F.2d 607, 26 USPQ2d 1475 (Fed. Cir. 1993); *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689 (TTAB 1991). If the foreign application or registration identifies a party other than the §44 applicant as the owner, the

## APPLICATIONS UNDER SECTION 44

examining attorney must require the applicant to establish that the applicant was the owner of the foreign application or registration on the date of filing in the United States.

Proof of ownership may consist of a copy of an assignment document recorded in the foreign country, or a statement from the agency administering the trademark register in the foreign country establishing that the applicant was the owner of the foreign application or registration as of the United States application filing date. Other forms of proof may also be acceptable. If the transfer of ownership took place before the United States application filing date, the §44 basis will be considered valid even if the change in ownership was not yet recorded in the foreign country on the United States application filing date.

If the applicant was not the owner of the foreign application or registration on the United States application filing date, the examining attorney must refuse registration under §44. The applicant may amend the application to claim §1(a) or §1(b) as a basis. See TMEP §§806.03 *et seq.* regarding amendment of the basis.

If a §44(d) applicant was not the owner of the foreign application on the United States application filing date, the examining attorney should advise the applicant that it is not entitled to priority, ensure that the priority claim is deleted from the TRAM database, and conduct a new search of Office records for conflicting marks. TMEP §1002.02.

### ***Section 44 Added to or Substituted for Valid Section 1 Basis***

If an application is properly filed based on §1(a) or §1(b), and the applicant later amends the application to add or substitute §44 as a basis, the applicant must be the owner of the foreign application or registration as of the filing date of the amendment adding or substituting §44 as a basis for registration. See TMEP §§806.03 *et seq.* regarding amendments to change the basis.

If the applicant owned the foreign application or registration on the filing date of the amendment, but did not own the foreign application or registration on the filing date of the United States application, the applicant will retain the original filing date in the United States, as long as there was a continuing valid basis since the application filing date. 37 C.F.R. §2.35(b)(3); TMEP §806.03(h).

If the foreign application or registration identifies a party other than the §44 applicant as the owner, the examining attorney will require the applicant to establish that applicant was the owner of the foreign application or registration on the filing date of the amendment adding or substituting §44 as a basis. If the applicant was not the owner of the foreign application or registration on the filing date of the amendment, the examining attorney must refuse registration under §44.

See TMEP §1006 regarding assignment of §44 applications.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1006 Assignment of §44 Applications

A §44 applicant may assign the foreign application or registration and/or the United States application from the original applicant to another party.

#### ***Assignee Must Be Eligible for the Benefits of §44***

In order to continue to claim the benefits of §44 after such an assignment, the assignee of the United States application must be eligible for the benefits of §44. *Nestle Co., Inc. v. Grenadier Chocolate Co., Ltd.*, 212 USPQ 214 (TTAB 1981); *In re Fisons Ltd.*, 197 USPQ 888 (TTAB 1978). See TMEP §1002.01 regarding applicants eligible for registration under §44(e), and TMEP §1002.02 regarding applicants eligible for a priority filing date under §44(d).

To be eligible for registration under §44(e), the assignee must establish that the country that issued the relevant registration is the assignee's country of origin. TMEP §§1002.01 and 1002.04. See *also* TMEP §1004 regarding the requirements for registration under §44(e).

To be eligible for a priority filing date under §44(d), the assignee must establish that the assignee's country of origin is a party to an international treaty or agreement with the United States that provides a right of priority, or extends reciprocal rights of priority to United States nationals. See TMEP §§1002.02, 1002.03 and 1002.04. See *also* TMEP §1003.

In any §44 application, if the assignee is not entitled to registration under §44(e), the examining attorney must refuse registration under that basis. The applicant may amend the application to claim §1(a) or §1(b) as a basis. See TMEP §§806.03 *et seq.* regarding amendment of the basis.

In a §44(d) application, if the assignee is not eligible for a priority filing date, the examining attorney should advise the assignee that it is not entitled to priority, ensure that the priority claim is deleted from the TRAM database, and conduct a new search of Office records for conflicting marks. TMEP §1002.02.

#### ***Assignee Does Not Have To Be the Owner of the Underlying Foreign Application or Registration***

The Trademark Act requires that an applicant own the underlying application or registration at the time of filing in the United States (or as of the filing date of the amendment adding or substituting §44 as a basis, for an application originally based on §1(a) or §1(b), and later amended to add or substitute §44 as a basis). TMEP §1005. However, if the applicant was the owner of the foreign application or registration on the filing date of the United States application (or amendment adding or substituting §44 as a basis), the applicant may assign the United States application to another party without assigning the underlying foreign application or

## APPLICATIONS UNDER SECTION 44

registration to that party. *In re De Luxe N.V.*, 990 F.2d 607, 26 USPQ2d 1475 (Fed. Cir. 1993). Therefore, examining attorneys should not require proof of assignment of the underlying foreign application or registration when an applicant assigns the United States application.

### ***Designation of Domestic Representative Encouraged***

If the United States application is assigned to a party who is not domiciled in the United States, the assignee may file an appointment of a domestic representative with the assignment of the United States application. 15 U.S.C. §1060(b); 37 C.F.R. §3.61. See TMEP §604. The Office encourages parties who do not reside in the United States to designate domestic representatives. This can be done through TEAS, at <http://www.uspto.gov/teas/index.html>.

### **1007 Standards for Registration Under Section 44**

Although §44 exempts qualified applicants from the use requirements of §1 of the Trademark Act, §44 applicants must meet all other requirements for registration set forth in the Trademark Act and relevant rules. Registration in a foreign country does not automatically ensure eligibility for registration in the United States. *In re Rath*, 402 F.3d 1207, 74 USPQ2d 1174, 1179 (Fed. Cir. 2005) ("[I]t is impossible to read section 44(e) to require the registration of foreign marks that fail to meet United States requirements for eligibility. Section 44 applications are subject to the section 2 bars to registration..."); *In re Mastic Inc.*, 829 F.2d 1114, 4 USPQ2d 1292 (Fed. Cir. 1987); *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); *Order Sons of Italy in America v. Marofa S.A.*, 38 USPQ2d 1602 (TTAB 1996).

The foreign registration that is the basis for the United States application may include disclaimers or may be on a secondary register, equivalent to the Supplemental Register. The United States application will be reviewed according to the standards for registrability in the United States, and the examining attorney will not require a disclaimer, amendment to the Supplemental Register or any other amendment unless it is required under United States law and Office policy.

See TMEP §1306.08 regarding the registration of certification marks under §44.

### **1008 Bona Fide Intention to Use the Mark in Commerce**

Any application filed under §44(d) or §44(e) on either the Principal or the Supplemental Register must include a verified statement that the applicant has a bona fide intention to use the mark in commerce. See TMEP §1101 for additional information about this requirement. If the verified statement is not filed with the initial application, the verified statement must allege that the applicant has had a bona fide intention to use the mark in commerce since the application filing date. 37 C.F.R. §§2.34(a)(3)(i) and 2.34(a)(4)(ii).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The allegation of the applicant's bona fide intention to use the mark in commerce is required even if use in commerce is asserted in the application. *In re Paul Wurth, S.A.*, 21 USPQ2d 1631 (Comm'r Pats. 1991). See also *In re Unisearch Ltd.*, 21 USPQ2d 1559 (Comm'r Pats. 1991) (requirement for verified statement of bona fide intent to use the mark in commerce held not contrary to Paris Convention).

### **1009 Allegation of Use and Specimen of Use Not Required Prior to Registration**

Although §44 applicants must assert a bona fide intention to use the mark in commerce, §44 applicants do not have to allege use or provide specimens or dates of use prior to registration on either the Principal or Supplemental Register in an application based solely on §44. *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909 (TTAB 1984). However, if a §44 applicant wishes to assert use in commerce under §1(a) or a bona fide intention to use the mark in commerce under §1(b) as an additional basis, then the applicant must comply with *all* applicable requirements related to the second basis asserted.

If the applicant provides specimens gratuitously in a §44 application, the examining attorney may refer to the specimens to determine issues unrelated to use, such as whether the mark is merely descriptive.

When the §44 application, as submitted, raises questions concerning the registrability of the mark, the examining attorney may request an explanation, information, literature or other materials to assist in consideration of the application. 37 C.F.R. §2.61(b); TMEP §814.

### **1010 Proof of Acquired Distinctiveness in §44 Applications**

A §44 applicant may assert that a mark has acquired distinctiveness under 15 U.S.C. §1052(f) if the applicant establishes that the mark has become distinctive of its goods or services *in commerce* in the same manner that any other applicant must. For these purposes, the applicant may not rely on use other than use in commerce that may be regulated by the United States Congress, that is, the applicant may not rely on use solely in a foreign country. See TMEP §1212.08 and cases cited therein for further information about claims of acquired distinctiveness in §44 applications.

### **1011 Drawings**

#### **1011.01 Substantially Exact Representation of Mark in Foreign Registration**

Applicants filing under §44 must comply with the drawing requirements of 37 C.F.R. §§2.51 through 2.54. The drawing of the mark must be "a substantially exact representation of the mark as it appears in the drawing in the registration certificate

## APPLICATIONS UNDER SECTION 44

of the mark duly registered in the country of origin of the applicant.” 37 C.F.R. §2.51(c); TMEP §807.12(b).

The “substantially exact representation” standard is construed narrowly. Only slight, inconsequential variations between the mark in the United States application and the mark shown in the foreign registration are permitted. *In re Hacot-Colombier*, 105 F.3d 616, 41 USPQ2d 1523, 1525 (Fed. Cir. 1997); *In re Larios S.A.*, 35 USPQ2d 1214, 1216 (TTAB 1995); *United Rum Merchants Ltd. v. Distillers Corp. (S.A.) Ltd.*, 9 USPQ2d 1481, 1484 (TTAB 1988). For example, non-material informational matter such as net weight or contents may be deleted. Beyond such limited exceptions, however, any difference between the mark on the drawing and the mark in the foreign registration requires the examining attorney to refuse registration. *In re Hacot-Colombier*, 105 F.3d at 619, 41 USPQ2d at 1525.

The standard for determining whether the mark in the drawing agrees with the mark in the foreign registration is stricter than the standard used to determine whether specimens support use of a mark in an application under §1 of the Trademark Act. In *United Rum Merchants*, the Trademark Trial and Appeal Board reasoned that a stricter standard is appropriate in §44 cases because §44 applications represent an exception to the use requirements of the Act, and that this exception should be construed narrowly to ensure that a foreign applicant cannot obtain a registration in the United States of matter that could not have been registered in the foreign country. 9 USPQ2d at 1483-84.

If the mark in the foreign registration is in special form, the mark in the United States application must appear in the same special form. Likewise, if the mark in the foreign registration is in standard characters, the mark in the United States application must also be in standard characters. If the foreign registration certificate does not indicate that the mark is in standard characters (or the equivalent), the examining attorney must inquire whether the foreign registration includes a claim that the mark is in standard characters. The applicant must either submit an affirmative statement that the foreign registration includes a claim that the mark is in standard characters (or the equivalent), or delete the standard character claim in the United States application. See TMEP §807.03(f) for further information.

The mark on the drawing in the United States application may not be a translation or transliteration of the mark in the foreign registration.

If the United States application is based on both a foreign registration and use in commerce, the mark in the drawing in the United States application may not differ in a material way from either the mark shown on the foreign registration or the mark shown on the specimen(s) of record. See TMEP §§807.12(b) and 807.14 *et seq.*

### **1011.02 One Mark Per Application**

If the foreign application or registration covers a series of distinct marks, the applicant must file separate applications in the United States to register each of the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

marks the applicant wishes to register in the United States. For example, some countries permit registration of several versions of a mark in a single application. In the United States, separate applications are required. The drawing in the United States application must show only one mark. 37 C.F.R. §2.52; TMEP §807.01.

### 1011.03 Amendment of Drawing

Section 44 applicants often try to amend the mark in the United States application to overcome an objection that the mark in the drawing does not agree with the mark in the foreign registration. Amendments to drawings in §44 applications are governed by 37 C.F.R. §2.72(c). An applicant cannot amend the drawing in the United States application to conform to the mark in the foreign registration if the amendment would result in a material alteration of the mark on the drawing submitted with the original application in the United States. *In re Hacot-Colombier*, 105 F.3d 616, 41 USPQ2d 1523 (Fed. Cir. 1997); *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989). Thus, when a §44 applicant proposes to amend its drawing, the examining attorney must consider: (1) whether the proposed amendment of the drawing would result in a material alteration of the mark on the original drawing; and (2) whether the proposed amendment is a substantially exact representation of the mark in the foreign registration. In *In re Larios S.A.*, 35 USPQ2d 1214, 1216 (TTAB 1995), the Trademark Trial and Appeal Board held that the mark “GRAN VINO MALAGA LARIOS” and design on the drawing originally filed with the United States application was not a substantially exact representation of the mark “VINO DE MALAGA LARIOS” with a similar design in the foreign registration; however, the Board found that amendment of the drawing to conform to the foreign registration was *not* a material alteration within the meaning of 37 C.F.R. §2.72. The Board noted that “[t]he material alteration test ... is not quite as rigorous as the substantially exact representation standard and thus allows for a bit more leeway or flexibility with respect to ... amendment of the drawing...” *Larios*, 35 USPQ2d at 1217. See TMEP §§807.14 *et seq.* regarding material alteration.

### 1012 Identification of Goods and Services

The identification of goods and services in a §44 application must comply with the same standards that govern other applications.

If the application is based on §44, the identification of goods and services covered by the §44 basis may not exceed the scope of the goods and services identified in the foreign registration. 37 C.F.R. §2.32(a)(6). See *Marmark Ltd. v. Nutrexpa S.A.*, 12 USPQ2d 1843 (TTAB 1989); *In re Löwenbräu München*, 175 USPQ 178 (TTAB 1972).

See TMEP §1402.01(b) for more information about the identification of goods or services in a §44 application.



## APPLICATIONS UNDER SECTION 44

### **1013                    Designation of Domestic Representative by Applicants Not Domiciled in the United States**

An applicant not domiciled in the United States may file a document designating the name and address of a person residing in the United States on whom may be served notices or process in proceedings affecting the mark. 15 U.S.C. §1051(e); 37 C.F.R. §2.24; TMEP §604. The Office encourages parties who do not reside in the United States to designate domestic representatives. This can be done through TEAS, at <http://www.uspto.gov/teas/index.html>.

### **1014                    Section 44 Applications for the Supplemental Register**

A §44 applicant may apply to register a mark on the Supplemental Register, and a §44 applicant may amend an application from the Principal Register to the Supplemental Register without filing any allegation of use. It is not necessary to change the application filing date after an amendment to the Supplemental Register in a §44 application. See TMEP §1008 regarding the requirement for an allegation of the applicant's bona fide intention to use the mark in commerce in a §44 application.

### **1015                    Section 44 Registration Independent of Underlying Foreign Registration**

Once issued, the United States registration issuing from a §44 application exists independent of the underlying foreign registration and is subject to all provisions of the Trademark Act that apply to all other registrations, such as affidavits of use, renewals, amendments under 15 U.S.C. §1057(e), assignments, and similar matters. 15 U.S.C. §1126(f). See *Imperial Tobacco Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990); *Exxon Corp. v. Oxon Italia S.p.A.*, 219 USPQ 907 (TTAB 1982); *Reynolds Televator Corp. v. Pfeffer*, 173 USPQ 437 (TTAB 1972); *Sinclair v. Deb Chemical Proprietaries Ltd.*, 137 USPQ 161 (TTAB 1963).

### **1016                    International Registration As Basis for §44 Application**

An international registration issued by the International Bureau of the World Intellectual Property Organization ("IB") can be the basis for a §44(e) application only if the international registration shows that there is an extension of protection of the international registration to applicant's country of origin. See TMEP Chapter 1900 regarding international registration. A request for an extension of protection of the international registration to applicant's country of origin is not sufficient.

An applicant should submit a copy of the registration (or certificate of extension of protection) issued by the national trademark office in the applicant's country of origin. 15 U.S.C. §1126(e); 37 C.F.R. §2.34(a)(3)(ii). If the applicant's country of origin does not issue registrations or certificates of extension of protection, the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

applicant may submit a copy of the international registration, showing that protection of the international registration has been extended to applicant's country of origin. A copy of a request for an extension of protection of the international registration to applicant's country of origin is not sufficient.

If the applicant is not domiciled or incorporated in the relevant country, the examining attorney must require the applicant to establish that the country is its country of origin. See TMEP §1002.04.

The applicant must meet all the requirements of the Trademark Act and the Trademark Rules of Practice for §44(e) applications. The requirements for §66(a) applications are not applicable.

The identification of goods/services covered by the §44(e) basis may not exceed the scope of the goods/services identified in the registered extension of protection in the applicant's country of origin. 37 C.F.R. §2.32(a)(6); TMEP §1012.

An extension of protection of an international registration cannot be the basis for a §44(d) application, because neither the international application nor the request for extension of protection is the first application filed in a treaty country for the same mark for the same goods or services. 15 U.S.C. §1126(d); 37 C.F.R. §§2.34(a)(4)(i)(A) and (B); TMEP §1003.01. The basic application or basic registration upon which the international registration is based was the first-filed application.

If an applicant wants to base a §44(e) application on the basic registration that was the basis for the international registration, the applicant must submit a copy of the basic registration issued by the Office of Origin, *i.e.*, the country or intergovernmental organization who issued the registration which provided the basis for the international registration (see TMEP §1901 regarding the Office of Origin). The applicant cannot submit the international registration, because an international registration does not provide protection in the territory of the Contracting Party whose office is the Office of Origin. Madrid Protocol Article 3<sup>bis</sup>.

# Chapter 1100 — Intent-to-Use Applications and Requests to Divide

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## **1101 Bona Fide Intention To Use the Mark In Commerce**

## **1102 Initial Examination of Intent-to-Use Applications**

1102.01 Substantive Refusals

1102.02 Drawings

1102.03 Intent-to-Use Applications and the Supplemental Register

1102.04 Claims of Acquired Distinctiveness under §2(f)

## **1103 Allegations of Use**

## **1104 Amendment to Allege Use Under §1(c) of the Act**

1104.01 Minimum Requirements for Filing an Amendment to Allege Use

1104.01(a) Review by Legal Instruments Examiner for Compliance with Minimum Filing Requirements

1104.01(b) Processing an Amendment to Allege Use That Does Not Meet Minimum Filing Requirements

1104.01(c) Processing Defective Amendment to Allege Use Filed With Other Amendments

1104.02 Form of Amendment to Allege Use

1104.03 Time for Filing Amendment to Allege Use

1104.03(a) Use on All Goods Required Before Filing

1104.03(b) The “Blackout Period”

1104.03(c) Processing Amendments to Allege Use Filed During the Blackout Period

1104.04 Processing Timely Amendments to Allege Use Located After Publication

1104.05 Amendments to Allege Use Filed in Conjunction With Application

1104.06 Processing Amendments to Allege Use Received Before Application is Assigned to an Examining Attorney

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- 1104.07 Amendments to Allege Use and *Ex Parte* Appeals
- 1104.08 Necessary Elements in a Complete Amendment to Allege Use
- 1104.09 Examination of Amendment to Allege Use by Examining Attorney
  - 1104.09(a) Ownership
  - 1104.09(b) Verification and Date of Execution
  - 1104.09(c) Identification of Goods or Services
  - 1104.09(d) Use in Commerce and Dates of Use
  - 1104.09(e) Specimen
  - 1104.09(f) Drawing
  - 1104.09(g) Fees
  - 1104.09(h) Issuance of Actions by Examining Attorney Related to the Amendment to Allege Use
- 1104.10 Amendment and Withdrawal of Amendment to Allege Use
- 1104.11 Approval of Amendment to Allege Use After Examination

### **1105 Publication of Intent-to-Use Applications for Opposition**

### **1106 Notice of Allowance**

- 1106.01 Issuance of the Notice of Allowance
- 1106.02 Action by Examining Attorney After Issuance of the Notice of Allowance
- 1106.03 Cancellation of Notice of Allowance
- 1106.04 Correction of Errors in Notice of Allowance

### **1107 Amendment After Issuance of the Notice of Allowance and Before Filing of the Statement of Use**

- 1107.01 Examination of Amendment Filed After the Notice of Allowance Issues But Before a Statement of Use is Filed

### **1108 Requests for Extensions of Time to File the Statement of Use**

- 1108.01 Time for Filing Requests for Extensions of Time to File the Statement of Use
- 1108.02 Requirements for Request For An Extension of Time to File a Statement of Use
  - 1108.02(a) Ownership

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

- 1108.02(b) Verification
- 1108.02(c) Filing Fee
- 1108.02(d) Identification of Goods or Services
- 1108.02(e) Bona Fide Intention to Use the Mark in Commerce
- 1108.02(f) Good Cause Required for Extensions Beyond the First Six-Month Extension
- 1108.03 Only One Extension Request May Be Filed With or After a Statement of Use
  - 1108.03(a) Processing Extension Request Filed After Statement of Use Has Been Referred to Examining Attorney
- 1108.04 Recourse After Denial of Extension Request
- 1108.05 Petitions From Denial of Request For An Extension of Time to File Statement of Use

### **1109 Statement of Use Under §1(d) of the Trademark Act**

- 1109.01 Minimum Filing Requirements for a Statement of Use
- 1109.02 Review for Compliance with Minimum Filing Requirements
  - 1109.02(a) Petition to Review Refusal Based on Noncompliance with Minimum Filing Requirements of 37 C.F.R. §2.88(e)
- 1109.03 Use on All Goods or Services Required Before Filing
- 1109.04 Time for Filing Statement of Use
- 1109.05 Form of Statement of Use
  - 1109.05(a) Papers Prepared for Filing as an Amendment to Allege Use May Be Filed as a Statement of Use
- 1109.06 Necessary Elements in a Complete Statement of Use
- 1109.07 Examination of the Statement of Use — In General
- 1109.08 The “Clear-Error” Standard in Examination of the Statement of Use
- 1109.09 Use in Commerce
  - 1109.09(a) Dates of Use
  - 1109.09(b) Specimens
- 1109.10 Ownership
- 1109.11 Verification and Execution

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- 1109.11(a) Authority of Signatory
- 1109.11(b) Verification of Essential Elements
- 1109.11(c) Date of Execution
- 1109.11(d) Signature of Electronically Transmitted Statement of Use

1109.12 Drawing

1109.13 Identification of Goods and Services in Statement of Use

1109.14 Classification

1109.15 Filing Fees

- 1109.15(a) Processing Deficient Fees

1109.16 Correcting Defects in Statement of Use

- 1109.16(a) Statutory Requirements That Must Be Met Within Statutory Filing Period

- 1109.16(b) Issuance of Examining Attorney's Office Action Holding that a Statement of Use Does Not Meet the Minimum Filing Requirements

- 1109.16(c) Requesting an Extension of Time to File a Statement of Use for the Purpose of Compliance with Minimum Filing Requirements

- 1109.16(d) Response to Office Action Required Within Six Months of Mailing Date Regardless of Expiration Date of Period for Filing the Statement of Use

- 1109.16(e) Applicant's Recourse After Refusal of Registration

1109.17 Withdrawal of the Statement of Use Prohibited

1109.18 Approval of the Statement of Use

### **1110 Request to Divide an Application**

1110.01 Time for Filing Request to Divide

1110.02 Fee for Filing Request to Divide

1110.03 Processing Request to Divide

1110.04 Dividing an Application When Statement of Use is Due

1110.05 Dividing an Application When Response to Office Action is Due

1110.06 Dividing an Application Subject to a Proceeding at Trademark Trial and Appeal Board

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

- 1110.07 Dividing a §44 Application
- 1110.08 Dividing a §66(a) Application After Change of Ownership With Respect to Some But Not All of the Goods
- 1110.09 Division of Registrations

### **1101 Bona Fide Intention To Use the Mark In Commerce**

Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), provides that an applicant may file an application based on a bona fide intention to use a mark in commerce “under circumstances showing the good faith of such person.”

A verified statement of the applicant’s bona fide intention to use the mark in commerce must be included in intent-to-use applications under §1(b), and in applications under §§44 and 66(a), 15 U.S.C. §§1126 and 1141f(a). See TMEP §1904.01(c) regarding the requirement for a declaration of the applicant’s bona fide intention to use the mark in commerce in a §66(a) application.

If the verification is not filed with the initial application, the verified statement must allege that the applicant has had a bona fide intention to use the mark in commerce since the filing date of the application. 37 C.F.R. §§2.34(a)(2), 2.34(a)(3)(i) and 2.34(a)(4)(ii). See TMEP §§804 *et seq.* regarding verifications.

A verified statement of the applicant’s continued bona fide intention to use the mark in commerce must be included in a request for an extension of time to file a statement of use. 15 U.S.C. §1051(d)(2); 37 C.F.R. §§2.89(a)(3) and (b)(3); TMEP §§1108.02 and 1108.02(e).

Reasonable variations in the wording of the statement may be acceptable. For example, the applicant may state that it has “a bona fide intention to use in commerce the mark on or in connection with...,” or may use the words “good faith” instead of “bona fide.” However, the wording “in commerce” is required and cannot be varied. *In re Custom Technologies Inc.*, 24 USPQ2d 1712 (Comm’r Pats. 1991); *In re B.E.L.-Tronics Ltd.*, 24 USPQ2d 1397 (Comm’r Pats. 1991).

See TMEP §1201.03(a) regarding an assertion by an intent-to-use applicant of a bona fide intention to use the mark in commerce through a related company.

See TMEP §1008 regarding the requirement for an allegation of a bona fide intention to use the mark in commerce in an application filed under §44 of the Trademark Act.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The Office will *not* evaluate the good faith of an applicant in the *ex parte* examination of applications. Generally, the applicant's sworn statement of a bona fide intention to use the mark in commerce will be sufficient evidence of good faith in the *ex parte* context. Consideration of issues related to good faith may arise in an *inter partes* proceeding, but the Office will not make an inquiry in an *ex parte* proceeding unless evidence of record clearly indicates that the applicant does not have a bona fide intention to use the mark in commerce.

### **1102 Initial Examination of Intent-to-Use Applications**

In an intent-to-use application, the examining attorney will potentially examine the application twice: first, when it is initially filed based on a bona fide intention to use the mark in commerce under 15 U.S.C. §1051(b), and second, when the applicant files an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d). After receipt of the application, the examining attorney will initially examine the application to determine whether the mark is eligible for registration but for lack of evidence of use. If the mark is determined to be eligible, the mark will be approved for publication and published for opposition. If the applicant has not submitted an amendment to allege use before approval for publication, and the application is not successfully opposed, the Office will issue a notice of allowance. 15 U.S.C. §1063(b); 37 C.F.R. §2.81. In such a case, the applicant must submit a statement of use. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88.

The intent-to-use application is subject to the same requirements and examination procedures as other applications, except as specifically noted. The examining attorney must raise all possible issues in initial examination, without regard to whether the applicant will file an amendment to allege use or statement of use.

#### **1102.01 Substantive Refusals**

To the fullest extent possible, the examining attorney will examine an intent-to-use application for registrability under Trademark Act §§1, 2(a), 2(b), 2(c), 2(d), and 2(e), 15 U.S.C. §§1051 and 1052(a), (b), (c), (d), and (e), according to the same procedures and standards that apply to any other application. That is, the examining attorney must make all appropriate refusals with respect to issues such as ownership, deceptiveness, mere descriptiveness, geographic significance, and surname significance. *In re Bacardi & Co. Limited*, 48 USPQ2d 1031 (TTAB 1997); *In re American Psychological Association*, 39 USPQ2d 1467 (Comm'r Pats. 1996). The examining attorney cannot issue a requirement or refusal under these sections during examination of the statement of use if the issue could or should have been



## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

raised during initial examination, unless the failure to issue the refusal or requirement would be a clear error. See TMEP §1109.08.

Where a significant length of time has elapsed since the initial examination, a mark may have become descriptive or even generic as applied to the goods or services. In such a case, since the evidence of the descriptive or generic use would not have been available during initial examination, the refusal may be issued during second examination. TMEP §1109.08.

The examining attorney should investigate all possible issues regarding registrability through all available sources. If appropriate, the examining attorney may request that the applicant provide literature or an explanation concerning the intended manner of use of the mark under 37 C.F.R. §2.61(b). See *In re Page*, 51 USPQ2d 1660, 1665 (TTAB 1999).

While the examining attorney must examine and act on all possible issues in the initial examination of the application, refusals specifically tied to use of the mark (e.g., ornamentation) should generally be addressed after the applicant submits an amendment to allege use or statement of use *and* a specimen. See TMEP §§1202 *et seq.* regarding use as a mark. However, in a §1(b) application for which no specimen has been submitted, if the examining attorney believes that a refusal of registration on the ground that the subject matter does not function as a mark may be made after an allegation of use is submitted, this potential refusal should be brought to the applicant's attention in the first action issued by the Office. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided to the applicant before the allegation of use is filed, the Office is not precluded from refusing registration on this basis.

### **1102.02 Drawings**

The examination of the drawing during initial examination, before submission of an allegation of use and specimen, will focus primarily on the form of the drawing and compliance with 37 C.F.R. §§2.52, 2.53 and 2.54. Intent-to-use applicants must comply with all formal requirements related to drawings, whether in standard characters or in special form. See TMEP §§807 *et seq.* See TMEP §1104.09(f) regarding the examination of the drawing after submission of an amendment to allege use, and TMEP §1109.12 regarding the examination of the drawing after submission of a statement of use. The applicant may not amend the mark in a drawing if the amendment constitutes a material alteration of the mark. 37 C.F.R. §2.72(b)(2).

### **1102.03 Intent-to-Use Applications and the Supplemental Register**

An applicant who relies on a bona fide intention to use the mark in commerce under §1(b) may not seek registration on the Supplemental Register until the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

applicant has submitted an amendment to allege use that meets the minimum filing requirements of 37 C.F.R. §2.76(e) or a statement of use that meets the minimum filing requirements of 37 C.F.R. §2.88(e). 37 C.F.R. §§2.47(d) and 2.75(b).

If an intent-to-use application requests registration on the Supplemental Register, the examining attorney will refuse registration under §23 of the Trademark Act, 15 U.S.C. §1091, on the ground that the mark is not in lawful use in commerce. If an application is based on intent-to-use in addition to another basis, registration of the entire application will be refused on the Supplemental Register unless the applicant either deletes the §1(b) basis or files a request to divide. See TMEP §§1110 *et seq.* regarding requests to divide. The examining attorney will withdraw the refusal if the applicant submits an acceptable allegation of use.

If an application is based solely on §1(b), and the applicant files an acceptable amendment to allege use or statement of use *and* an acceptable amendment to the Supplemental Register, the Office will consider the filing date of the amendment to allege use or statement of use to be the effective filing date of the application. 37 C.F.R. §2.75(b); TMEP §206.01. The examining attorney must conduct a new search of Office records for conflicting marks. In this situation, the Office does not alter the original filing date in its automated records. TMEP §206.

When the applicant files an allegation of use together with an amendment to the Supplemental Register, the examining attorney should examine the allegation of use before taking action on the amendment to the Supplemental Register.

See TMEP §§815 and 816 *et seq.* for additional information about the Supplemental Register.

### **1102.04 Claims of Acquired Distinctiveness under §2(f)**

See TMEP §§1212.09 *et seq.* regarding claims of distinctiveness under §2(f), 15 U.S.C. §1052(f), in intent-to-use applications.

### **1103 Allegations of Use**

While §1(b) of the Trademark Act provides for *filing* an application based on the applicant's bona fide intent to use the mark in commerce, registration cannot be granted until the applicant files an allegation of use (*i.e.*, either an amendment to allege use under §1(c) of the Act or a statement of use under §1(d) of the Act). The allegation of use must include verified dates of first use (see TMEP §903), and a specimen of use for each class of goods or services (see TMEP §§904 *et seq.*).

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

The allegation of use can be filed electronically using the Trademark Electronic Application System (“TEAS”), available at <http://www.uspto.gov/teas/index.html>. See TMEP §301 for additional information about electronic filing. Alternatively, the owner can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a form (“Trademark/Service Mark Allegation of Use”) that can be used to file either an amendment to allege use or a statement of use via mail, fax or hand delivery.

The principal difference between the amendment to allege use and the statement of use is the time of filing. The amendment to allege use may be filed after the application filing date but before approval of the mark for publication. 37 C.F.R. §2.76(a); TMEP §1104.03. If the applicant does not file an acceptable amendment to allege use during initial examination or if an amendment to allege use is filed and withdrawn, and the Office issues a notice of allowance under 15 U.S.C. §1063(b)(2) (see TMEP §§1106 *et seq.*), the applicant must file a statement of use within six months of the mailing date of the notice of allowance, or within an extension of time granted for filing of the statement of use. 15 U.S.C. §1051(d). See TMEP §§1109 *et seq.* regarding statements of use.

The applicant may *not* file the allegation of use after approval of the mark for publication and before issuance of the notice of allowance. 37 C.F.R. §2.88(a); TMEP §1104.03.

### **1104 Amendment to Allege Use Under §1(c) of the Act**

As previously stated, an intent-to-use applicant must file either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d) before issuance of the registration. This section pertains only to amendments to allege use. Statements of use are discussed in TMEP §§1109 *et seq.*

Filing an amendment to allege use does not relieve the applicant of the duty to file a response to an outstanding Office action or to take any other action required in the case, including filing a notice of appeal. See TMEP §1104.07 regarding the filing of an amendment to allege use in conjunction with an appeal.

#### **1104.01 Minimum Requirements for Filing an Amendment to Allege Use**

The amendment to allege use must include the following minimum elements to be referred to the examining attorney for examination on the merits:

- (1) the prescribed fee for at least one class;
- (2) one specimen or facsimile of the mark as used in commerce; and

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- (3) a verification or declaration signed by the applicant stating that the mark is in use in commerce.

37 C.F.R. §2.76(e).

An amendment to allege use that omits the allegation of use in commerce, but asserts a verified date of first use in commerce, may be accepted as substantially in compliance with the minimum filing requirement of 37 C.F.R. §2.76(e)(3) for a verified statement that the mark is in use in commerce. *Cf. In re Carnicon Development Company*, 34 USPQ2d 1541 (Comm'r Pats. 1992); *In re Conservation Technology Inc.*, 25 USPQ2d 1079 (Comm'r Pats. 1992). The examining attorney will require an allegation that the “mark is in use in commerce” during examination.

See TMEP §1104.08 regarding the necessary elements in a complete amendment to allege use.

### **1104.01(a) Review by Legal Instruments Examiner for Compliance with Minimum Filing Requirements**

The legal instruments examiner (“LIE”) in the law office will conduct a preliminary review of an amendment to allege use to determine whether it is timely and complies with the minimum requirements of 37 C.F.R. §2.76(e). If the amendment to allege use is timely and complies with the minimum requirements, the LIE will refer the amendment to allege use to the examining attorney for examination on the merits. See TMEP §§1104.09 *et seq.* regarding examination by the examining attorney.

See TMEP §1104.01(b) regarding processing an amendment to allege use that does not meet minimum filing requirements, and TMEP §1104.03(c) regarding processing an untimely amendment to allege use.

### **1104.01(b) Processing an Amendment to Allege Use That Does Not Meet Minimum Filing Requirements**

If an amendment to allege use is timely, but does not comply with the minimum requirements of 37 C.F.R. §2.76(e) (see TMEP §1104.01), the LIE will advise the applicant in writing of the deficiency. The applicant may correct the deficiency, provided the applicant does so before the mark is approved for publication. See 37 C.F.R. §2.76(g). If an acceptable amendment to correct the deficiency is not filed before the mark is approved for publication, the amendment to allege use will not be examined. 37 C.F.R. §2.76(g).

If the filing fee for at least a single class is omitted or is deficient (e.g., if the fee is charged to a deposit account with insufficient funds, if an electronic funds transfer (“EFT”) or credit card payment is refused or charged back by a financial institution, or a check is returned unpaid), the LIE will advise the

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

applicant that the applicant must repay the fee before the mark is approved for publication, or the amendment to allege use will not be examined. In addition, when an EFT or credit card is refused or a check is returned unpaid, the applicant must pay the processing fee required by 37 C.F.R. §2.6(b)(12). This processing fee must be paid even if the applicant withdraws the amendment to allege use. See TMEP §405.06 regarding payments that are refused.

If the amendment to allege use does not include a specimen, the LIE will advise the applicant that the applicant must submit a specimen, supported by an affidavit or declaration under 37 C.F.R. §2.20 stating that the specimen is in use in commerce on or in connection with the goods/services, before the mark is approved for publication, or the Office will not examine the amendment to allege use.

If the amendment to allege use is not signed, the LIE will advise the applicant that the applicant must submit a properly signed amendment to allege use before the mark is approved for publication, or the Office will not examine the amendment to allege use.

An amendment to allege use that does not meet the minimum filing requirements will remain in the record. If the applicant does not correct all deficiencies before approval of the mark for publication, the examining attorney will not examine the amendment to allege use. In such a case, if the applicant has submitted the fee, the fee will not be refunded and cannot be applied to a later-filed statement of use. If the mark is published for opposition and a notice of allowance issues, the applicant must file a statement of use or request for extension of time to file a statement of use to avoid abandonment of the application.

If the applicant wishes to establish that the amendment to allege use as filed met the minimum requirements of 37 C.F.R. §2.76(e), the applicant must file a petition under 37 C.F.R. §2.146. In addition to the petition fee (37 C.F.R. §2.6), the petition should include a copy of the amendment to allege use and specimen, and any evidence establishing that the amendment to allege use as filed met the minimum filing requirements. See Chapter 1700 for additional information about petitions. If the petition is granted, the amendment to allege use will be considered filed on the date it was originally received in the Office.

See TMEP §1104.03(c) regarding processing an untimely amendment to allege use.

### **1104.01(c) Processing Defective Amendment to Allege Use Filed With Other Amendments**

After the LIE has taken appropriate action on the amendment to allege use (see TMEP §1104.01(b)), the LIE will process any other amendments filed

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

with the amendment to allege use and will refer the application to the assigned examining attorney for appropriate action on those other amendments.

If the amendment to allege use did not meet the minimum requirements of 37 C.F.R. §2.76(e), the examining attorney will act on any other amendments in the case without considering the amendment to allege use. The examining attorney should issue requirements or refusals according to standard examination procedure without considering the amendment to allege use. Any specimen submitted becomes part of the record and may be relied on in relation to issues unrelated to use.

If the examining attorney determines that the LIE erred in holding that the amendment to allege use did not meet the minimum requirements of 37 C.F.R. §2.76(e), the examining attorney should telephone to advise the applicant that the amendment to allege use will be examined on the merits and to disregard the LIE's action.

### **1104.02 Form of Amendment to Allege Use**

To expedite processing, the Office recommends that an applicant file an amendment to allege use through TEAS, available at <http://www.uspto.gov/teas/index.html>. See TMEP §301 for more information about electronic filing. Alternatively, the owner can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed form that can be used to file either a statement of use or amendment to allege use ("Trademark/Service Mark Allegation of Use"). The applicant may mail, fax or hand-deliver the completed form to the Office. If the form is faxed, it must be accompanied by an authorization to charge the filing fee to a credit card or deposit account. The credit card authorization form is available at <http://www.uspto.gov/web/forms/2038.pdf>. If the amendment to allege use is filed through TEAS, payment must be made by credit card, deposit account or EFT.

If the applicant does not file electronically or use the form designed by the Office, the applicant should submit the amendment to allege use in a document separate from other amendments, with the title "Amendment to Allege Use" appearing at the top of the first page. 37 C.F.R. §2.76(d). However, this format is not mandatory. The Office will accept and enter any paper that includes an amendment to allege use if it meets the minimum filing requirements set forth in 37 C.F.R. §2.76(e), regardless of whether it is properly titled or includes other amendments. The Office will process the form even if it is captioned as a "Statement of Use," as long as it is filed before the examining attorney approves the mark for publication.

See TMEP §1104.01 regarding the minimum requirements that must be met before an amendment to allege use can be referred to an examining attorney

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

for examination, and TMEP §1104.08 regarding the necessary elements in a complete amendment to allege use.

### **1104.03 Time for Filing Amendment to Allege Use**

An applicant may file an amendment to allege use at any time between the application filing date and the date the examining attorney approves the mark for publication. 37 C.F.R. §2.76(a).

An amendment to allege use may be filed after commencement of an *ex parte* appeal. See TMEP §1104.07.

An applicant may not file either an amendment to allege use or a statement of use between the date the examining attorney approves the mark for publication and the date of issuance of the notice of allowance. This period, during which no allegation of use can be filed, is known as the “blackout period.” See TMEP §§1104.03(b) and (c).

### **1104.03(a) Use on All Goods Required Before Filing**

An applicant may not file an amendment to allege use until the applicant has used the mark in commerce on or in connection with *all* goods/services for which the applicant seeks registration under §1(b), unless the applicant files a request to divide. 37 C.F.R. §2.76(c). If the applicant files an amendment to allege use before using the mark on or in connection with all the goods/services, but does not file a request to divide, the examining attorney will require the applicant to: (1) withdraw the amendment to allege use (see TMEP §1104.10); (2) delete the goods/services not covered by the amendment to allege use from the application; or (3) file a request to divide out the goods/services that are not yet in use. See TMEP §§1110 *et seq.* regarding requests to divide.

### **1104.03(b) The “Blackout Period”**

Under 37 C.F.R. §2.76(a), an applicant may not file an amendment to allege use under 15 U.S.C. §1051(c) after the date that the application is approved for publication by the examining attorney. Under 37 C.F.R. §2.88(a), an applicant may not file a statement of use under 15 U.S.C. §1051(d) before the issuance of the notice of allowance. These two rules combine to create a period of time when neither an amendment to allege use nor a statement of use can be filed. This period is known as the “blackout period.” Any statement of use or amendment to allege use filed during this period will be deemed untimely and the fee will be refunded. *In re Sovran Financial Corp.*, 25 USPQ2d 1537 (Comm’r Pats. 1991). See TMEP §1104.03(c) regarding processing allegations of use filed during the blackout period.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Intent-to-use applicants are encouraged to check the Trademark Applications and Registrations Retrieval (“TARR”) database on the Office’s website at <http://tarr.uspto.gov> to determine the status of the application before filing an amendment to allege use.

If the status check indicates that the status of the application is any of the following, then the blackout period is in effect because the mark has been approved for publication and a notice of allowance has not yet issued:

- Approved for Publication (by the examining attorney)
- Publication/Registration review complete (by the law office clerk)
- Published for Opposition
- Notice of Allowance—Withdrawn
- Notice of Allowance—Cancelled
- Withdrawn from publication
- Withdrawn from registration—Jurisdiction restored (to the examining attorney)
- Withdrawn from registration
- Cancelled—Restored to Pendency (indicates subject registration number was issued inadvertently and correction requires restoration of the application to pendency)
- Inadvertently issued registration number—Cancelled (indicates the subject registration number was issued inadvertently and has been cancelled)
- Concurrent use proceeding terminated—granted
- Concurrent use proceeding terminated—denied
- Concurrent use proceeding pending
- Interference proceeding pending
- Interference proceeding terminated
- Opposition pending
- Opposition dismissed
- Opposition dismissed—See TTAB records
- Opposition sustained
- Opposition instituted
- Request for extension of time to file opposition
- Amendment after publication

If the reported status is one of those listed above, then the blackout period has begun and the applicant should *not* file the amendment to allege use. On the other hand, if the reported status is not one of those listed above, the applicant may file the amendment to allege use.

It is possible that the mark could be approved for publication on the same day but shortly after the applicant checks the status of the application. However, the blackout period does not begin until the day *after* a mark is approved for publication.



## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

### **1104.03(c) Processing Amendments to Allege Use Filed During the Blackout Period**

If an applicant files an amendment to allege use during the blackout period, the Office will notify the applicant that the amendment to allege use is untimely and will not be processed, and refund the filing fee for the amendment to allege use.

The examining attorney should not cancel the approval or withdraw the application from publication to process the untimely amendment to allege use. Furthermore, the examining attorney should not suspend action in the case or take any other similar action to extend the time for filing an amendment to allege use.

The Office will not retain an untimely amendment to allege use and process it as a statement of use. However, the applicant may resubmit an untimely amendment to allege use as a statement of use after the notice of allowance issues. TMEP §1109.05(a).

### **1104.04 Processing Timely Amendments to Allege Use Located After Publication**

If an amendment to allege use is timely (see TMEP §1104.03) and complies with the minimum requirements to be referred for examination on the merits (TMEP §1104.01), but the mark was published for opposition before the amendment to allege use was associated with the file, the Office will proceed as follows.

The examining attorney will contact the applicant or the applicant's attorney by telephone or e-mail (if the applicant has authorized e-mail communications) to give the applicant the opportunity to withdraw the amendment to allege use. The examining attorney should advise the applicant that the application will be withdrawn from publication if the amendment to allege use is not withdrawn.

#### *Amendment to Allege Use Withdrawn*

If the applicant withdraws the amendment to allege use, the examining attorney should advise applicant that a notice of allowance will issue if the application is not successfully opposed, and that the applicant must file a statement of use (or request for extension of time to file a statement of use) within six months after the mailing date of the notice of allowance. The examining attorney should advise applicant that, instead of filing a statement of use, the applicant may file a written request that the Office treat the amendment to allege use as a statement of use. Such a request *must be filed within six months after the mailing date of the notice of allowance*, and should be faxed to the ITU/Divisional Unit of the Office at (571) 273-9550. The examining attorney should make a note to the file reflecting the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

substance of the communication with the applicant. The filing date of the statement of use will be the date of receipt of the applicant's request to treat the amendment to allege use as a statement of use.

The applicant has the option of receiving a refund of the filing fee for the amendment to allege use, or applying the fee toward a statement of use. If the applicant requests a refund, the examining attorney should ask the legal instruments examiner in the law office to arrange for a refund of the fee.

Because §1(d)(1) of the Trademark Act explicitly requires that a statement of use be filed within six months *after* the issuance of the notice of allowance, the Office cannot process the amendment to allege use as a statement of use unless the applicant files a written request within six months after the mailing date of the notice of allowance. If the applicant does not file a statement of use, or a written request to treat the amendment to allege use as a statement of use, within six months after the mailing date of the notice of allowance, the application will be abandoned, even if the amendment to allege use is still in the record and the filing fee for the amendment to allege use has not been refunded.

### *Amendment to Allege Use Not Withdrawn*

If the applicant does not withdraw the amendment to allege use, and no notice of allowance has issued, the examining attorney must withdraw the application from publication. If the notice of allowance has issued, the examining attorney must ask the ITU/Divisional Unit to cancel the notice of allowance. The examining attorney should make an appropriate note to the file, and then examine the amendment to allege use. If the amendment to allege use can be approved, and does not raise any issues that require the examining attorney to issue an Office action that requires a response, the examining attorney should approve the amendment to allege use (see TMEP §1104.11). The mark must be republished.

If examination of the amendment to allege use raises issues that would require the examining attorney to raise requirements or refusals in a form other than an examiner's amendment, the examining attorney should request jurisdiction for the purpose of issuing the relevant requirements or refusals. See TMEP §1504.04(a). The proposed Office action setting forth the relevant requirements or refusals should accompany the request for jurisdiction. If the applicant ultimately complies with all requirements and overcomes all refusals, the mark must be republished.

### *Applications That are the Subject of an Opposition or Request for Extension of Time to Oppose*

If a notice of opposition has been filed when a timely amendment to allege use is associated with the application, the Board will usually suspend the opposition proceeding and remand the application to the examining attorney

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

for examination of the amendment to allege use. The examining attorney should follow the procedures explained above, except that no request for jurisdiction is necessary. If the amendment to allege use is ultimately approved or withdrawn, the application should be referred to the Board for appropriate action. *Trademark Trial and Appeal Board Manual of Procedure* (“TBMP”) §219.

If the application is under an extension of time to file an opposition when the amendment to allege use is associated with the application, the potential opposer must continue to file further request(s) for extension(s) of time to oppose, or file a notice of opposition, if it wishes to preserve its right to oppose if the amendment to allege use is withdrawn by the applicant or approved by the examining attorney. TBMP §219. The Board will not suspend the potential opposer’s time to file a notice of opposition. See notice at 68 Fed. Reg. 55748, 55760 (Sept. 26, 2003).

### **1104.05 Amendments to Allege Use Filed in Conjunction With Application**

If an applicant files an intent-to-use application under 15 U.S.C. §1051(b), and, at the same time, an amendment to allege use asserting dates of use before the filing date of the application, the applicant will be required to comply with all requirements related to the amendment to allege use, including the payment of the required fees for all classes.

### **1104.06 Processing Amendments to Allege Use Received Before Application is Assigned to an Examining Attorney**

If an amendment to allege use is received before an application has been assigned to an examining attorney, the LIE will review the amendment to allege use to determine whether it complies with the minimum requirements of 37 C.F.R. §2.76(e) and will take appropriate action. See TMEP §§1104.01 *et seq.*

### **1104.07 Amendments to Allege Use and *Ex Parte* Appeals**

An amendment to allege use may be filed together with a notice of appeal to the Trademark Trial and Appeal Board, or it may be filed while an appeal is pending.

Once the appeal is filed, the Board has jurisdiction over the application. If the applicant files the amendment to allege use *with* the notice of appeal, the Board will institute the appeal, suspend action on the appeal, and remand the case to the examining attorney to examine the amendment to allege use. When the applicant files the amendment to allege use *after* commencement of the appeal, the Board may in its discretion suspend action on the appeal and remand the application to the examining attorney for consideration of the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

amendment to allege use, or it may continue action on the appeal, thus deferring examination of the amendment to allege use until after disposition of the appeal.

If the Board remands the application, the examining attorney should continue examination according to standard examining procedures until final resolution of any new issues that arise in the examination of the amendment to allege use. If all issues are resolved or made the subject of a final action, the examining attorney should refer the application to the Board for resumption of the appeal. TBMP §1206.01.

If the examining attorney withdraws the refusal or requirement that is the subject of the appeal, he or she should advise the applicant or the applicant's attorney by telephone or by e-mail (if the applicant has authorized e-mail communications), and make an appropriate note to the file.

### **1104.08 Necessary Elements in a Complete Amendment to Allege Use**

The *complete* amendment to allege use must include the following elements:

- (1) a verified statement that the applicant is believed to be the owner of the mark and that the mark is in use in commerce, specifying the date of the applicant's first use of the mark anywhere and first use of the mark in commerce, and a listing of those goods/services specified in the application on or in connection with which the mark is in use in commerce;
- (2) one specimen or facsimile per class of the mark as used in commerce that meets the requirements of 37 C.F.R. §2.56; and
- (3) the prescribed fee for each class (37 C.F.R. §2.6).

37 C.F.R. §2.76(b).

### **1104.09 Examination of Amendment to Allege Use by Examining Attorney**

If a timely filed amendment to allege use meets the minimum requirements of 37 C.F.R. §2.76(e) (see TMEP §1104.01), the examining attorney will examine the amendment to allege use, in turn, with other amended cases.

The examining attorney must examine the amendment to allege use for compliance with all relevant sections of the Act. The clear-error standard that limits the issues that may be raised in examination of a statement of use (see TMEP §1109.08) does not apply to the examination of an amendment to allege use.

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

The following sections present examples of issues that should be considered during examination of the amendment to allege use. These sections do not exhaust all possibilities, but rather present a general framework governing the areas for examination.

### **1104.09(a) Ownership**

The examining attorney must confirm that the proper party has filed the amendment to allege use. Only the applicant or a valid assignee under §10 of the Trademark Act, 15 U.S.C. §1060, can file an amendment to allege use.

If the party filing the amendment to allege use is the owner at the time of filing, but the records of the Office show title in another party, the examining attorney must refuse to approve the amendment to allege use, on the ground that it was not filed by the owner. To overcome the refusal, the applicant may submit evidence to establish chain of title within the response period specified in the examining attorney's Office action. See 37 C.F.R. §§3.71 and 3.73; TMEP §502.01. To establish ownership, the party who filed the amendment to allege use must either: (1) record an assignment or other document of title with the Assignment Services Division, and include a statement that the document has been recorded in the response to the Office action; or (2) submit other evidence of ownership, in the form of a document transferring ownership from one party to another or an explanation, in the form of an affidavit or declaration under 37 C.F.R. §2.20, that a valid transfer of legal title has occurred. 37 C.F.R. §3.73(b)(1); TMEP §502.01.

If the party filing the amendment to allege use was not the owner of the mark at the time of filing the amendment to allege use, the examining attorney should not approve the amendment to allege use. The true owner may file a substitute amendment to allege use (including a filing fee) on or before the date the application is approved for publication.

See 37 C.F.R. §3.85 and TMEP §502.02(a) regarding the issuance of registration certificate in the name of the new owner, and TMEP §502.02(c) regarding an examining attorney's handling of an application after the mark has been assigned.

### **1104.09(b) Verification and Date of Execution**

The verification should be signed by the applicant or a person properly authorized to sign on behalf of the applicant. 37 C.F.R. §2.76(b)(1). See 37 C.F.R. §2.33(a) and TMEP §804.04 as to who is properly authorized to sign on behalf of an applicant. Generally, the Office will not question the authority of the person who signs a verification unless there is an inconsistency in the record as to the signatory's authority to sign.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If the amendment to allege use is not filed within one year after it is signed, the examining attorney must require a substitute or supplemental verification or declaration under 37 C.F.R. §2.20 stating that the mark is still in use in commerce. 37 C.F.R. §2.76(i); TMEP §804.03.

See TMEP §§301 and 804.05 regarding signature of electronically filed documents.

### **1104.09(c) Identification of Goods or Services**

The examining attorney must examine the identification of goods/services in an amendment to allege use to ensure that it conforms to the goods/services specified in the application. The applicant may limit or clarify the goods/services, but may not add to or expand the identification. 37 C.F.R. §2.71(a). The amendment to allege use must include all the goods/services for which the applicant seeks registration under §1(b). An amendment to allege use cannot be accepted for only some of the goods/services. See TMEP §1104.03(a).

If the applicant has not specified the goods/services in the amendment to allege use, as required by 37 C.F.R. §2.76(b), or if the goods/services specified in the amendment to allege use exceed the scope of the goods/services specified in the application, the examining attorney must require amendment.

If goods/services identified in the application are omitted from the amendment to allege use, but the applicant has not indicated an intention to delete those goods/services from the application, the examining attorney should confirm that the applicant intends to delete the omitted goods/services. *Note: If the applicant files the amendment to allege use through TEAS, and fails to identify and pay the fee for an **entire class(es)**, then the examining attorney should consider the goods/services in the omitted class(es) to have been expressly deleted, and should not issue any inquiry with respect to the goods/services in the omitted class(es). The applicant may not reinsert these goods/services.*

If the applicant lists *all* the goods/services identified in the application in the section of a pre-printed amendment to allege use form designated for the identification of goods that are not in use (the effect of which is a representation that the mark was not used in connection with any goods), then the applicant has not expressed an intention to delete these goods/services, and the examining attorney must inquire as to the discrepancy.

The applicant may amend the amendment to allege use to claim use on or in connection with the goods/services that were omitted, provided that (1) the applicant did not expressly delete the goods/services, and (2) the applicant verifies that it has used the mark in commerce on or in connection with the

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

goods/services in an affidavit or declaration under 37 C.F.R. §2.20. Inadvertently omitted goods or services may not be reinserted by examiner's amendment, because verification is required.

Omission of goods/services in an amendment to allege use or statement of use is the only instance when an applicant may reinsert goods or services. Goods or services once expressly deleted, or omitted from the identification of goods/services in a request for an extension of time to file a statement of use, may not be reinserted by later amendment. TMEP §1402.07.

If an amendment of the identification of goods/services results in the addition of class(es) to the application after an amendment to allege use is filed, the examining attorney must require payment of the fee(s) for filing the amendment to allege use in the added class(es), in addition to the fee required by 37 C.F.R. §2.6(a)(1) for adding a class(es) to the application. TMEP §1403.02(c).

### **1104.09(d) Use in Commerce and Dates of Use**

An amendment to allege use must include a verified statement that the mark is in use in commerce, and must specify the date of the applicant's first use of the mark and first use of the mark in commerce for each class of goods/services. 37 C.F.R. §2.76(b)(1)(ii). The applicant may amend the dates of use if the applicant supports the amendment with an affidavit or declaration under 37 C.F.R. §2.20. 37 C.F.R. §2.71(c). The applicant may not amend the dates of use to recite dates of use that are subsequent to the filing of the amendment to allege use. However, the applicant may withdraw the amendment to allege use. 37 C.F.R. §2.76(h).

### **1104.09(e) Specimen**

An amendment to allege use must include a specimen for each class of goods or services. The examining attorney must review the specimen for compliance with all relevant requirements. See TMEP §904.04 regarding material that is appropriate as a trademark specimen, TMEP §§1301.04 *et seq.* regarding material that is appropriate as a service mark specimen, and TMEP §§1202 *et seq.* and 1301.02 *et seq.* regarding use as a mark.

If the applicant submits a substitute specimen in conjunction with an amendment to allege use, the applicant must verify that the applicant used the substitute specimen in commerce on or in connection with the goods/services prior to filing the amendment to allege use. Similarly, if the applicant submits an additional specimen in support of a multiple class application that is not identical to the specimen originally filed, the applicant must verify that the applicant used the new specimen in commerce on or in connection with the goods/services prior to filing the amendment to allege use. TMEP §904.09.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If in fact the mark was first used on dates other than those asserted in the amendment to allege use, the dates of use must be corrected. See TMEP §§903.05 and 1104.09(d) regarding amendment of the dates of use.

If the amendment to allege use is filed through TEAS, the specimen must be a digitized image in .jpg format. 37 C.F.R. §2.56(d)(4). See TMEP §904.02(a) for additional information about electronically filed specimens.

### **1104.09(f) Drawing**

Under 37 C.F.R. §2.51(b), the drawing in an intent-to-use application must be a substantially exact representation of the mark as intended to be used *and* as actually used as shown on the specimen filed with the amendment to allege use. An applicant may not amend the mark in the original drawing if the amendment constitutes a material alteration of the mark. 37 C.F.R. §2.72(b)(2); TMEP §§807.14 *et seq.* The same standards that apply to use applications in determining whether specimens support use of the mark and whether amendments to the drawing can be permitted also apply in the examination of an amendment to allege use.

Therefore, if the mark in the drawing filed with the original application is not a substantially exact representation of the mark as used on the specimen filed with the amendment to allege use, the examining attorney must require: (1) *either* submission of a new specimen *or* an amendment of the mark in the drawing, if the amendment of the mark would not be a material alteration of the mark on the original drawing; or (2) submission of a new specimen, if the amendment of the mark would be a material alteration of the mark on the original drawing. 37 C.F.R. §2.72(b)(2). See TMEP §§807.14 *et seq.* regarding material alteration.

### **1104.09(g) Fees**

While the payment of the fee for at least one class is enough to meet the minimum filing requirements for an amendment to allege use (37 C.F.R. §2.76(e)), the examining attorney must require payment of fees to cover *all* classes identified in the application before approving the amendment to allege use. The applicant may amend the identification to delete classes.

If class(es) are added to the application after the filing of the amendment to allege use, the examining attorney must require payment of the fee(s) for filing the amendment to allege use in the added class(es), in addition to the fee required by 37 C.F.R. §2.6(a)(1) for adding a class(es) to the application. TMEP §1403.02(c).

If the applicant submits a filing fee that is deficient (*e.g.*, if the fee is charged to a deposit account with insufficient funds, a check is returned unpaid, or an EFT or credit card payment is refused or charged back by a financial



## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

institution), the examining attorney must require repayment of the fee before approving the mark for publication. In addition, when an EFT or credit card is refused, or a check is returned unpaid, the examining attorney must require a \$50 processing fee under 37 C.F.R. §2.6(b)(12). This processing fee must be paid even if the applicant withdraws the amendment to allege use. See TMEP §405.06 regarding payments that are refused.

### **1104.09(h) Issuance of Actions by Examining Attorney Related to the Amendment to Allege Use**

If the LIE reviews an amendment to allege use and refers it to the examining attorney for examination on the merits, the examining attorney should examine the amendment to allege use.

If the examining attorney determines that the amendment to allege use is not acceptable, or that it raises new issues in the case, the examining attorney will issue an action stating all refusals and requirements arising in the examination of the amendment to allege use and incorporating all unresolved issues from any outstanding Office action in the case. The examining attorney's action related to the amendment to allege use supersedes any outstanding Office action, and the applicant's response on all issues is due six months from the date of the new action. The new action must be nonfinal, because those issues arising from the examination of the amendment to allege use will have been raised for the first time.

If the amendment to allege use was referred for examination before the case was assigned to the examining attorney, the examining attorney will examine the application as a whole, including the amendment to allege use, and will issue a first action addressing all issues in the case.

If the application is suspended, the examining attorney should examine the amendment to allege use. If any action is required, the examining attorney should remove the application from suspension and take appropriate action. Any refusals or requirements that were operative at the time of suspension should be incorporated in the examining attorney's action.

If the amendment to allege use is referred for examination on the merits at the same time as a response, or if it is referred for examination when the application is in the examining attorney's amended docket after receipt of a response, the examining attorney should consider both the response and the amendment to allege use. If the amendment to allege use is acceptable in all respects, the examining attorney should approve the amendment to allege use and take whatever action is necessary on the response. See TMEP §1104.11 regarding approval of the amendment to allege use.

See TMEP §1104.07 regarding amendments to allege use filed with a notice of appeal or after the commencement of an appeal.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1104.10 Amendment and Withdrawal of Amendment to Allege Use

The applicant may amend the amendment to allege use to correct deficiencies, to overcome a refusal, to comply with a requirement, or for any other purpose.

The applicant may withdraw the amendment to allege use at any time before approval of the mark for publication. 37 C.F.R. §2.76(h). The Office will *not* refund the fee for filing an amendment to allege use that is withdrawn (except as provided in TMEP §1104.04), and the document and specimen(s) filed with the amendment to allege use will remain part of the record.

The applicant may authorize the examining attorney to issue an examiner's amendment that withdraws the amendment to allege use.

If the applicant withdraws the amendment to allege use, the application will be processed as an intent-to-use application subject to publication and issuance of a notice of allowance. After issuance of the notice of allowance, the applicant must file a statement of use.

If the applicant wishes to request withdrawal of an amendment to allege use during an *ex parte* appeal, the applicant should direct the request to the Trademark Trial and Appeal Board.

If the applicant withdraws the amendment to allege use, the examining attorney will withdraw any requirements or refusals specifically related to use of the mark, such as objections related to the form of the verified statement itself, the agreement of the mark as used on the specimens with the mark shown on the drawing, or the use of the applied-for designation as a trademark or service mark evidenced by the specimen. The examining attorney should also withdraw any requirement or refusal related to the execution of the amendment to allege use.

The examining attorney should maintain any requirement or refusal arising from the amendment to allege use not specifically related to the dates of use or use of the mark, such as refusals or requirements related to ownership or refusals under 15 U.S.C. §1052(e)(1), §1052(e)(2), §1052(e)(3) or §1052(e)(4). The specimens or any other submission related to the amendment to allege use will remain part of the record and may be relied on to support refusals and requirements under these sections.

If the applicant withdraws the amendment to allege use after it has been approved, the examining attorney must withdraw the approval on the Office's automated Trademark Reporting and Monitoring ("TRAM") System.

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

### **1104.11 Approval of Amendment to Allege Use After Examination**

The examining attorney should approve the amendment to allege use if it complies with the requirements specified in 37 C.F.R. §§2.76(b) and (c). The amendment to allege use should be approved even if requirements or refusals unrelated to §2.76(b) or (c) are necessary as a result of the examination of the amendment to allege use. *Approval of the amendment to allege use does not signify that the application is in condition for approval for publication.*

The examining attorney should *not* approve the amendment to allege use if it does not meet the requirements of 37 C.F.R. §§2.76(b) and (c), e.g., if the applicant has not provided a specimen and fee for each class, or if the goods/services in the amendment to allege use do not conform to the goods/services specified in the application.

On the other hand, if the amendment to allege use meets the requirements of 37 C.F.R. §§2.76(b) and (c), but requirements or refusals related to the ownership of the mark, use of the mark, inconsistencies between the mark in the drawing and the mark on the specimens, or other matters require action, the examining attorney should approve the amendment to allege use and then take action on those other issues. For example, if the specimen shows ornamental use of the proposed mark, the examining attorney should approve the amendment to allege use and issue a refusal based on ornamental use of the proposed mark.

When approving an amendment to allege use, the examining attorney must perform the appropriate TRAM transaction to ensure that a computer-generated notice is issued advising the applicant that the amendment to allege use has been approved and that the application will be published in the same manner as a use-based application. In other words, publication in the *Official Gazette* will include dates of use and, if the applicant survives the opposition period, the Office will issue a certificate of registration rather than a notice of allowance.

### **1105 Publication of Intent-to-Use Applications for Opposition**

If an amendment to allege use has been submitted and accepted, the intent-to-use application is processed as a use application. If the examining attorney determines that the mark is entitled to registration, the examining attorney will approve the mark for publication and the mark will be published for opposition. If the application is not successfully opposed, the mark will register.

If no amendment to allege use has been accepted for an intent-to-use application, and the examining attorney determines that the mark is entitled to registration but for the submission of an allegation of use, the examining

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

attorney will approve the mark for publication and the mark will be published for opposition. If the application is not successfully opposed, the Office will issue a notice of allowance. 15 U.S.C. §1063(b)(2); 37 C.F.R. §2.81(b).

### **1106 Notice of Allowance**

#### **1106.01 Issuance of the Notice of Allowance**

Section 13(b)(2) of the Trademark Act, 15 U.S.C. §1063(b)(2), provides for issuance of a notice of allowance if a §1(b) application is published for opposition and is not successfully opposed. The notice of allowance in an intent-to-use application will issue on the same date that a registration would issue in a use application (normally 12 weeks after the date of publication). The Office does not publish any notification that a notice of allowance has been issued in the *Official Gazette*.

The notice of allowance will list the serial number of the application, the name of the applicant, the correspondence address, the mark, the identification of goods/services, and the date of issuance of the notice of allowance. 37 C.F.R. §2.81(b). The notice of allowance is a key document because its issue date establishes the due date for filing a statement of use. The accuracy of the information stated on the notice of allowance is important. If there are any errors in the notice of allowance, the applicant should notify the ITU/Divisional Unit immediately. See TMEP §1106.04.

If an applicant asserts other bases for registration in addition to §1(b), the Office will publish the mark for opposition and will issue a notice of allowance if there is no successful opposition. The goods/services for all the bases will remain in the application pending the filing and approval of a statement of use for the goods/services based on §1(b), unless the applicant files a request to divide. See TMEP §§1110 *et seq.* regarding requests to divide. If the applicant fails to timely file a statement of use or a request for an extension of time to file a statement of use in response to a notice of allowance, the entire application will be abandoned, unless the applicant files a request to divide before the expiration of the deadline for filing the statement of use. TMEP §806.02(d). The applicant may file a petition to revive if the delay in filing the statement of use or extension request was unintentional. See TMEP §§1714 *et seq.*

#### **1106.02 Action by Examining Attorney After Issuance of the Notice of Allowance**

If, after issuance of the notice of allowance but before submission of the statement of use, the Office determines that a clear error was made in approving the mark for publication, the Office will cancel the notice of allowance and return the application to examination. The examining attorney will issue an appropriate Office action that includes the relevant requirement

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

or refusal and informs the applicant of the cancellation of the notice of allowance. See TMEP §1106.03 regarding cancellation of the notice of allowance.

After the notice of allowance issues, the examining attorney has jurisdiction to act in the case. 37 C.F.R. §2.84(a). Therefore, the examining attorney does not have to request jurisdiction to take an action, as would be required to take an action after publication but before the notice of allowance issues.

However, after a notice of allowance issues, the examining attorney should not make a refusal or requirement that could or should have been made during initial examination of the application unless the initial failure to make the refusal or requirement was a clear error. See TMEP §1109.08 regarding the “clear error” standard. If, after the notice of allowance issues, the examining attorney determines that he or she must make a refusal or requirement that could or should have been made during initial examination of the application, the examining attorney should consult the managing attorney or senior attorney before taking any such action. This must be done whether the action is to be taken before, during or after examination of the statement of use, and regardless of whether the notice of allowance is cancelled. This applies to any refusal that arguably could or should have been made during initial examination, such as most refusals under §2(d) or §2(e)(1) of the Act.

### **1106.03 Cancellation of Notice of Allowance**

If the Office cancels the notice of allowance before the filing or examination of the statement of use, the Office will refund any fees paid in conjunction with a statement of use or request(s) for extension(s) of time to file a statement of use.

Cancellation of the notice of allowance is handled by the ITU/Divisional Unit of the Office.

When the notice of allowance is cancelled, the application is returned to initial examination. The examining attorney does not have to request jurisdiction to issue an Office action. If the applicant overcomes the refusal or complies with the requirement, the examining attorney may approve the mark for publication again. The mark must be republished.

If the application is returned to initial examination, any statement of use that had previously been submitted will remain in the record but will not be examined unless it is resubmitted with the required fee as an amendment to allege use or statement of use at the appropriate time.

If the applicant files a statement of use or request for extension of time to file a statement of use after the notice of allowance has been cancelled, the ITU/Divisional Unit will inform the applicant in writing that the statement of use or extension request is untimely, and refund the filing fee.

**1106.04 Correction of Errors in Notice of Allowance**

When the applicant receives a notice of allowance, the applicant should check the accuracy of the information. If there are any errors in the notice of allowance, the applicant should notify the ITU/Divisional Unit of the Office immediately, preferably by fax or telephone.

*Correction of Office Error*

If an error in the notice of allowance was the result of an Office error (e.g., entering data incorrectly or failing to enter a timely filed amendment), the Office will determine whether the change requires republication. If necessary, the ITU Unit will refer the application to the examining attorney to approve the change and determine whether republication is required.

If the change can be made without republication, the ITU Unit will make the correction. *The Office will not issue a new notice of allowance or extend the time for filing a statement of use.*

If republication is required, and no action by the examining attorney that requires a response is necessary, the ITU Unit will make the correction, cancel the notice of allowance, and refund any fees paid for filing a statement of use or request(s) for extension of time to file a statement of use. The application will then be scheduled for republication. If the application is not opposed or survives all oppositions filed, the Office will issue a new notice of allowance.

If the examining attorney must issue an Office action that requires a response as a result of the requested correction, the ITU Unit will cancel the notice of allowance, refund any fees paid for filing a statement of use or request(s) for extension of time to file a statement of use, and send the file to the examining attorney for further action.

*Correction of Applicant's Error*

If an error in the notice of allowance is the result of an applicant's error (e.g., providing incorrect information in the application or in an amendment to the application), the applicant must file a written amendment, which will be processed like any other amendment filed after issuance of the notice of allowance and before filing of the statement of use. See TMEP §1107.

**1107 Amendment After Issuance of the Notice of Allowance and Before Filing of the Statement of Use**

Generally, the only amendments that can be entered in an application between the issuance of the notice of allowance and the submission of a statement of use are (1) the deletion of specified goods/services from the identification of goods and services (37 C.F.R. §2.77), (2) the deletion of a

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

basis in a multi-basis application (37 C.F.R. §2.35(b)(1)), and (3) changes of attorney and changes of address.

“Deletion,” within the meaning of 37 C.F.R. §2.77, means the elimination of an existing item in an identification of goods and services in its entirety. Deletion is distinct from other types of amendments to limit an identification, such as amendments to limit the goods as to types, channels of trade or class of purchasers, or to restrict an existing item in scope by the introduction of some qualifying language or the substitution of specific for more general terms.

The Office will normally not consider any other amendment to the application during this period. If the applicant submits any other amendment during this period, the Office will place the amendment in the record for consideration at the time of examination of the statement of use. 37 C.F.R. §2.77. The ITU paralegal or LIE will advise the applicant that the amendment has been received but that it will not be considered until the examining attorney examines the statement of use.

The applicant may file a petition under 37 C.F.R. §§2.146(a)(3) and (a)(5) to waive 37 C.F.R. §2.77 to permit an examining attorney to examine an amendment (other than an amendment deleting a basis or deleting specified goods/services) during the period between the issuance of the notice of allowance and the filing of the statement of use. TMEP §1107.01. *In re Upsher-Smith Laboratories, Inc.*, 45 USPQ2d 1371 (Comm’r Pats. 1997). The petition must be accompanied by the fee required by 37 C.F.R. §2.6. See TMEP Chapter 1700 regarding petitions.

The filing of an amendment after issuance of the notice of allowance does not extend the deadline for filing the statement of use. Unless the amendment requires republication, the applicant must file a statement of use or request for an extension of time to file a statement of use.

See TMEP §1106.04 regarding correction of errors in a notice of allowance, TMEP §806.04(a) regarding the deletion of a §1(b) basis after issuance of a notice of allowance, and TMEP §806.03(j)(ii) regarding amendments to add or substitute a basis between issuance of the notice of allowance and filing the statement of use.

### **1107.01 Examination of Amendment Filed After the Notice of Allowance Issues But Before a Statement of Use is Filed**

As noted in TMEP §1107, an applicant may file a petition under 37 C.F.R. §§2.146(a)(3) and (a)(5) to waive 37 C.F.R. §2.77 to permit an examining attorney to examine an amendment during the period between the issuance of a notice of allowance and the filing of a statement of use. *In re Upsher-Smith Laboratories, Inc.*, 45 USPQ2d 1371 (Comm’r Pats. 1997). If such a petition is granted, the examining attorney will either accept or reject the proposed amendment(s) in accordance with the following procedures:

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*Amendment Accepted/Republication Not Required:* If an examining attorney determines that an amendment is acceptable and republication is not required, the examining attorney will call the applicant to notify the applicant of acceptance, and make a note to the file that the proposed amendment has been accepted and that the applicant has been notified of the acceptance. The examining attorney will instruct the LIE to enter the amendment. The application will await the filing of a statement of use or extension request.

*Amendment Unacceptable:* If an examining attorney determines that an amendment is unacceptable, the examining attorney will call the applicant to notify the applicant that the amendment is not accepted, and make a note to the file that the proposed amendment is unacceptable and that the applicant has been notified of this. The application will await filing of a statement of use or extension request. The applicant must accept the denial, but may again request to amend the application when filing the statement of use.

*Amendment Accepted; Republication Required:* If an examining attorney determines that the amendment is acceptable, but that republication is required, the examining attorney will call the applicant to ask if the applicant wishes to maintain the request for amendment in light of the fact that republication is required. If the applicant elects to maintain the request, the examining attorney will make a note to the file that the proposed amendment has been accepted, that republication is required, and that the applicant has been advised of this. The examining attorney will have the amendment entered and request the ITU/Divisional Unit to cancel the notice of allowance. The ITU/Divisional Unit will cancel the notice of allowance and the application will be scheduled for republication.

*Examiner's Amendment Required; Republication Not Required:* If an examining attorney determines that an examiner's amendment is necessary, and republication is not required, the examining attorney will prepare, but not mail, the examiner's amendment. The examiner's amendment will contain a statement that republication is not required. The examining attorney will refer the application to the Photocomposition Coordinator in the Publication and Issue Section for text editing and mailing of the examiner's amendment. The application will await filing of a statement of use.

*Examiner's Amendment Required; Republication Required:* If an examining attorney determines that an examiner's amendment is



## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

necessary, and republication is required, the examining attorney will call the applicant to ask if the applicant wishes to maintain the request for amendment in light of the fact that republication is required. If the applicant elects to maintain the request, the examining attorney will prepare, but not mail, the examiner's amendment. The examiner's amendment will contain a statement that republication is required. The examining attorney will refer the application, with the unmailed examiner's amendment, to the ITU/Divisional Unit for cancellation of the notice of allowance. The ITU/Divisional Unit will cancel the notice of allowance and refer the application to the Photocomposition Coordinator in the Publication and Issue Section for text editing and mailing of the examiner's amendment and processing for republication.

*The granting of a petition to examine an amendment between issuance of the notice of allowance and filing of the statement of use does not extend the deadline for filing a statement of use (unless the notice of allowance is cancelled). Where an applicant has not yet received a response to a proposed amendment, the applicant must file its extension request or statement of use. The extension request or statement of use may use alternative language, e.g., refer both to the goods/services identified in the Notice of Allowance, and to a proposed amended identification.*

### **1108                      Requests for Extensions of Time to File the Statement of Use**

Section 1(d) of the Trademark Act, 15 U.S.C. §1051(d), requires that a statement of use be filed within six months after the issuance of the notice of allowance, or before the expiration of a previously granted extension of time to file a statement of use. If the mark is not in use in commerce before the expiration of the six-month period following the issuance of the notice of allowance, the applicant must file a request for extension of time to file a statement of use within the six-month period to avoid abandonment of the application.

The first six-month extension can be requested without a showing of good cause. Up to four additional six-month extensions can be requested, with a showing of good cause. 15 U.S.C. §1051(d)(2). Thus, the time available for filing the statement of use may not be extended beyond thirty-six months from the mailing date of the notice of allowance.

**To expedite processing**, it is recommended that the applicant file the extension request through TEAS, at <http://www.uspto.gov/teas/index.html>. Alternatively, an applicant can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed form. The applicant may mail, fax or hand-deliver the completed form to the Office. If the form is faxed, it must be accompanied by an authorization to charge the filing fee to a

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

credit card or deposit account. The credit card authorization form is available at <http://www.uspto.gov/web/forms/2038.pdf>. If the extension request is filed through TEAS, payment must be made by credit card, deposit account or EFT.

Extension requests are handled by the ITU/Divisional Unit of the Office.

### **1108.01 Time for Filing Requests for Extensions of Time to File the Statement of Use**

Under 15 U.S.C. §1051(d), the applicant must file the extension request within six months of the mailing date of the notice of allowance, or before the expiration of a previously granted extension; otherwise the application is abandoned. 15 U.S.C. §1051(d)(4); 37 C.F.R. §§2.65(c) and 2.88(h).

Extensions of time are granted in six-month increments. 37 C.F.R. §2.89(c). The first extension will begin to run from the expiration of the six-month period following issuance of the notice of allowance. An applicant will receive the full benefit of each extension before a subsequent extension will begin to run. The six-month period following issuance of the notice of allowance (or any subsequent six-month extension period) will not be cut short by the grant of an extension. No extension will be granted for more than six months. 37 C.F.R. §2.89(b).

The applicant cannot file two extension requests within the same six-month period following the issuance of the notice of allowance. For example, if the notice of allowance is issued May 6, 2004, and the applicant files the first extension request on July 2, 2004, the applicant may file the second extension request no earlier than November 7, 2004 (the beginning of the second six-month period after issuance of the notice of allowance) and no later than May 6, 2005 (the expiration of the first extension of time to file a statement of use).

The Office will notify the applicant of the grant or denial of a request for an extension of time, and of the reasons for a denial. However, failure to notify the applicant of the grant or denial of an extension request before the expiration of the requested extension does not relieve the applicant of the responsibility of timely filing a statement of use or further extension request. 37 C.F.R. §2.89(g).

Under 37 C.F.R. §2.195(a)(2), an extension request filed through TEAS is considered to have been filed on the date the Office receives the transmission (Eastern Standard Time), regardless of whether that date is a Saturday, Sunday, or federal holiday within the District of Columbia. When an extension request is filed through TEAS, the Office immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission, which is evidence of filing should any question arise as to the filing date of the request. See TMEP §301 for more information about electronic filing.

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

A request for an extension of time to file a statement of use filed on paper is considered timely if it is mailed or transmitted by the due date with a certificate of mailing or facsimile transmission under 37 C.F.R. §2.197. See TMEP §§305.02 and 306.05 for certificate of mailing and certificate of facsimile transmission procedures to avoid lateness.

### **1108.02 Requirements for Request For An Extension of Time to File a Statement of Use**

#### *First Extension Request*

The first request for an extension of time to file a statement of use must include: (1) a written request, before expiration of the six-month period following issuance of the notice of allowance; (2) the prescribed fee for each class of goods or services; and (3) a verified statement signed by the applicant that the applicant has a continued bona fide intention to use the mark in commerce, specifying those goods/services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce. 37 C.F.R. §2.89(a).

#### *Second and Subsequent Extension Requests*

A second or subsequent extension request must be submitted before expiration of a previously granted extension of time and must include: (1) a written request; (2) the prescribed fee for each class of goods or services; (3) a verified statement signed by the applicant that the applicant has a continued bona fide intention to use the mark in commerce, specifying those goods/services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce; and (4) a showing of good cause, as required by 37 C.F.R. §2.89(d). 37 C.F.R. §2.89(b). Extensions of time under 37 C.F.R. §2.89(b) (*i.e.*, second and subsequent extension requests) are granted in six-month increments and may not aggregate more than 24 months. 37 C.F.R. §2.89(c).

### **1108.02(a) Ownership**

The party filing the request for an extension of time to file a statement of use must be the owner of the mark at the time of filing. 15 U.S.C. §1051(d)(2); 37 C.F.R. §§2.89(a)(3) and 2.89(b)(3). If the party filing the extension request is not the owner of record, the request should include a statement that the assignment or other document of title is recorded (or filed for recordation) in the Assignment Services Division of the Office, or other evidence that the party filing the extension request is the owner of the application in accordance with 37 C.F.R. §§3.71 and 3.73. (*Note:* An application under §1(b) cannot be assigned before the applicant files an allegation of use, except to a successor

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

to the applicant's business, or portion of the business to which the mark pertains. See TMEP §501.01(a.)

If the extension request does not include the necessary evidence, the ITU paralegal will issue an Office action denying the request. If the party who filed the extension request was the owner of the mark at the time of filing, the applicant may submit evidence to establish the chain of title after expiration of the statutory filing period. The response must be filed within the time provided in the Office action advising the applicant of the denial.

To establish ownership, the new owner must either: (1) record an assignment or other document of title with the Assignment Services Division, and state that the document has been recorded in the response to the Office action; or (2) submit other evidence of ownership, in the form of a document transferring ownership from one party to another or an explanation, in the form of an affidavit or declaration under 37 C.F.R. §2.20, that a valid transfer of legal title has occurred. 37 C.F.R. §3.73(b)(1); TMEP §502.01. The Office recommends that requests to record documents with the Assignment Services Division be filed through Electronic Trademark Assignment System ("ETAS") at <http://etas.uspto.gov>.

If the party who filed the extension request was not the owner at the time of filing, the true owner may not file a substitute extension request unless there is time remaining in the statutory filing period. *Cf. In re Colombo Inc.*, 33 USPQ2d 1530 (Comm'r Pats. 1994).

If the applicant notifies the ITU/Divisional Unit during the processing of an extension request that a document has been recorded, the ITU paralegal will change the owner of record in TRAM. See 37 C.F.R. §3.85 and TMEP §502.02(a) regarding the issuance of a registration certificate in the name of a new owner, and TMEP §§504 *et seq.* regarding the circumstances in which the ownership field in the trademark databases will be automatically updated after recordation of a document with the Assignment Services Division, even if the new owner does not notify the Trademark Operation that the document has been recorded.

### **1108.02(b) Verification**

The extension request must be verified by someone properly authorized to sign on behalf of applicant. If the extension request is unsigned (or signed by the wrong party), a substitute verification must be submitted before the expiration of the deadline for filing the statement of use. 37 C.F.R. §§2.89(a)(3) and 2.89(b)(3). See 37 C.F.R. §2.33(a) and TMEP §804.04 regarding the definition of a person properly authorized to sign on behalf of applicant. Generally, the Office will not question the authority of the person who signs a verification, unless there is an inconsistency in the record as to the signatory's authority to sign.

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

If the extension request is not filed within one year after it is signed, the Office will require a substitute verification or declaration under 37 C.F.R. §2.20 that the applicant still has a bona fide intention to use the mark in commerce. 37 C.F.R. §2.89(h). See TMEP §804.03.

See TMEP §§301 and 804.05 regarding signature of electronically filed documents.

### **1108.02(c) Filing Fee**

A filing fee sufficient to cover at least one class must be submitted within the statutory time for filing the extension request, or the request will be denied. See 37 C.F.R. §§2.89(a)(2) and 2.89(b)(2). In a multiple-class application, if at least one complete fee is filed, the extension request will be provisionally accepted, and the ITU paralegal will issue a notice of fee deficiency allowing the applicant additional time to remit the amount by which the fee was deficient. *In re Wolf*, 33 USPQ2d 1054 (Comm'r Pats. 1993). If the Office does not receive a timely response to a fee deficiency letter, the Office will apply the fees paid to the lowest numbered classes in ascending order, unless the applicant has expressly abandoned a specific unpaid-for class, and will delete the goods in the higher classes from the application.

If the filing fee for at least a single class is not submitted or is deficient (e.g., if the fee is charged to a deposit account with insufficient funds, an EFT or credit card payment is refused or charged back by a financial institution, or a check is returned unpaid), the fee for at least one class of goods or services must be submitted before the expiration of the statutory filing period. If the extension request was not accompanied by an authorization to charge deficient fees to a deposit account (37 C.F.R. §2.208) that has sufficient funds to cover the fee, and the fee is not resubmitted before expiration of the statutory deadline, the extension request will be denied and the application will be abandoned. 37 C.F.R. §§2.89(a)(2) and (b)(2). In addition, when an EFT or credit card is refused or a check is returned unpaid, the applicant must pay the processing fee required by 37 C.F.R. §2.6(b)(12). See TMEP §405.06 regarding payments that are refused.

### **1108.02(d) Identification of Goods or Services**

The goods/services on or in connection with which the applicant still has a bona fide intention to use the mark in commerce must be identified in an extension request. 15 U.S.C. §1051(d)(2); 37 C.F.R. §§2.89(a)(3) and (b)(3). The goods/services identified in the extension request must conform to those identified in the notice of allowance. 37 C.F.R. §2.89(f). If goods or services are to be deleted, the applicant should clearly specify those goods and services to be deleted.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The applicant may incorporate by reference the specification of goods/services in the notice of allowance. This is advisable, in order to avoid the possibility that goods or services will be deleted unintentionally. Thus, the applicant may specify the goods/services by stating “those goods/services identified in the notice of allowance” or “those goods/services identified in the notice of allowance except... [followed by a listing of the goods/services to be deleted].”

If the applicant lists the goods/services specifically in the request for an extension of time, and omits any goods or services that were listed in the notice of allowance, the Office will presume these goods/services to be deleted. The applicant may not thereafter request that the goods/services be reinserted in the application. 37 C.F.R. §2.89(f).

If an applicant files an extension request on a form provided by the Office and fails to check either of the boxes available for identifying the goods/services on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce, the ITU paralegal will assume that the applicant has a continued bona fide intention to use the mark in commerce on or in connection with all the goods/services identified in the notice of allowance, and will grant the extension request, if it meets all other requirements of 15 U.S.C. §1051(d)(2) and 37 C.F.R. §2.89. *In re Omega-3 Marketing Inc.*, 35 USPQ2d 1158 (Comm’r Pats. 1994).

If the applicant lists goods/services to be deleted and the result would be to delete all of the goods/services in the notice of allowance, the Office will presume this was a typographical error. Applicant will be allowed to correct the mistake. However, if by mistake the applicant lists goods/services to be deleted and removal does not result in the deletion of all goods/services, the goods/services specifically listed will be deleted and may not later be reinserted.

See TMEP §1107 regarding amendments to the identification of goods/services filed between the issuance of the notice of allowance and the filing date of the statement of use.

### **1108.02(e) Bona Fide Intention to Use the Mark in Commerce**

A request for an extension of time to file a statement of use must include a verified statement that the applicant has a continued bona fide intention to use the mark in commerce on or in connection with the goods/services identified in the notice of allowance. 37 C.F.R. §§2.89(a)(3) and (b)(3). This is a statutory requirement that must be satisfied before expiration of the statutory period for filing the extension request. *In re Custom Technologies Inc.*, 24 USPQ2d 1712 (Comm’r Pats. 1991); *In re Raychem Corp.*, 20 USPQ2d 1355 (Comm’r Pats. 1991).

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

The Office will accept an allegation of actual use in commerce as meeting the requirement for an allegation of bona fide intention to use the mark in commerce in an extension request. *In re Vitamin Beverage Corp.*, 37 USPQ2d 1537 (Comm'r Pats. 1995).

See TMEP §1101 for additional information about the requirement for an allegation of the applicant's bona fide intention to use the mark in commerce.

### **1108.02(f) Good Cause Required for Extensions Beyond the First Six-Month Extension**

No showing of good cause is required in the first request for an extension of time to file a statement of use. However, each subsequent extension request must include a showing of good cause. 15 U.S.C. §1051(d)(2); 37 C.F.R. §2.89(b)(4). The showing of good cause must include a statement of the applicant's ongoing efforts to make use of the mark in commerce on or in connection with each of the goods/services covered by the extension request. Efforts to use the mark in commerce may include product or service research or development, market research, manufacturing activities, promotional activities, steps to acquire distributors, steps to obtain required governmental approval, or other similar activities. In the alternative, a satisfactory explanation for the failure to make such efforts may be submitted. 37 C.F.R. §2.89(d).

A mere assertion that the applicant is engaged in ongoing efforts is not enough; the efforts must be specified. *In re Comdial Corp.*, 32 USPQ2d 1863 (Comm'r Pats. 1993). However, the Office will not require a detailed explanation or evidence in a showing of good cause. The statement concerning good cause only has to refer to the types of activities listed in the rule or similar types of activities. For example, the applicant may simply state that the applicant is engaged in manufacturing and promotional activities.

The applicant may satisfy the requirement for a showing of good cause by asserting that the applicant believes that it has made valid use of the mark in commerce, and is in the process of preparing (or is concurrently filing) a statement of use, but that if the statement of use is found by the Office to be fatally defective, the applicant will need additional time to file a new statement of use. However, such a statement will be accepted only once as a statement of the applicant's ongoing efforts to make use the mark in commerce. Repetition of these same allegations in a subsequent extension request is not, without more, deemed to be a statement of the applicant's *ongoing* efforts, as required by 37 C.F.R. §2.89(d). *In re SPARC International Inc.*, 33 USPQ2d 1479 (Comm'r Pats. 1993).

If an extension request does not include a showing of good cause, or if the showing of good cause in an extension request is deemed insufficient, the ITU paralegal will issue an Office action denying the extension request but

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

granting the applicant additional time to overcome the denial by submitting a verified showing of good cause (or a substitute extension request that includes a showing of good cause). *In re El Taurino Restaurant, Inc.*, 41 USPQ2d 1220 (Comm'r Pats. 1996).

### **1108.03            Only One Extension Request May Be Filed With or After a Statement of Use**

An applicant may file a request for an extension of time to file a statement of use with a statement of use, or after filing the statement of use if there is time remaining in the statutory period for filing the statement of use, provided that granting the extension request would not extend the time for filing the statement of use more than thirty-six months after the issuance of the notice of allowance. *The applicant may not request any further extensions of time after this request.* 37 C.F.R. §2.89(e)(1).

The purpose of such a request (sometimes called an “insurance” extension request) is to secure additional time to correct any deficiency in the statement of use that must be corrected before the expiration of the deadline for filing the statement of use. See TMEP §§1109.01 and 1109.16(a) regarding the deficiencies that must be cured before expiration of the statutory filing period. Consider the following examples:

*Example:* If the notice of allowance was issued February 6, 2004, and the applicant filed the statement of use on August 6, 2004 (but did not file an extension request), the applicant has only until August 6, 2004 to cure any deficiency that must be corrected before the expiration of the statutory period for filing the statement of use.

*Example:* If the notice of allowance was issued February 6, 2004, the applicant could file a statement of use, together with an “insurance” request for an extension of time to file a statement of use, on or before August 6, 2004. If the extension request were granted, this would give the applicant until February 6, 2005 to cure any deficiency that must be corrected before the expiration of the statutory filing period. No further extension request(s) could be filed.

*Example:* If the notice of allowance was issued February 6, 2004, and the applicant filed a statement of use on February 7, 2004, the applicant could file an “insurance” extension request on or before August 6, 2004. If the request were granted, this would give the applicant until February 6, 2005 to cure any deficiency that must be corrected before the expiration of the statutory filing period. No further extension request(s) could be filed.



## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

An extension request filed with a statement of use (or after the filing of the statement of use) must meet all relevant requirements including payment of the applicable fee. If the request is not the first request for an extension of time, and thus a showing of good cause is required, the applicant may satisfy the requirement for a showing of good cause by asserting that the applicant believes that it has made valid use of the mark in commerce, as evidenced by the statement of use, but that if the statement of use is found to be fatally defective, the applicant will need additional time to correct defects or file a substitute statement of use. 37 C.F.R. §2.89(e)(2); TMEP §1108.02(f).

The filing fee for the “insurance” extension request will not be refunded, even if the extension is not needed to perfect the statement of use.

If the applicant files an insurance extension request in conjunction with a statement of use, and the applicant submits fees sufficient for one but not both, the Office will apply the fees as follows: (1) if there is enough money to cover the extension request, the Office will apply the fees to the extension request to avoid abandonment of the application; or (2) if there is enough money to cover the statement of use, but not enough to cover the extension request, the Office will apply the fees to the statement of use. See TMEP §1110.04 regarding the application of fees when an applicant submits a request to divide along with an extension request and statement of use.

If an applicant files an extension request with a statement of use and the extension request is defective, the ITU paralegal will deny the request and will advise the applicant of the reason for denial. The paralegal will then forward the file to the examining attorney if the statement of use meets the minimum requirements for examination on the merits. If there is time remaining in the current period for filing a statement of use, the applicant may file a substitute extension request.

See TMEP §1108.03(a) regarding the processing of an extension request after a statement of use has been referred to an examining attorney.

### **1108.03(a) Processing Extension Request Filed After Statement of Use Has Been Referred to Examining Attorney**

Under 37 C.F.R. §2.89(e)(1), an applicant may file a request for an extension of time to file a statement of use after filing a statement of use if there is time remaining in the statutory period for filing the statement of use, provided that granting the extension request would not extend the time for filing the statement of use more than thirty-six months after the issuance of the notice of allowance. See TMEP §1108.03.

When an extension request is filed after the statement of use has been referred to the examining attorney, the request will be referred to the examining attorney. The Office will not examine the extension request unless the applicant needs the extension to perfect the statement of use.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If the examining attorney issues a requirement or refusal based on the statement of use, the examining attorney should note in the Office action that the extension request is being referred to the ITU Unit for processing of the extension request. If the examining attorney does not issue a requirement or refusal based on the statement of use, the Office will not take formal action on the extension request.

The Office will not refund the filing fee for the extension request, even if the extension is not needed to perfect the statement of use.

Filing an extension request does *not* extend the time for responding to an examining attorney's Office action. See TMEP §1109.16(d).

### **1108.04 Recourse After Denial of Extension Request**

If an extension request is denied, the applicant will be notified of the reason(s) for denial.

To avoid abandonment of the application, the applicant must meet the minimum requirements for filing the extension request on or before the deadline for filing a statement of use.

If the Office denies the extension request because the applicant failed to meet minimum filing requirements on or before the statutory deadline, and there is time remaining in the applicant's existing period for filing the statement of use, the applicant may file the statement of use and/or a substitute extension request. Otherwise, the applicant's only recourse after denial of the extension request is a petition under 37 C.F.R. §§2.89(g) and 2.146, or a petition to revive under 37 C.F.R. §2.66, if appropriate. See TMEP §1108.05 regarding petitions that can be filed after the denial of an extension request.

The minimum filing requirements that must be satisfied before expiration of the statutory deadline are: (1) a verified statement that the applicant has a continued bona fide intention to use the mark in commerce; (2) a specification of the goods/services on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce; and (3) payment of the prescribed fee for at least one class of goods or services. *In re El Taurino Restaurant, Inc.*, 41 USPQ2d 1220, 1222 (Comm'r Pats. 1996).

### **1108.05 Petitions From Denial of Request For An Extension of Time to File Statement of Use**

If an extension is denied, and there is no time remaining in the statutory filing period, applicant's recourse is as follows:

- *Petition to Revive Under 37 C.F.R. §2.66.* If the applicant unintentionally failed to comply with the minimum filing requirements (see TMEP §1108.04 for a list of the minimum filing requirements), the

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

applicant may file a petition to revive under 37 C.F.R. §2.66, within two months of the mailing date of the denial of the extension request. See TMEP §§1714 *et seq.* regarding petitions to revive.

- *Request for Reinstatement.* If the applicant has proof that shows on its face that the extension request met the minimum requirements when filed, the applicant may request reinstatement within two months of the mailing date of the denial of the extension request. For example, if the extension request is denied due to the omission of a fee, and the applicant has proof that shows on its face that the fee was included, the applicant may request reinstatement. No fee is required. The request should be directed to the ITU Unit. See TMEP §1712.01 regarding the types of evidence that support reinstatement.
- *Petition Under 37 C.F.R. §2.146.* The applicant may file a petition under 37 C.F.R. §2.146 if the applicant believes that the ITU paralegal's denial of an extension request was improper (*e.g.*, if applicant contends that the extension request actually met the requirements of 15 U.S.C. §1051(d)(2) and 37 C.F.R. §2.89, but was improperly denied). 37 C.F.R. §§2.89(g) and 2.146(a)(2). For example, the applicant might file a petition claiming that the denial was improper if the paralegal denied an extension request because the applicant's showing of good cause was insufficient, but applicant believes that the showing was sufficient. The applicant must file the petition within two months of the mailing date of the denial of the extension request, and must include the fee required by 37 C.F.R. §2.6. See TMEP Chapter 1700 regarding petitions.

Filing a petition or request for reinstatement does not stay the time for filing a statement of use or further extension request. 37 C.F.R. §2.89(g). However, if the applicant fails to file a statement of use or further request(s) for extension(s) of time to file a statement of use during the pendency of a petition, the applicant will be given an opportunity to perfect the petition by paying the fees for each missed extension request and filing the last extension request, or statement of use, that should have been filed. *In re Moisture Jamzz, Inc.*, 47 USPQ2d 1762 (Comm'r Pats. 1997).

If a petition is granted, the term of the requested six-month extension will run from the date of the expiration of the previously existing six-month period for filing a statement of use. 37 C.F.R. §2.89(g).

No petition or request for reinstatement will be granted if it would extend the deadline for filing a statement of use beyond thirty-six months after the issuance of the notice of allowance. 15 U.S.C. §1051(d)(2).

**1109 Statement of Use Under §1(d) of the Trademark Act**

As noted in TMEP §1103, an intent-to-use applicant must file either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d) to obtain a registration. This section discusses statements of use only. See TMEP §§1104 *et seq.* regarding amendments to allege use.

Under 15 U.S.C. §1051(d), a statement of use must be filed within six months of the mailing date of the notice of allowance, or within a previously granted extension of time.

**1109.01 Minimum Filing Requirements for a Statement of Use**

The minimum requirements that a statement of use must meet before it can be referred to an examining attorney for examination on the merits are:

- (1) the prescribed fee for at least one class;
- (2) one specimen or facsimile of the mark as used in commerce; and
- (3) a verification or declaration signed by the applicant stating that the mark is in use in commerce.

37 C.F.R. §2.88(e).

A statement of use that omits the allegation of use in commerce, but asserts a verified date of first use in commerce, may be accepted as substantially in compliance with the minimum filing requirement of 37 C.F.R. §2.88(e)(3) for a verified statement that the mark is in use in commerce. *In re Carnicon Development Company*, 34 USPQ2d 1541 (Comm'r Pats. 1992); *In re Conservation Technology Inc.*, 25 USPQ2d 1079 (Comm'r Pats. 1992). The examining attorney will require an allegation that the “mark is in use in commerce” during examination. See TMEP §1109.09.

See TMEP §1109.02 regarding review of the statement of use for compliance with minimum filing requirements, and TMEP §1109.06 regarding the necessary elements in a complete statement of use.

**1109.02 Review for Compliance with Minimum Filing Requirements**

Statements of use are reviewed by the ITU/Divisional Unit to determine whether they are timely and in compliance with the minimum requirements listed in 37 C.F.R. §2.88(e). If the statement of use is untimely, either because it is premature or late, the ITU paralegal will notify the applicant that the statement of use cannot be considered because it is late, and refund the filing fee.

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

If the statement of use is timely, but does not comply with one or more of the minimum filing requirements of 37 C.F.R. §2.88(e), the ITU paralegal will notify the applicant of the defect and will advise the applicant that the Office will not examine the statement of use on the merits unless the applicant can correct the defect before expiration of the deadline for filing a statement of use.

If the applicant does not correct the deficiency before the expiration of the statutory deadline, the application will be declared abandoned. In such a case, the Office will *not* refund the filing fee.

The paralegal will review the verification or declaration stating that the mark is in use in commerce to determine whether it bears a signature, but will not question the authority of the person who signed. See TMEP §1109.11(a) regarding the proper party to sign on behalf of applicant.

The ITU paralegal will not determine whether the statement of use was filed by the record owner of the application. That issue will be addressed by the examining attorney. See TMEP §1109.10.

The applicant may not withdraw the statement of use and return the application to the previous status of awaiting filing of the statement of use, even if the statement of use fails to meet the minimum filing requirements. 37 C.F.R. §2.88(g); TMEP §1109.17.

However, to gain additional time to comply with the minimum requirements, the applicant may file a final (“insurance”) extension request with or after the filing of a statement of use, if there is time remaining in the statutory period for filing the statement of use, provided that granting the extension request would not extend the time for filing the statement of use beyond thirty-six months from the issuance of the notice of allowance. 37 C.F.R. §2.89(e)(1); TMEP §1108.03.

### **1109.02(a) Petition to Review Refusal Based on Noncompliance with Minimum Filing Requirements of 37 C.F.R. §2.88(e)**

If the ITU paralegal determines that a statement of use does not meet the minimum requirements of 37 C.F.R. §2.88(e), and there is no time remaining in the statutory filing period, applicant’s recourse is as follows:

- *Petition to Revive Under 37 C.F.R. §2.66.* If the applicant unintentionally failed to comply with the minimum filing requirements, the applicant may file a petition to revive under 37 C.F.R. §2.66 within two months of the mailing date of the Office action notifying the applicant that the statement of use is deficient. See TMEP §§1714 *et seq.* regarding petitions to revive.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- *Request for Reinstatement.* If the applicant has *proof that shows on its face* that the statement of use met the minimum requirements when filed, the applicant may request reinstatement, within two months of the mailing date of the Office action notifying the applicant that the statement of use is deficient. For example, if the statement of use is rejected due to the omission of a specimen or fee, and the applicant has proof that shows on its face that the missing element was included, the applicant may request reinstatement. No fee is required. The request should be directed to the ITU Unit. See TMEP §1712.01 regarding the types of evidence that support reinstatement.
- *Petition Under 37 C.F.R. §2.146.* If the applicant contends that the statement of use met the requirements of 37 C.F.R. §2.88(e) when filed but was improperly denied by the ITU paralegal, and the applicant does *not* have proof that shows *on its face* that the statement of use was complete when filed (see TMEP §1712.01), the applicant may file a petition under 37 C.F.R. §2.146(a)(3), asking the Director to review the action of the paralegal. The petition must be filed within two months of the mailing date of the Office action notifying the applicant that the statement of use is deficient, and must include the petition fee required by 37 C.F.R. §2.6, a copy of the papers filed, proof in the form of an affidavit or declaration under 37 C.F.R. §2.20, and any available evidence showing that the statement of use was complete when filed. See TMEP §1705.03 regarding proof of facts on petition.

No petition or request for reinstatement will be granted if it would extend the deadline for filing a statement of use beyond thirty-six months after the issuance of the notice of allowance. 15 U.S.C. §1051(d)(2).

### **1109.03 Use on All Goods or Services Required Before Filing**

The applicant may not file a statement of use until the applicant has made use of the mark in commerce on or in connection with all goods/services specified in the notice of allowance, unless the applicant files a request to divide. 37 C.F.R. §2.88(c). See TMEP §§1110 *et seq.* regarding requests to divide.

If the applicant files a statement of use for some of the goods/services identified in the notice of allowance, and a request for an extension of time to file a statement of use for other goods/services that are identified in the notice of allowance, but does not file a request to divide, the ITU Unit will issue an Office action granting the applicant additional time to either: (1) file a request to divide, or (2) delete the goods/services that are not in use from the application. If the applicant met the minimum requirements for filing the statement of use and extension request before expiration of the deadline for filing the statement of use, the applicant may file the request to divide after expiration of the statutory deadline for filing the statement of use. If the

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

applicant does not file a proper request to divide within the time specified in the Office action, the goods/services that are not covered by the statement of use will be deleted from the application.

See TMEP §1109.13 regarding examination of a statement of use that omits, but does not expressly delete, some of the goods/services identified in the notice of allowance.

### **1109.04 Time for Filing Statement of Use**

The statement of use must be filed within six months after the mailing date of the notice of allowance or within a previously granted extension of time for filing the statement of use. See TMEP §§1108 *et seq.* regarding extension requests.

Under 37 C.F.R. §2.195(a)(2), a statement of use filed through TEAS is considered to have been filed on the date the Office receives the transmission (Eastern Standard Time), regardless of whether that date is a Saturday, Sunday, or federal holiday within the District of Columbia. When a statement of use is filed through TEAS, the Office immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission. This confirmation is evidence of filing should any question arise as to the filing date. See TMEP §301 for more information about electronic filing.

A statement of use filed on paper is considered timely if it is mailed or transmitted by the due date with a certificate of mailing or facsimile transmission in accordance with 37 C.F.R. §2.197. See TMEP §§305.02 and 306.05 for certificate of mailing and certificate of facsimile transmission procedures to avoid lateness.

Any statement of use filed after the examining attorney approves the mark for publication but before the notice of allowance is mailed is untimely and will not be considered. The Office will refund the filing fee for the untimely statement of use. 37 C.F.R. §§2.76(a) and 2.88(a); TMEP §1104.03(c).

If the applicant does not timely file a statement of use within six months after the mailing date of the notice of allowance (or before the expiration of a previously granted extension of time to file the statement of use), the application is abandoned. 15 U.S.C. §1051(d)(4); 37 C.F.R. §2.88(h). If the failure to timely file a statement of use is unintentional, the applicant may file a petition to revive under 37 C.F.R. §2.66. See TMEP §§1714 *et seq.*

If a paper captioned as a “statement of use” is filed before the examining attorney approves the mark for publication, the Office will process it as an amendment to allege use. See TMEP §§1104 *et seq.* regarding amendments to allege use.

**1109.05 Form of Statement of Use**

To expedite processing, it is recommended that the statement of use be filed through TEAS, available at <http://www.uspto.gov/teas/index.html>. See TMEP §301 for more information about electronic filing.

Alternatively, the applicant can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to have a pre-printed form mailed. The completed form may be mailed, faxed, or hand-delivered to the Office. If the form is faxed, it must be accompanied by an authorization to charge the filing fee to a credit card or deposit account. The credit card authorization form is available at <http://www.uspto.gov/web/forms/2038.pdf>. If statement of use is filed through TEAS, payment must be made by credit card, deposit account or EFT.

If the applicant does not file electronically or use the Office's form, the statement of use should be captioned as a "Statement of Use." 37 C.F.R. §2.88(d).

**1109.05(a) Papers Prepared for Filing as an Amendment to Allege Use May Be Filed as a Statement of Use**

The United States Patent and Trademark Office ("USPTO") recommends that all statements of use be filed through TEAS. However, papers that were prepared for filing as an amendment to allege use may be filed as a statement of use if the papers are filed at the appropriate time (see TMEP §1109.04) and meet the requirements of 37 C.F.R. §2.88. The applicant may amend the form, as necessary, to eliminate inappropriate language in referring to the goods/services. For example, the applicant can amend an identification referring to "the goods/services identified in the application" to "the goods/services identified in the notice of allowance."

If an applicant is filing a statement of use that was prepared for filing as an amendment to allege use, the applicant should ensure that it is clear that the paper is to be considered a statement of use. The applicant can provide a transmittal letter or cover sheet to clearly identify the paper as a statement of use.

If the statement of use is filed more than one year after the date of execution, the examining attorney will require a substitute verification or declaration under 37 C.F.R. §2.20 stating that the mark is still in use in commerce. 37 C.F.R. §2.88(k); TMEP §804.03.

**1109.06 Necessary Elements in a Complete Statement of Use**

*A complete* statement of use must include the following elements:



## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

- (1) a verified statement that the applicant is believed to be the owner of the mark and that the mark is in use in commerce, specifying the date of the applicant's first use of the mark and first use of the mark in commerce, and a listing of those goods or services specified in the notice of allowance on or in connection with which the mark is in use in commerce;
- (2) one specimen or facsimile per class of the mark as used in commerce; and
- (3) the fee per class required by 37 C.F.R. §2.6.

37 C.F.R. §2.88(b).

### **1109.07 Examination of the Statement of Use — In General**

If the statement of use is timely and complies with the minimum requirements of 37 C.F.R. §2.88(e), the ITU paralegal will refer it to the examining attorney for examination on the merits. If available, the same examining attorney who initially examined the application will examine the statement of use. Examination of the statement of use is sometimes referred to as “second examination.”

The examining attorney will review the statement of use to confirm that it meets the requirements of the Act and the rules. See TMEP §1109.06 for the necessary elements in a complete statement of use.

The examining attorney will examine the specimen to confirm that it shows use as a mark on or in connection with the goods/services identified in the statement of use (see TMEP §§1202 *et seq.* and 1301.02 *et seq.*), and will also determine whether the mark shown on the drawing is a substantially exact representation of the mark as used on the specimens (see TMEP §§807.12(a) and 1109.12).

If the applicant has complied with the statutory requirements for a statement of use before the expiration of the deadline for filing the statement of use, the applicant may amend or correct the statement of use during examination. See TMEP §§1109.16(a) through 1109.16(d) regarding compliance with statutory requirements before the expiration of the time for filing the statement of use.

If the examining attorney finds the statement of use acceptable, the Office will notify the applicant that the statement of use is approved. See TMEP §1109.18 regarding approval of the statement of use. The Office will then issue the registration and publish notice of the registration in the *Official Gazette*. The application is not again subject to opposition.

**1109.08            The “Clear-Error” Standard in Examination of the Statement of Use**

Generally, in examining the statement of use, the Office will only issue requirements or refusals concerning matters related to the statement of use. The Office will not issue any requirements or refusals concerning matters that could or should have been raised during initial examination unless the failure to do so in initial examination constitutes a clear error. “Clear error” means an error that, if not corrected, would result in issuance of a registration in violation of the Act. The failure to make a refusal is a clear error if reasonable minds could not differ as to the propriety of the refusal.

The examining attorney must act on all new issues arising in the examination of the statement of use. For example, the examining attorney must issue a refusal if the specimen fails to show use of the designation as a mark. See TMEP §§1202 *et seq.* and 1301.02 *et seq.*

The examining attorney may not issue a refusal under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), unless the refusal is dictated by changed circumstances from the time of initial examination, or the failure to issue such a refusal would be a clear error. If a significant length of time has elapsed since the initial examination, in some cases, the mark may have become descriptive or even generic as applied to the goods or services. In such a case, the evidence of the descriptive or generic use would not have been available during initial examination, so the clear error standard would not apply.

However, if evidence that the mark is merely descriptive was available during initial examination and the refusal could or should have been issued in initial examination, the examining attorney may not issue the refusal unless there is clear error. That is, the evidence of descriptiveness must be substantial and unequivocal.

Likewise, the examining attorney must not issue requirements or refusals related to informalities that could or should have been addressed during the initial examination unless there is clear error.

If the goods or services were classified incorrectly and published for opposition in the wrong class, the examining attorney should require correction of the classification, because publication in the wrong class is a clear error.

If a disclaimer could or should have been required during initial examination, the examining attorney should not require a disclaimer during the examination of the statement of use unless there is clear error. For example, a disclaimer of all of the wording in a mark may be required under the clear-error standard when the mark consists of merely descriptive wording and distinctive design elements if the evidence of descriptiveness is substantial and unequivocal.

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

Issuing a registration without the disclaimer would violate the Act by granting the applicant rights beyond those to which the applicant is entitled.

Generally, the Office will not conduct any search for conflicting marks or issue any refusals under §2(d) of the Act in the examination of the statement of use. However, if the examining attorney determines that a second search is necessary, the examining attorney will conduct a second search and take any action that is appropriate. Sometimes, the Office may discover a clear error during internal Office quality review or through a letter of protest. The Office will not issue any refusal under §2(d) in the examination of the statement of use unless the failure to issue the refusal constitutes a clear error.

On appeal, the Trademark Trial and Appeal Board will review only the correctness of the underlying substantive refusal of registration. The Board will not second guess the application of the “clear error” standard. The question of whether the examining attorney properly applied the “clear error” standard is reviewable on petition under 37 C.F.R. §2.146. *In re Sambado & Son, Inc.*, 45 USPQ2d 1312 (TTAB 1997). See TMEP Chapter 1700 regarding petitions.

### **1109.09 Use in Commerce**

The filing of a verified statement that “the mark is in use in commerce” is a minimum requirement that must be satisfied before the expiration of the statutory period for filing the statement of use. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88(e)(3). If the examining attorney determines, before taking an action in connection with the statement of use, that the verified statement of use in commerce has been omitted, the examining attorney should refer the application to the ITU Unit for appropriate action.

An application that omits the allegation of use in commerce, but asserts a verified date of first use in commerce, is considered to be substantially in compliance with the minimum filing requirements under 37 C.F.R. §2.88(e)(3). *In re Carnicon Development Company*, 34 USPQ2d 1541 (Comm’r Pats. 1992); *In re Conservation Technology Inc.*, 25 USPQ2d 1079 (Comm’r Pats. 1992). Thus, if the applicant files a statement containing a verified date of first use *in commerce* on or before the expiration of the period for filing the statement of use, the applicant has met minimum filing requirements. The examining attorney must nevertheless require a verified statement that the “mark is in use in commerce” before approving the statement of use. This statement may be filed after expiration of the deadline for filing the statement of use, within the period for response to the examining attorney’s Office action.

An applicant is not required to specify the method of use or the type of commerce in which a mark is used. TMEP §§903.03 and 905.

**1109.09(a) Dates of Use**

The statement of use must include the dates of the applicant's first use of the mark and first use of the mark in commerce. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88(b)(1)(ii). However, this is not a minimum filing requirement that must be met before the application will be referred to the examining attorney. If the dates of use are omitted from the statement of use, but the statement that "the mark is in use in commerce" is included, the dates can be supplied after the expiration of the statutory period for filing the statement of use. The applicant may also amend or correct the dates of use after the expiration of the deadline for filing the statement of use, if the applicant meets the requirements of 37 C.F.R. §2.71(c)(2). Any amendment to the dates of use must be verified. 37 C.F.R. §2.71(c).

The date of first use in commerce may not be earlier than the date of first use anywhere. TMEP §903.04.

The applicant must state dates of use for each class. The dates of first use for each class must apply to at least one item in the class but do not have to apply to more than one item. However, the applicant must have used the mark in commerce on all items listed in the notice of allowance before filing the statement of use, unless the applicant files a request to divide. TMEP §1109.03. See TMEP §§1110 *et seq.* regarding requests to divide.

The dates of use can be supplied after expiration of the statutory filing period; however, the applicant must make valid use of the mark in commerce on or in connection with all the goods/services in the application before the expiration of the time for filing the statement of use. 37 C.F.R. §2.71(c)(2). If the applicant attempts to amend the dates of use to state a date of first use in commerce that is later than the time permitted for filing the statement of use, the examining attorney must refuse registration because the applicant failed to make use within the time permitted, and hold the application abandoned. When refusing registration on this ground, the examining attorney should issue a regular Office action with a six-month response clause. See TMEP §1109.16(b).

**1109.09(b) Specimens**

The examining attorney must examine the specimen(s) to confirm that they show use of the subject matter as a mark on or in connection with the goods/services identified in the statement of use. See TMEP §§1202 and 1301.02 *et seq.* The examining attorney must also determine whether the mark as used on the specimens is a substantially exact representation of the mark on the drawing (see TMEP §§807.12(a) and 1109.12). The examining attorney should issue requirements and refusals, as appropriate, based on the examination of the specimens, subject to the same standards that govern the examination of specimens in initial examination. TMEP §904 *et seq.*

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

The submission of at least one specimen with a statement of use is a statutory requirement that must be satisfied before expiration of the statutory period for filing the statement of use. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88(e); *In re Campbell*, 33 USPQ2d 1055 (Comm'r Pats. 1993). If the examining attorney determines, before taking an action regarding the statement of use, that no specimen has been submitted, the examining attorney should refer the application to the ITU Unit for appropriate action.

In a multi-class application, the applicant must submit one specimen for each class of goods/services in the statement of use before the statement of use can be approved. 37 C.F.R. §§2.86(b) and 2.88(b)(2). However, only one specimen for one class is needed to comply with the minimum filing requirements. If at least one specimen is filed within the time permitted for filing the statement of use, specimen(s) for the other class(es) can be filed after the expiration of the statutory filing period, if the applicant verifies that the additional specimen(s) was in use in commerce before the expiration of the deadline for filing the statement of use. 37 C.F.R. §2.59(b).

If the applicant files at least one specimen with the statement of use, but the specimen is unacceptable, the applicant may provide a substitute specimen after the expiration of the time permitted for filing the statement of use, provided that the applicant verifies that the substitute specimen was in use in commerce before the expiration of the deadline for filing the statement of use. 37 C.F.R. §2.59(b). If the applicant does not provide an acceptable specimen that was in use in commerce before the expiration of the deadline, the examining attorney must refuse registration because the applicant failed to make use within the time permitted, and hold the application abandoned. The examining attorney should issue a regular Office action with a six-month response clause. TMEP §1109.16(b). See TMEP §1108.03 regarding the filing of an "insurance" request for an extension of time to file a statement of use in order to gain additional time to make proper use of the mark.

If the dates of first use change as a result of the submission of a new specimen, the applicant must also amend the dates of use in the statement of use. The amendment must be supported by an affidavit or declaration. 37 C.F.R. §2.71(c); TMEP §1109.09(a).

If the statement of use is filed electronically using TEAS, the applicant must submit a digitized image in .jpg format. 37 C.F.R. §2.56(d)(4). See TMEP §904.02(a) for additional information about electronically filed specimens.

### **1109.10            Ownership**

The party filing the statement of use must be the owner of the mark at the time the statement is filed. If the party filing the statement of use is the owner at the time of filing but the records of the Office show title in another party, the examining attorney must require the applicant to submit evidence to establish

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

chain of title. If the party who filed the statement of use was the owner at the time of filing, evidence to establish ownership can be provided after expiration of the deadline for filing the statement of use. See 37 C.F.R. §§3.71 and 3.73; TMEP §502.01. To establish ownership, the new owner must either: (1) record an assignment or other document of title with the Assignment Services Division, and include a statement that the document has been recorded in the response to the Office action; or (2) submit other evidence of ownership, in the form of a document transferring ownership from one party to another or an explanation, in the form of an affidavit or declaration under 37 C.F.R. §2.20, that a valid transfer of legal title occurred prior to filing the statement of use. 37 C.F.R. §3.73(b)(1); TMEP §502.01. The applicant must submit the evidence within the response period specified in the examining attorney's Office action.

If the party who filed the statement of use was not the owner of the mark at the time of filing, the true owner may not file a substitute statement of use unless there is time remaining in the statutory filing period. *In re Colombo Inc.*, 33 USPQ2d 1530 (Comm'r Pats. 1994). See TMEP §1108.03 regarding the filing of an "insurance" request for extension of time to file a statement of use in order to gain additional time to file a proper statement of use.

Therefore, if the party filing the statement of use is not the owner of the mark at the time the statement of use is filed, the examining attorney cannot accept the statement of use. If no time remains in the statutory period for filing the statement of use, the examining attorney must refuse registration because no acceptable statement of use was filed within the time permitted, and hold the application abandoned. A regular Office action refusing registration should be issued, with a six-month response period. See TMEP §1109.16(b). The applicant cannot file a petition to revive under 37 C.F.R. §2.66 in this situation. TMEP §1714.01(f)(ii).

See 37 C.F.R. §3.85 and TMEP §502.02(a) regarding the issuance of registration certificate in the name of a new owner, and TMEP §502.02(c) regarding an examining attorney's handling of an application after the mark has been assigned.

### **1109.11 Verification and Execution**

The requirement that a statement of use include a signed verification or declaration is a statutory requirement that must be satisfied before expiration of the deadline for filing the statement of use. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88(e)(3); *In re Kinsman*, 33 USPQ2d 1057 (Comm'r Pats. 1993).

If, before taking an action in connection with the statement of use, the examining attorney determines that the statement of use does not include a signed verification or declaration, the examining attorney should refer the application to the ITU Unit for appropriate action.

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

### **1109.11(a) Authority of Signatory**

A statement of use must include a statement that is signed and verified by a person properly authorized to sign on behalf of the applicant. 37 C.F.R. §2.88(b)(1). Anyone who can verify the initial application can verify the statement of use. Generally, the Office will not question the authority of the person who signs a verification unless there is an inconsistency in the record as to the signatory's authority to sign. See TMEP §804.04.

### **1109.11(b) Verification of Essential Elements**

The examining attorney must review the verified statement of use to confirm that it conforms to the requirements of the Act and the rules. The statement must include a verified statement that the applicant believes it is the owner of the mark, and a verification of the dates of use and identification of the goods/services. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88(b)(1). See TMEP §1109.10 regarding ownership, TMEP §1109.09(a) regarding dates of use, and TMEP §1109.13 regarding the identification of goods/services.

The averment of ownership is an essential element of the verification. If it is omitted, the examining attorney must require the applicant to submit a verified statement that the applicant is the owner of the mark. This statement can be submitted after expiration of the time for filing the statement of use.

### **1109.11(c) Date of Execution**

If the statement of use was executed before the stated dates of use, the examining attorney must require that the statement be re-executed. See TMEP §903.07(a) regarding apparent discrepancies between dates of use and execution dates, and TMEP §§903.05 and 1109.09(a) regarding amendment of the dates of use.

If the statement of use is filed more than one year after the date of execution, the examining attorney will require a substitute verification or declaration under 37 C.F.R. §2.20 stating that the mark is still in use in commerce. 37 C.F.R. §2.88(k); TMEP §804.03.

### **1109.11(d) Signature of Electronically Transmitted Statement of Use**

See TMEP §§301 and 804.05 regarding signature of electronically filed documents.

### **1109.12 Drawing**

Under 37 C.F.R. §2.51(b), the drawing in an intent-to-use application must be a substantially exact representation of the mark as intended to be used *and*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

as actually used on filing the amendment to allege use or statement of use. An applicant may not amend the mark in a drawing if the amendment is a material alteration of the mark on the drawing originally submitted with the application. 37 C.F.R. §2.72(b)(2); TMEP §§807.13(a) and 807.14 *et seq.* Also, the mark in the drawing must agree with the mark as used on the specimen(s). TMEP §807.12(a). The same standards for determining whether a specimen supports use of the mark and whether an amendment can be permitted that apply to §1(a) applications also apply in the examination of the statement of use.

Therefore, if the mark in the drawing filed with the application is not a substantially exact representation of the mark as used on the specimen filed with the statement of use, the examining attorney must require: (1) *either* submission of a new specimen *or* an amendment of the mark in the drawing, if the amendment of the mark would not be a material alteration of the mark on the original drawing; or (2) submission of a new specimen, if the amendment of the mark would be a material alteration of the mark on the original drawing. 37 C.F.R. §2.72(b)(2).

### 1109.13 Identification of Goods and Services in Statement of Use

The statement of use must either list or incorporate by reference the goods/services specified in the notice of allowance on or in connection with which the mark is in use in commerce. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88(b)(1)(ii). The goods/services specified in the statement of use must conform to the goods/services identified in the notice of allowance. 37 C.F.R. §2.88(i)(1). To incorporate the goods/services by reference, the applicant may state that the mark is in use on “those goods/services identified in the notice of allowance” or “those goods/services identified in the notice of allowance except...[followed by an identification of the goods/services to be deleted].”

If the applicant omits any goods/services specified in the notice of allowance from the identification of goods/services in the statement of use, and the applicant has not expressed a clear intention to delete those goods/services, the examining attorney must inquire as to the discrepancy. 37 C.F.R. §2.88(h)(2). *Note: If the applicant files the statement of use through TEAS, and fails to identify and pay the fee for an **entire class(es)**, then the examining attorney should consider the goods/services in the omitted class(es) to have been expressly deleted, and should not issue any inquiry with respect to the goods/services in the omitted class(es). The applicant may not reinsert these goods/services.*

If the applicant lists *all* the goods/services identified in the Notice of Allowance in the section of a pre-printed statement of use form designated for the identification of goods that are not in use (the effect of which is a representation that the mark was not used in connection with any goods),



## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

then the applicant has not expressed a clear intention to delete these goods/services, and the examining attorney must inquire as to the discrepancy.

The examining attorney will permit the applicant to amend the statement of use to reinsert any omitted goods/services, if the applicant did not expressly delete the goods/services, and the applicant verifies that the mark was in use in commerce on or in connection with those goods/services before the expiration of the time for filing the statement of use. 37 C.F.R. §2.88(i)(2). Inadvertently omitted goods/services cannot be reinserted by examiner's amendment, because verification is required.

If the applicant wishes to delete goods/services, the applicant should clearly indicate its intention to delete the omitted goods/services to avoid an unnecessary inquiry by the examining attorney.

Trademark Rule 2.71(a), 37 C.F.R. §2.71(a), prohibits additions to the identification of goods/services. If the applicant proposes to expand the identification of goods/services, the examining attorney must refuse to accept the amendment.

The applicant may amend to limit or clarify the identification of goods/services if the amendment does not exceed the scope of goods/services specified in the notice of allowance. 37 C.F.R. §2.71(a). For example, the applicant may amend to limit the goods as to types, channels of trade or class of purchasers, or to restrict an existing item in scope by the introduction of some qualifying language or the substitution of specific for more general terms. The same principles that govern amendments to delete, limit or clarify in general also apply in the examination of the statement of use. See TMEP §§1402.06 *et seq.*

### **1109.14 Classification**

If the publication for opposition incorrectly identified the class of the goods/services, the examining attorney should require correction of the classification.

If classes are added to the application after the filing of the statement of use, the examining attorney must require payment of the fee(s) for filing the statement of use for the added classes, in addition to the fee required by 37 C.F.R. §2.6(a)(1) for adding a class(es) to the application. TMEP §1403.02(c).

### **1109.15 Filing Fees**

Payment of the filing fee for the statement of use is a statutory requirement that must be satisfied before the expiration of the statutory filing period. *In re L.R. Sport Inc.*, 25 USPQ2d 1533 (Comm'r Pats. 1992).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

In a multi-class application, if the applicant files the fee for at least one class of goods or services but fails to file the fees for additional classes, the examining attorney must require payment of the additional fees during examination of the statement of use. The additional fees may be paid after the time for filing the statement of use has expired, within the six-month period for response to the examining attorney's Office action.

If an applicant files a statement of use and a request to divide the application at the same time, and the fees submitted are sufficient for one but not both, the fees will be applied first to the statement of use, and the applicant will be notified of the deficiency. See TMEP §§1110.02 and 1110.04 for further information about filing fees for requests to divide.

If the applicant files a final ("insurance") extension request in conjunction with a statement of use (see TMEP §1108.03), and the applicant submits fees sufficient for one but not both, the Office will apply the fees as follows: (1) if there is enough money to cover the extension request, the Office will apply the fees to the extension request to avoid abandonment of the application; or (2) if there is enough money to cover the statement of use, but not enough to cover the extension request, the Office will apply the fees to the statement of use.

See TMEP §1109.15(a) regarding returned checks, EFT and credit card payments that are refused by financial institutions, and fees charged to deposit accounts with insufficient funds.

### **1109.15(a) Processing Deficient Fees**

If the filing fee for at least a single class is deficient (*e.g.*, if the fee is charged to a deposit account with insufficient funds, an EFT or credit card payment is refused or charged back by a financial institution, or a check is returned unpaid), the fee for at least one class of goods or services must be repaid before the expiration of the statutory filing period. If the fee for at least a single class of goods or services is not resubmitted before expiration of the statutory deadline, the application is abandoned.

If a check is returned unpaid or an EFT or credit card payment is refused, and the statement of use was accompanied by an authorization to charge deficient fees to a deposit account (37 C.F.R. §2.208) that has sufficient funds to cover the fee, the Office will charge the filing fee for the statement of use and the fee for processing the returned check or refused payment (37 C.F.R. §2.6(b)(12)) to the deposit account.

If the examining attorney determines, *before* taking an action regarding the statement of use, that the filing fee for at least a single class of goods or services has not been paid, the examining attorney should refer the application to the ITU Unit for appropriate action.

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

If the examining attorney determines, *after* taking an action regarding the statement of use, that the filing fee for at least a single class of goods or services has not been paid, the examining attorney must refuse registration on the ground that the filing fee for the statement of use was not paid. If there is time remaining in the statutory period for filing the statement of use, the examining attorney should require the applicant to resubmit the filing fee on or before the statutory deadline. If a check was returned unpaid, or an EFT or credit card was refused, the examining attorney should also require submission of the processing fee required by 37 C.F.R. §2.6(b)(12); the processing fee may be paid after expiration of the statutory deadline for filing the statement of use.

If the fee for at least a single class has not been paid, and there is no time remaining in the statutory period for filing the statement of use, the examining attorney will issue an Office action refusing registration and stating that the application is abandoned because a proper statement of use was not filed within the time required by statute. 37 C.F.R. §§2.88(e)(1) and 2.88(h). In such a case, the examining attorney should issue a regular Office action, with a six-month response clause. If the applicant does not establish within the six-month response period that the fee for at least a single class of goods or services was paid prior to the expiration of the statutory filing period, the application will be abandoned.

If the fee for at least a single class is paid before expiration of the statutory deadline, but the fee for additional class(es) is deficient, the examining attorney will issue an Office action requiring payment of the fee. The fee may be submitted after expiration of the deadline for filing the statement of use, within the period for response to the examining attorney's Office action. If a check was returned unpaid, or an EFT or credit card payment was refused, the examining attorney should also require submission of the processing fee required by 37 C.F.R. §2.6(b)(12).

If the statement of use has been approved and the mark is registered when the Office learns that the fee for the statement of use was deficient, the Office will cancel the registration as inadvertently issued. If the fee for at least a single class of goods or services was not paid before the expiration of the statutory filing period, the application will be abandoned. If the fee for at least a single class of goods or services was timely paid, but the fees for additional class(es) have not been paid, the Office will restore the application to pendency and refer it to the examining attorney for appropriate action.

See TMEP §405.06 regarding payments that are refused.

### **1109.16            Correcting Defects in Statement of Use**

The applicant must comply with the statutory requirements for filing the statement of use (37 C.F.R. §2.88(b)) before the expiration of the deadline for

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

filing the statement of use (*i.e.*, within six months of the mailing date of the notice of allowance or before the expiration of an extension of time for filing a statement of use). Other defects may be cured after the expiration of the statutory filing period, within the response periods established under standard examination procedure to avoid abandonment of the application. See TMEP §1109.16(a) regarding defects that must be cured before the expiration of the statutory filing period.

### **1109.16(a) Statutory Requirements That Must Be Met Within Statutory Filing Period**

The applicant must comply with the statutory requirements for filing a statement of use (37 C.F.R. §2.88(b)) before expiration of the period for filing the statement of use (*i.e.*, within six months of the mailing date of the notice of allowance or before the expiration of an extension of time for filing a statement of use). Thus, the following deficiencies must be cured before expiration of the statutory filing period:

- (1) *Specimens and Dates of Use in Commerce.* The applicant must make valid use of the mark in commerce and must, for each class, provide one specimen that was in use before the expiration of the time permitted for filing the statement of use. 37 C.F.R. §2.59(b)(2). If the applicant does not provide an acceptable specimen that was in use in commerce before the expiration of the deadline for filing the statement of use, the examining attorney must refuse registration because the applicant failed to make use within the time permitted, and hold the application abandoned. See TMEP §1109.09(b).

The examining attorney must refuse registration on the same grounds if the applicant attempts to amend the dates of use to state a date of first use in commerce that is later than the time permitted for filing the statement of use. 37 C.F.R. §2.71(c)(2); TMEP §1109.09(a).

- (2) *Filing by Owner.* The party filing the statement of use must be the owner of the mark at the time of filing. If the party who filed the statement of use was not the owner at the time of filing the statement of use, the applicant may not provide a substitute statement of use (or the equivalent) in the name of the true owner after the expiration of the deadline for filing the statement of use. *In re Colombo, Inc.*, 33 USPQ2d 1530 (Comm'r Pats. 1994). Therefore, if the party filing the statement of use was not the owner of the mark at the time of filing, and no time remains in the statutory period for filing the statement of use, the examining attorney must refuse registration and hold the application abandoned because the owner failed to file a statement of use within the time permitted. TMEP §1109.10.

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

- (3) *Verification.* The statement of use must be verified by someone properly authorized to sign on behalf of applicant. If the statement of use is unsigned or signed by the wrong party, a substitute verification must be filed before the expiration of the statutory period for filing the statement of use. 37 C.F.R. §2.88(e)(3). Generally, however, the Office does not question the authority of the person who verifies a statement of use. See TMEP §1109.11(a).
- (4) *Filing Fee For At Least a Single Class.* Payment of the filing fee for at least a single class is a statutory requirement that must be satisfied before the expiration of the statutory period for filing the statement of use. See TMEP §§1109.15 and 1109.15(a).

When refusing registration on the above grounds, the examining attorney should issue a regular Office action with a six-month response clause. See TMEP §1109.16(b).

### **1109.16(b) Issuance of Examining Attorney's Office Action Holding that a Statement of Use Does Not Meet the Minimum Filing Requirements**

When the examining attorney determines that the applicant did not meet the minimum statutory requirements within the period for filing the statement of use, the examining attorney must issue an Office action refusing registration on the ground that the applicant did not file a statement of use that meets the requirements of 15 U.S.C. §1051(d)(1). If there is time remaining in the statutory filing period, the Office action should state that the deficiency must be cured before the expiration of the deadline for filing the statement of use.

If there is no time remaining in the statutory filing period, the examining attorney should issue an Office action with a six-month response clause, stating that the application will be abandoned for failure to timely file a statement of use that meets the requirements of §1(d)(1) of the Act. Even if the statutory filing period has expired, the Office action should include a six-month response clause. This gives the applicant six months to establish that it met the minimum requirements on or before the expiration of the time for filing the statement of use.

If the applicant fails to respond to the Office action, the application will be abandoned for failure to respond. If the applicant responds to the Office action, but does not establish that the requirements for filing a statement of use had been satisfied *as of the expiration of the deadline for filing the statement of use*, the examining attorney will make the refusal of registration final. If the applicant does not respond, the application will be abandoned for failure to respond to the final refusal.

See TMEP §1109.16(e) regarding the applicant's recourse after an examining attorney's refusal of registration on the ground that the applicant did not

comply with the statutory requirements for filing the statement of use within the statutory filing period.

**1109.16(c) Requesting an Extension of Time to File a Statement of Use for the Purpose of Compliance with Minimum Filing Requirements**

In limited circumstances, an applicant may file a request for an extension of time to file a statement of use after filing a statement of use, in order to gain more time to comply with the minimum requirements for filing the statement of use (an “insurance” extension request). An applicant may file an extension request after filing a statement of use only if: (1) there is time remaining in the statutory period for filing the statement of use; (2) no extension request was filed together with the statement of use; *and* (3) granting the extension would not extend the time for filing the statement of use more than thirty-six months beyond the issuance of the notice of allowance. 37 C.F.R. §2.89(e)(1). See TMEP §1108.03 regarding the time periods and requirements for filing an “insurance” extension request, and TMEP §1108.03(a) regarding the procedures for processing such a request.

The filing of such an extension request is not in itself a proper response to an Office action, and does not extend the six-month period for response to the Office action. See TMEP §1109.16(d).

*Example:* Assume that a notice of allowance issues July 3, 2004; the applicant files a statement of use on July 22, 2004; and the examining attorney issues an Office action requiring substitute specimens on August 6, 2004. The applicant may file its first extension request on or before January 3, 2005, which would give the applicant until July 3, 2004 to make proper use of the mark. However, the applicant must file a response to the Office action on or before February 6, 2005. See TMEP §1109.16(d) for information about responding to an Office action in this situation.

**1109.16(d) Response to Office Action Required Within Six Months of Mailing Date Regardless of Expiration Date of Period for Filing the Statement of Use**

In limited circumstances, when the applicant files an extension request in conjunction with or after filing a statement of use (see TMEP §1108.03 regarding “insurance” extension requests), the six-month period for response to the examining attorney’s Office action will expire before the statutory deadline for filing the statement of use. To avoid abandonment, the applicant must respond to the Office action within six months of the mailing date, regardless of the expiration date of the time for filing the statement of use.

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

If the time for filing the statement of use expires after the time for responding to an Office action, and the applicant believes that it can cure a deficiency raised in the Office action before expiration of the time for filing the statement of use, the applicant should timely respond to the Office action, stating in the response that it intends to comply with the minimum requirements for filing the statement of use on or before the expiration of the statutory filing period.

If the applicant files such a response, the examining attorney should *not* suspend the application. Instead, the examining attorney should make final any outstanding refusal or requirement. The applicant will then have six months from the mailing date of the final action to cure statutory deficiencies. Of course, applicant must comply with the minimum requirements for filing the statement of use before the expiration date of the deadline for filing the statement of use.

*Example:* If the deadline for filing the statement of use expires July 3, 2004, and the examining attorney issues an Office action requiring substitute specimens on March 4, 2004, the applicant has until September 4, 2004, to file the substitute specimens, but the applicant must verify that the specimens were in use in commerce on or before July 3, 2004.

If the applicant files a proper response to the final Office action within six months of the mailing date, *and* complies with the minimum requirements for filing the statement of use before the expiration of the period for filing the statement of use, the examining attorney will withdraw the refusal based on non-compliance with the statutory requirements for filing the statement of use.

### **1109.16(e) Applicant's Recourse After Refusal of Registration**

If the applicant unintentionally fails to meet the minimum requirements for *filing* a statement of use, as set forth in 37 C.F.R. §2.88(e) (see TMEP §1109.01), the applicant may file a petition to revive under 37 C.F.R. §2.66. However, if the applicant met the minimum filing requirements of 37 C.F.R. §2.88(e), but the examining attorney later refuses registration on the ground that the applicant failed to satisfy the statutory requirements for a *complete* statement of use on or before the statutory deadline (*e.g.*, because the specimen is unacceptable or the dates of use are subsequent to the deadline for filing the statement of use), the applicant cannot overcome the refusal by filing a petition to revive under 37 C.F.R. §2.66. TMEP §1714.01(f)(ii). The applicant's only recourse is to appeal the examining attorney's refusal of registration to the Trademark Trial and Appeal Board.

See 37 C.F.R. §2.88(b) and TMEP §1109.16(a) regarding the statutory requirements that must be met within the statutory period for filing the statement of use (*i.e.*, within six months of the mailing date of the notice of

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

allowance or before the expiration of an extension of time for filing a statement of use).

### **1109.17 Withdrawal of the Statement of Use Prohibited**

Once an applicant has filed a statement of use, the applicant may not withdraw the statement of use, even if the Office determines that the statement of use does not comply with the minimum filing requirements. 37 C.F.R. §2.88(g). *In re Informix Software, Inc.*, 32 USPQ2d 1861 (Comm'r Pats. 1993).

See TMEP §1109.16(e) regarding the applicant's recourse after an examining attorney's refusal of registration on the ground that applicant did not meet the statutory requirements for filing a statement of use before the expiration of the statutory deadline.

### **1109.18 Approval of the Statement of Use**

Approval of the statement of use indicates that the mark is eligible for registration. If the examining attorney determines that the application is in condition for registration, the examining attorney will approve the mark for registration under §1(d) of the Trademark Act. Before approving the mark for registration, the examining attorney must ensure that the information contained in the file is accurate, that material that should be printed in the *Official Gazette* and on the registration certificate has been properly entered, and that material that should not be printed has been deleted from the database. See TMEP §817 regarding preparation of an application for publication or registration. If an assignment has been recorded, the examining attorney should ensure that the ownership information in TRAM is updated. See TMEP §502.02(c). The examining attorney must also perform the appropriate TRAM transaction to ensure that the computer-generated notice of approval of the statement of use is issued.

If the applicant filed an amendment to the Supplemental Register with or after filing a statement of use, and the application is otherwise in condition to be approved for registration, the examining attorney should approve the statement of use and approve the application for registration on the Supplemental Register. See TMEP §1102.03 regarding the examination of intent-to-use applications for registration on the Supplemental Register.

### **1110 Request to Divide an Application**

37 C.F.R. §2.87. *Dividing an application.*

(a) *An application may be physically divided into two or more separate applications upon the payment of a fee for each new application created and submission by the applicant of a request in accordance with paragraph (d) of*



## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

*this section.*

*(b) In the case of a request to divide out one or more entire classes from an application, only the fee for dividing an application under paragraph (a) of this section, as set forth in §2.6(a)(19), will be required. However, in the case of a request to divide out some, but not all, of the goods or services in a class, the application filing fee, as set forth in §2.6(a)(1), for each new separate application to be created by the division must be submitted, together with the fee for dividing an application under paragraph (a) of this section, as set forth in §2.6(a)(19).*

*(c) A request to divide an application may be filed at any time between the filing of the application and the date the Trademark Examining Attorney approves the mark for publication; or during an opposition, concurrent use, or interference proceeding, upon motion granted by the Trademark Trial and Appeal Board. Additionally, a request to divide an application under section 1(b) of the Act may be filed with a statement of use under §2.88 or at any time between the filing of a statement of use and the date the Trademark Examining Attorney approves the mark for registration.*

*(d) A request to divide an application should be made in a separate paper from any other amendment or response in the application. The title "Request to divide application." should appear at the top of the first page of the paper.*

Under 37 C.F.R. §2.87(a), an applicant may divide the application into two or more separate applications upon payment of the applicable fees. When dividing an application, the applicant preserves the filing date for all the goods/services covered by the application. See 37 C.F.R. §2.87(b) and TMEP §1110.02 regarding the fees for a request to divide.

An applicant may request division of an application for any reason. For example, in an intent-to-use application, the applicant may wish to proceed to publication or registration with the goods/services on or in connection with which the applicant has used the mark in commerce and retain an active intent-to-use application for any remaining goods/services.

The applicant *must* file a request to divide if the applicant files an amendment to allege use before making use on all the goods/services for which applicant seeks registration under §1(b), or a statement of use before making use on all the goods/services specified in the notice of allowance. 37 C.F.R. §§2.76(c) and 2.88(c); TMEP §§1104.03(a) and 1109.03.

### **1110.01 Time for Filing Request to Divide**

An applicant may file a request to divide the application at any time between the filing of the application and the date the examining attorney approves the mark for publication; or during an opposition, concurrent use, or interference proceeding upon motion granted by the Trademark Trial and Appeal Board.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

A request to divide a §1(b) application may also be filed with a statement of use or at any time between the filing of a statement of use and the date the examining attorney approves the mark for registration. 37 C.F.R. §2.87(c). If the Office receives a request to divide at any other time, the Office will deny the request to divide, and refund any fee(s) submitted with the request.

### **1110.02 Fee for Filing Request to Divide**

A request to divide out one or more entire classes from an application must be accompanied by a fee for dividing the application. This fee is based on the number of new applications created by the division. 37 C.F.R. §§2.6(a)(19), 2.87(a), and 2.87(b).

A request to divide out some, but not all, of the goods or services in a class must be accompanied by the fee for dividing the application, based on the number of new applications created, *and* by an application filing fee for each new separate application created by the division. 37 C.F.R. §§2.6(a)(1), 2.6(a)(19), 2.87(a) and 2.87(b). Currently, a request to divide cannot be filed through TEAS. Therefore, the applicant must pay the paper application filing fee. 37 C.F.R. §2.6(a)(1)(i). See notice at 70 Fed. Reg. 2952 (Jan. 19, 2005).

If the request to divide does not include the required fee(s), the ITU/Divisional Unit will notify the applicant of the deficiency and grant the applicant time to submit the required fees. The applicant must submit the fee within the time permitted, or the request to divide will be considered abandoned and the application will not be divided. If the applicant does not submit the necessary fees, the ITU/Divisional Unit will notify the applicant that the request to divide is considered abandoned.

See TMEP §1110.04 regarding the application of fees when an applicant files a request to divide in conjunction with a statement of use and/or request for an extension of time to file a statement of use, but submits insufficient fees.

### **1110.03 Processing Request to Divide**

All requests to divide should be immediately referred to the ITU/Divisional Unit of the Office for processing, unless the application is the subject of a proceeding before the Trademark Trial and Appeal Board. See TMEP §1110.06 regarding requests to divide applications that are the subject of a proceeding at the Board.

### **1110.04 Dividing an Application When Statement of Use is Due**

Filing a request to divide does not extend the deadline for filing a statement of use or request for extension of time to file a statement of use in response to a Notice of Allowance.

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

Any outstanding deadline in effect at the time the application is divided applies not only to the original application, but also to each new application created by the division of the application. 37 C.F.R. §2.87(b). Therefore, if a statement of use is due, the statement of use (or request for extension of time to file a statement of use) is due in each new application created by the division unless the following exception applies: In a multi-basis application, if the applicant files a request to divide out the basis or bases to which the Notice of Allowance does not pertain before the deadline for filing the statement of use, the new applications created by the division are not affected by the Notice of Allowance.

A request to divide *must* be filed if the applicant files a statement of use before making use of the mark in commerce on all the goods/services specified in the notice of allowance, unless the applicant deletes the goods/services that are not in use. 37 C.F.R. §2.88(c); TMEP §1109.03.

Requests to divide are given priority in processing over any other paper, with one exception: If the applicant submits a request for an extension of time to file a statement of use at the same time as or before the request to divide, *and* the extension request applies to the resulting applications, the extension request will be processed first. This provides the applicant with an extension that applies to all resulting applications without requiring additional fees for extension requests.

When the applicant files a request to divide goods that are in use from goods that are not yet in use, the Office puts the goods in use in the newly created (child) application, and retains the goods not in use in the original (parent) application. More child applications may later be created from the parent file.

If the applicant submits a request to divide along with a statement of use and a request for an extension of time to file a statement of use, and the fees are insufficient to cover all three, the fees will be applied first to the extension request (if there is enough to cover the extension request), second to the statement of use, and last to the request to divide. See TMEP §§1108.02(c) regarding fee deficiencies in extension requests, TMEP §§1109.15 and 1109.15(a) regarding fee deficiencies in statements of use, and TMEP §1110.02 regarding fee deficiencies in requests to divide.

### **1110.05 Dividing an Application When Response to Office Action is Due**

Filing a request to divide is not a proper response to an Office action and does not relieve an applicant of the duty to respond to any outstanding Office action or to take any other required action.

Any outstanding deadline in effect at the time the application is divided applies not only to the original application, but also to each new application created by the division of the application. 37 C.F.R. §2.87(b). Therefore, if a

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

response to an Office action is due, the response is due in each new application created by the division of the application, unless one of the following exceptions applies:

- (1) If the Office action pertains to less than all the classes in a multi-class application, and the applicant files a request to divide out the class(es) to which the Office action does not pertain before the response deadline, a response to the Office action is not due in the new (child) application(s) created by the division of the application.
- (2) If the Office action pertains to only one basis in a multi-basis application, and the applicant files a request to divide out the basis to which the Office action does not pertain before the response deadline, a response to the Office action is not due in the new (child) application(s) created by the division of the application.

If the applicant files a request to divide goods or services that are subject to a refusal from goods or services that are not subject to a refusal, the Office puts the goods/services that are *not* subject to refusal in the child application, and retains the goods/services that *are* subject to refusal in the parent application. More child applications may later be created from the parent file.

When a request to divide is filed together with a response to an Office action, the law office should first enter the response, and then refer the request to divide to the ITU/Divisional Unit. The ITU/Divisional Unit will process the request and then return the application to regular processing.

A request to divide may be made by examiner's amendment in appropriate circumstances. The fee must be paid by credit card or deposit account authorization.

### **1110.06 Dividing an Application Subject to a Proceeding at Trademark Trial and Appeal Board**

A request to divide may be filed during an opposition, concurrent use, or interference proceeding upon motion granted by the Trademark Trial and Appeal Board. 37 C.F.R. §2.87(c). When an application is the subject of a proceeding before the Board, any request to divide should first be referred to the Board for appropriate action. If the Board determines that the request to divide should be granted, the Board will refer the request to the ITU Unit with instructions for dividing the application. The ITU Unit will process the request and then return the application to regular processing. See TBMP §516.

### **1110.07 Dividing a §44 Application**

When the applicant divides an application that includes a claim of priority under §44(d), the new application(s) created through the division retain the priority filing date, provided that each application meets the requirements of

## INTENT TO USE APPLICATIONS AND REQUESTS TO DIVIDE

§44(d). This is true even if the applicant does not ultimately perfect a §44(e) basis (see TMEP §§806.01(c) and 806.02(f)).

When an applicant requests division of an application that includes a copy of a foreign registration, the applicant does not have to provide additional copies for each application created by the division.

### **1110.08 Dividing a §66(a) Application After Change of Ownership With Respect to Some But Not All of the Goods**

When ownership of an international registration changes with respect to some but not all of the goods/services for all designated Contracting Parties, the International Bureau of the World Intellectual Property Organization (“IB”) will create a separate new international registration for the goods/services that have been transferred, and notify the USPTO accordingly. See the IB’s *Guide to International Registration*, Para. B.II.65.01 (2004).

To obtain a certificate of registration in the name of the new owner for those goods/services that have been divided out, the new owner(s) must:

- (1) File a request to divide with the USPTO pursuant to 37 C.F.R. §2.87, and
- (2) Pay the required fee(s). A request to divide out one or more entire classes from the application must be accompanied by a fee for dividing the application, based on the number of new applications created by the division. No application filing fee is required when an entire class is divided out. A request to divide out some, but not all, of the goods or services in a class must be accompanied by the fee for dividing the application, based on the number of new applications created, *and* by an application filing fee for each new separate application created by the division. 37 C.F.R. §§2.6(a)(1), 2.6(a)(19), 2.87(a) and 2.87(b). See TMEP §1110.02.

When the IB notifies the USPTO of the division of an international registration resulting from a change of ownership with respect to some but not all of the goods or services, the USPTO will record the partial change of ownership in the Assignment Services Division, and divide out the assigned goods/services from the original (parent) application.

The USPTO will create a new (child) application serial number, and enter the information about the new application in its automated records. An Office action will issue in the child application requiring the applicant to file a request to divide and pay the required fee. If the owner of the child application fails to respond, the child application will be abandoned. The USPTO will not approve the child application for publication or registration until the assignee files a request to divide under 37 C.F.R. §2.87, and pays the required fee.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The USPTO will not divide a §66(a) application unless the IB notifies the USPTO that the international registration has been divided.

See TMEP §1615.02 regarding division of registered extensions of protection of international registrations, and TMEP §501.07 regarding assignment of extensions of protection.

### **1110.09            Division of Registrations**

See TMEP §§1615 *et seq.* regarding division of registrations.

# Chapter 1200

## Substantive Examination of Applications

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### 1201 Ownership of Mark

1201.01 Claim of Ownership May Be Based on Use By Related Companies

1201.02 Identifying the Applicant in the Application

1201.02(a) Identifying the Applicant Properly

1201.02(b) Application Void if Wrong Party Identified as the Applicant

1201.02(c) Correcting Errors in How the Applicant Is Identified

1201.02(d) Operating Divisions

1201.02(e) Changes in Ownership After Application Is Filed

1201.03 Use by Related Companies

1201.03(a) Use Solely by Related Company Must be Disclosed

1201.03(b) No Explanation of Applicant's Control Over Use of Mark by Related Companies Required

1201.03(c) Wholly Owned Related Companies

1201.03(d) Common Stockholders, Directors or Officers

1201.03(e) Sister Corporations

1201.03(f) License and Franchise Situations

1201.04 Inquiry Regarding Parties Named on Specimens or Elsewhere in Record

1201.05 Acceptable Claim of Ownership Based on Applicant's Own Use

1201.06 Special Situations Pertaining to Ownership

1201.06(a) Applicant Is Merely Distributor or Importer

1201.06(b) Goods Manufactured in a Country Other than Where Applicant Is Located

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1201.07 Related Companies and Likelihood of Confusion

1201.07(a) “Single Source” -- “Unity of Control”

1201.07(b) Appropriate Action with Respect to Assertion of Unity of Control

1201.07(b)(i) When Either Applicant or Registrant Owns All of the Other Entity

1201.07(b)(ii) When Either Applicant or Registrant Owns Substantially All of the Other Entity

1201.07(b)(iii) When the Record Does Not Support a Presumption of Unity of Control

1201.07(b)(iv) When the Record Contradicts an Assertion of Unity of Control

### 1202 Use of Subject Matter as Trademark

1202.01 Refusal of Matter Used Solely as a Trade Name

1202.02 Registration of Trade Dress

1202.02(a) Functionality

1202.02(a)(i) Statutory Basis for Functionality Refusal

1202.02(a)(ii) Purpose of Functionality Doctrine

1202.02(a)(iii) Definitions

1202.02(a)(iii)(A) Functionality

1202.02(a)(iii)(B) “*De Jure*” and “*De Facto*” Functionality

1202.02(a)(iii)(C) Aesthetic Functionality

1202.02(a)(iv) Burden of Proof in Functionality Determinations

1202.02(a)(v) Evidence and Considerations Regarding Functionality Determinations

1202.02(a)(v)(A) Advertising, Promotional or Explanatory Material in Functionality Determinations

1202.02(a)(v)(B) Availability of Alternative Designs in Functionality Determinations

1202.02(a)(v)(C) Ease or Economy of Manufacture in Functionality Determinations

1202.02(b) Distinctiveness of Trade Dress

1202.02(b)(i) Distinctiveness and Product Design Trade Dress

1202.02(b)(ii) Distinctiveness and Product Packaging Trade Dress for Goods or Services

1202.02(c) Distinctiveness and Functionality are Separate Issues



## **SUBSTANTIVE EXAMINATION OF APPLICATIONS**

- 1202.02(d) Drawing and Description of Mark in Trade Dress Applications
- 1202.02(e) Trade Dress in Intent-to-Use Applications
- 1202.02(f) Trade Dress in §44 and §66(a) Applications
- 1202.03 Refusal on Basis of Ornamentation
  - 1202.03(a) Commercial Impression
  - 1202.03(b) Practices of the Trade
  - 1202.03(c) “Secondary Source”
  - 1202.03(d) Evidence of Distinctiveness
  - 1202.03(e) Ornamentation with Respect to Intent-to-Use Applications
  - 1202.03(f) Ornamentation: Case References
    - 1202.03(f)(i) Slogans or Words Used on the Goods
    - 1202.03(f)(ii) Designs Used on the Goods
    - 1202.03(f)(iii) Trade Dress on the Containers for the Goods
  - 1202.03(g) Ornamentation Cases and Acquired Distinctiveness
- 1202.04 Informational Matter
- 1202.05 Color as a Mark
  - 1202.05(a) Color Marks Never Inherently Distinctive
  - 1202.05(b) Functional Color Marks Not Registrable
  - 1202.05(c) Color as a Separable Element
  - 1202.05(d) Drawings of Color Marks Required
    - 1202.05(d)(i) Drawings of Color Marks in Trademark Applications
    - 1202.05(d)(ii) Drawings of Color Marks in Service Mark Applications
    - 1202.05(d)(iii) Drawings for Marks Including Both Color and Words or Design
  - 1202.05(e) Written Explanation of a Color Mark
  - 1202.05(f) Specimens for Color Marks
  - 1202.05(g) Special Considerations for Service Mark Applications
  - 1202.05(h) Applications for Color Marks Based on Intent-to-Use

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

1202.05(i) Applications for Color Marks Based on §44 or §66(a)

1202.06 Goods in Trade

1202.06(a) Goods Must Have Utility to Others

1202.06(b) Registration Must Be Refused if Trademark Not Used on Goods in Trade

1202.06(c) “Goods in Trade” in Intent-to-Use Applications

1202.07 Marks That Identify Columns or Sections of Publications

1202.07(a) Marks That Identify Columns or Sections of Printed Publications

1202.07(a)(i) Syndicated Columns and Sections

1202.07(a)(ii) Non-Syndicated Columns and Sections

1202.07(a)(iii) Marks That Identify Columns and Sections of Printed Publications in Intent-to-Use Applications

1202.07(b) Marks That Identify Columns and Sections of Online Publications

1202.08 Title of a Single Creative Work

1202.09 Names of Artists and Authors

1202.09(a) Names of Performing Artists Used on Sound Recordings

1202.10 Model or Grade Designations

1202.11 Background Designs and Shapes

1202.12 Varietal and Cultivar Names (Examination of Applications for Seeds and Plants)

1202.13 Scent or Fragrance

1202.14 Holograms

1202.15 Sound Marks

### **1203 Refusal on Basis of Immoral or Scandalous Matter; Deceptive Matter; Matter which May Disparage, Falsely Suggest a Connection, or Bring into Contempt or Disrepute**

1203.01 Immoral or Scandalous Matter

1203.02 Deceptive Matter

1203.02(a) Distinction between Marks Comprising Deceptive Matter (§2(a)) and Deceptively Misdescriptive Marks (§2(e)(1))

## **SUBSTANTIVE EXAMINATION OF APPLICATIONS**

1203.02(b) Deceptive Matter: Case References

1203.03 Matter which May Disparage, Falsely Suggest a Connection, or Bring into Contempt or Disrepute

1203.03(a) "Persons" Defined

1203.03(b) "National Symbols" Defined

1203.03(c) Disparagement, Bringing into Contempt and Bringing into Disrepute

1203.03(d) Disparagement, Bringing into Contempt and Bringing into Disrepute: Case References

1203.03(e) False Suggestion of a Connection

1203.03(f) False Suggestion of a Connection: Case References

### **1204 Refusal on Basis of Flag, Coat of Arms or Other Insignia of United States, State or Municipality, or Foreign Nation**

### **1205 Refusal on Basis of Matter Protected by Statute or Convention**

1205.01 Statutory Protection

1205.02 Article 6<sup>ter</sup> of the Paris Convention

### **1206 Refusal on Basis of Name, Portrait or Signature of Particular Living Individual or Deceased U.S. President Without Consent**

1206.01 Name, Portrait or Signature

1206.02 Particular Living Individual or Deceased U.S. President

1206.03 Consent of Individual or President's Widow Required

1206.03(a) Consent Must Be Written Consent to Registration

1206.03(b) Implicit Consent

### **1207 Refusal on Basis of Likelihood of Confusion, Mistake or Deception**

1207.01 Likelihood of Confusion

1207.01(a) Relatedness of the Goods or Services

1207.01(a)(i) Goods or Services Need Not Be Identical

1207.01(a)(ii) Goods May Be Related to Services

1207.01(a)(ii)(A) Food and Beverage Products Versus Restaurant Services

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- 1207.01(a)(iii) Reliance on Identification of Goods/Services in Registration and Application
- 1207.01(a)(iv) No “Per Se” Rule
- 1207.01(a)(v) Expansion of Trade Doctrine
- 1207.01(a)(vi) Evidence Showing Relatedness of Goods or Services
- 1207.01(b) Similarity of the Marks
  - 1207.01(b)(i) Word Marks
  - 1207.01(b)(ii) Similarity In Appearance
  - 1207.01(b)(iii) Comparing Marks That Contain Additional Matter
  - 1207.01(b)(iv) Similarity in Sound – Phonetic Equivalents
  - 1207.01(b)(v) Similarity in Meaning
  - 1207.01(b)(vi) Doctrine of Foreign Equivalents
  - 1207.01(b)(vii) Transposition of Terms
  - 1207.01(b)(viii) Marks Consisting of Multiple Words
  - 1207.01(b)(ix) Weak or Descriptive Marks
  - 1207.01(b)(x) Parody Marks
- 1207.01(c) Design Marks
  - 1207.01(c)(i) Legal Equivalents - Comparison of Words and Their Equivalent Designs
  - 1207.01(c)(ii) Composite Marks Consisting of Both Words and Designs
  - 1207.01(c)(iii) Comparison of Standard Character Marks and Special Form Marks
- 1207.01(d) Miscellaneous Considerations
  - 1207.01(d)(i) Doubt Resolved in Favor of Registrant
  - 1207.01(d)(ii) Absence of Actual Confusion
  - 1207.01(d)(iii) Third-Party Registrations and Evidence of Third-Party Use
  - 1207.01(d)(iv) Collateral Attack on Registration Improper in *Ex Parte* Proceeding
  - 1207.01(d)(v) Classification of Goods/Services

## **SUBSTANTIVE EXAMINATION OF APPLICATIONS**

- 1207.01(d)(vi) Prior Decisions of Examining Attorneys
- 1207.01(d)(vii) Sophisticated Purchasers
- 1207.01(d)(viii) Consent Agreements
- 1207.01(d)(ix) Fame of Mark
- 1207.01(d)(x) Conflicting Marks Owned by Different Parties
- 1207.02 Marks That Are Likely to Deceive
- 1207.03 Marks Previously Used in United States but Not Registered
- 1207.04 Concurrent Use Registration
  - 1207.04(a) Concurrent Use – In General
  - 1207.04(b) Filing Basis of Application Seeking Concurrent Use
  - 1207.04(c) Basis for Concurrent Use Registration
  - 1207.04(d) Determining Eligibility for Concurrent Use
    - 1207.04(d)(i) Requirements for All Concurrent Use Applications
  - 1207.04(e) Applications Subject to Concurrent Use Proceeding Before the Trademark Trial and Appeal Board
    - 1207.04(e)(i) Preparing the File for Publication
  - 1207.04(f) Application for Concurrent Use Registration Pursuant to Court Decree
    - 1207.04(f)(i) Preparing the File for Publication

### **1208 Conflicting Marks in Pending Applications**

- 1208.01 Priority for Publication or Issue Based on Effective Filing Date
  - 1208.01(a) What Constitutes Conflict Between Pending Applications
  - 1208.01(b) What Constitutes Effective Filing Date
  - 1208.01(c) Change in Effective Filing Date During Examination
  - 1208.01(d) Examination of Conflicting Marks After Reinstatement or Revival
- 1208.02 Conflicting Applications Examination Procedure
  - 1208.02(a) Examination of Application with Earliest Effective Filing Date
  - 1208.02(b) Action on Later-Filed Application: Giving Notice of the Earlier Application or Applications
  - 1208.02(c) Suspension of Later-Filed Application

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

1208.02(d) Action on Later-Filed Application upon Disposition of the Earlier Application or Applications

1208.02(e) Applicant's Argument on Issues of Conflict

1208.02(f) Conflicting Mark Mistakenly Published or Approved for Issuance on the Supplemental Register

1208.03 Procedure Relating to Possibility of Interference

1208.03(a) Procedures on Request for Interference

1208.03(b) Decision on Request for Interference

1208.03(c) Procedure When Interference Is to be Declared

### **1209 Refusal on Basis of Descriptiveness**

1209.01 Distinctiveness/Descriptiveness Continuum

1209.01(a) Fanciful, Arbitrary and Suggestive Marks

1209.01(b) Merely Descriptive Marks

1209.01(c) Generic Terms

1209.01(c)(i) Test

1209.01(c)(ii) Terminology

1209.01(c)(iii) Generic Matter: Case References

1209.02 Procedure for Descriptiveness and/or Genericness Refusal

1209.03 Considerations Relevant to Determination of Descriptiveness

1209.03(a) Third-Party Registrations

1209.03(b) No Dictionary Listing

1209.03(c) First or Only User

1209.03(d) Combined Terms

1209.03(e) More Than One Meaning

1209.03(f) Picture or Illustration

1209.03(g) Foreign Equivalents/Dead or Obscure Languages

1209.03(h) Incongruity

1209.03(i) Intended Users

1209.03(j) Phonetic Equivalent

## **SUBSTANTIVE EXAMINATION OF APPLICATIONS**

- 1209.03(k) Laudatory Terms
- 1209.03(l) Telephone Numbers
- 1209.03(m) Domain Names
- 1209.03(n) “America” or “American”
- 1209.03(o) “National” or “International”
- 1209.03(p) Function or Purpose
- 1209.03(q) Source or Provider of Goods or Services
- 1209.03(r) Retail Store and Distributorship Services
- 1209.03(s) Slogans
- 1209.04 Deceptively Misdescriptive Marks

### **1210 Refusal on Basis of Geographic Significance**

- 1210.01 Elements
  - 1210.01(a) Geographically Descriptive Marks - Test
  - 1210.01(b) Geographically Deceptively Misdescriptive Marks - Test
  - 1210.01(c) Geographically Deceptive Marks - Test
- 1210.02 Primarily Geographic Significance
  - 1210.02(a) Geographic Locations
  - 1210.02(b) Primary Significance
    - 1210.02(b)(i) Other Meanings
    - 1210.02(b)(i)(A) Surname Significance
    - 1210.02(b)(ii) More Than One Geographic Location With Same Name
    - 1210.02(b)(iii) Non-Geographic Characteristics of Goods or Services
    - 1210.02(b)(iv) “America” or “American” and Similar Terms in Marks
  - 1210.02(c) Geographic Terms Combined With Additional Matter
    - 1210.02(c)(i) Two Geographic Terms Combined
    - 1210.02(c)(ii) Geographic Terms Combined With Descriptive or Generic Matter
    - 1210.02(c)(iii) Arbitrary, Fanciful or Suggestive Composites

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- 1210.03 Geographic Origin of the Goods or Services
- 1210.04 Goods/Place or Services/Place Association
  - 1210.04(a) Establishing Goods/Place Association
  - 1210.04(b) Establishing Services/Place Association
  - 1210.04(c) Obscure or Remote Geographic Marks
  - 1210.04(d) Arbitrary Use of Geographic Terms
- 1210.05 Geographically Deceptive Marks
  - 1210.05(a) Basis for Refusal
  - 1210.05(b) Materiality of Deception
    - 1210.05(b)(i) Materiality of Deception In Cases Involving Goods
    - 1210.05(b)(ii) Materiality of Deception In Cases Involving Services
- 1210.06 Procedure for Examining Geographic Composite Marks
  - 1210.06(a) Marks That Include Primarily Geographically Descriptive Terms Combined With Additional Matter
  - 1210.06(b) Marks That Include Primarily Geographically Deceptively Misdescriptive and Deceptive Terms Combined With Additional Matter
- 1210.07 Supplemental Register and Section 2(f)
  - 1210.07(a) Registrability of Geographic Terms on the Supplemental Register
  - 1210.07(b) Registrability of Geographic Terms Under Section 2(f)
- 1210.08 Wines and Spirits
- 1210.09 Geographic Certification Marks

### **1211 Refusal on Basis of Surname**

- 1211.01 “Primarily Merely a Surname”
  - 1211.01(a) Non-Surname Significance
    - 1211.01(a)(i) Ordinary Language Meaning
    - 1211.01(a)(ii) Phonetic Equivalent of Term With Ordinary Language Meaning
    - 1211.01(a)(iii) Geographical Significance
    - 1211.01(a)(iv) Historical Place or Person



## **SUBSTANTIVE EXAMINATION OF APPLICATIONS**

- 1211.01(a)(v) Rare Surnames
- 1211.01(a)(vi) “Look And Feel” of a Surname
- 1211.01(b) Surname Combined with Additional Matter
  - 1211.01(b)(i) Double Surnames
  - 1211.01(b)(ii) Stylization or Design Elements
  - 1211.01(b)(iii) Surname Combined with Initials
  - 1211.01(b)(iv) Surname Combined with Title
  - 1211.01(b)(v) Surname in Plural or Possessive Form
  - 1211.01(b)(vi) Surname Combined with Wording
  - 1211.01(b)(vii) Surname Combined With Domain Name
- 1211.02 Evidence Relating to Surname Refusal
  - 1211.02(a) Evidentiary Burden - Generally
  - 1211.02(b) Evidentiary Considerations
    - 1211.02(b)(i) Telephone Directory Listings
    - 1211.02(b)(ii) LEXIS-NEXIS® Research Database Evidence
    - 1211.02(b)(iii) Surname of Person Associated with Applicant
    - 1211.02(b)(iv) Specimens Confirming Surname Significance of Term
    - 1211.02(b)(v) Negative Dictionary Evidence
    - 1211.02(b)(vi) Evidence of Fame of a Mark

### **1212 Acquired Distinctiveness or Secondary Meaning**

- 1212.01 General Evidentiary Matters
- 1212.02 General Procedural Matters
  - 1212.02(a) Situations in which a Claim of Distinctiveness under §2(f) Is Appropriate
  - 1212.02(b) Section 2(f) Claim Is, for Procedural Purposes, a Concession that Matter Is Not Inherently Distinctive
  - 1212.02(c) Claiming §2(f) Distinctiveness in the Alternative
  - 1212.02(d) Unnecessary §2(f) Claims
  - 1212.02(e) Disclaimers in Applications Claiming Distinctiveness under §2(f)

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- 1212.02(f) Section 2(f) Claim in Part (as to a Portion of the Mark)
- 1212.02(g) Examining Attorney's Role in Suggesting §2(f) or Appropriate Kind/Amount of Evidence
- 1212.02(h) Non-Final and Final Refusals
- 1212.02(i) Section 2(f) Claim with Respect to Incapable Matter
- 1212.03 Evidence of Distinctiveness Under §2(f)
- 1212.04 Prior Registrations as Proof of Distinctiveness
  - 1212.04(a) Sufficiency of Claim vis-à-vis Nature of the Mark
  - 1212.04(b) "Same Mark"
  - 1212.04(c) Relatedness of Goods or Services
  - 1212.04(d) Registration Must Be in Full Force and Effect and on Principal Register or under Act of 1905
  - 1212.04(e) Form of §2(f) Claim Based on Ownership of Prior Registrations
- 1212.05 Five Years of Use as Proof of Distinctiveness
  - 1212.05(a) Sufficiency of Claim Vis-à-Vis Nature of the Mark
  - 1212.05(b) "Substantially Exclusive and Continuous"
  - 1212.05(c) Use "as a Mark"
  - 1212.05(d) Form of the Proof of Five Years' Use
- 1212.06 Establishing Distinctiveness by Actual Evidence
  - 1212.06(a) Long Use of the Mark
  - 1212.06(b) Advertising Expenditures
  - 1212.06(c) Affidavits or Declarations Asserting Recognition of Mark as Source Indicator
  - 1212.06(d) Survey Evidence, Market Research and Consumer Reaction Studies
  - 1212.06(e) Miscellaneous Considerations Regarding Evidence Submitted to Establish Distinctiveness
    - 1212.06(e)(i) First or Only User
    - 1212.06(e)(ii) State Trademark Registrations
    - 1212.06(e)(iii) Design Patent
    - 1212.06(e)(iv) Acquiescence to Demands of Competitors

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

- 1212.07 Form of Application Asserting Distinctiveness
- 1212.08 Section 44 and §66(a) Applications and Distinctiveness
- 1212.09 Intent-to-Use Applications and Distinctiveness
  - 1212.09(a) Section 2(f) Claim Requires Prior Use
  - 1212.09(b) Claim of §2(f) “in Part” in §1(b) Application
- 1212.10 Printing “§2(f)” Notations

### **1213 Disclaimer of Elements in Marks**

- 1213.01 History of Disclaimer Practice
  - 1213.01(a) Discretion in Requiring Disclaimer
  - 1213.01(b) Refusal to Register Because of Failure to Disclaim
  - 1213.01(c) Voluntary Disclaimer of Registrable or Unregistrable Matter
- 1213.02 “Composite” Marks
- 1213.03 Disclaimer of Unregistrable Components of Marks
  - 1213.03(a) “Unregistrable Components” in General
  - 1213.03(b) Generic Matter and Matter Which Does Not Function as a Mark
  - 1213.03(c) Pictorial Representations of Descriptive Matter
  - 1213.03(d) Entity Designations
- 1213.04 Trade Names
- 1213.05 “Unitary” Marks
  - 1213.05(a) Compound Word Marks
    - 1213.05(a)(i) Telescoped Words
    - 1213.05(a)(ii) Compound Words Formed with Hyphen or Other Punctuation
  - 1213.05(b) Slogans
  - 1213.05(c) “Double Entendre”
  - 1213.05(d) Incongruity
  - 1213.05(e) Sound Patterns
  - 1213.05(f) Display of Mark
- 1213.06 Entire Mark May Not Be Disclaimed

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- 1213.07 Removal Rather than Disclaimer
- 1213.08 Form of Disclaimers
  - 1213.08(a) Wording of Disclaimer
    - 1213.08(a)(i) Standardized Printing Format for Disclaimer
    - 1213.08(a)(ii) Unacceptable Wording for Disclaimer
  - 1213.08(b) Disclaimer of Unregistrable Matter in Its Entirety
  - 1213.08(c) Disclaimer of Misspelled Words
  - 1213.08(d) Disclaimer of Non-English Words
- 1213.09 Mark of Another May Not Be Registered with Disclaimer
- 1213.10 Disclaimer in Relation to Likelihood of Confusion
- 1213.11 Acquiring Rights in Disclaimed Matter

### **1214 “Phantom” Elements in Marks**

- 1214.01 Single Application May Seek Registration of Only One Mark
- 1214.02 Agreement of Mark on Drawing With Mark on Specimens or Foreign Registration
- 1214.03 “Phantom Marks” in Intent-to-Use Applications
- 1214.04 “Phantom Marks” in §44 and §66(a) Applications

### **1215 Marks Composed, in Whole or in Part, of Domain Names**

- 1215.01 Background
- 1215.02 Use as a Mark
  - 1215.02(a) Use Applications
  - 1215.02(b) Advertising One’s Own Products or Services on the Internet is not a Service
  - 1215.02(c) Agreement of Mark on Drawing with Mark on Specimens of Use
  - 1215.02(d) Marks Comprised Solely of TLDs for Domain Name Registry Services
  - 1215.02(e) Intent-to-Use Applications
  - 1215.02(f) Section 44 and §66(a) Applications
- 1215.03 Surnames
- 1215.04 Descriptiveness

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

- 1215.05 Generic Refusals
- 1215.06 Marks Containing Geographical Matter
- 1215.07 Disclaimers
- 1215.08 Material Alteration
  - 1215.08(a) Adding or Deleting TLDs in Domain Name Marks
  - 1215.08(b) Adding or Deleting TLDs in Other Marks
- 1215.09 Likelihood of Confusion
- 1215.10 Marks Containing the Phonetic Equivalent of a Top-Level Domain

### 1216 Effect of Applicant's Prior Registrations

- 1216.01 Decisions Involving Prior Registrations Not Controlling
- 1216.02 Effect of "Incontestability" in *Ex Parte* Examination

### 1217 Res Judicata

#### 1201 Ownership of Mark

Under Section 1(a)(1) of the Trademark Act, 15 U.S.C. §1051(a)(1), an application based on use in commerce must be filed by the owner of the mark. A §1(a) application must include a verified statement that the applicant believes it is the owner of the mark sought to be registered. 15 U.S.C. §1051(a)(3)(A); 37 C.F.R. §2.33(b)(1). An application that is not filed by the owner is void. See TMEP §1201.02(b).

An application under §1(b) or §44 of the Act, 15 U.S.C. §1051(b) or §1126, must be filed by a party who is entitled to use the mark in commerce, and must include a verified statement that the applicant is entitled to use the mark in commerce and that the applicant has a bona fide intention to use the mark in commerce as of the application filing date. 15 U.S.C. §§1051(b)(3), 1126(d)(2) and 1126(e); 37 C.F.R. §2.33(b)(2). When the person designated as the applicant was not the person with a bona fide intention to use the mark in commerce, the application is void. See TMEP §1201.02(b).

In a §1(b) application, before the mark can be registered, the applicant must file an amendment to allege use under 15 U.S.C. §1051(c) (see TMEP §§1104 *et seq.*) or a statement of use under 15 U.S.C. §1051(d) (see TMEP §§1109 *et seq.*) that states that the applicant is the owner of the mark. 15 U.S.C. §§1051(b)(3)(A) and (B); 37 C.F.R. §§2.76(b)(1), and 2.88(b)(1).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

In a §44 application, the applicant must be the owner of the foreign application or registration on which the United States application is based as of the filing date of the United States application. See TMEP §1005.

An application under §66(a) of the Trademark Act (*i.e.*, a request for extension of protection of an international registration to the United States under the Madrid Protocol), must be filed by the holder of the international registration. 15 U.S.C. §1141e(a). The application must include a verified statement that the applicant has a bona fide intention to use the mark in commerce. 15 U.S.C. §1141(5). The verified statement in a §66(a) application is part of the international registration on file at the International Bureau of the World Intellectual Property Organization (“IB”). The IB will have established that the international registration includes this verified statement before it sends the request for extension of protection to the United States Patent and Trademark Office (“USPTO”). See TMEP §804.06. The request for extension of protection remains part of the international registration, and ownership is determined by the IB. See TMEP §501.07 regarding assignment of §66(a) applications.

### **1201.01 Claim of Ownership May Be Based on Use By Related Companies**

In an application under §1 of the Trademark Act, an applicant may base its claim of ownership of a trademark or a service mark on:

- (1) its own exclusive use of the mark;
- (2) use of the mark solely by a related company whose use inures to the applicant’s benefit (see TMEP §§1201.03 *et seq.*); or
- (3) use of the mark both by the applicant and by a related company whose use inures to the applicant’s benefit (see TMEP §1201.05).

Where the mark is used by a related company, the owner is the party who controls the nature and quality of the goods sold or services rendered under the mark. The owner is the only proper party to apply for registration. 15 U.S.C. §1051. See TMEP §§1201.03 *et seq.* for additional information about use by related companies.

The examining attorney should accept the applicant’s statement regarding ownership of the mark unless it is clearly contradicted by information in the record. *In re Los Angeles Police Revolver and Athletic Club, Inc.*, 69 USPQ2d 1630 (TTAB 2004).

The Office does not inquire about the relationship between the applicant and other parties named on the specimens or elsewhere in the record, except when the reference to another party clearly contradicts the applicant’s verified statement that it is the owner of the mark or entitled to use the mark.

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

Moreover, where the application states that use of the mark is by a related company or companies, the examining attorney should not require any explanation of how the applicant controls such use.

The above provisions also apply to service marks, collective marks and certification marks, except that, by definition, collective marks and certification marks are not used by the owner of the mark, but are used by others under the control of the owner. 15 U.S.C. §§1053 and 1054. See TMEP §§1303.01, 1304.03 and 1306.01(a).

See TMEP §1201.04 for information about when an examining attorney should issue an inquiry or refusal with respect to ownership.

### **1201.02 Identifying the Applicant in the Application**

#### **1201.02(a) Identifying the Applicant Properly**

The applicant may be any person or entity capable of suing and being sued in a court of law. See TMEP §§803 *et seq.* for the appropriate format for identifying the applicant and setting forth the relevant legal entity. See TMEP §1201.03(a) regarding the form for indicating that the mark is used solely by a related company.

#### **1201.02(b) Application Void if Wrong Party Identified as the Applicant**

An application must be filed by the party who is the owner of (or is entitled to use) the mark as of the application filing date. See TMEP §1201.

An application based on use in commerce under 15 U.S.C. §1051(a) must be filed by the party who owns the mark on the application filing date. If the applicant does not own the mark on the application filing date, the application is *void*. 37 C.F.R. §2.71(d). *Huang v. Tzu Wei Chen Food Co. Ltd.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988).

If the record indicates that the applicant is not the owner of the mark, the examining attorney should refuse registration on that ground. The statutory basis for this refusal is §1 of the Trademark Act, 15 U.S.C. §1051, and, where related company issues are relevant, §§5 and 45, 15 U.S.C. §§1055 and 1127. The examining attorney should not have the filing date cancelled or refund the application filing fee.

In an application under §1(b) or §44 of the Trademark Act, 15 U.S.C. §1051(b) or §1126, the applicant must be entitled to use the mark in commerce on the application filing date, and the application must include a verified statement that the applicant has a bona fide intention to use the mark in commerce. 15 U.S.C. §§1051(b)(3)(A), 1051(b)(3)(B), 1126(d)(2) and 1126(e). When the person designated as the applicant was not the person

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

with a bona fide intention to use the mark in commerce at the time the application was filed, the application is void. *American Forests v. Sanders*, 54 USPQ2d 1860 (TTAB 1999), *aff'd*, 232 F.3d 907 (Fed. Cir. 2000) (intent-to-use application filed by an individual held void, where the entity that had a bona fide intention to use the mark in commerce on the application filing date was a partnership composed of the individual applicant and her husband). However, the examining attorney will not inquire into the bona fides, or good faith, of an applicant's asserted intention to use a mark in commerce during *ex parte* examination, unless there is evidence in the record clearly indicating that the applicant does not have a bona fide intention to use the mark in commerce. See TMEP §1101.

When an application is filed in the name of the wrong party, this defect cannot be cured by amendment or assignment. 37 C.F.R. §2.71(d); TMEP §803.06. However, if the application was filed by the owner, but there was a mistake in the manner in which the applicant's name is set forth in the application, this may be corrected. See TMEP §1201.02(c) for examples of correctable and non-correctable errors.

See TMEP §1201 regarding ownership of a §66(a) application.

### **1201.02(c) Correcting Errors in How the Applicant Is Identified**

If the party applying to register the mark is in fact the owner of the mark, but there is a mistake in the manner in which the name of the applicant is set out in the application, the mistake may be corrected by amendment. *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613 (Comm'r Pats. 1974). However, the application may *not* be amended to designate another entity as the applicant. 37 C.F.R. §2.71(d); TMEP §803.06. An application filed in the name of the wrong party is void and cannot be corrected by amendment. *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689 (TTAB 1991).

The following are examples of correctable errors in identifying the applicant:

- (1) If the applicant identifies itself by a name under which it does business, which is not its name as a legal entity, then amendment to state the applicant's correct legal name is permitted.
- (2) If the applicant mistakenly names an operating division that is not a legal entity as the owner, then the applicant's name may be amended. See TMEP §1201.02(d).
- (3) Clerical errors such as the mistaken addition or omission of "The" or "Inc." in the applicant's name may be corrected by amendment.
- (4) If the record is ambiguous as to who owns the mark, *e.g.*, an individual and a corporation are each identified as the owner in



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

different places in the application, the application may be amended to indicate the proper applicant.

- (5) If the owner of a mark legally changed its name before filing an application, but mistakenly lists its former name on the application, the error may be corrected because the correct party filed, but merely identified itself incorrectly. *In re Techsonic Industries, Inc.*, 216 USPQ 619 (TTAB 1982).
- (6) If an applicant has been identified as “A and B, doing business as The AB Company, a partnership,” and the true owner is a partnership organized under the name The AB Company and composed of A and B, the applicant’s name should be amended to “The AB Company, a partnership composed of A and B.”
- (7) If an applicant has been identified as “ABC Corporation, formerly known as XYZ, Inc.,” and the correct entity is “XYZ, Inc.,” the applicant’s name may be amended to “XYZ, Inc.,” as long as “ABC Corporation, formerly known as XYZ, Inc.” was not a different existing legal entity. *Cf. Custom Computer Services Inc. v. Paychex Properties Inc.*, 337 F.3d 1334, 67 USPQ2d 1638, 1640 (Fed. Cir. 2003).

To correct an obvious mistake of this nature, a verification or declaration is not normally necessary.

The following are examples of non-correctable errors in identifying the applicant:

- (1) If the president of a corporation is identified as the owner of the mark when in fact the corporation owns the mark, the application is void as filed because the applicant is not the owner of the mark.
- (2) If an application is filed in the name of entity A, when the mark was assigned to entity B before the application filing date, the application is void as filed because the applicant was not the owner of the mark at the time of filing. *Huang v. Tzu Wei Chen Food Co. Ltd.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988) (application filed by an individual two days after ownership of the mark was transferred to a newly formed corporation held void).
- (3) If the application is filed in the name of a joint venturer when the mark is owned by the joint venture, the applicant’s name cannot be amended. *In re Tong Yang Cement Corp.*, *supra*.
- (4) If an application is filed in the name of corporation A and a sister corporation (corporation B) owns the mark, the application is void as filed because the applicant is not the owner of the mark.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1201.02(d) Operating Divisions**

An operating division that is not a legal entity that can sue and be sued does not have standing to own a mark or to file an application to register a mark. The application must be filed in the name of the company of which the division is a part. *In re Cambridge Digital Systems*, 1 USPQ2d 1659, 1660 n.1 (TTAB 1986). An operating division's use is considered to be use by the applicant and not use by a related company; therefore, reference to related-company use is permissible but not necessary.

### **1201.02(e) Changes in Ownership After Application Is Filed**

See TMEP Chapter 500 regarding changes of ownership and changes of name subsequent to filing an application for registration, and TMEP §§502.02 *et seq.* regarding the procedure for requesting that a certificate of registration be issued in the name of an assignee or in an applicant's new name.

### **1201.03 Use by Related Companies**

Section 5 of the Trademark Act, 15 U.S.C. §1055, states, in part, as follows:

Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration, and such use shall not affect the validity of such mark or of its registration, provided such mark is not used in such manner as to deceive the public.

Section 45 of the Act, 15 U.S.C. §1127, defines "related company" as follows:

The term "related company" means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.

Thus, §5 of the Act permits applicants for registration to rely on use of the mark by related companies. Either a natural person or a juristic person may be a related company. 15 U.S.C. §1127.

The essence of related-company use is the control exercised over the nature and quality of the goods or services on or in connection with which the mark is used. When a mark is used by a related company, use of the mark inures to the benefit of the party who controls the nature and quality of the goods or services. This party is the owner of the mark and, therefore, is the only party that may apply to register the mark. *Smith International, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981).

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

Reliance on related-company use requires, *inter alia*, that the related company use the mark in connection with the same goods or services recited in the application. *In re Admark, Inc.*, 214 USPQ 302 (TTAB 1982) (related company use not at issue where the applicant sought registration of a mark for advertising agency services and the purported related company used the mark for retail store services).

A related company is different from a successor in interest who is in privity with the predecessor in interest for purposes of determining the right to register. *Wells Cargo, Inc. v. Wells Cargo, Inc.*, 197 USPQ 569 (TTAB 1977), *aff'd*, 606 F.2d 961, 203 USPQ 564 (C.C.P.A. 1979).

See TMEP §1201.03(c) regarding wholly owned related companies, §1201.03(d) regarding corporations with common stockholders, directors or officers, §1201.03(e) regarding sister corporations, and §1201.03(f) regarding license and franchise situations.

### **1201.03(a) Use Solely by Related Company Must be Disclosed**

If the mark is not being used by the applicant but is being used by one or more related companies whose use inures to the benefit of the applicant under §5 of the Act, then these facts must be disclosed in the application. 37 C.F.R. §2.38(b). See *Pease Woodwork Co., Inc. v. Ready Hung Door Co., Inc.*, 103 USPQ 240 (Comm'r Pats. 1954); *Industrial Abrasives, Inc. v. Strong*, 101 USPQ 420 (Comm'r Pats. 1954). Use that inures to the applicant's benefit is a proper and sufficient support for an application and satisfies the requirement of 37 C.F.R. §2.33(b)(1) that a §1(a) application specify that the *applicant* has adopted and is using the mark.

The party who controls the nature and quality of the goods or services on or in connection with which the mark is used should be set forth as the applicant. In an application under §1(a) of the Trademark Act, the applicant should state in the body of the application that the applicant has adopted and is using the mark *through its related company* (or equivalent explanatory wording). In a §1(b) application, the statement that the applicant is using the mark through a related company should be included in the amendment to allege use under 15 U.S.C. §1051(c) (see TMEP §§1104 *et seq.*) or statement of use under 15 U.S.C. §1051(d) (see TMEP §§1109 *et seq.*).

The applicant is not required to give the name of the related-company user unless it is necessary to explain information in the record that clearly contradicts the applicant's verified claim of ownership of the mark.

The applicant may claim the benefit of use by a related company in an amendment to the application. *Greyhound Corp. v. Armour Life Insurance Co.*, 214 USPQ 473, 475 (TTAB 1982).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If the applicant and a related company both use the mark, and it is the applicant's own use of the mark that is relied on in the application, then the applicant does not have to include a reference to use by a related company in the application. See TMEP §1201.05.

### **1201.03(b) No Explanation of Applicant's Control Over Use of Mark by Related Companies Required**

Where the application states that use of the mark is by a related company or companies, the Office does not require an explanation of how the applicant controls the use of the mark.

Similarly, the Office does not inquire about the relationship between the applicant and other parties named on the specimens or elsewhere in the record, except when the reference to another party clearly contradicts the applicant's verified statement that it is the owner of the mark or entitled to use the mark. See TMEP §1201.04.

### **1201.03(c) Wholly Owned Related Companies**

Related-company use includes situations where a wholly owned related company of the applicant uses the mark or the applicant is wholly owned by a related company that uses the mark.

Frequently, related companies comprise parent and wholly owned subsidiary corporations. Either a parent corporation or a subsidiary corporation may be the proper applicant, depending on the facts concerning ownership of the mark. The Office will consider the filing of the application in the name of either the parent or the subsidiary to be the expression of the intention of the parties as to ownership in accord with the arrangements between them.

Either an individual or a juristic entity may own a mark that is used by a wholly owned related company. See *In re Hand*, 231 USPQ 487 (TTAB 1986).

### **1201.03(d) Common Stockholders, Directors or Officers**

Corporations are not "related companies" within the meaning of §5 of the Trademark Act, 15 U.S.C. §1055, merely because they have the same stockholders, directors or officers, or because they occupy the same premises. *In re Raven Marine, Inc.*, 217 USPQ 68, 69 (TTAB 1983) (statement that both the applicant corporation and the corporate user of the mark have the same principal stockholder and officer held insufficient to show that the user is a related company).

If an individual applicant is not the sole owner of the corporation that is using the mark, the question of whether the corporation is a "related company" depends on whether the applicant maintains control over the nature and

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

quality of the goods or services such that use of the mark inures to the applicant's benefit. A formal written licensing agreement between the parties is not necessary, nor is its existence sufficient to establish ownership rights. The critical question is whether the applicant sufficiently controls the nature and quality of the goods or services with which the mark is used. See *Pneutek, Inc. v. Scherr*, 211 USPQ 824 (TTAB 1981) (detailed written agreement and substantial evidence in the record indicating that the applicant, an individual, exercised control over the nature and quality of the goods sold under the mark by the user corporation held sufficient to show that the corporation was a related company).

Similarly, where an individual applicant is not the sole owner of the corporation that is using the mark, the fact that the individual applicant is a stockholder, director or officer in the corporation is insufficient in itself to establish that the corporation is a related company. The question depends on whether the applicant maintains control over the nature and quality of the goods or services.

See TMEP §1201.03(c) regarding use by wholly owned related companies.

### **1201.03(e) Sister Corporations**

The fact that two sister corporations are controlled by a single parent corporation does not mean that they are related companies. Where two corporations are wholly owned subsidiaries of a common parent, use by one sister corporation is not considered to inure to the benefit of the other unless the applicant sister corporation exercises appropriate control over the nature and quality of the goods or services on or in connection with which the mark is used. *In re Pharmacia Inc.*, 2 USPQ2d 1883 (TTAB 1987); *Greyhound Corp. v. Armour Life Insurance Co.*, 214 USPQ 473 (TTAB 1982).

See TMEP §1201.03(c) regarding use by wholly owned related companies.

### **1201.03(f) License and Franchise Situations**

The Office accepts applications by parties who claim to be owners of marks through use by controlled licensees, pursuant to a contract or agreement. *Pneutek, Inc. v. Scherr*, 211 USPQ 824, 833 (TTAB 1981).

A controlled licensing agreement may be recognized whether oral or in writing. *In re Raven Marine, Inc.*, 217 USPQ 68, 69 (TTAB 1983).

If the application indicates that use of the mark is pursuant to a license or franchise agreement, and the record contains nothing that contradicts the assertion of ownership by the applicant (*i.e.*, the licensor or franchisor), the examining attorney will not inquire about the relationship between the applicant and the related company (*i.e.*, the licensee or franchisee).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Ownership rights in a trademark or service mark may be acquired and maintained through the use of the mark by a controlled licensee even when the only use of the mark has been made, and is being made, by the licensee. *Turner v. HMH Publishing Co., Inc.*, 380 F.2d 224, 154 USPQ 330, 334 (5<sup>th</sup> Cir. 1967), *cert. denied*, 389 U.S. 1006, 156 USPQ 720 (1967); *Central Fidelity Banks, Inc. v. First Bankers Corp. of Florida*, 225 USPQ 438, 440 (TTAB 1984) (use of the mark by petitioner's affiliated banks considered to inure to the benefit of petitioner bank holding company, even though the bank holding company could not legally render banking services and thus could not use the mark).

Joint applicants enjoy rights of ownership to the same extent as any other "person" who has a proprietary interest in a mark. Therefore, joint applicants may license others to use a mark and, by exercising sufficient control and supervision of the nature and quality of the goods or services to which the mark is applied, the joint applicants/licensors may claim the benefits of the use by the related company/licensee. *In re Diamond Walnut Growers, Inc. and Sunsweet Growers Inc.*, 204 USPQ 507 (TTAB 1979).

Stores that are operating under franchise agreements from another party are considered "related companies" of that party, and use of the mark by the franchisee/store inures to the benefit of the franchisor. *Mr. Rooter Corp. v. Morris*, 188 USPQ 392, 394 (E.D. La. 1975); *Southland Corp. v. Schubert*, 297 F. Supp. 477, 160 USPQ 375, 381 (C.D. Cal. 1968).

In all franchise and license situations, the key to ownership is the nature and extent of the control by the applicant of the goods or services to which the mark is applied. A trademark owner who fails to exercise sufficient control over licensees or franchisees may be found to have abandoned its rights in the mark. See *Hurricane Fence Co. v. A-1 Hurricane Fence Co. Inc.*, 468 F. Supp. 975, 208 USPQ 314, 325-27 (S.D. Ala. 1979).

In general, where the application states that a mark is used by a licensee or franchisee, the Office does not require an explanation of how the applicant controls the use. See TMEP §1201.03(b).

### **1201.04 Inquiry Regarding Parties Named on Specimens or Elsewhere in Record**

The Office does not inquire about the relationship between the applicant and other parties named on the specimens or elsewhere in the record, except when the reference to another party clearly contradicts the applicant's verified statement that it is the owner of the mark or entitled to use the mark.

The examining attorney should inquire about another party if the record specifically states that another party is the owner of the mark, or if the record specifically identifies the applicant in a manner that contradicts the claim of ownership, for example, as a licensee. In these circumstances, registration

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

should be refused under §1 of the Trademark Act, on the ground that the applicant is not the owner of the mark. Similarly, when the record indicates that the applicant is a United States distributor, importer or other distributing agent for a foreign manufacturer, the examining attorney should require the applicant to establish its ownership rights in the United States in accordance with TMEP §1201.06(a).

Where the specimen of use indicates that the goods are manufactured in a country other than the applicant's home country, the examining attorney normally should not inquire whether the mark is used by a foreign manufacturer. See TMEP §1201.06(b). Also, where the application states that use of the mark is by related companies, an explanation of how the applicant controls use of the mark by the related companies is not required. See TMEP §1201.03(b).

### **1201.05            Acceptable Claim of Ownership Based on Applicant's Own Use**

An applicant's claim of ownership of a mark may be based on the applicant's own use of the mark, even though there is also use by a related company. The applicant is the owner by virtue of the applicant's own use, and the application does not have to refer to use by a related company.

An applicant may claim ownership of a mark when the mark is applied on the applicant's instruction. For example, if the applicant contracts with another party to have goods produced for the applicant and instructs the party to place the mark on the goods, that is the equivalent of the applicant itself placing the mark on its own goods and reference to related-company use is not necessary.

### **1201.06            Special Situations Pertaining to Ownership**

#### **1201.06(a)        Applicant Is Merely Distributor or Importer**

A distributor, importer or other distributing agent of the goods of a manufacturer or producer does not acquire a right of ownership in the manufacturer's or producer's mark merely because it moves the goods in trade. *In re Bee Pollen from England Ltd.*, 219 USPQ 163 (TTAB 1983); *Audioson Vertriebs - GmbH v. Kirksaeter AudioSonics, Inc.*, 196 USPQ 453 (TTAB 1977); *Jean D'Albret v. Henkel-Khasana G.m.b.H.*, 185 USPQ 317 (TTAB 1975); *In re Lettmann*, 183 USPQ 369 (TTAB 1974); *Bakker v. Steel Nurse of America Inc.*, 176 USPQ 447 (TTAB 1972). A party that merely distributes goods bearing the mark of a manufacturer or producer is neither the owner nor a related-company user of the mark.

If the applicant merely distributes or imports goods for the owner of the mark, registration must be refused under §1 of the Trademark Act, *except* in the following situations:

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- (1) If a parent and wholly owned subsidiary relationship exists between the distributor and the manufacturer, then the applicant's statement that such a relationship exists disposes of an ownership issue. See TMEP §1201.03(c).
- (2) If an applicant is the United States importer or distribution agent for a foreign manufacturer, then the applicant can register the foreign manufacturer's mark in the United States, if the applicant submits one of the following:
  - (a) written consent from the owner of the mark to registration in the applicant's name, or
  - (b) written agreement or acknowledgment between the parties that the importer or distributor is the owner of the mark in the United States, or
  - (c) an assignment (or true copy) to the applicant of the owner's rights in the mark as to the United States together with the business and good will appurtenant thereto.

See *In re Pharmacia Inc.*, 2 USPQ2d 1883 (TTAB 1987); *In re Geo. J. Ball, Inc.*, 153 USPQ 426 (TTAB 1967).

### **1201.06(b) Goods Manufactured in a Country Other than Where Applicant Is Located**

Where a specimen of use indicates that the goods are manufactured in a country other than the applicant's home country, the examining attorney normally should not inquire whether the mark is used by a foreign manufacturer. If, however, information in the record clearly contradicts the applicant's verified claim of ownership (e.g., a statement in the record that the mark is owned by the foreign manufacturer and that the applicant is only an importer or distributor), then registration must be refused under §1, 15 U.S.C. §1051, unless registration in the United States by the applicant is supported by the applicant's submission of one of the documents listed in TMEP §1201.06(a).

### **1201.07 Related Companies and Likelihood of Confusion**

#### **1201.07(a) "Single Source" -- "Unity of Control"**

Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), requires that the examining attorney refuse registration when an applicant's mark, as applied to the specified goods or services, so resembles a registered mark as to be likely to cause confusion. In general, registration of confusingly similar marks to separate legal entities is barred by §2(d). See, e.g., *In re Citibank, N.A.*, 225 USPQ 612 (TTAB 1985); *In re Champion International Corp.*, 220 USPQ



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

478 (TTAB 1982); *In re Air Products, Inc.*, 124 USPQ 81 (TTAB 1960). However, the Court of Appeals for the Federal Circuit has held that, where the applicant is related in ownership to a company that owns a registered mark that would otherwise give rise to a likelihood of confusion, the examining attorney must consider whether, in view of all the circumstances, use of the mark by the applicant is likely to confuse the public about the source of the applicant's goods because of the resemblance of the applicant's mark to the mark of the other company. The Court stated that:

The question is whether, despite the similarity of the marks and the goods on which they are used, the public is likely to be confused about the source of the hair straightening products carrying the trademark "WELLAstrate." In other words, is the public likely to believe that the source of the product is Wella U.S. rather than the German company or the Wella organization.

*In re Wella A.G.*, 787 F.2d 1549, 1552, 229 USPQ 274, 276 (Fed. Cir. 1986). The Court remanded the case to the Board for consideration of the likelihood of confusion issue.

In ruling on that issue, the Board concluded that there was no likelihood of confusion, stating as follows:

[A] determination must be made as to whether there exists a likelihood of confusion as to *source*, that is, whether purchasers would believe that particular goods or services emanate from a single source, when in fact those goods or services emanate from more than a single source. Clearly, the Court views the concept of "source" as encompassing more than "legal entity." Thus, in this case, we are required to determine whether Wella A.G. and Wella U.S. are the same source or different sources....

The existence of a related company relationship between Wella U.S. and Wella A.G. is not, in itself, a basis for finding that any "WELLA" product emanating from either of the two companies emanates from the same source. Besides the existence of a legal relationship, there must also be a unity of control over the use of the trademarks. "Control" and "source" are inextricably linked. If, notwithstanding the legal relationship between entities, each entity exclusively controls the nature and quality of the goods to which it applies one or more of the various "WELLA" trademarks, the two entities are in fact separate sources. Wella A.G. has made of record a declaration of the executive vice president of Wella U.S., which declaration states that Wella A.G. owns substantially all the outstanding stock of Wella U.S. and "thus controls the activities and operations of Wella U.S., including the selection, adoption and use of the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

trademarks.” While the declaration contains no details of how this control is exercised, the declaration is sufficient, absent contradictory evidence in the record, to establish that control over the use of all the “WELLA” trademarks in the United States resides in a single source.

*In re Wella A.G.*, 5 USPQ2d 1359, 1361 (TTAB 1987) (emphasis in original), *rev'd on other grounds*, 858 F.2d 725, 8 USPQ2d 1365 (Fed. Cir. 1988).

Therefore, in some limited circumstances, the close relationship between related companies will obviate any likelihood of confusion in the public mind because the related companies constitute a single source. See TMEP §§1201.07(b) *et seq.* for further information.

### **1201.07(b) Appropriate Action with Respect to Assertion of Unity of Control**

First, it is important to note that analysis under *Wella* is not triggered until an applicant affirmatively asserts that a §2(d) refusal is inappropriate because the applicant and the registrant, though separate legal entities, constitute a single source, or the applicant raises an equivalent argument. Examining attorneys should issue §2(d) refusals in any case where an analysis of the marks and the goods or services of the respective parties indicates a bar to registration under §2(d). The examining attorney should not attempt to analyze the relationship between an applicant and registrant until an applicant, in some form, relies on the nature of the relationship to obviate a refusal under §2(d).

Once an applicant has made this assertion, the question is whether the specific relationship is such that the two entities constitute a “single source,” so that there is no likelihood of confusion. The following guidelines may assist the examining attorney in resolving questions of likelihood of confusion when the marks are owned by related companies and the applicant asserts unity of control. (Of course, in many of these situations, the applicant may choose to attempt to overcome the §2(d) refusal by submitting a consent agreement or other conventional evidence to establish no likelihood of confusion. See *In re Sumitomo Electric Industries, Ltd.*, 184 USPQ 365 (TTAB 1974). Another way to overcome a §2(d) refusal is to assign all relevant registrations to the same party.)

### **1201.07(b)(i) When Either Applicant or Registrant Owns All of the Other Entity**

If the applicant or the applicant’s attorney represents that *either* the applicant or the registrant owns *all* of the other entity, and there is no contradictory evidence, then the examining attorney should conclude that there is unity of control, a single source and no likelihood of confusion. This would apply to

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

an individual who owns all the stock of a corporation, and to a corporation and a wholly owned subsidiary. In this circumstance, additional representations or declarations should generally *not* be required, absent contradictory evidence.

### **1201.07(b)(ii) When Either Applicant or Registrant Owns Substantially All of the Other Entity**

In *Wella*, the applicant provided a declaration stating that the applicant owned *substantially all* of the stock of the registrant and that the applicant thus controlled the activities of the registrant, including the selection, adoption and use of trademarks. The Board concluded that this declaration alone, absent contradictory evidence, established unity of control, a single source and no likelihood of confusion. Therefore, if *either* the applicant or the registrant owns substantially all of the other entity and asserts control over the activities of the other entity, including its trademarks, and there is no contradictory evidence, the examining attorney should conclude that unity of control is present, that the entities constitute a single source, and that there is no likelihood of confusion under §2(d). In such a case the applicant should generally provide these assertions in the form of an affidavit or declaration under 37 C.F.R. §2.20.

### **1201.07(b)(iii) When the Record Does Not Support a Presumption of Unity of Control**

If neither the applicant nor the registrant owns all or substantially all of the other entity, the applicant bears a more substantial burden to establish that unity of control is present. For instance, if both the applicant and the registrant are wholly owned by a third common parent, the applicant would have to provide detailed evidence to establish how one sister corporation controlled the trademark activities of the other to establish unity of control to support the contention that the sister corporations constitute a single source. See *In re Pharmacia Inc.*, 2 USPQ2d 1883 (TTAB 1987); *Greyhound Corp. v. Armour Life Ins. Co.*, 214 USPQ 473 (TTAB 1982). Likewise, where an applicant and registrant have certain stockholders, directors or officers in common, the applicant must demonstrate with detailed evidence or explanation how those relationships establish unity of control. See *Pneutek, Inc. v. Scherr*, 211 USPQ 824 (TTAB 1981). The applicant's evidence or explanation should generally be supported by an affidavit or a declaration under 37 C.F.R. §2.20.

### **1201.07(b)(iv) When the Record Contradicts an Assertion of Unity of Control**

In contrast to those circumstances where the relationship between the parties may support a presumption of unity of control or at least afford an applicant the opportunity to demonstrate unity of control, some relationships, by their

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

very nature, contradict any claim that unity of control is present. For instance, if the relationship between the parties is that of licensor and licensee, unity of control will ordinarily not be present. The licensing relationship suggests ownership in one party and control by that one party over only the use of a specific mark or marks, but not over the operations or activities of the licensee generally. Thus, there is no unity of control and no basis for concluding that the two parties form a single source. Precisely because unity of control is absent, a licensing agreement is necessary. The licensing agreement enables the licensor/owner to control specific activities to protect its interests as the sole source or sponsor of the goods or services provided under the mark. Therefore, in these situations, it is most unlikely that an applicant could establish unity of control to overcome a §2(d) refusal.

### **1202 Use of Subject Matter as Trademark**

In an application under §1 of the Act, the examining attorney must determine whether the subject matter for which registration is sought is used as a trademark by reviewing all evidence (e.g., the specimens of use and any promotional material) of record in the application. See *In re Safariland Hunting Corp.*, 24 USPQ2d 1380 (TTAB 1992) (examining attorney should look primarily to specimens to determine whether a designation would be perceived as a source indicator, but may also consider other evidence, if there is other evidence of record).

Not everything that a party adopts and uses with the intent that it function as a trademark necessarily achieves this goal or is legally capable of doing so, and not everything that is recognized or associated with a party is necessarily a registrable trademark. As the Court of Customs and Patent Appeals observed in *In re Standard Oil Co.*, 275 F.2d 945, 947, 125 USPQ 227, 229 (C.C.P.A. 1960):

The Trademark Act is not an act to register words but to register trademarks. Before there can be registrability, there must be a trademark (or a service mark) and, unless words have been so used, they cannot qualify for registration. Words are not registrable *merely* because they do not happen to be descriptive of the goods or services with which they are associated.

Sections 1 and 2 of the Trademark Act, 15 U.S.C. §§1051 and 1052, require that the subject matter presented for registration be a “trademark.” Section 45 of the Act, 15 U.S.C. §1127, defines that term as follows:

The term “trademark” includes any word, name, symbol, or device, or any combination thereof--

- (1) used by a person, or

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

Thus, §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, provide the statutory basis for refusal to register on the Principal Register subject matter that, due to its inherent nature or the manner in which it is used, does not function as a mark to identify and distinguish the applicant's goods. The statutory basis for refusal of registration on the Supplemental Register of matter that does not function as a trademark because it does not fit within the statutory definition of a trademark is §§23 and 45, 15 U.S.C. §§1091 and 1127.

When the examining attorney refuses registration on the ground that the subject matter is not used as a trademark, the examining attorney should explain the specific reason for the conclusion that the subject matter is not used as a trademark. See TMEP §§1202.01 *et seq.* for a discussion of situations in which it may be appropriate, depending on the circumstances, for the examining attorney to refuse registration on the ground that the asserted trademark does not function as a trademark, *e.g.*, TMEP §§1202.01 (trade names), 1202.02(a) *et seq.* (functionality), 1202.03 (ornamentation), 1202.04 (informational matter), 1202.05 (color marks), 1202.06 (goods in trade), 1202.07 (columns or sections of publications), 1202.08 (title of single creative work), 1202.09 (names of artists and authors), 1202.10 (model or grade designations), 1202.11 (background designs and shapes), 1202.12 (varietal and cultivar names).

The presence of the letters "SM" or "TM" cannot transform an otherwise unregistrable designation into a mark. *In re Remington Products Inc.*, 3 USPQ2d 1714 (TTAB 1987); *In re Anchor Hocking Corp.*, 223 USPQ 85 (TTAB 1984); *In re Minnetonka, Inc.*, 212 USPQ 772 (TTAB 1981).

See TMEP §§1301.02 *et seq.* regarding use of subject matter as a service mark; TMEP §§1302 through 1304 regarding use of subject matter as a collective mark; and TMEP §1306 regarding use of subject matter as a certification mark.

### **1202.01 Refusal of Matter Used Solely as a Trade Name**

The name of a business or company is a trade name. The Trademark Act distinguishes trade names from trademarks by definition. While a trademark is used to identify and distinguish the trademark owner's goods from those manufactured or sold by others and to indicate the source of the goods, "trade name" and "commercial name" are defined in §45 of the Act, 15 U.S.C. §1127, as follows:

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The terms “trade name” and “commercial name” mean any name used by a person to identify his or her business or vocation.

The Trademark Act does not provide for registration of trade names. See *In re Letica Corp.*, 226 USPQ 276, 277 (TTAB 1985) (“[T]here was a clear intention by the Congress to draw a line between indicia which perform only trade name functions and indicia which perform or also perform the function of trademarks or service marks.”).

If the examining attorney determines that matter for which registration is requested is merely a trade name, registration must be refused both on the Principal Register and on the Supplemental Register. The statutory basis for refusal of trademark registration on the ground that the matter is used merely as a trade name is §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127, and, in the case of matter sought to be registered for services, §§1, 3, and 45, 15 U.S.C. §§1051, 1053 and 1127.

A designation may function as both a trade name and a trademark or service mark. See *In re Walker Process Equipment Inc.*, 233 F.2d 329, 332, 110 USPQ 41, 43 (C.C.P.A. 1956), *aff’g* 102 USPQ 443 (Comm’r Pats. 1954).

If subject matter presented for registration in an application is a trade name or part of a trade name, the examining attorney must determine whether it is also used as a trademark or service mark by examining the specimens and other evidence of record in the application file. See *In re Diamond Hill Farms*, 32 USPQ2d 1383 (TTAB 1994) (DIAMOND HILL FARMS, as used on containers for goods, found to be a tradename that identifies applicant as a business entity rather than a mark that identifies applicant’s goods and distinguishes them from those of others).

Whether matter that is a trade name (or a portion thereof) also performs the function of a trademark depends on the manner of its use and the probable impact of the use on customers. See *In re Unclaimed Salvage & Freight Co., Inc.*, 192 USPQ 165, 168 (TTAB 1976) (“It is our opinion that the foregoing material reflects use by applicant of the notation ‘UNCLAIMED SALVAGE & FREIGHT CO.’ merely as a commercial, business, or trade name serving to identify applicant as a viable business entity; and that this is or would be the general and likely impact of such use upon the average person encountering this material under normal circumstances and conditions surrounding the distribution thereof.”); *In re Lytle Engineering & Mfg. Co.*, 125 USPQ 308 (TTAB 1960) (“LYTLE’ is applied to the container for applicant’s goods in a style of lettering distinctly different from the other portion of the trade name and is of such nature and prominence that it creates a separate and independent impression.”)

The presence of an entity designator in a name sought to be registered and the proximity of an address are both factors to be considered in determining

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

whether a proposed mark is merely a trade name. *In re Univar Corp.*, 20 USPQ2d 1865, 1869 (TTAB 1991) (“[T]he mark “UNIVAR” independently projects a separate commercial impression, due to its presentation in a distinctively bolder, larger and different type of lettering and, in some instances, its additional use in a contrasting color, and thus does more than merely convey information about a corporate relationship.”) See also *Book Craft, Inc. v. BookCrafters USA, Inc.*, 222 USPQ 724, 727 (TTAB 1984) (“That the invoices ... plainly show ... service mark use is apparent from the fact that, not only do the words ‘BookCrafters, Inc.’ appear in larger letters and a different style of print than the address, but they are accompanied by a design feature (the circularly enclosed ends of two books).”).

A determination of whether matter serves solely as a trade name rather than as a mark requires consideration of the way the mark is used, as evidenced by the specimens. Therefore, no refusal on that ground will be issued in an intent-to-use application until the applicant has submitted specimens of use in conjunction with either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d).

### **1202.02 Registration of Trade Dress**

When an applicant applies to register a product’s design, product packaging, color, or other trade dress for goods or services, the examining attorney must consider two issues: (1) functionality; and (2) distinctiveness. See *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1004-1005 (2001); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 775, 23 USPQ2d 1081, 1086 (1992) (only nonfunctional distinctive trade dress is protected). See TMEP §§1202.02(a) *et seq.* regarding functionality, TMEP §§1202.02(b) and 1212 *et seq.* regarding distinctiveness, and TMEP §1202.02(c) regarding separate treatment of the two issues procedurally. With respect to the functionality and distinctiveness issues in the specific context of color as a mark, see TMEP §§1202.05 and 1202.05(f).

#### **1202.02(a) Functionality**

##### **1202.02(a)(i) Statutory Basis for Functionality Refusal**

Before October 30, 1998, there was no specific statutory reference to functionality as a ground for refusal, and functionality refusals were thus issued as failure-to-function refusals under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127.

Effective October 30, 1998, the Technical Corrections to Trademark Act of 1946, Pub. L. No. 105-330, §201, 112 Stat. 3064, 3069, amended the Trademark Act to expressly prohibit registration on either the Principal or Supplemental Register of matter that is functional:

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- Section 2(e)(5) of the Trademark Act, 15 U.S.C. §1052(e)(5), prohibits registration on the Principal Register of “matter that, as a whole, is functional.”
- Section 2(f) of the Act, 15 U.S.C. §1052(f), provides that matter that, as a whole, is functional may not be registered even on a showing that it has become distinctive.
- Section 23(c) of the Act, 15 U.S.C. §1091(c), provides that a mark that, as a whole, is functional may not be registered on the Supplemental Register.
- Section 14(3) of the Act, 15 U.S.C. §1064(3), lists functionality as a ground that can be raised in a cancellation proceeding more than five years after the date of registration.
- Section 33(b)(8) of the Act, 15 U.S.C. §1115(b)(8), lists functionality as a statutory defense to infringement in a suit involving an incontestable registration.

These amendments codified case law and the longstanding Office practice of refusing registration of matter that is functional.

### **1202.02(a)(ii) Purpose of Functionality Doctrine**

The functionality doctrine, which prohibits registration of functional product features, is intended to encourage legitimate competition by maintaining the proper balance between trademark law and patent law. As the Supreme Court explained, in *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 164, 34 USPQ2d 1161, 1163 (1995):

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm’s reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, 35 U.S.C. §§154, 173, after which competitors are free to use the innovation. If a product’s functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).

In other words, the functionality doctrine ensures that protection for utilitarian product features be properly sought through a limited-duration utility patent, and not through the potentially unlimited protection of a trademark registration. Upon expiration of a utility patent, the invention covered by the



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

patent enters the public domain, and the functional features disclosed in the patent may then be copied by others – thus encouraging advances in product design and manufacture. In *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 34-35, 58 USPQ2d 1001, 1007 (2001), the Supreme Court reiterated this rationale, also noting that the functionality doctrine is not affected by evidence of acquired distinctiveness:

The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity. The Lanham Act, furthermore, does not protect trade dress in a functional design simply because an investment has been made to encourage the public to associate a particular functional feature with a single manufacturer or seller.

Thus, even where the evidence establishes that consumers have come to associate a functional product feature with a single source, trademark protection will not be granted in light of the public policy reasons just stated. *Id.*

### **1202.02(a)(iii) Definitions**

#### **1202.02(a)(iii)(A) Functionality**

Functional matter cannot be protected as trade dress or a trademark. 15 U.S.C. §§1052(e)(5) and (f), 1091(c), 1064(3), and 1115(b). A feature is functional as a matter of law if it is “essential to the use or purpose of the product or if it affects the cost or quality of the product.” *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001); *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-64 (1995); *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850, 214 USPQ 1, 4 n.10 (1982).

While some courts had developed a definition of functionality that focused solely on “competitive need” – thus finding a particular product feature functional only if competitors needed to copy that design in order to compete effectively – the Supreme Court held that this “was incorrect as a comprehensive definition” of functionality. *TrafFix*, 532 U.S. at 33, 58 USPQ2d at 1006. The Court emphasized that where a product feature meets the traditional functionality definition – that is, it is essential to the use or purpose of the product or affects the cost or quality of the product – then the feature is functional. *Id.* However, an inquiry into competitive need for the product design or feature at issue may be appropriate in cases where the mark sought to be registered is a color or other matter that does not easily fit within the “utilitarian” definition of functionality. *Id.* at 1006-07 (stating that inquiring into the issue of “significant non-reputation-related disadvantage” (*i.e.*, competitive need) would be appropriate in cases of “aesthetic

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

functionality,” such as *Qualitex*). See TMEP §§1202.02(a)(iii)(C) and 1202.05 regarding the issues of “aesthetic functionality” and color as a mark.

The determination that a proposed mark is functional constitutes, for public policy reasons, an absolute bar to registration on either the Principal Register or the Supplemental Register – regardless of evidence showing that the proposed mark has acquired distinctiveness. *TrafFix*, 532 U.S. at 29, 58 USPQ2d at 1006. See also *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422 (Fed. Cir. 2002); *In re Controls Corp. of America*, 46 USPQ2d 1308, 1311 (TTAB 1998).

See TMEP §§1202.02(a)(v) *et seq.* regarding evidentiary considerations pertaining to functionality refusals.

### **1202.02(a)(iii)(B) “De Jure” and “De Facto” Functionality**

Prior to 2002, the Office used the terms “*de facto*” and “*de jure*” in assessing whether “subject matter” (usually a product feature or the configuration of the goods) presented for registration was functional. This distinction originated with the Court of Customs and Patent Appeals’ *Morton-Norwich* decision, which was discussed by the Federal Circuit in *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1425 (Fed. Cir. 2002):

Our decisions distinguish *de facto* functional features, which may be entitled to trademark protection, from *de jure* functional features, which are not. ‘In essence, *de facto* functional means that the design of a product has a function, *i.e.*, a bottle of any design holds fluid.’ *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484, 222 USPQ 1, 3 (Fed. Cir. 1984). *De facto* functionality does not necessarily defeat registrability. *Morton-Norwich*, 671 F.2d [1332,] at 1337, 213 USPQ [9] at 13 [(C.C.P.A. 1982)] (A design that is *de facto* functional, *i.e.*, ‘functional’ in the lay sense ... may be legally recognized as an indication of source.’). *De jure* functionality means that the product has a particular shape ‘because it works better in this shape.’ *Smith*, 734 F.2d at 1484, 222 USPQ at 3.

However, in three Supreme Court decisions involving functionality - *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161 (1995), *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000), and *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001) - the Court did not use the “*de facto/de jure*” distinction. Nor were these terms used when the Trademark Act was amended to expressly prohibit registration of matter that is “functional.” Technical Corrections to Trademark Act of 1946, Pub. L. No. 105-330, §201, 112 Stat. 3064, 3069 (1998). Accordingly, in general, examining attorneys no longer make this distinction in Office actions which refuse registration based on functionality.

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

*De facto* functionality is not a ground for refusal. *In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1282 (TTAB 2000); *In re Parkway Machine Corp.*, 52 USPQ2d 1628, 1631 n.4 (TTAB 1999).

### 1202.02(a)(iii)(C) Aesthetic Functionality

The concept of “aesthetic functionality” (as opposed to “utilitarian functionality”) has for many years been the subject of much confusion as to its precise meaning, as well as whether it is even a viable legal principle. While the Court of Customs and Patent Appeals (the predecessor to the Court of Appeals for the Federal Circuit) appeared to reject the doctrine of aesthetic functionality in *In re DC Comics, Inc.*, 689 F.2d 1042, 215 USPQ 394 (C.C.P.A. 1982), the Supreme Court later referred to aesthetic functionality as a valid legal concept in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001). In discussing the proper definition of “functionality,” the Court distinguished its previous decision in *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161 (1995), specifically contrasting the fact that, unlike the issue currently before the Court, in *Qualitex* “aesthetic functionality was the central question, there having been no indication that the green-gold color of the laundry press pad had any bearing on the use or purpose of the product or its cost or quality.” *TrafFix*, 532 U.S. at 33, 58 USPQ2d at 1006-07. Although the references to aesthetic functionality in the *TrafFix* decision are *dicta*, the Court’s use of this terminology appears to indicate that the concept of aesthetic functionality – at least when used properly – is a viable legal principle.

The confusion regarding this concept stems from widespread misuse of the term “aesthetic functionality” in cases involving ornamentation issues, with some courts having mistakenly expanded the category of “functional” marks to include matter that is solely ornamental, essentially on the theory that such matter serves an “aesthetic function” or “ornamentation function.” It is this incorrect use of the term “aesthetic functionality” in connection with ornamentation cases that was rejected by the Court of Customs and Patent Appeals. See *In re DC Comics, Inc.*, 689 F.2d 1042, 215 USPQ 394, 397, 399-401 (majority opinion and Rich, J., concurring) (C.C.P.A. 1982) (holding, in a case involving features of toy dolls, that the Board had improperly “intermingled the concepts of utilitarian functionality and what has been termed ‘aesthetic functionality’”; and rejecting the concept of aesthetic functionality where it is used as a substitute for “the more traditional source identification principles of trademark law,” such as the ornamentation and functionality doctrines).

Where the issue presented is whether the proposed mark is ornamental in nature, it is improper to refer to “aesthetic functionality,” because the doctrine of “functionality” is inapplicable to such cases. The proper refusal is on the basis that the matter is ornamental and thus does not function as a mark

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

under §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127. See TMEP §§1202.03 *et seq.* regarding ornamentation.

The Supreme Court's use of the term "aesthetic functionality" in the *TrafFix* case appears limited to cases where the issue is one of actual functionality, but where the nature of the proposed mark makes it difficult to evaluate the functionality issue from a purely utilitarian standpoint. This is the case with color marks and product features that enhance the attractiveness of the product. The color or feature does not normally give the product a truly utilitarian advantage (in terms of making the product actually perform better), but may still be found to be functional because it provides other real and significant competitive advantages and thus should remain in the public domain.

For example, in *Qualitex, supra*, referred to as an "aesthetic functionality" case in *TrafFix, supra*, the Supreme Court considered whether a green-gold color used on the pads for dry cleaning presses was barred from trademark protection under the functionality doctrine. While the Court ultimately concluded that the color at issue was not functional, the Court evaluated the proposed mark not only in light of the traditional "utilitarian" definition of functionality (*i.e.*, whether the proposed mark is essential to the use or purpose of the product or affects the cost or quality of the product), but also in terms of whether there was a competitive need for the color in that industry, stating that the color would be considered functional if its exclusive use "would put competitors at a significant non-reputation-related disadvantage." *Qualitex*, 514 U.S. 165, 34 USPQ2d at 1163-65. See also *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994) (affirming the Board's determination that the color black for outboard motors was functional because while it had no utilitarian effect on the mechanical working of the engines, it nevertheless provided other identifiable competitive advantages – *i.e.*, ease of coordination with a variety of boat colors and reduction in the apparent size of the engines).

In *M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001), the Board considered the proper use of the aesthetic functionality doctrine in connection with product designs for metal ventilating ducts and vents for tile or concrete roofs:

This case seems to involve elements of both utilitarian and aesthetic functionality. Here, for example, there is evidence of utility in applicant's patent application, as well as statements touting the superiority of applicant's design in applicant's promotional literature, and statements that applicant's design results in reduced costs of installation. On the other hand, there is no question that applicant's roof designs which match the appearance of surrounding roof tiles are more pleasing in appearance because the venting tiles in each case are unobtrusive.

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

*M-5 Steel*, 61 USPQ2d at 1096. Citing extensively from the *TrafFix*, *Qualitex* and *Brunswick* cases, the Board concluded that the product designs were functional for a combination of utilitarian and aesthetic reasons:

[W]e agree with opposer that applicant's product designs are functional in the sense that these configurations blend in or match the roof tiles with which they are used better than alternative products. As in *Brunswick*, these configurations do not make the roof vents work better because they are in these shapes. Rather, like the advantages of color compatibility and reduction in apparent engine size afforded by the color black, applicant's designs are compatible with the roof tiles with which they are used and supply applicant with a competitive advantage in each case. Because applicant's vents match the contours of the roof vents with which they are used, alternatives will not have this advantage. Applicant's patent application and other evidence of record, including applicant's promotional literature and applicant's own testimony, tout the designs' unobtrusive appearance, state that they are "functional in design," camouflage the existence of the vents and are aesthetically pleasing. Applicant also represents in its promotional material that its vents are cheaper to install. We conclude that applicant's product designs are, as a whole, functional, and that registration by applicant would hinder competition by placing competitors at a substantial competitive disadvantage.

*M-5 Steel*, 61 USPQ2d at 1097.

Note that this type of functionality determination – while employed in connection with a normally "aesthetic" feature such as color – is a proper use of the functionality doctrine, necessitating a §2(e)(5) refusal where the evidence establishes that a color or other matter at issue provides identifiable competitive advantages and thus should remain in the public domain. This is the opposite of an ornamentation refusal, where the matter at issue serves no identifiable purpose other than that of pure decoration.

Generally speaking, examining attorneys should exercise caution in the use of the term "aesthetic functionality," in light of the confusion that historically has surrounded this issue. In most situations, reference to aesthetic functionality will be unnecessary, since a determination that the matter sought to be registered is purely ornamental in nature will result in an ornamentation refusal under §§1, 2 and 45, and a determination that the matter sought to be registered is functional will result in a functionality refusal under §2(e)(5). Use of the term "aesthetic functionality" may be appropriate in limited circumstances where the proposed mark presents issues similar to those involved in the *M-5 Steel* and *Brunswick* cases, *supra* – *i.e.*, where the issue is one of true functionality under §2(e)(5), but where the nature of the mark

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

makes the functionality determination turn on evidence of particular competitive advantages that are not necessarily categorized as “utilitarian” in nature. Any such use of the term “aesthetic functionality” should be closely tied to a discussion of specific competitive advantages resulting from use of the proposed mark at issue, so that it is clear that the refusal is properly based on the functionality doctrine and not on an incorrect use of “aesthetic functionality” to mean ornamentation.

See TMEP §§1202.05 and 1202.05(f) for additional discussion and case references regarding the functionality issue in connection with color marks.

### **1202.02(a)(iv) Burden of Proof in Functionality Determinations**

The examining attorney must establish a *prima facie* case that the trade dress sought to be registered is functional. The burden then shifts to the applicant to present sufficient evidence to rebut the examining attorney’s *prima facie* case of functionality. *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1, 3 (Fed. Cir. 1984); *In re Bio-Medicus Inc.*, 31 USPQ2d 1254, 1257 n.5 (TTAB 1993).

The functionality determination is a question of fact, and depends on the totality of the evidence presented in each particular case. *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422 (Fed. Cir. 2002); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1339 (TTAB 1997). While there is no set amount of evidence that an examining attorney must present to establish a *prima facie* case of functionality, it is clear that there must be evidentiary support for the refusal in the record. *See, e.g., In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9, 16-17 (C.C.P.A. 1982) (admonishing both the examining attorney and the Board for failing to support the functionality determination with even “one iota of evidence”).

If the trade dress sought to be registered as a mark is the subject of a utility patent that discloses the feature’s utilitarian advantages, then the applicant bears an especially “heavy burden of overcoming the strong evidentiary inference of functionality.” *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1005 (2001). *See* TMEP §1202.02(a)(v).

### **1202.02(a)(v) Evidence and Considerations Regarding Functionality Determinations**

Trade dress is functional if it is essential to the use or purpose of a product or if it affects the cost or quality of the product. *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850, 214 USPQ 1, 4 n. 10 (1982).

In *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1005 (2001), the Supreme Court resolved a circuit split regarding the proper weight to be afforded a utility patent in the functionality determination, stating:

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

A utility patent is strong evidence that the features claimed therein are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection. Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.

See also *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985); *In re Visual Communications Co., Inc.*, 51 USPQ2d 1141 (TTAB 1999); *In re Edward Ski Products, Inc.*, 49 USPQ2d 2001 (TTAB 1999); *In re Caterpillar Inc.*, 43 USPQ2d 1335 (TTAB 1997).

The Court in *TrafFix* went on to hold that where the evidence includes a utility patent that claims the product features at issue, it is unnecessary to consider evidence relating to the availability of alternative designs:

There is no need, furthermore, to engage, as did the Court of Appeals, in speculation about other design possibilities, such as using three or four springs which might serve the same purpose. Here, the functionality of the spring design means that competitors need not explore whether other spring juxtapositions might be used. The dual-spring design is not an arbitrary flourish in the configuration of MDI's product; it is the reason the device works. Other designs need not be attempted.

*TrafFix*, 532 U.S. at 23, 58 USPQ2d at 1007 (citation omitted).

Therefore, in those instances where the examining attorney is presented with facts similar to those in *TrafFix* – *i.e.*, where there is a utility patent establishing the utilitarian nature of the product design at issue – the examining attorney may properly issue a final functionality refusal based primarily on the utility patent.

In relevant cases, the examining attorney should ask the applicant to provide copies of any patent(s) or any pending or abandoned patent application(s). See *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1429 (Fed. Cir. 2002) (“We agree with the Board that an abandoned patent application should be considered under the first Morton-Norwich factor, because an applied-for utility patent that never issued has evidentiary significance for the statements and claims made in the patent application concerning the utilitarian advantages, just as an issued patent has evidentiary significance.”).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

It is important to read the patent to determine whether the patent actually claims the features presented in the proposed mark. If it does not, or if the features are referenced in the patent, but only as arbitrary or incidental features, then the probative value of the patent as evidence of functionality is substantially diminished or negated entirely. *TrafFix*, 532 U.S. at 34, 58 USPQ2d at 1007 (where a manufacturer seeks to protect arbitrary, incidental or ornamental aspects or features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs, functionality will not be established if the manufacturer can prove that those aspects do not serve a purpose within the terms of utility patent); see also *Black & Decker Inc. v. Hoover Service Ctr.*, 886 F.2d 1285, 12 USPQ2d 1250 (Fed. Cir. 1989); *In re Zippo Mfg. Co.*, 50 USPQ2d 1852 (TTAB 1999); *In re Weber-Stephen Products Co.*, 3 USPQ2d 1659 (TTAB 1987).

It is not necessary that the utility patent be owned by the applicant; a third-party utility patent is also relevant to the functionality determination if the patent claims the features in the product design sought to be registered. See *In re Virshup*, 42 USPQ2d 1403 (TTAB 1997); *In re American National Can Co.*, 41 USPQ2d 1841 (TTAB 1997); *In re Cabot Corp.*, 15 USPQ2d 1224 (TTAB 1990). Therefore, the examining attorney may also search the Office's patent records to see if there are utility patents owned by third parties that disclose the functional advantages of the product design that the applicant seeks to register.

Statements regarding utilitarian advantages of the design made in the course of the prosecution of the patent application can be very strong evidence of functionality. *TrafFix*, 532 U.S. at 32, 58 USPQ2d at 1006 ("These statements [regarding specific functional advantages of the product design] made in the patent applications and in the course of procuring the patents demonstrate the functionality of the design. MDI does not assert that any of these representations are mistaken or inaccurate, and this is further strong evidence of the functionality of the dual-spring design.").

Where a utility patent claims more than what is sought to be registered, this fact does not establish the nonfunctionality of the product design if the patent shows that the part claimed as a trademark is an essential or integral part of the invention and has utilitarian advantages. *Cf. TrafFix*, 532 U.S. at 31, 58 USPQ2d at 1006.

The fact that the proposed mark is *not* the subject of a utility patent does not establish that the product feature is nonfunctional. *TrafFix*, 532 U.S. at 31, 58 USPQ2d at 1006; *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1950 n. 3, (TTAB 2001). If the patent does not disclose utilitarian advantages of the design features at issue, or if no utility patent/application is of record, the evidence normally involves consideration of one or more of the other factors commonly known as the "*Morton-Norwich* factors:"



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

- (1) the existence of a utility patent that discloses the utilitarian advantages of the design sought to be registered;
- (2) advertising by the applicant that touts the utilitarian advantages of the design;
- (3) facts pertaining to the availability of alternative designs; and
- (4) facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.

*In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (C.C.P.A. 1982).

Moreover, even in the absence of a utility patent or utility patent application, it is not necessary to consider all these factors in every case. The Supreme Court held that “[w]here the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature.” *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001). See also *Gibson Guitar Corp., supra* (where there was no utility patent, and no evidence that applicant’s guitar configuration resulted from a simpler or cheaper method of manufacture, these factors did not weigh in Board’s decision).

Relevant technical information is usually more readily available to an applicant. *In re Witco Corp.*, 14 USPQ2d 1557, 1560 (TTAB 1990). Therefore, the applicant will often be the source of most of the evidence relied upon by the examining attorney in establishing a *prima facie* case of functionality in an *ex parte* case. *In re Teledyne Industries Inc.*, 696 F.2d 968, 971, 217 USPQ 9, 11 (Fed. Cir. 1982). When there is reason to believe the proposed mark may be functional, in the first Office action the examining attorney should require the applicant to provide information necessary to permit an informed determination concerning the registrability of the proposed mark. See 37 C.F.R. §2.61(b); *In re Babies Beat Inc.*, 13 USPQ2d 1729, 1731 (TTAB 1990) (registration properly refused where applicant failed to comply with examining attorney’s request for copies of patent applications and other patent information). In addition to asking whether the proposed mark is or has been the subject of a utility patent or a pending or abandoned patent application, the examining attorney should require an applicant to provide advertising or promotional materials. The examining attorney should also inquire whether the feature makes the product easier or cheaper to manufacture and whether alternative designs are available.

It is important that the inquiry focus on the utility of the feature or combination of features that is claimed as protectible trade dress, and not on the usefulness of the article overall. *Morton-Norwich*, 671 F.2d at 1338, 213 USPQ at 13. Generally, dissecting the design into its individual features and analyzing the utility of each separate feature does not establish that the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

overall design is functional. 15 U.S.C. §1052(e)(5); *Teledyne Industries Inc.*, 696 F.2d at 971, 217 USPQ at 11. However, it is sometimes helpful to analyze the design from the standpoint of its various features. *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484, 222 USPQ 1, 2 (Fed. Cir. 1984) (affirming the functionality determination, where the Board had initially considered the six individual features of the design, and then had concluded that the design as a whole was functional); *In re Controls Corp. of America*, 46 USPQ2d 1308, 1312 (TTAB 1998) (finding the entire configuration at issue functional because it consisted of several individual features, each of which was functional in nature). See also *Elmer v. ICC Fabricating Inc.*, 67 F.3d 1571, 1579-80, 36 USPQ2d 1417, 1422-23 (Fed. Cir. 1995) (rejecting the argument that the combination of individually functional features in the configuration resulted in an overall nonfunctional product design).

Where the evidence shows that the overall design is functional, the inclusion of a few arbitrary or otherwise nonfunctional features in the design will not change the result. See *Textron, Inc. v. U.S. International Trade Commission*, 753 F.2d 1019, 224 USPQ 625, 628-29 (Fed. Cir. 1985); *In re Vico Products Mfg. Co., Inc.*, 229 USPQ 364, 368 (TTAB 1985).

A design patent is a factor that weighs against a finding of functionality because design patents by definition protect only ornamental and nonfunctional features. However, ownership of a design patent does not in itself establish that a product feature is nonfunctional, and can be outweighed by other evidence supporting the functionality determination. *R.M. Smith, Inc.*, 734 F.2d at 1485, 222 USPQ at 3; *American National Can Co.*, 41 USPQ2d at 1843; *Caterpillar Inc.*, 43 USPQ2d at 1339; *Witco Corp.*, 14 USPQ2d at 1559.

### **1202.02(a)(v)(A) Advertising, Promotional or Explanatory Material in Functionality Determinations**

The examining attorney should examine the specimens of record, and should also ask an applicant to provide any available advertising, promotional or explanatory material concerning the goods/services, particularly any material specifically related to the features embodied in the proposed mark. The examining attorney should also check to see if the applicant has a website on which the product is advertised or described.

The applicant's own advertising touting the utilitarian aspects of its design is often strong evidence supporting a functionality refusal. See, e.g., *In re Gibson Guitar Corp.*, 61 USPQ2d 1948 (TTAB 2001); *M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001); *In re Visual Communications Co., Inc.*, 51 USPQ2d 1141 (TTAB 1999); *In re Edward Ski Products, Inc.*, 49 USPQ2d 2001 (TTAB 1999); *In re Caterpillar Inc.*, 43 USPQ2d 1335 (TTAB 1997); *In re Bio-Medicus Inc.*, 31 USPQ2d 1254 (TTAB 1993); *In re Witco Corp.*, 14 USPQ2d 1557 (TTAB 1989).

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

An applicant will often assert that statements in its promotional materials touting the utilitarian advantages of the product feature are mere “puffery” and thus entitled to little weight in the functionality analysis. However, where the advertising statements clearly emphasize specific utilitarian features of the design claimed as a mark, the Board will reject such assertions of “puffing.” See, e.g., *In re Gibson Guitar Corp.*, *supra*; *Goodyear Tire and Rubber Co. v. Interco Tire Corp.*, 49 USPQ2d 1705, 1716-17 (TTAB 1998); *In re Bio-Medicus Inc.*, 31 USPQ2d 1254, 1260 (TTAB 1993); *In re Witco Corp.*, 14 USPQ2d 1557, 1559-61 (TTAB 1989).

In *Gibson Guitar*, the Board found the design of a guitar body to be functional, noting that applicant’s literature clearly indicated that the shape of applicant’s guitar produced a better musical sound. Applicant’s advertisements stated that “This unique body shape creates a sound which is much more balanced and less ‘muddy’ than other ordinary dreadnought acoustics.” 61 USPQ2d at 1951.

The examining attorney may also check trade publications and computer databases to determine whether others have written about the applicant’s design and its functional features or characteristics. In *Gibson Guitar*, the record included an advertisement obtained from the website of a competitor whose guitar appeared to be identical in shape to applicant’s configuration, touting the acoustical advantages of the shape of the guitar.

### **1202.02(a)(v)(B) Availability of Alternative Designs in Functionality Determinations**

An applicant attempting to rebut a *prima facie* case of functionality will often submit evidence of alternative designs to demonstrate that there is no “competitive need” in the industry for the applicant’s particular product design. See TMEP §1202.02(a)(iii)(A).

However, in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001), the Supreme Court clearly indicated that if the record shows that a design is essential to the use or purpose of a product, or if it affects the cost or quality of the product, it is unnecessary to consider whether there is a competitive need for the product feature. The Court explained:

[W]e have said “in general terms, a product feature is functional, and cannot serve as a trademark, if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” Expanding upon the meaning of this phrase, we have observed that a functional feature is one the “exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage.” The Court of Appeals in the instant case seemed to interpret this language to mean that a necessary test for functionality is “whether the particular product configuration is a competitive necessity.” . . . This was incorrect as a

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

comprehensive definition. As explained in *Qualitex, supra*, and *Inwood, supra*, a feature is also functional when it is essential to the use or purpose of the device or when it affects the cost or quality of the device . . . *Where the design is functional under the Inwood formulation there is no need to proceed further to consider if there is a competitive necessity for the feature.*

\* \* \*

*There is no need, furthermore, to engage, as did the Court of Appeals, in speculation about other design possibilities, such as using three or four springs which might serve the same purpose. Here, the functionality of the spring design means that competitors need not explore whether other spring juxtapositions might be used. The dual-spring design is not an arbitrary flourish in the configuration of MDI's product; it is the reason the device works. Other designs need not be attempted (emphasis added).*

*TrafFix*, 58 USPQ2d at 1006-1007 (citations and additional internal quotations omitted).

Thus, where the evidence clearly establishes the utilitarian nature of the trade dress at issue in view of a utility patent and/or advertising statements and facts showing a positive effect on the cost or quality of manufacture, it is unnecessary to consider whether alternative designs are available. See *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002) discussing the Supreme Court's decision in *TrafFix* ("once a product feature is found functional based on other considerations there is no need to consider the availability of alternative designs, because the feature cannot be given trade dress protection merely because there are alternative designs available.").

Evidence of the availability of alternative designs may be helpful where the record is otherwise unclear regarding the utilitarian functionality of the design at issue. *Id.* Accordingly, examining attorneys may continue to request information about alternative designs in the initial Office action, *i.e.*, inquire whether alternative designs are available for the feature embodied in the proposed mark, and whether the alternatives are more costly to produce. See TMEP 1212.02(a)(v).

In *In re Gibson Guitar Corp.*, 61 USPQ2d 1948 (TTAB 2001), the Board found that the applicant had not shown that there were alternative guitar shapes that could produce the same sound as applicant's configuration. The Board noted that the record contained an advertisement obtained from the website of a competitor whose guitar appeared to be identical in shape to applicant's configuration, stating that the shape of the guitar produces a better sound.

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

In order to be probative, the alternative design evidence must pertain to the same category of goods as the applicant's goods. *See, e.g., In re Zippo Mfg. Co.*, 50 USPQ2d 1852, 1854 (TTAB 1999); *In re EBSCO Industries Inc.*, 41 USPQ2d 1917, 1919 (TTAB 1997).

### **1202.02(a)(v)(C) Ease or Economy of Manufacture in Functionality Determinations**

As noted in TMEP §1202.02(a)(iii)(A), a product feature is functional if it is essential to the use or purpose of the product *or if it affects the cost or quality of the product*. *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850, 214 USPQ 1, 4 n.10 (1982). Therefore, a showing that a design results from a comparatively simple or inexpensive method of manufacture will support a finding that the design is functional.

In most cases, there is little or no evidence pertaining to this factor. However, the examining attorney should still ask the applicant for information as to whether the subject design makes the product simpler or less costly to manufacture, since evidence on this issue weighs strongly in favor of a finding of functionality. *See, e.g., TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001); *In re Virshup*, 42 USPQ2d 1403 (TTAB 1997). Statements pertaining to the cost or ease of manufacture may sometimes also be found in informational or advertising materials submitted by the applicant. *See M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1097 (TTAB 2001) (statements in promotional material that applicant's design results in reduced costs of installation found to be evidence of functionality of applicant's configurations of metal ventilating ducts and vents for tile or concrete roofs).

While evidence showing that the product feature results from a comparatively simple or inexpensive method of manufacture supports a finding that the design is functional, the opposite is not necessarily the case – *i.e.*, assertions by the applicant that its design is more expensive or more difficult to make will not establish that the configuration is not functional.

### **1202.02(b) Distinctiveness of Trade Dress**

In *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 215, 54 USPQ2d 1065, 1069 (2000) the Supreme Court distinguished between two types of trade dress - product design and product packaging. If the trade dress falls within the category of "product design," it can never be inherently distinctive. *Id.* 529 U.S. at 212, 54 USPQ2d at 1068 ("It seems to us that design, like color, is not inherently distinctive."). Moreover, the Court held that in close cases in which it is difficult to determine whether the trade dress at issue is product packaging or product design, "courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning." *Id.* at 215, 54 USPQ2d at 1070. (*Note:* If the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

trade dress is functional, it cannot be registered despite acquired distinctiveness. *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1007 (2001)).

The statutory basis for refusal of registration on the Principal Register on the ground that the trade dress is nondistinctive is 15 U.S.C. §§1051, 1052, and 1127.

### **1202.02(b)(i) Distinctiveness and Product Design Trade Dress**

In addition to determining whether a proposed mark is functional, the examining attorney must refuse to register, on the Principal Register, any mark that consists of a product design, unless the applicant establishes that the mark has acquired distinctiveness under §2(f). *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 210, 54 USPQ2d 1065, 1068 (2000). Features of a product's design can never be inherently distinctive and are registrable only upon a showing of secondary meaning. *Id.* at 213–14, 54 USPQ2d at 1069. The Supreme Court noted that product design almost invariably serves purposes other than source identification, and that consumers are aware that even the most unusual product design (such as a cocktail shaker shaped like a penguin) is intended not to identify the source, but to render the product itself more useful or appealing. *Id.*

The examining attorney must issue this refusal in *all* applications seeking registration of a product design unless the applicant claims that the mark has acquired distinctiveness under §2(f) and includes sufficient evidence to show that the mark has acquired distinctiveness. The ground for refusal is that the proposed mark consists of a nondistinctive product design, and thus does not function as a mark under §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127. If the product design is not functional, the mark may be registered on the Supplemental Register, or, if the applicant shows that the product design has acquired distinctiveness, on the Principal Register under §2(f). See TMEP §1202.02(a) regarding functionality, TMEP §§815 and 816 *et seq.* regarding the Supplemental Register, and TMEP §§1212 *et seq.* regarding acquired distinctiveness.

For applications based on §1(b) of the Trademark Act, 15 U.S.C. §1051(b), the examining attorney must issue the refusal even if the applicant has not filed an amendment to allege use or statement of use. See TMEP §1202.02(e) regarding examination of intent-to-use applications.

### **1202.02(b)(ii) Distinctiveness and Product Packaging Trade Dress for Goods or Services**

Where a proposed mark consists of product packaging trade dress for goods or services, the examining attorney must determine whether the proposed mark is inherently distinctive. If it is not inherently distinctive, the examining

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

attorney must refuse registration on the Principal Register on the ground that the proposed mark is nondistinctive trade dress under §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127, for trademark applications; or §§1, 3 and 45 of the Act, 15 U.S.C. §§1051, 1053 and 1127, for service mark applications.

In *Wal-Mart Stores, Inc., v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000), the Supreme Court discussed the distinction between the trade dress at issue in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081 (1992), and the product design trade dress (designs for children's clothing) under consideration in *Wal-Mart*:

*Two Pesos* unquestionably establishes the legal principle that trade dress can be inherently distinctive, but it does not establish that *product design* trade dress can be. *Two Pesos* is inapposite to our holding here because the trade dress at issue, the decor of a restaurant, seems to us not to constitute *product design*. It was either product packaging – which, as we have discussed, normally is taken by the consumer to indicate origin – or else some *tertium quid* that is akin to product packaging.

*Wal-Mart*, 529 U.S. at 215, 54 USPQ2d at 1069.

Thus, unlike product design trade dress, trade dress constituting product packaging may be inherently distinctive for goods or services and registrable on the Principal Register without a showing of acquired distinctiveness. However, the examining attorney should be mindful of the Supreme Court's admonishment that where there are close cases, trade dress should be classified as product design for which secondary meaning is always required. *Id.*, 529 U.S. at 215, 54 USPQ2d at 1070.

"[A] mark is inherently distinctive if '[its] intrinsic nature serves to identify a particular source.'" *Id.* at 210, 54 USPQ2d at 1068 (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 23 USPQ2d 1081 (1992)). The test for determining inherent distinctiveness set forth in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344, 196 USPQ 289, 291 (C.C.P.A. 1977), although not applicable to product design trade dress, is still viable in the examination of product packaging trade dress. The examining attorney should consider the following "Seabrook" factors - whether the proposed mark is:

- (1) a "common" basic shape or design;
- (2) unique or unusual in the field in which it is used;
- (3) a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods;

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- (4) capable of creating a commercial impression distinct from the accompanying words.

*Id.* See also *Yankee Candle Co. v. Bridgewater Candle Co., LLC*, 259 F.3d 25, 59 USPQ2d 1720 (1<sup>st</sup> Cir. 2001) (trade dress for common elements of candle labels was nondistinctive product packaging for which insufficient evidence of acquired distinctiveness was shown; and evidence of acquired distinctiveness for trade dress comprised of label elements, candle holders, display systems, and candle containers was deemed insufficient); *Tone Brothers, Inc. v. Sysco Corp.*, 28 F.3d 1192, 1205, 31 USPQ2d 1321, 1331 (Fed. Cir. 1994) (citing *Seabrook*); *In re Hudson News Co.*, 39 USPQ2d 1915, 1923 (TTAB 1996), *aff'd per curiam*, 114 F.3d 1207 (Fed. Cir. 1997) (“[f]or the ‘blue motif’ of a retail store to be registrable on the Principal Register without resort to Section 2(f), the trade dress would have to be immediately recognizable as a distinctive way of identifying the source of the store services.”); *In re File*, 48 USPQ2d 1363, 1367 (TTAB 1998) (novel tubular lights used in connection with bowling alley services would be perceived by customers as “simply a refinement of the commonplace decorative or ornamental lighting... and would not be inherently regarded as a source indicator.”); *In re J. Kinderman & Sons Inc.*, 46 USPQ2d 1253, 1255 (TTAB 1998) (“... while the designs applicant seeks to register [the packaging for electric lights for Christmas trees] may be unique in the sense that we have no evidence that anyone else is using designs which are identical to them, they are nonetheless not inherently distinctive.”).

Unlike §1(b) applications for product design trade dress, §1(b) applications for product packaging trade dress generally will not be refused registration on the ground of nondistinctiveness until the applicant has filed an amendment to allege use or a statement of use. See TMEP §1202.02(e).

Regardless of the bases for filing, if a proposed mark is inherently distinctive, it may be registered on the Principal Register. See *In re Creative Beauty Innovations, Inc.*, 56 USPQ2d 1203 (TTAB 2000) (bottle configuration found inherently distinctive); *In re Fre-Mar Industries, Inc.*, 158 USPQ 364, 367 (TTAB 1968) (“[A]lthough the particular shape is a commonplace one for flashlights, it is nevertheless so unique and arbitrary as a container in the tire repair field that it may be inherently distinctive and, therefore, by reason of its shape alone, serve to identify applicant’s goods and distinguish them from like goods of others.”); *In re International Playtex Corp.*, 153 USPQ 377 (TTAB 1967) (container configuration having the appearance of an ice cream cone found inherently distinctive as a trademark for baby pants).

If a proposed mark is *not* inherently distinctive, the mark may be registered on either the Principal Register under §2(f) or on the Supplemental Register. Secondary meaning is acquired when the public views its primary significance as identifying the source of the product rather than the product itself. *Wal-Mart*, 529 U.S. at 211, 54 USPQ2d at 1068. In the following cases, the



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

applicant's evidence was found to be sufficient to support a claim of acquired distinctiveness: *In re World's Finest Chocolate, Inc.*, 474 F.2d 1012, 177 USPQ 205 (C.C.P.A. 1973) (package design found to identify applicant's candy bars and distinguish them from those of others); *Ex parte Haig & Haig Ltd.*, 118 USPQ 229, 230 (Comm'r Pats. 1958) ("The decree recited that because of the original, distinctive and peculiar appearance of the 'Pinched Decanter' the brand of whiskey in such bottles had come to be known and recognized by the public, by dealers and by consumers; and that the whiskey contained in such bottles had come to be identified with the 'Pinched Decanter' in the minds of the public generally.")

In *In re Usher, S.A.*, 219 USPQ 920, 921 (TTAB 1983), the evidence of secondary meaning was insufficient. (The configuration of a package for mint candies was not functional but the package design was not shown to possess secondary meaning).

The examining attorney must establish a *prima facie* case that the trade dress is not inherently distinctive. To meet this burden, the examining attorney must at a minimum, set forth a "reasonable predicate" for its position of no inherent distinctiveness." The USPTO is an agency of limited resources, and as such, it cannot be expected to shoulder the burden of conducting market research. *In re Pacer Technology*, 338 F.3d 1348, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003) (design patents showing other adhesive container cap designs found sufficient to establish *prima facie* case that applicant's adhesive container cap was not inherently distinctive).

See TMEP §§1212 *et seq.* regarding acquired distinctiveness and TMEP §§815 and 816 *et seq.* regarding the Supplemental Register.

### **1202.02(c) Distinctiveness and Functionality are Separate Issues**

As stated in TMEP §1202.02, in an application for trade dress, distinctiveness and functionality are two separate issues, both of which must be considered by the examining attorney.

In many cases, registration is refused on both grounds. In any case where a product design or product packaging is refused because it is functional, registration should also be refused on the ground that the proposed mark is nondistinctive.

In appropriate cases, the issues of functionality and acquired distinctiveness should be argued in the alternative. For example, if the examining attorney has determined that a mark is functional and the applicant has made a claim of acquired distinctiveness, the examining attorney must determine whether the showing of acquired distinctiveness would be sufficient to warrant registration if the examining attorney's decision on the functionality issue is reversed. Of course, if the mark is ultimately determined to be functional, evidence of acquired distinctiveness is irrelevant and registration will be

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

refused. *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1007 (2001).

### **1202.02(d) Drawing and Description of Mark in Trade Dress Applications**

In an application to register a mark with three-dimensional features, the applicant must submit a drawing that depicts the mark in a single rendition. 37 C.F.R. §2.52(b)(2). See TMEP §807.10. If the mark comprises the design of only a portion of a product or container, broken lines should be used in the drawing to indicate that portion of the product or container that is not claimed as part of the mark. 37 C.F.R. §2.52(b)(4). See *In re Water Gremlin Co.*, 635 F.2d 841, 208 USPQ 89 (C.C.P.A. 1980); *In re Famous Foods, Inc.*, 217 USPQ 177 (TTAB 1983); TMEP §807.08. The matter that is shown in broken (dotted) lines does not have to be disclaimed, because it does not form part of the mark. If the drawing does not meet the requirements of 37 C.F.R. §2.52, the examining attorney should require the applicant to submit a substitute drawing.

If an acceptable statement describing the mark is not in the record, the examining attorney *must* require the applicant to submit a description to clarify what the applicant seeks to register. The description of the mark should include a statement that the matter shown in broken lines is not part of the mark. See 37 C.F.R. §2.52(b)(4); TMEP §§808 *et seq.* The description is printed in the *Official Gazette* and on the registration certificate. Examples of acceptable language are, “The mark consists of the design of the blade portion of a flyswatter,” and “The mark consists of the design of a perfume or cologne bottle and cap therefor, both having a ‘V’ shape as viewed from above.” The description must adequately describe the mark, with unnecessary matter kept to a minimum. If applicable, the description must clearly indicate the portion of the product or container that the mark comprises. An example of acceptable language for this purpose is: “The mark consists of a red button positioned on the lower front area of a shirt. The dotted outline of the shirt is not part of the mark but is merely intended to show the position of the mark.” As in this example, the description should make it clear what the dotted lines represent. The examining attorney should ensure that the description statement has been entered into the Trademark Reporting and Monitoring (“TRAM”) database, so that it will be printed in the *Official Gazette* and on the certificate of registration. See TMEP §817.

See TMEP §1202.05(d)(i) and (d)(ii) regarding drawings in applications for color marks consisting solely of one or more colors.

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### 1202.02(e) Trade Dress in Intent-to-Use Applications

#### ***Distinctiveness and Product Design***

A product design trademark can never be inherently distinctive and is registrable only upon a showing of secondary meaning. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 212, 54 USPQ2d 1065, 1069 (2000); TMEP §1202.02(b)(i). Therefore, if the mark is comprised of a product design, the examining attorney will refuse registration on the Principal Register on the ground that the proposed mark consists of a nondistinctive product design under 15 U.S.C. §§1051, 1052 and 1127. The examining attorney will make this refusal even in an intent-to-use application under 15 U.S.C. §1051(b) for which no statement of use or amendment to allege use has been filed.

#### ***Distinctiveness and Product Packaging***

If the mark comprises product packaging trade dress for goods or services, the examining attorney must determine whether the mark is inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081 (1992). This requires consideration of the context in which the mark is used and the impression it would make on purchasers. Generally, no refusal based on lack of inherent distinctiveness will be issued in an intent-to-use application until the applicant has submitted specimens with an amendment to allege use or a statement of use. However, if appropriate, the examining attorney has discretion to issue this refusal before specimens are submitted.

#### ***Functionality***

To determine whether a proposed mark is functional, the examining attorney must consider how the asserted mark is used. Generally, in a §1(b) application the examining attorney will not issue a refusal on the ground that the mark is functional until the applicant has filed either an amendment to allege use under §1(c), or a statement of use under §1(d), 15 U.S.C. §§1051(c) or (d).

#### ***Advisory Statement***

In a §1(b) application for which no specimens have been submitted, if the examining attorney anticipates that a refusal based on functionality or nondistinctive trade dress will be made, the potential refusal should be brought to the applicant's attention in the first action issued by the Office. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided to the applicant before the allegation of use is filed, the Office is not precluded from refusing registration on this basis.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1202.02(f) Trade Dress in §44 and §66(a) Applications

#### ***Distinctiveness and Product Design***

A product design trademark can never be inherently distinctive and is registrable only upon a showing of secondary meaning. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 212, 54 USPQ2d 1065, 1069 (2000); TMEP §1202.02(b)(i). Therefore, if the proposed mark is comprised of a product design, the examining attorney must refuse registration on the Principal Register on the ground that the proposed mark consists of a nondistinctive product design under 15 U.S.C. §§1051, 1052 and 1127.

#### ***Distinctiveness and Product Packaging***

If the mark comprises product packaging trade dress for goods or services, the examining attorney must determine whether the mark is inherently distinctive. *Wal-Mart Stores, Inc., v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081 (1992). See TMEP §§1202.02(b) *et seq.* regarding distinctiveness of trade dress.

#### ***Functionality***

If the record indicates that the proposed mark is functional, the examining attorney should issue a refusal of registration on the Principal Register under §2(f), or on the Supplemental Register. See TMEP §§1202.02(a) *et seq.* regarding functionality. *NOTE: A mark in a §66(a) application cannot be registered on the Supplemental Register under any circumstances. 15 U.S.C. §1141h(a)(4); 37 C.F.R. §§2.47(c) and 2.75(c).*

### 1202.03 Refusal on Basis of Ornamentation

Subject matter that is merely a decorative feature does not identify and distinguish the applicant's goods and, thus, does not function as a trademark. A decorative feature may include words, designs, slogans or other trade dress. This matter should be refused registration because it is merely ornamentation and, therefore, does not function as a trademark as required by §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127.

Generally, the ornamentation refusal applies only to trademarks, not to service marks. See TMEP §§1301.02 *et seq.* regarding matter that does not function as a service mark.

Matter that serves primarily as a source indicator, either inherently or as a result of acquired distinctiveness, and that is only incidentally ornamental or decorative, can be registered as a trademark. *In re Soccer Sport Supply Co., Inc.*, 507 F.2d 1400, 184 USPQ 345 (C.C.P.A. 1975); *In re Paramount Pictures Corp.*, 213 USPQ 1111 (TTAB 1982).

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

With regard to registrability, ornamental matter may be categorized along a continuum ranging from ornamental matter that is registrable on the Principal Register, to purely ornamental matter that is incapable of trademark significance and unregistrable under any circumstances, as follows:

- (1) Ornamental matter that serves as an identifier of a “secondary source” is registrable on the Principal Register. For example, ornamental matter on a T-shirt (*e.g.*, the designation “NEW YORK UNIVERSITY”) can convey to the purchasing public the “secondary source” of the T-shirt (rather than the manufacturing source). Thus, even where the T-shirt is distributed by a party other than that identified by the designation, sponsorship or authorization by the identified party is indicated. See TMEP §1202.03(c).
- (2) Ornamental matter that is neither inherently distinctive nor a secondary source indicator may be registered on the Principal Register under §2(f) if the applicant establishes that the subject matter has acquired distinctiveness as a mark in relation to the goods. See TMEP §1202.03(d).
- (3) Ornamental matter that is neither inherently distinctive nor an indicator of secondary source, and has not acquired distinctiveness, but is capable of attaining trademark significance, may be registered on the Supplemental Register.
- (4) Some matter is determined to be purely ornamental and thus incapable of trademark significance and unregistrable on either the Principal Register or the Supplemental Register. See TMEP §1202.03(a).

The examining attorney should consider the following factors to determine whether ornamental matter can be registered: (1) the commercial impression of the proposed mark; (2) the relevant practices of the trade; (3) secondary source, if applicable; and (4) evidence of distinctiveness. These factors are discussed in the following sections.

### **1202.03(a) Commercial Impression**

The examining attorney must determine whether the overall commercial impression of the proposed mark is that of a trademark. Matter that is purely ornamental or decorative does not function as a trademark and is unregistrable on either the Principal Register or the Supplemental Register.

The significance of the proposed mark is a factor to consider when determining whether ornamental matter serves a trademark function. Common expressions and symbols (*e.g.*, the peace symbol, “smiley face,” or the phrase “Have a Nice Day”) are normally not perceived as marks.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The examining attorney must also consider the size, location and dominance of the proposed mark, as applied to the goods, to determine whether ornamental matter serves a trademark function. *In re Dimitri's Inc.*, 9 USPQ2d 1666, 1667 (TTAB 1988); *In re Astro-Gods Inc.*, 223 USPQ 621, 623 (TTAB 1984). A small, neat and discrete word or design feature (e.g., small design of animal over pocket or breast portion of shirt) may be likely to create the commercial impression of a trademark, whereas a larger rendition of the same matter emblazoned across the front of a garment (or a tote bag, or the like) may be likely to be perceived merely as a decorative or ornamental feature of the goods. However, a small, neat and discrete word or design feature will not necessarily be perceived as a mark in all cases.

### **1202.03(b) Practices of the Trade**

In determining whether a proposed mark is inherently distinctive, factors to be considered include whether the subject matter is unique or unusual in a particular field or whether it is a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods that would be viewed by the public as a dress or ornamentation for the goods. See, e.g., *In re Soccer Sport Supply Co., Inc.*, 507 F.2d 1400, 184 USPQ 345 (C.C.P.A. 1975) (pentagon-shaped repetitive design applied to the entire surface of soccer balls); *In re General Tire & Rubber Co.*, 404 F.2d 1396, 160 USPQ 415 (C.C.P.A. 1969) (three narrow white concentric rings of approximately equal width applied to the outer surface of a dark sidewall tire); *In re Chung, Jeanne & Kim Co., Inc.*, 226 USPQ 938 (TTAB 1985) (stripe design applied to sides of sport shoes)).

Even if a proposed mark is not inherently distinctive, it may be registered on the Principal Register if it has become distinctive of the applicant's goods in commerce. See TMEP §1202.03(d). The practices of the trade may be relevant in assessing the applicant's burden of proving that the proposed mark has become distinctive. Typically, more evidence is required if the proposed mark is a type of ornamental matter used so frequently in the relevant industry that consumers would be less apt to discern a source-indicating significance from its use. See *Anchor Hocking Glass Corp. v. Corning Glass Works*, 162 USPQ 288 (TTAB 1969) (cornflower design recognized as a trademark for coffee percolators and culinary vessels and utensils). Cf. *In re Villeroy & Boch S.A.R.L.*, 5 USPQ2d 1451, 1454 (TTAB 1987) (affirming refusal to register design of morning glories and leaves for tableware, the Board noting that the design "has not been shown to be other than another decorative pattern without trademark significance....").

If the applicant cannot show that the proposed mark has acquired distinctiveness, the mark may be registered on the Supplemental Register if it is "capable of distinguishing the applicant's goods or services." 15 U.S.C. §1091. The practices of the trade may be relevant in determining whether a proposed mark is capable of distinguishing the goods or services. If the

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

practices of the trade suggest that certain matter performs the function of a trademark by signifying to purchasers and prospective purchasers the goods of a particular entity and distinguishing the goods from those of others, the matter is assumed to be capable of distinguishing the applicant's goods and, therefore, may be registered on the Supplemental Register. See *In re Todd Co., Inc.*, 290 F.2d 597, 129 USPQ 408 (C.C.P.A. 1961) (repeating pattern of green lines, used to cover the entire back surface of safety paper products (e.g., checks), held registrable on the Supplemental Register for safety paper products, where the record showed that it had long been the practice in the industry to use distinctive overall surface designs to indicate origin of the products).

### 1202.03(c) “Secondary Source”

To show that a proposed mark that is used on the goods in a decorative or ornamental manner also serves a source-indicating function, the applicant may submit evidence that the proposed mark would be recognized as a mark through its use with goods or services other than those identified in the application. To show secondary source, the applicant may show:

(1) ownership of a U.S. registration on the Principal Register of the same mark for other goods or services based on use in commerce under §1 of the Trademark Act; (2) non-ornamental use of the mark in commerce on other goods or services; or (3) ownership of a pending use-based application for the same mark, used in a non-ornamental manner, for other goods or services. Ownership of an intent-to-use application for which no allegation of use has been filed is not sufficient to show secondary source. If the applicant establishes that the proposed mark serves as an identifier of a secondary source, the matter is registrable on the Principal Register.

See *In re Paramount Pictures Corp.*, 213 USPQ 1111 (TTAB 1982), in which MORK & MINDY was held registrable for decals, because applicant had a television series of that name and had previously registered MORK & MINDY for various goods and services. The Board found that the *primary* significance of the term MORK & MINDY to a prospective purchaser of decals was to indicate the television series and the principal characters of the television series. *Id.* at 1112. The Board held that the case was controlled by its decision in *In re Olin Corp.*, 181 USPQ 182 (TTAB 1973) (stylized “O” design registrable for T-shirts, where applicant had previously registered the “O” design for skis), in which that Board had stated:

It is a matter of common knowledge that T-shirts are “ornamented” with various insignia ... or ... various sayings such as “Swallow Your Leader.” In that sense what is sought to be registered could be construed to be ornamental. If such ornamentation is without any meaning other than as mere ornamentation it is apparent that the ornamentation could not and would not serve as an indicia of source. Thus, to use our

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

own example, “Swallow Your Leader” probably would not be considered as an indication of source.

The “ornamentation” of a T-shirt can be of a special nature which inherently tells the purchasing public the source of the T-shirt, not the source of manufacture but the secondary source....

181 USPQ at 182.

In *Paramount*, applying the test set forth in *Olin*, the Board found that “the paired names ‘MORK & MINDY,’ while certainly part of the ornamentation of the decal, also indicate source or origin in the proprietor of the Mork & Mindy television series in the same sense as the stylized ‘O’ in *Olin*.” 213 USPQ at 1113. The Board noted that “while purchasers may be accustomed to seeing characters’ names and images as part of the ornamentation of decals, T-shirts and the like, they are also accustomed to seeing characters’ names and images used as trademarks to indicate source ....” *Id.* at 1114.

See also *In re Watkins Glen International, Inc.*, 227 USPQ 727 (TTAB 1985) (stylized checkered flag design registrable for patches and clothing items, where applicant had previously registered WATKINS GLEN and checkered flag design (with “WATKINS GLEN” disclaimed) for services); *In re Expo ‘74*, 189 USPQ 48 (TTAB 1975) (EXPO ‘74 registrable for handkerchiefs and T-shirts, where applicant, organizer of the 1974 World’s Fair, had previously registered EXPO ‘74 for other goods and services).

A series of ornamental uses of the subject matter on various items will not establish that the subject matter functions as an indicator of secondary source; use as a trademark for the other goods or services must be shown. See *In re Astro-Gods Inc.*, 223 USPQ 621 (TTAB 1984) (refusal to register ASTRO GODS and design for T-shirts affirmed despite applicant’s ornamental use of the proposed mark on other goods and appearance of applicant’s trade name “Astro Gods Inc.” on the T-shirt as part of a copyright notice).

### **1202.03(d) Evidence of Distinctiveness**

As noted above, even if a proposed mark is not inherently distinctive, it may nevertheless be registered on the Principal Register under §2(f), 15 U.S.C. §1052(f), if it becomes distinctive of the applicant’s goods in commerce. See TMEP §§1212 *et seq.* regarding acquired distinctiveness.

### **1202.03(e) Ornamentation with Respect to Intent-to-Use Applications**

Generally, the issue of ornamentation is tied to the use of the mark as evidenced by the specimens. Therefore, no ornamentation refusal will be issued in an intent-to-use application until the applicant has submitted



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

specimens of use with either an amendment to allege use under §1(c), or a statement of use under §1(d), 15 U.S.C. §§1051(c) or (d).

### **1202.03(f) Ornamentation: Case References**

The following cases show the various ways in which ornamental matter was found not to function as a mark.

#### **1202.03(f)(i) Slogans or Words Used on the Goods**

Slogans or phrases used on items such as t-shirts and sweatshirts, jewelry, and ceramic plates have been refused registration as ornamentation that purchasers will perceive as conveying a message rather than indicating source of the goods. See *Damn I'm Good Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357, 212 USPQ 684 (S.D.N.Y. 1981) ("DAMN I'M GOOD," inscribed in large letters on bracelets and used on hang tags affixed to the goods, found to be without any source-indicating significance); *In re Pro-Line Corp.*, 28 USPQ2d 1141 (TTAB 1993) (BLACKER THE COLLEGE SWEETER THE KNOWLEDGE primarily ornamental slogan that is not likely to be perceived as source indicator); *In re Dimitri's Inc.*, 9 USPQ2d 1666 (TTAB 1988) ("SUMO," as used in connection with stylized representations of sumo wrestlers on applicant's T-shirts and baseball-style caps); *In re Astro-Gods Inc.*, 223 USPQ 621, 624 (TTAB 1984) ("[T]he designation 'ASTRO GODS' and design is not likely to be perceived as anything other than part of the thematic whole of the ornamentation of applicant's shirts."); *In re Original Red Plate Co.*, 223 USPQ 836 (TTAB 1984) ("YOU ARE SPECIAL TODAY" for ceramic plates found to be without any source-indicating significance).

See also TMEP §1202.04 regarding informational matter.

#### **1202.03(f)(ii) Designs Used on the Goods**

See *In re Soccer Sport Supply Co., Inc.*, 507 F.2d 1400, 184 USPQ 345 (C.C.P.A. 1975) (evidence of record insufficient to establish distinctiveness of pentagon-shaped repetitive design applied to the entire surface of soccer balls); *In re General Tire & Rubber Co.*, 404 F.2d 1396, 160 USPQ 415 (C.C.P.A. 1969) (three narrow white concentric rings of approximately equal width applied to the outer surface of a dark sidewall tire considered just a refinement of a general ornamental concept rather than a trademark); *In re David Crystal, Inc.*, 296 F.2d 771, 132 USPQ 1 (C.C.P.A. 1961) (two parallel colored bands at the top of the sock, the upper band red and the lower band blue, for men's ribbed socks); *In re Sunburst Products, Inc.*, 51 USPQ2d 1843 (TTAB 1999) (combination of matching color of watch bezel and watch band and contrasting colors of watch case and watch bezel for sports watches found to be nothing more than a mere refinement of a common or basic color scheme for sports watches and therefore would not immediately be recognized or perceived as a source indicator); *In re Villeroy & Boch S.A.R.L.*,

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

5 USPQ2d 1451 (TTAB 1987) (floral pattern design of morning glories and leaves for tableware not distinctive and not shown to be other than decorative pattern without trademark significance).

### **1202.03(f)(iii) Trade Dress on the Containers for the Goods**

See *In re J. Kinderman & Sons Inc.*, 46 USPQ2d 1253 (TTAB 1998) (design of container for Christmas decorations that resembles a wrapped Christmas gift not inherently distinctive); *In re F.C.F. Inc.*, 30 USPQ2d 1825 (TTAB 1994) (rose design used on cosmetics packaging is essentially ornamental or decorative background and does not function as mark); *In re Petersen Mfg. Co.*, 2 USPQ2d 2032 (TTAB 1987) (design representing the rear panel of a container for hand tools held unregistrable as merely ornamental, notwithstanding §2(f) claim).

### **1202.03(g) Ornamentation Cases and Acquired Distinctiveness**

In the following cases, subject matter sought to be registered was found to have acquired distinctiveness as a trademark: *In re Jockey International, Inc.*, 192 USPQ 579 (TTAB 1976) (inverted Y design used on underwear found to have acquired distinctiveness, where evidence showed extensive use on packaging and in advertising in a manner calculated to draw the attention of prospective purchasers to the design and for them to look at the design as a badge of origin); *Anchor Hocking Glass Corp. v. Corning Glass Works*, 162 USPQ 288 (TTAB 1969) (blue cornflower design for coffee percolators and culinary vessels and utensils found to have acquired distinctiveness, where evidence showed extensive and prominent use of the design in advertising, use of the design on pins and aprons worn by sales promotion representatives in the course of their duties, and surveys and statements of purchasers indicating that they recognized the design as indicating origin in applicant ).

### **1202.04 Informational Matter**

Slogans that are considered to be merely informational in nature or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry are not registrable. *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998) (DRIVE SAFELY perceived as an everyday, commonplace safety admonition that does not function as mark); *In re Manco Inc.*, 24 USPQ2d 1938, 1942 (TTAB 1992) (THINK GREEN and design found unregistrable for weatherstripping and paper products, the Board stating, “[R]ather than being regarded as an indicator of source, the term ‘THINK GREEN’ would be regarded simply as a slogan of environmental awareness and/or ecological consciousness ...”); *In re Southbrook Entertainment Corp.*, 8 USPQ2d 1166 (TTAB 1988) (HI-YO-SILVER, for videotapes and cassettes, held to be a well known expression

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

closely linked to a character, but did not function as a trademark for the goods); *In re Remington Products Inc.*, 3 USPQ2d 1714 (TTAB 1987) (PROUDLY MADE IN USA, for electric shavers, held incapable of functioning as a mark, notwithstanding use of letters “TM” in connection with prominent display of slogan on packages for the goods and claim of acquired distinctiveness); *In re Tilcon Warren, Inc.*, 221 USPQ 86 (TTAB 1984) (WATCH THAT CHILD held not to function as a mark for construction material notwithstanding long use, where the only use was on the bumpers of construction vehicles in which the goods were transported); *In re Schwauss*, 217 USPQ 361 (TTAB 1983) (FRAGILE used on labels and bumper stickers does not function as a mark).

See TMEP §1301.02(a) regarding informational matter that does not function as a service mark.

A slogan can function as a trademark if it is not merely descriptive or informational. See e.g., *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970) (affirming the Board’s dismissal of an opposition to the registration of HAIR COLOR SO NATURAL ONLY HER HAIRDRESSER KNOWS FOR SURE for a hair coloring preparation); *In re The Hallicrafters Co.*, 153 USPQ 376 (TTAB 1967) (QUALITY THROUGH CRAFTSMANSHIP found registrable for radio equipment). See TMEP §1202.03(f)(i) regarding ornamental slogans used on goods.

### 1202.05 Color as a Mark

Color marks are marks that consist *solely* of one or more colors used on particular objects. For marks used in connection with goods, the color may be used on the entire surface of the goods, on a portion of the goods, or on all or part of the packaging for the goods. For example, a color trademark might consist of purple used on a salad bowl, or pink used on the handle of a shovel, or a blue background and a pink circle used on all or part of a product package. See *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161 (1995) (green-gold used on dry cleaning press pads held to be a protectible trademark, where the color had acquired secondary meaning); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985) (the color pink as applied to fibrous glass residential insulation registrable where the evidence showed the color had acquired secondary meaning). Similarly, service marks may consist of color used on all or part of materials used in the advertising and rendering of the services.

The registrability of a color mark depends on the manner in which the proposed mark is used. *In re Owens-Corning*, 227 USPQ at 419, 774 F.2d at 1120. A color(s) takes on the characteristics of the object or surface to which it is applied, and the commercial impression of a color will change accordingly. See *In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121, 1124 (Fed. Cir. 2001) (“a word mark retains its same appearance when used on

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

different objects, but color is not immediately distinguishable as a service mark when used in similar circumstances”).

Color marks are never inherently distinctive, and cannot be registered on the Principal Register without a showing of acquired distinctiveness under §2(f) of the Trademark Act, 15 U.S.C. §1052(f). *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 211-212, 54 USPQ2d 1065, 1068 (2000). See TMEP §1202.05(a) and cases cited therein.

Color, whether a single overall color or multiple colors applied in a specific and arbitrary fashion, is usually perceived as an ornamental feature of the goods or services. *In re Owens-Corning*, 227 USPQ at 422, 774 F.2d at 1124; *In re Hudson News Co.*, 39 USPQ2d 1915, 1923 (TTAB 1996), *aff'd per curiam*, 114 F.3d 1207 (Fed. Cir. 1997) (“blue motif” used in retail stores would likely be perceived by prospective purchasers as “nothing more than interior decoration” that “could be found in any number of retail establishments. Undoubtedly such features are usually perceived as interior decoration or ornamentation.”) However, color can function as a mark if it is used in the manner of a trademark/service mark and if it is perceived by the purchasing public to identify and distinguish the goods or services on or in connection with which it is used and to indicate their source. The United States Supreme Court has held that color alone may sometimes meet the basic legal requirements for a trademark. When it does, there is no rule that prevents color from serving as a mark. *Qualitex*, 514 U.S. at 161, 34 USPQ2d at 1162. If a color is not functional and is shown to have acquired distinctiveness on or in connection with the applicant’s goods or services, it is registrable as a mark.

Functional color marks are not registrable. See TMEP §1202.05(b) and cases cited therein.

### **1202.05(a) Color Marks Never Inherently Distinctive**

Color marks are never inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 211-212, 54 USPQ2d 1065, 1068 (2000) (citing *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 162-163, 34 USPQ2d 1161, 1162-1163 (1995)); *In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121, 1124 (Fed. Cir. 2001). Therefore, the examining attorney must refuse to register a color mark on the Principal Register unless the applicant establishes that the mark has acquired distinctiveness under §2(f). The examining attorney must issue this refusal in *all* color mark applications where acquired distinctiveness has not been shown, regardless of the filing basis of the application. The ground for refusal is that the color is not inherently distinctive and thus does not function as a trademark under §§1, 2 and 45, or does not function as a service mark under §§1, 3 and 45.

If the proposed color mark is not functional, it may be registrable on the Principal Register if it is shown to have acquired distinctiveness under §2(f).

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

If it is not distinctive, it is registrable only on the Supplemental Register. See *In re Hudson News Co.*, 39 USPQ2d 1915 (TTAB 1996), *aff'd per curiam*, 114 F.3d 1207 (Fed. Cir. 1997) (“blue motif” applied to retail store services not registrable on Principal Register without resort to Section 2(f)); *Edward Weck Inc. v. IM Inc.*, 17 USPQ2d 1142 (TTAB 1990) (the color green, as uniformly applied to medical instruments, not barred from registration on the basis of functionality; however, evidence failed to establish that the color had become distinctive of the goods); *In re Deere & Co.*, 7 USPQ2d 1401 (TTAB 1988) (the colors green and yellow, as applied to the body and wheels of machines, respectively, not barred from registration on the basis of functionality; evidence held to establish that the colors had become distinctive of the goods).

The burden of proving that a color mark has acquired distinctiveness is substantial. See *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985) (the color pink, as uniformly applied to fibrous glass residential insulation, shown to have acquired distinctiveness as a trademark for the goods); *In re Benetton Group S.p.A.*, 48 USPQ2d 1214 (TTAB 1998) (evidence insufficient to establish that green rectangular background design had acquired distinctiveness as applied to clothing and footwear); *In re American Home Products Corp.*, 226 USPQ 327 (TTAB 1985) (tri-colored, three-dimensional circular-shaped design found to have become distinctive of analgesic and muscle relaxant tablets); *In re Star Pharmaceuticals, Inc.*, 225 USPQ 209 (TTAB 1985) (evidence found insufficient to establish that two-colored drug capsules and multi-colored seeds or granules contained therein had become distinctive of methyltestosterone).

As noted above, the commercial impression of a color may change depending on the object to which it is applied. Therefore, evidence submitted to demonstrate acquired distinctiveness of a color may show consumer recognition with respect to certain objects, but not for other objects. See *In re Thrifty, Inc.*, 61 USPQ2d at 1124. Cf. *Qualitex*, 514 U.S. at 163, 34 USPQ2d at 1162-1163 (“The imaginary word ‘Suntost,’ or the words ‘Suntost Marmalade,’ on a jar of orange jam immediately would signal a brand or a product ‘source’; the jam’s orange color does not do so. But, over time, customers may come to treat a particular color on a product or its packaging (say, a color that in context seems unusual, such as pink on a firm’s insulating material or red on the head of a large industrial bolt) as signifying a brand. And, if so, that color would have come to identify and distinguish the goods -- *i. e.*, ‘to indicate’ their ‘source...’”)

### **1202.05(b) Functional Color Marks Not Registrable**

A color mark is not registrable on the Principal Register under §2(f), or the Supplemental Register, if the color is functional. *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), *cert. denied*,

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

514 U.S. 1050 (1995); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985). A color may be functional if it yields a utilitarian or functional advantage, for example, yellow or orange for safety signs. *Brunswick Corp. v. British Seagull*, *supra* (holding the color black functional for outboard motors because while the color did not provide utilitarian advantages in terms of making the engines work better, it nevertheless provided recognizable competitive advantages in terms of being compatible with a wide variety of boat colors and making the engines appear smaller); *In re Ferris Corporation*, 59 USPQ2d 1587 (TTAB 2000) (color pink used on surgical wound dressings is functional because the actual color of the goods closely resembles Caucasian human skin); *In re Orange Communications, Inc.*, 41 USPQ2d 1036 (TTAB 1996) (colors yellow and orange held to be functional for public telephones and telephone booths, since they are more visible under all lighting conditions in the event of an emergency); *In re Howard S. Leight & Associates Inc.*, 39 USPQ2d 1058 (TTAB 1996) (color coral held to be functional for earplugs, because it is more visible during safety checks). A color may also be functional if it is more economical to manufacture or use. For example, a color may be a natural by-product of the manufacturing process for the goods. In such a case, appropriation of the color by a single party would place others at a competitive disadvantage by requiring them to alter the manufacturing process.

*See also In re Pollak Steel Co.*, 314 F.2d 566, 136 USPQ 651 (C.C.P.A. 1963) (reflective color on fence found to be functional); *R.L. Winston Rod Co. v. Sage Mfg. Co.*, 838 F. Supp. 1396, 29 USPQ2d 1779 (D. Mont. 1993) (color green used on graphite fishing rods found to be functional); *Russell Harrington Cutlery Inc. v. Zivi Hercules Inc.*, 25 USPQ2d 1965 (D. Mass. 1992) (color white used on cutlery handles found to be functional); *Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ2d 1501 (TTAB 1993) (color green used as wrapper for saw blades is functional when the color is one of the six colors used in a color-coding system to identify the type of blade).

The doctrine of “aesthetic functionality” may apply in some cases where the evidence indicates that the color at issue provides specific competitive advantages that, while not necessarily categorized as purely “utilitarian” in nature, nevertheless dictate that the color remain in the public domain. *Brunswick Corp. v. British Seagull*, *supra*. *See also TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001) (in which the Supreme Court discussed aesthetic functionality, distinguishing *Qualitex*, *supra*, as a case where “aesthetic functionality was the central question...”). *See* TMEP §1202.02(a)(iii)(C) regarding the “aesthetic functionality” doctrine.

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### **1202.05(c) Color as a Separable Element**

As with all trademarks, a color mark may contain only those elements that make a separable commercial impression. See TMEP §807.12(d). Accordingly, an applicant may not seek to register the color of the wording or design apart from the words or designs themselves if the color does not create a separate commercial impression. For example, an applicant may not register the color of words that make up its mark apart from the words themselves, if the color does not create a separate commercial impression apart from the words. However, the applicant may register the color of the background material on which the words or design appear apart from the words or design. See TMEP §1202.11.

The commercial impression of a color may change depending on the object to which it is applied. *In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121, 1124 (Fed. Cir. 2001); *In re Hayes*, 62 USPQ2d 1443 (TTAB 2002). An application seeking registration of color in the abstract, without considering the manner or context in which the color is used, would be contrary to law and public policy because it would result in an unlimited number of marks being claimed in a single application. *Cf. In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 1368, 51 USPQ2d 1513, 1517-18 (Fed. Cir. 1999) (mark with changeable or “phantom” element unregistrable because it would “encompass too many combinations and permutations to make a thorough and effective search possible,” and, therefore, would not provide adequate notice to the public); *In re Upper Deck Co.*, 59 USPQ2d 1688 (TTAB 2001) (hologram used on trading cards in varying shapes, sizes, contents and positions constitutes more than one “device” as contemplated by §45 of the Trademark Act). Only one mark can be registered in a single application. TMEP §807.01.

### **1202.05(d) Drawings of Color Marks Required**

All marks, other than sound and scent marks, require a drawing. TMEP §807. An application for a color mark that is filed without a drawing will be denied a filing date. 37 C.F.R. §2.21(a)(3). Similarly, an application for a color mark with a proposed drawing page that states “no drawing” or sets forth only a written description of the mark will be denied a filing date. The drawing provides notice of the nature of the mark sought to be registered. Only marks that are not capable of representation in a drawing, such as sound or scent marks, are excluded from the requirement for a drawing. Color marks are visual, and should be depicted in a color drawing, accompanied by (1) a color claim naming the color(s) that are a feature of the mark; and (2) a separate statement describing where the color(s) appear and how they are used on the mark. 37 C.F.R. §2.52(b)(1); TMEP §807.07(a).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1202.05(d)(i) Drawings of Color Marks in Trademark Applications**

In most cases, the drawing will consist of a representation of the product or product package. The drawing of the mark must be a substantially exact representation of the mark as used or intended to be used on the goods. 37 C.F.R. §2.51. A depiction of the object on which the color is used is needed to meet this requirement.

The object depicted on the drawing should appear in broken lines. The broken lines inform the viewer where and how color is used on the product or package, while at the same time making it clear that the shape of the product, or the shape of the package, is not claimed as part of the mark. 37 C.F.R. §2.52(b)(4); TMEP §807.08. In the absence of a broken-line drawing, the Office will assume that the mark is a composite mark consisting of the product shape, or the packaging shape, in a particular color.

#### ***Color used on multiple goods***

If the mark is used on multiple goods, the drawing required will depend on the nature of the goods. The drawing of the mark must be a substantially exact representation of the mark as used or intended to be used on the goods. 37 C.F.R. §2.51. A drawing consisting of a depiction of only one of the goods will be accepted if the goods, or the portions of the goods on which color appears, are similar in form and function so that a depiction of only one of the products is still a substantially exact representation of the mark as used on all of the products. For example, if the mark is the color purple used on refrigerators and freezers, a drawing of a freezer (in broken lines, with a description of the mark indicating that the color purple is used on the mark) would be sufficient. Or, if the mark is the color pink used on the handles of rakes, shovels and hoes, a drawing of any of those items (in dotted lines with a description of the mark stating that the handle is pink) would be sufficient. Or, if the mark consists of packaging for various food items that is always blue with a pink circle, a drawing of any one of the packages (in dotted lines with a description of the colors) would be sufficient.

If the mark is used on multiple goods that are dissimilar or unrelated, or if color is used in different ways on different goods, so that a depiction of one of the goods is not a substantially exact representation of the mark as used on all of the goods (for example, the color purple used on microscopes and vending machines), a separate application must be submitted for each item.

#### ***Color used on liquids or powders***

Sometimes a color mark consists of color(s) used on liquids or powders. For example, the mark might consist of fuchsia body oil or red, white and blue granular washing machine detergent. In these cases, the nature of the drawing will depend on the manner of use of the liquid or powder. If the liquid or powder is visible through the product package, then the drawing should



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

consist of the shape of the product package in broken lines, with the description of the mark identifying the color of the liquid or powder.

### **1202.05(d)(ii) Drawings of Color Marks in Service Mark Applications**

It is difficult to anticipate all of the issues that may arise, because there are a myriad of ways that color can be used in connection with services. However, the following general guidelines will be used to determine the sufficiency of drawings in these cases:

- The purpose of a drawing is to provide notice to the public of the nature of the mark. As with color used on goods, a color service mark does not consist of color in the abstract. Rather, the mark consists of color used in a particular manner, and the context in which the color is used is critical to provide notice of the nature of the mark sought to be registered. Therefore, as with color marks used on goods, a drawing, supplemented with a written description, is required.
- The drawing must display the manner in which the mark is used in connection with the services. As with any application, only one mark can be registered in a single application. TMEP §807.01. The mark depicted on the drawing must, as used on the specimens, make a separate and distinct commercial impression to be considered one mark. See *In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001); *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988). See TMEP §1202.05(c) regarding color as a separable element.
- If color is used in a variety of ways, but in a setting that makes a single commercial impression, such as a retail outlet with various color features, a broken-line drawing of the setting must be submitted, with a detailed description of the color(s).
- If an applicant seeks to register a single color as a service mark used on a variety of items not viewed simultaneously by purchasers, e.g., stationery, uniforms, pens, signs, shuttle buses, the store awning and the walls of the store, the drawing must display a solid-colored square with a dotted peripheral outline and include a detailed description of the mark. *Thrifty*, 274 F.3d at 1353, 61 USPQ2d at 1124. Applicant will receive a filing date for its application. However, as yet, the issues raised by the use of this type of drawing, e.g., sufficient notice and phantom marks, have not yet been decided by the Office. Cf. *In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 1368, 51 USPQ2d 1513, 1517-18 (Fed. Cir. 1999). See TMEP §1202.05(c).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- The commercial impression of a color may change depending on the object on which it is applied. See *Thrifty*, 61 USPQ2d at 1124.

### **1202.05(d)(iii) Drawings for Marks Including Both Color and Words or Design**

Sometimes a product or advertisement for a service will include both color and words or a design. For example, the surface of a toaster might be green, with the trademark “ABC” and design displayed on the toaster. In this situation, the applicant must decide whether to seek registration for the color green used on toasters, the letters “ABC” with or without the design, the design, or some combination of those elements. If applicant only seeks registration for the use of the color, no word or design elements should appear on the drawing.

### **1202.05(e) Written Explanation of a Color Mark**

The drawing of a color mark must be supplemented with a written description of the mark, naming the color(s), and a separate statement describing where the colors appear on the mark. 37 C.F.R. §§2.52(b)(1); TMEP §807.07(a).

The description of the mark must be clear and specific, use ordinary language, and identify the mark as consisting of the particular color as applied to the goods or services. If the color is applied only to a portion of the goods, the description must indicate the specific portion. Similarly, if the mark includes gradations of color, the description should so indicate. If the applicant is claiming a shade of color, the shade must be described in ordinary language, for example, “maroon,” “turquoise,” “navy blue,” “reddish orange.” This is required even if the applicant also describes the color using a commercial coloring system.

The applicant may not amend the description of the mark if the amendment is a material alteration of the mark on the drawing filed with the original application. 37 C.F.R. §2.72. See *In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001); cf. *In re Hacot-Colombier*, 105 F.3d 616, 41 USPQ2d 1523 (Fed. Cir. 1997). See TMEP §§807.14 *et seq.* regarding material alteration.

The description of a color mark must be limited to a single mark, because only one mark can be registered in a single application. See *In re International Flavors & Fragrances Inc.*, 83 F.3d 1361 51 USPQ2d 1513 (Fed. Cir. 1999); *In re Hayes*, 62 USPQ2d 1443 (TTAB 2002). See TMEP §1202.05(c) regarding color as a separable element. Cf. TMEP §807.01 (drawing must be limited to a single mark).

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### **1202.05(f) Specimens for Color Marks**

An application §1 of the Trademark Act must be supported by a specimen that shows use of the mark depicted in the drawing. Therefore, an applicant who applies to register a color mark must submit a specimen showing use of color, either with a §1(a) application or with an allegation of use in a §1(b) application. If a black and white specimen is submitted, the examining attorney will require a substitute specimen. See TMEP §904.02(c).

See TMEP §§904.04 *et seq.* regarding trademark specimens and TMEP §§1301.04 *et seq.* regarding service mark specimens.

### **1202.05(g) Special Considerations for Service Mark Applications**

No service mark registrations have issued for a single color *per se*. Although the applicant in *In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001) argued that it applied for the color blue *per se* as a service mark, the Court determined that the drawing controlled, such that the application was for the color blue applied to a building. Although the Court did not reach the issue of color *per se* as a service mark, the Court acknowledged the special evidentiary problem associated with showing acquired distinctiveness in this context. *Thrifty*, 274 F.3d at 1353, 61 USPQ2d at 1124 (“ . . . [E]vidence submitted to demonstrate acquired distinctiveness of a color may show consumer recognition with respect to certain objects (e.g., blue vehicle rental centers), but not for other objects (e.g., blue rental cars)”). Accordingly, any claim to color *per se* must be specific as to use and include evidence of acquired distinctiveness for each claimed use.

### **1202.05(h) Applications for Color Marks Based on Intent-to-Use**

A color mark can never be inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 211-212, 54 USPQ2d 1065, 1068 (2000) (citing *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 162-163, 34 USPQ2d 1161, 1162-1163 (1995)); TMEP §1202.05. Therefore, the examining attorney must refuse to register a color mark on the Principal Register unless the applicant establishes that the mark has acquired distinctiveness under §2(f). The ground for refusal is that the color is not inherently distinctive and thus does not function as a trademark under §§1, 2 and 45, or does not function as a service mark under §§1, 3 and 45.

The issue of whether the proposed mark is functional requires consideration of the manner in which the mark is used. Generally, no refusal on these grounds will be issued in a §1(b) application until the applicant has submitted specimens of use with an amendment to allege use or statement of use. See TMEP §§1102.01, 1202.02(e) and 1202.03(e). The specimens provide a better record upon which to determine the registrability of the mark. In appropriate cases, the examining attorney will bring the potential refusal to

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

the applicant's attention in the initial Office action. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided to the applicant before the allegation of use is filed, the Office is not precluded from refusing registration on this basis.

### **1202.05(i) Applications for Color Marks Based on §44 or §66(a)**

A color mark can never be inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 211-212, 54 USPQ2d 1065, 1068 (2000) (citing *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 162-163, 34 USPQ2d 1161, 1162-1163 (1995)); TMEP §1202.05. Therefore, the examining attorney must refuse to register a proposed color mark on the Principal Register unless the applicant establishes that the mark has acquired distinctiveness under §2(f). The ground for refusal is that the color is not inherently distinctive and thus does not function as a trademark under 15 U.S.C. §§1051, 1052 and 1127, or does not function as a service mark under 15 U.S.C. §§1051, 1053 and 1127.

If the record indicates that the proposed mark is functional, the examining attorney should issue a refusal of registration on the Principal Register under §2(f), or on the Supplemental Register. See TMEP §1202.05(b). *NOTE: A mark in a §66(a) application cannot be registered on the Supplemental Register under any circumstances. 15 U.S.C. §1141h(a)(4); 37 C.F.R. §§2.47(c) and 2.75(c).*

### **1202.06 Goods in Trade**

Section 45 of the Trademark Act, 15 U.S.C. §1127, defines a "trademark" as a "word, name, symbol, or device, or any combination thereof" that is used or intended to be used in commerce to *identify and distinguish his or her goods* (emphasis added)." Before rights in a term as a trademark can be established, the subject matter to which the term is applied must be "goods in trade." Incidental items that an applicant uses in conducting its business (such as letterhead, invoices and business forms), as opposed to items sold or transported in commerce for use by others, are not "goods in trade." See *In re Shareholders Data Corp.*, 495 F.2d 1360, 181 USPQ 722 (C.C.P.A. 1974) (reports not goods in trade, where applicant is not engaged in the sale of reports, but solely in furnishing financial reporting services, and reports are merely conduit through which services are rendered); *In re Compute-Her-Look, Inc.*, 176 USPQ 445 (TTAB 1972) (reports and printouts not goods in trade, where they are merely the means by which the results of a beauty analysis service is transmitted and have no viable existence separate and apart from the service); *Ex parte Bank of America National Trust and Savings Association*, 118 USPQ 165 (Comm'r Pats. 1958) (mark not registrable for passbooks, checks and other printed forms, where forms are used only as necessary tools in the performance of banking services, and the applicant is not engaged in printing or selling forms as commodities in trade).

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### 1202.06(a) Goods Must Have Utility to Others

Affixing a mark to an item that is transported in commerce does not in and of itself establish that the mark is used on “goods.” While a formal sale is not always necessary, items sold or transported in commerce are not “goods in trade” unless they have utility to others as the type of product named in the application.

*Example:* Holiday greeting cards sent by a law firm to its clients are not “goods,” where applicant is merely sending its own cards through the mail as a holiday greeting, and the cards are not suitable for use by the recipients as a greeting card.

See *Gay Toys, Inc. v. McDonald's Corp.*, 585 F.2d 1067, 199 USPQ 722 (C.C.P.A. 1978) (plaster mockup of toy truck not goods in trade, where there is no evidence the mockup is actually used as a toy); *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994), *aff'd*, 108 F.3d 1392 (Fed. Cir. 1997) (mark not registrable for games, where purported games are advertising flyers used to promote applicant's services and have no real utilitarian function or purpose as games); *In re Douglas Aircraft Co., Inc.*, 123 USPQ 271 (TTAB 1959) (books, pamphlets and brochures that serve only to explain and advertise the goods in which applicant deals are not “goods”). *Cf. In re Snap-On Tools Corp.*, 159 USPQ 254 (TTAB 1968) (ball point pens used to promote applicant's tools are goods in trade, where they have a utilitarian function and purpose, and have been sold to applicant's franchised dealers and transported in commerce under mark); *In re United Merchants & Manufacturers, Inc.*, 154 USPQ 625 (TTAB 1967) (calendar used to promote applicant's plastic film constitutes goods in trade, where calendar has a utilitarian function and purpose in and of itself, and has been regularly distributed in commerce for several years).

### 1202.06(b) Registration Must Be Refused if Trademark Not Used on Goods in Trade

If the specimens, identification of goods, or other evidence in the record indicate that the applicant uses the mark only on items incidental to conducting its own business, as opposed to items intended to be used by others, the examining attorney should refuse registration on the Principal Register under §§1, 2 and 45 of the Trademark Act; 15 U.S.C. §§1051, 1052 and 1127, on the ground that the mark is not used on “goods in trade.”

If a mark is not used on “goods in trade,” it is not registrable on the Principal Register under §2(f) of the Trademark Act, 15 U.S.C. §1052(f), or on the Supplemental Register.

If some, but not all of the items listed in the identification of goods are found not to be “goods in trade,” it is not necessary to refuse registration of the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

entire application, but the examining attorney should require that these items be deleted from the identification of goods.

### **1202.06(c) “Goods in Trade” in Intent-to-Use Applications**

In an intent-to-use application under §1(b) of the Trademark Act, the question of whether a mark is used on goods in trade usually does not arise until the applicant files an allegation of use under §1(c) or §1(d) of the Act, because this issue is based on the manner in which the mark is used. However, if the identification of goods in an intent-to-use application includes items that do not appear to be goods in trade, the potential refusal should be brought to the applicant’s attention in the first action issued by the Office. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided to the applicant before the allegation of use is filed, the Office is not precluded from refusing registration on this basis.

### **1202.07 Marks That Identify Columns or Sections of Publications**

#### **1202.07(a) Marks That Identify Columns or Sections of Printed Publications**

A column, section or supplement of a printed publication is normally not considered to be separate “goods” or “goods in trade” unless it is sold, syndicated, or offered for syndication separate and apart from the larger publication in which it appears. *In re Broadcasting Publications, Inc.*, 135 USPQ 374 (TTAB 1962); *Ex parte Meredith Publishing Co.*, 109 USPQ 426 (Comm’r Pats. 1956). This is true even of a removable or separable “pullout” section of a newspaper or other publication. In *Meredith*, the issue was analyzed as follows:

The basic question is whether or not, under the circumstances of use, the section title is a name adopted and used by the publisher to identify his goods and distinguish them from those of others. The “goods” actually are magazines-not sections of magazines. When the magazine is purchased, the purchaser receives the sections whether he wants them or not, and it is doubtful that magazine readers *ordinarily* purchase a magazine merely to receive a section of it, or think of a magazine merely in terms of a section title. Sections of magazines are not in and of themselves articles of commerce other than as a part of an integrated whole; and we must therefore be concerned with whether a section title actually identifies and distinguishes, and if so, what it distinguishes. Under these circumstances it becomes necessary to ask: Was the mark adopted to identify a section of applicant’s magazine and distinguish it from sections of other publishers’ magazines, or was it adopted to distinguish one section of applicant’s magazine from the

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

other sections of its magazine? *Ordinarily*, it is the latter (emphasis in original).

109 USPQ 426.

### **1202.07(a)(i) Syndicated Columns and Sections**

Columns or sections that are separately sold, syndicated, or offered for syndication do constitute goods in trade. A mark that identifies a column or section that is separately syndicated or offered for syndication is registrable on the Principal Register without resort to §2(f) of the Trademark Act, 15 U.S.C. §1052(f), if registration is not barred by other sections of the Act.

### **1202.07(a)(ii) Non-Syndicated Columns and Sections**

A column or section of a printed publication that is not separately sold, syndicated, or offered for syndication is not, in and of itself, considered to be separate goods in trade. Therefore, where the specimens, identification of goods, or other evidence in the record indicates that the mark identifies a column or section of a printed publication that is not separately sold, syndicated, or offered for syndication, the examining attorney should refuse registration on the Principal Register under §§1, 2 and 45 of the Trademark Act; 15 U.S.C. §§1051, 1052 and 1127, on the ground that the mark is not used on separate goods in trade.

Marks that identify non-syndicated columns or sections of printed publications are registrable on the Principal Register under §2(f) of the Trademark Act, 15 U.S.C. §1052(f), if the column or section is shown to have acquired separate recognition and distinctiveness. The applicant who seeks registration on the Principal Register bears the burden of establishing, through evidence of promotion, long use, advertising expenditures, and breadth of distribution or sales figures, that the public has come to recognize the proposed mark as an indicator of source.

The evidence of acquired distinctiveness must show that the column or section title is used and promoted to distinguish applicant's column or section from the columns or sections of other publishers' publications rather than merely to distinguish applicant's column or section from other columns or sections of applicant's publication. *Metro Publishing v. San Jose Mercury News*, 987 F.2d 637, 25 USPQ2d 2049 (9<sup>th</sup> Cir. 1993); *In re Broadcasting Publications, Inc.*, 135 USPQ 374 (TTAB 1962).

The amount of evidence needed to establish distinctiveness must be evaluated by the examining attorney on a case-by-case basis, in light of the type of column or supplement. If the mark identifies a removable or pull-out section, a lesser degree of evidence might be required to establish distinctiveness. Of course, the amount of evidence needed to establish

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

distinctiveness in any particular case will also vary depending on the strength or weakness of the mark. TMEP §1212.04(a).

Marks that identify non-syndicated columns or sections of printed publications, but have not yet acquired distinctiveness and therefore are not registrable under §2(f) of the Act, are registrable on the Supplemental Register, if registration is not barred by other sections of the Act. *Ex parte Meredith Publishing Co.*, 109 USPQ 426 (Comm'r Pats. 1956).

### **1202.07(a)(iii) Marks That Identify Columns and Sections of Printed Publications in Intent-to-Use Applications**

Since a refusal to register a mark that identifies a column or section of a printed publication is based on whether the column or section is separately sold or syndicated, the issue ordinarily does not arise in an intent-to-use application under §1(b) of the Trademark Act, 15 U.S.C. §1051(b), until the applicant has filed either an amendment to allege use under §1(c), or a statement of use under §1(d), 15 U.S.C. §§1051(c) and (d). However, if the identification of goods indicates that the mark is intended to be used to identify a column or section of a printed publication that is not separately sold or syndicated, the potential refusal on the ground that the proposed mark is not used on separate goods in trade should be brought to the applicant's attention in the first Office Action. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided to the applicant prior to the filing of the allegation of use, the Office is not precluded from refusing registration on this basis.

### **1202.07(b) Marks That Identify Columns and Sections of Online Publications**

An online publication is considered a service rather than a product. Therefore, refusal of registration on the ground that the proposed mark is not used on goods in trade is inappropriate. Unlike a printed column or section, an online column or section can be accessed directly and can exist independent of any single publication. *See Ludden v. Metro Weekly*, 8 F. Supp.2d 7, 47 USPQ2d 1087, 1093 (D.D.C. 1998). Therefore, a mark that identifies an online column is registrable on the Principal Register without resort to §2(f) of the Trademark Act, 15 U.S.C. §1052(f), if registration is not barred by other sections of the Act.

### **1202.08 Title of a Single Creative Work**

The title of a single creative work is not registrable on the Principal Register or the Supplemental Register. Examples of "single creative works" include books, videotapes, films and theatrical performances. *Herbko International, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) ("the title of a single book cannot serve as a source



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

identifier”); *In re Cooper*, 254 F.2d 611, 615-16, 117 USPQ 396, 400 (C.C.P.A. 1958), *cert. denied*, 358 U.S. 840, 119 USPQ 501 (1958) (“A book title ... identifies a specific literary work ... and is not associated in the public mind with the publisher, printer or bookseller...”); *In re Posthuma*, 45 USPQ2d 2011 (TTAB 1998) (title of a live theater production held unregistrable); *In re Hal Leonard Publishing Corp.*, 15 USPQ2d 1574 (TTAB 1990) (INSTANT KEYBOARD, as used on music instruction books, found unregistrable as the title of a single work); *In re Appleby*, 159 USPQ 126 (TTAB 1968) (title of single phonograph record, as distinguished from series, does not function as mark).

The name of a series of books or other creative works may be registrable if it serves to identify and distinguish the source of the goods. *In re Scholastic Inc.*, 23 USPQ2d 1774, 1778 (TTAB 1992) (THE MAGIC SCHOOL BUS, prominently displayed on the cover of a series of books, has come to represent a source to purchasers and would be recognized as a trademark). However, a term used in the title of a series of books is not registrable if it merely identifies a character in the books. *In re Scholastic Inc.*, 223 USPQ 431 (TTAB 1984) (THE LITTLES, used in the title of each in a series of children’s books, does not function as a mark where it merely identifies the main characters in the books). *Cf. In re Caserta*, 46 USPQ2d 1088 (TTAB 1998) (FURR-BALL FURCANIA, used as the principal character in a single children’s book, was found not to function as a mark even though the character’s name appeared on the cover and every page of the story); *In re Frederick Warne & Co. Inc.*, 218 USPQ 345 (TTAB 1983) (an illustration of a frog used on the cover of a single book served only to depict the main character in the book and did not function as a trademark).

See TMEP §1301.02(d) regarding the registrability of titles of radio and television programs as service marks, and TMEP §1202.09(a) regarding the registrability of the names of performing artists on sound recordings.

### **1202.09 Names of Artists and Authors**

Generally, subject matter used solely as an author’s name, even on multiple books, does not function as a trademark. *See In re Chicago Reader Inc.*, 12 USPQ2d 1079 (TTAB 1989) (CECIL ADAMS, as used on the specimens, merely identifies the author and is not used as a trademark). *Cf. In re Wood*, 217 USPQ 1345 (TTAB 1983) (artist’s pseudonym YSABELLA, affixed to an original work of art, functioned as a trademark).

See TMEP §1202.09(a) regarding the registrability of the names of performing artists used on sound recordings.

See *also* TMEP §1301.02(b) regarding the registrability of the names of characters and personal names as service marks.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1202.09(a) Names of Performing Artists Used on Sound Recordings

Subject matter that, as used on sound recordings, *merely* serves to identify the artist or artists whose performance comprises the content of the recording is not registrable as a trademark for the recordings. *In re Spirer*, 225 USPQ 693 (TTAB 1985). As noted by the Court of Appeals for the Federal Circuit in *In re Polar Music International AB*, 714 F.2d 1567, 1572, 221 USPQ 315, 318 (Fed. Cir. 1983), “just showing the name of the recording group on a record will not by itself enable that name to be registered as a trademark. Where, however, the owner of the mark controls the quality of the goods, and where the name of that recording group has been used numerous times on different records and has therefore come to represent an assurance of quality to the public, the name may be registered as a trademark since it functions as one.” Personal names of individuals or groups function as service marks for entertainment services only if they identify and distinguish the services recited and not merely the individual or group. See TMEP §1301.02(b).

The following guidelines must be followed to ensure consistent action on applications to register the names of performers for sound recordings in accordance with *In re Polar Music International AB* and *In re Spirer*.

- First, the names of performers may only be registered as a trademark if the mark is used on a series of sound recordings. The identification of goods must specifically indicate that there is a series. If the application does not identify the goods in this fashion, the examining attorney must require an appropriate amendment.
- Secondly, the applicant must provide evidence that the mark has been applied to at least two different recordings in the series. In an intent-to-use application, the applicant must provide evidence of use on at least two recordings at the time the applicant files either the amendment to allege use or the statement of use. The examining attorney should provide advance notice of this requirement during initial examination, where appropriate. If the applicant is unable to demonstrate use on a series, the mark may be registered on the Supplemental Register, provided it is otherwise proper. These procedures apply specifically to performers' names used on recordings and not to other types of marks used on other types of artistic material.
- Finally, it is only necessary to inquire about the applicant's control over the nature and quality of the goods if information in the application record clearly contradicts the applicant's verified statement that it is the owner of the mark or entitled to use the mark.

Similarly, the name of a performer is not registrable as a service mark for entertainment services unless the record shows the name identifies a

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

continuing series of presentations, performances or recordings. See TMEP §1301.02(d).

### 1202.10 Model or Grade Designations

Subject matter used solely as a model, style or grade designation within a product line does not function as a trademark. *In re Dana Corp.*, 12 USPQ2d 1748 (TTAB 1989) (alphanumeric designations, such as “5-469X,” held unregistrable for universal joint couplings; evidence insufficient to establish distinctiveness and recognition as a mark). *Cf. In re Clairol Inc.*, 457 F.2d 509, 173 USPQ 355 (C.C.P.A. 1972) (SWEDISH CRYSTAL found to be a registrable trademark, not merely a color designation, for a hair coloring preparation, the Court relying on the arbitrariness of the mark, its manner of use and the fact that it was always used in addition to a shade designation); *In re Petersen Mfg. Co., Inc.*, 229 USPQ 466, 468 (TTAB 1986) (letter-number combinations found registrable for locking hand tools, the Board stating, “[T]here is no question that such model designations can, through use and promotion, be perceived as marks indicating origin in addition to functioning as model designations.”)

### 1202.11 Background Designs and Shapes

“A background design which is always used in connection with word marks must create a commercial impression on buyers separate and apart from the word marks for the design to be protectible as a separate mark. In deciding whether the design background of a word mark may be separately registered, the essential question is whether or not the background material is or is not inherently distinctive.... If the background portion is inherently distinctive, no proof of secondary meaning need be introduced; if not, such proof is essential (citations omitted).” *In re Chemical Dynamics, Inc.*, 839 F.2d 1569, 1570-1571, 5 USPQ2d 1828, 1829 (Fed. Cir. 1988).

Common geometric shapes, when used as vehicles for the display of word marks, are not regarded as indicators of origin absent evidence of distinctiveness of the design alone. Additionally, the Supreme Court stated in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 211-212, 54 USPQ2d 1065, 1068 (2000) that color can never be inherently distinctive.

In the following cases, the evidence of distinctiveness was insufficient: *In re Benetton Group S.p.A.*, 48 USPQ2d 1214 (TTAB 1998) (green rectangular background design not inherently distinctive; evidence of acquired distinctiveness found insufficient); *In re Anton/Bauer Inc.*, 7 USPQ2d 1380 (TTAB 1988) (parallelogram designs used as background for word marks found not inherently distinctive; evidence of record held insufficient to establish acquired distinctiveness pursuant to §2(f)); *In re Kerr-McGee Corp.*, 190 USPQ 204 (TTAB 1976) (affirming refusals to register escutcheon design used as a frame or border for words, under §2(f)).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

In the following cases, the evidence of distinctiveness was sufficient: *In re Schenectady Varnish Co., Inc.*, 280 F.2d 169, 126 USPQ 395 (C.C.P.A. 1960) (where use of applicant's design of a cloud and a lightning flash was always used as a background for the word "SCHENECTADY," evidence of record found sufficient to show acquired distinctiveness of the design alone as a trademark for synthetic resins); *In re Raytheon Co.*, 202 USPQ 317 (TTAB 1979) (light-colored oval within black rectangular carrier considered not inherently distinctive; evidence of record found sufficient to establish acquired distinctiveness).

An applicant may respond to a refusal to register by submitting evidence that the subject matter has acquired distinctiveness, under §2(f) of the Trademark Act, 15 U.S.C. §1052(f). The examining attorney should scrutinize any submission that asserts distinctiveness solely on the basis of a statement of substantially exclusive and continuous use for five years to determine whether it truly establishes that the subject matter is perceived as a trademark by the purchasing public. The examining attorney may continue to refuse registration if he or she believes that the applicant's assertion does not establish that the matter is perceived as a trademark. The applicant may submit additional evidence to establish distinctiveness. See TMEP §§1212 *et seq.*

### **1202.12 Varietal and Cultivar Names (Examination of Applications for Seeds and Plants)**

Varietal or cultivar names are designations given to cultivated varieties or subspecies of live plants or agricultural seeds. They amount to the generic name of the plant or seed by which such variety is known to the public. These names can consist of a numeric or alphanumeric code or can be a "fancy" (arbitrary) name. The terms "varietal" and "cultivar" may have slight semantic differences but pose indistinguishable issues and are treated identically for trademark purposes.

Subspecies are types of a particular species of plant or seed that are members of a particular genus. For example, all maple trees are in the genus *Acer*. The sugar maple species is known as *Acer saccharum*, while the red maple species is called *Acer rubrum*. In turn, these species have been subdivided into various cultivated varieties that are developed commercially and given varietal or cultivar names that are known to the public.

If the examining attorney determines that wording sought to be registered as a mark for live plants, agricultural seeds, fresh fruits or fresh vegetables comprises a varietal or cultivar name, then the examining attorney must refuse registration, or require a disclaimer, on the ground that the matter is the varietal name of the goods and does not function as a trademark under §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127. See *Dixie Rose Nursery v. Coe*, 131 F.2d 446, 55 USPQ 315 (D.C. Cir. 1942),

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

*cert. denied* 318 U.S. 782, 57 USPQ 568 (1943); *In re Hilltop Orchards & Nurseries, Inc.*, 206 USPQ 1034 (TTAB 1979); *In re Farmer Seed & Nursery Co.*, 137 USPQ 231 (TTAB 1963); *In re Cohn Bodger & Sons Co.*, 122 USPQ 345 (TTAB 1959). Likewise, if the mark identifies the prominent portion of a varietal name, it must be refused. *In re Delta and Pine Land Co.*, 26 USPQ2d 1157 (TTAB 1993) (Board affirmed refusal to register DELTAPINE, which was a portion of the varietal names Deltapine 50, Deltapine 20, Deltapine 105 and Deltapine 506).

A varietal or cultivar name is used in a plant patent to identify the variety. Thus, even if the name was originally arbitrary, it “describe[s] to the public a [plant] of a particular sort, not a [plant] from a particular [source].” *Dixie Rose*, 131 F.2d at 447, 55 USPQ at 316. It is against public policy for any one supplier to retain exclusivity in a patented variety of plant, or the name of a variety, once its patent expires. *Id.*

Market realities and lack of laws concerning the registration of varietal and cultivar names have created a number of problems in this area. Some varietal names are not attractive or easy to remember by the public. As a result, many arbitrary terms are used as varietal names. Problems arise when trademark registration is sought for varietal names, when arbitrary varietal names are thought of as being trademarks by the public, and when terms intended as trademarks by plant breeders become generic through public use. These problems make this a difficult area for the examining attorney in terms of gathering credible evidence and knowing when to make refusals.

Whenever an application is filed to register a mark containing wording for live plants, agricultural seeds, fresh fruits, or fresh vegetables, the examining attorney must inquire of the applicant whether the term has ever been used as a varietal name, and whether such name has been used in connection with a plant patent, a utility patent, or a certificate for plant variety protection. See 37 C.F.R. §2.61(b). The examining attorney should also undertake an independent investigation of any evidence that would support a refusal to register, using sources of evidence that are appropriate for the particular goods specified in the application (e.g., laboratories and repositories of the United States Department of Agriculture, plant patent information from the USPTO, a variety name search of plants certified under the Plant Variety Protection Act listed at [www.ars-grin.gov/npgs/searchgrin.html](http://www.ars-grin.gov/npgs/searchgrin.html)).

### 1202.13 Scent or Fragrance

The scent of a product may be registrable if it is used in a non-functional manner. See *In re Clarke*, 17 USPQ2d 1238 (TTAB 1990), in which the Trademark Trial and Appeal Board held that a scent functioned as a mark for “sewing thread and embroidery yarn.” Scents that serve a utilitarian purpose, such as the scent of perfume, would be functional and not registrable. See

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

TMEP §§1202.02(a) *et seq.* regarding functionality. When a scent is not functional, it may be registered on the Principal Register under §2(f), or on the Supplemental Register. The amount of evidence required to establish that a scent or fragrance functions as a mark is substantial. *Cf. In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985).

The requirement for a drawing does not apply to scent marks. 37 C.F.R. §2.52(e). See TMEP §807.09.

### **1202.14 Holograms**

A hologram used in varying forms does not function as a mark in the absence of evidence that consumers would perceive it as a trademark. See *In re Upper Deck Co.*, 59 USPQ2d 1688 (TTAB 2001), where the Board held that a hologram used on trading cards in varying shapes, sizes, and positions did not function as a mark, because the record showed that other companies used holograms on trading cards and other products as anti-counterfeiting devices, and there was no evidence that the public would perceive applicant's hologram as an indicator of source. The Board noted that "the common use of holograms for non-trademark purposes means that consumers would be less likely to perceive applicant's uses of holograms as trademarks." 59 USPQ2d at 1693.

Therefore, in the absence of evidence of consumer recognition as a mark, the examining attorney should refuse registration on the ground that the hologram does not function as a mark, under §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127.

Generally, if a hologram has two or more views, the examining attorney should also refuse registration under §§1 and 45 of the Trademark Act, 15 U.S.C. §§1051 and 1127, on the ground that the application seeks registration of more than one mark. *In re Upper Deck, supra*. See TMEP §807.01.

### **1202.15 Sound Marks**

A sound mark identifies and distinguishes a product or service through audio rather than visual means. Examples of sound marks include: (1) a series of tones or musical notes, with or without words, and (2) wording accompanied by music. For a discussion of the criteria for registration of sound marks, see *In re General Electric Broadcasting Co., Inc.*, 199 USPQ 560 (TTAB 1978).

The requirement for a drawing does not apply to sound marks. 37 C.F.R. §2.52(e). See TMEP §807.09.

Audio cassettes and compact disks may be accepted as specimens for sound marks. 37 C.F.R. §2.56(d)(3). To show that the sound mark actually identifies and distinguishes the services and indicates their source, the

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

specimen should contain a sufficient portion of the audio content to indicate the nature of the services. If the mark comprises music or words set to music, the applicant may also submit the musical score as a specimen.

When filing through TEAS, a musical score must be submitted in .wav format. However, a .wav file cannot be sent as an attachment to a TEAS filing, because all TEAS attachments must be in .jpg format. Therefore, the Office has developed a special procedure for handling .wav files. The .wav file must be sent after the application is filed, as an attachment to an e-mail message directed to [TEAS@uspto.gov](mailto:TEAS@uspto.gov), with clear instructions that the .wav file should be associated with “the application filed under Serial No. <specify>.”

### **1203 Refusal on Basis of Immoral or Scandalous Matter; Deceptive Matter; Matter which May Disparage, Falsely Suggest a Connection, or Bring into Contempt or Disrepute**

*Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it--*

*(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 2(9) of the Uruguay Round Agreements Act) enters into force with respect to the United States.*

The provisions of 15 U.S.C. §1052(a) apply to both the Principal Register and the Supplemental Register.

### **1203.01 Immoral or Scandalous Matter**

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), is an absolute bar to the registration of immoral or scandalous matter on either the Principal Register or the Supplemental Register.

Although the words “immoral” and “scandalous” may have somewhat different connotations, case law has included immoral matter in the same category as scandalous matter. See *In re McGinley*, 660 F.2d 481, 484 n.6, 211 USPQ 668, 672 n.6 (C.C.P.A. 1981), *aff'g* 206 USPQ 753 (TTAB 1979) (“Because of our holding, *infra*, that appellant’s mark is ‘scandalous,’ it is unnecessary to consider whether appellant’s mark is ‘immoral.’ We note the dearth of

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

reported trademark decisions in which the term ‘immoral’ has been directly applied.”)

The prohibition against the registration of marks that consist of or comprise immoral or scandalous matter was originally enacted as §5(a) of the Trademark Act of 1905, and was reenacted as part of §2(a) of the Act of 1946. There is little legislative history concerning the intent of Congress with regard to the provision; therefore, the term “scandalous” is interpreted by looking to “its ordinary and common meaning.” *In re Riverbank Canning Co.*, 95 F.2d 327, 328, 37 USPQ 268, 269 (C.C.P.A. 1938). This may be established by referring to court decisions, decisions of the Trademark Trial and Appeal Board and dictionary definitions. *In re McGinley*, 660 F.2d at 485, 211 USPQ at 673.

In affirming a refusal to register a mark as scandalous under §2(a), the Court of Customs and Patent Appeals noted dictionary entries that defined “scandalous” as, *inter alia*, shocking to the sense of propriety, offensive to the conscience or moral feelings or calling out for condemnation. *In re McGinley*, 660 F.2d at 486, 211 USPQ at 673 (mark comprising a photograph of a nude, reclining man and woman, kissing and embracing, for a “newsletter devoted to social and interpersonal relationship topics” and for “social club services,” held scandalous). The statutory language “scandalous” has also been considered to encompass matter that is “vulgar,” defined as “lacking in taste, indelicate, morally crude.” *In re Runsdorf*, 171 USPQ 443, 444 (TTAB 1971). See also *In re Tinseltown, Inc.*, 212 USPQ 863, 864 (TTAB 1981) (BULLSHIT, which the Board termed “profane,” held scandalous for “accessories of a personal nature, ... attaché cases, hand bags, purses, belts, and wallets”).

The meaning imparted by a mark must be determined in the context of the current attitudes of the day. See *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 31 USPQ2d 1923 (Fed. Cir. 1994) (evidence found insufficient to establish that BLACK TAIL used on adult entertainment magazines comprises scandalous matter; court noted that there were both vulgar and non-vulgar definitions of “tail,” and that the record was devoid of evidence demonstrating which of these definitions a substantial composite of the general public would choose in the context of the relevant marketplace); *In re Old Glory Condom Corp.*, 26 USPQ2d 1216 (TTAB 1993) (OLD GLORY CONDOM CORP and design comprising the representation of a condom decorated with stars and stripes in a manner to suggest the American flag held not to be scandalous); *In re Thomas Laboratories, Inc.*, 189 USPQ 50, 52 (TTAB 1975) (“[I]t is imperative that fullest consideration be given to the moral values and conduct which contemporary society has deemed to be appropriate and acceptable.”)

The determination of whether a mark is scandalous must be made in the context of the relevant marketplace for the goods or services identified in the application, and must be ascertained from the standpoint of not necessarily a majority, but a “substantial composite of the general public.” *In re McGinley*,



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

660 F.2d at 485, 211 USPQ at 673 (“[T]he Lanham Act does not require, under the rubric of ‘scandalous,’ any inquiry into the specific goods or services not shown in the application itself.”); *In re Wilcher Corp.*, 40 USPQ2d 1929 (TTAB 1996) (mark for restaurant and bar services consisting of words DICK HEADS positioned directly underneath caricature of a human head composed primarily of graphic and readily recognizable representation of male genitalia held scandalous, as it would be considered offensive by a substantial portion of the public); *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1639 (TTAB 1988) (graphic design of a dog defecating, as applied to polo shirts and T-shirts, held scandalous, given the broad potential audience that may view applicant’s mark in sales establishments and “virtually all public places”); *In re Hepperle*, 175 USPQ 512 (TTAB 1972) (while the words might be a reference to marijuana, ACAPULCO GOLD found not scandalous when used as a mark for suntan lotion); .

Therefore, to support a refusal on the ground that a proposed mark is immoral or scandalous, the examining attorney must provide evidence that a substantial portion of the general public would consider the mark to be scandalous in the context of contemporary attitudes and the relevant marketplace. *In re Mavety Media*, 33 F.3d at 1371-1372, 31 USPQ2d at 1925. This evidence could include dictionary definitions, newspaper articles and magazine articles.

Dictionary definitions alone may be sufficient to establish that a proposed mark comprises scandalous matter, where multiple dictionaries, including at least one standard dictionary, all indicate that a word is vulgar, and the applicant’s use of the word is limited to the vulgar meaning of the word. *In re Boulevard Entertainment, Inc.*, 334 F.3d 1336, 67 USPQ2d 1475 (Fed. Cir. 2003) (1-800-JACK-OFF and JACK OFF held scandalous, where all dictionary definitions of “jack-off” were considered vulgar).

It has been noted that the threshold is lower for what can be described as “scandalous” than for “obscene.” Refusal to register immoral or scandalous matter has been found not to abridge First Amendment rights, because no conduct is proscribed and no tangible form of expression is suppressed. Also, the term “scandalous” has been held sufficiently precise to satisfy due process requirements under the Fifth Amendment. *In re McGinley*, 660 F.2d at 484-85, 211 USPQ at 672.

The prohibition in §2(a) of the Act against the registration of scandalous matter pertains only to *marks* that are scandalous. The authority of the Act does not extend to goods that may be scandalous. *See In re Madsen*, 180 USPQ 334, 335 (TTAB 1973) (WEEK-END SEX for magazines held not scandalous, the Board observing that whether the magazine contents may be pornographic was not an issue before the Board).

The examining attorney may look to the specimen(s) or other aspects of the record to determine how the mark will be seen in the marketplace. *See In re*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*McGinley*, 660 F.2d at 482 n.3, 211 USPQ at 670 n.3 (containing excerpts from appellant's newsletters pertaining to their subject matter); *In re Hershey*, 6 USPQ2d 1470, 1472 (TTAB 1988) (BIG PECKER BRAND for T-shirts found not scandalous, the Board considering the labels that were submitted as specimens in determining the question of how the mark might be perceived. "[T]he inclusion of the bird design would make it less likely that purchasers would attribute any vulgar connotation to the word mark and we note that it is proper to look to the specimens of record to determine connotation or meaning of a mark.")

To ensure consistency in examination with respect to immoral or scandalous matter, when an examining attorney believes, for whatever reason, that a mark may be considered to comprise such matter, the examining attorney must consult with his or her supervisor.

### 1203.02 Deceptive Matter

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), is an absolute bar to the registration of deceptive matter on either the Principal Register or the Supplemental Register. Neither a disclaimer of the deceptive matter nor a claim that it has acquired distinctiveness under §2(f) can obviate a refusal under §2(a) on the ground that the mark consists of or comprises deceptive matter. See *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798, 808 (TTAB 1984); *In re Charles S. Loeb Pipes, Inc.*, 190 USPQ 238, 241 (TTAB 1975).

Deceptive marks may include marks that falsely describe the material content of a product (see *In re Intex Plastics Corp.*, 215 USPQ 1045 (TTAB 1982)) and marks that are geographically deceptive (see *Stabilisierungsfonds für Wein v. Peter Meyer Winery GmbH*, 9 USPQ2d 1073 (TTAB 1988); *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984)). See TMEP §1210.05 *et seq.* regarding geographically deceptive marks.

The Court of Appeals for the Federal Circuit has articulated the following test for whether a mark consists of or comprises deceptive matter:

- (1) Is the term misdescriptive of the character, quality, function, composition or use of the goods?
- (2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods?
- (3) If so, is the misdescription likely to affect the decision to purchase?

*In re Budge Mfg. Co. Inc.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988), *aff'g* 8 USPQ2d 1790 (TTAB 1987).

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

The fact that only those knowledgeable in the relevant trade, and not average purchasers, would be deceived does not preclude a finding that a mark comprises deceptive matter. *In re House of Windsor, Inc.*, 223 USPQ 191, 192 (TTAB 1984).

### **1203.02(a) Distinction between Marks Comprising Deceptive Matter (§2(a)) and Deceptively Misdescriptive Marks (§2(e)(1))**

If the first two inquiries set forth by the Federal Circuit in *In re Budge Mfg. Co. Inc.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988) (*i.e.*, whether a mark is misdescriptive of the goods or services and whether prospective purchasers are likely to believe the misdescription), are answered affirmatively, the mark is deceptively misdescriptive of the goods/services under §2(e)(1).

The third inquiry, whether the misdescription is likely to affect the decision to purchase, distinguishes marks that are deceptive under §2(a) from marks that are deceptively misdescriptive under §2(e)(1).

To establish that a misdescription would be likely to affect the decision to purchase, the examining attorney should provide evidence that the misdescriptive quality or characteristic would make the product or service more appealing or desirable to prospective purchasers. *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992).

The examining attorney is to refuse registration of a mark of this type under both §2(a) and §2(e)(1), where it is difficult to determine whether misdescriptive matter would materially affect a decision to purchase. See, *e.g.*, *Gold Seal Co. v. Weeks*, 129 F. Supp. 928, 105 USPQ 407 (D.D.C. 1955), *aff'd sub nom. S. C. Johnson & Son, Inc. v. Gold Seal Co.*, 230 F.2d 832, 108 USPQ 400 (D.C. Cir. 1956) (*per curiam*), *cert. denied*, 352 U.S. 829, 111 USPQ 467 (1956). See also *R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d 786, 140 USPQ 276 (C.C.P.A. 1964), and *Stabilisierungsfonds fur Wein v. Peter Meyer Winery GmbH*, 9 USPQ2d 1073 (TTAB 1988), in which third parties filed oppositions based on both statutory sections.

Marks that are deceptive under §2(a) are unregistrable on either the Principal Register or the Supplemental Register, whereas marks that are deceptively misdescriptive under §2(e)(1) may be registrable on the Principal Register with a showing of acquired distinctiveness under §2(f), 15 U.S.C. §1052(f), or on the Supplemental Register.

See TMEP §1210.05(a) regarding the distinction between marks comprising deceptive matter under §2(a) and matter that is primarily geographically deceptively misdescriptive under §2(e)(3).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1203.02(b) Deceptive Matter: Case References

In the following cases, proposed marks were determined to be deceptive, under §2(a): *In re Budge Mfg. Co. Inc.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988), *aff'g* 8 USPQ2d 1790 (TTAB 1987) (LOVEE LAMB held deceptive for seat covers not made of lambskin); *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047 (TTAB 2002) (SUPER SILK held deceptive for “clothing, namely dress shirts and sport shirts made of silk-like fabric”); *In re Organik Technologies, Inc.*, 41 USPQ2d 1690 (TTAB 1997) (ORGANIK deceptive for clothing and textiles made from cotton that is neither from an organically grown plant nor free of chemical processing or treatment, notwithstanding applicant’s assertions that the goods are manufactured by a process that avoids the use of chemical bleaches, because the identification of goods was broad enough to include textiles and clothing manufactured with chemical processes or dyes); *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992) (LONDON LONDON held deceptive for clothing having no connection with London); *In re Perry Mfg. Co.*, 12 USPQ2d 1751 (TTAB 1989) (PERRY NEW YORK and design of New York City skyline held deceptive for clothing originating in North Carolina, in view of the renown of New York City in the apparel industry); *Stabilisierungsfonds fur Wein v. Peter Meyer Winery GmbH*, 9 USPQ2d 1073, 1075 (TTAB 1988) (GOLDENER TROPFEN held deceptive for wines, in view of evidence of the international renown of the Goldtropfchen vineyard of West Germany, the Board finding that the purchasing public would be likely to think, mistakenly, that applicant’s wines were produced from grapes grown there in accordance with German wine laws and regulations); *Bureau National Interprofessionnel Du Cognac v. International Better Drinks Corp.*, 6 USPQ2d 1610 (TTAB 1988) (COLAGNAC held deceptive for cola-flavored liqueur containing Spanish brandy, the Board concluding that purchasers were likely to believe that applicant’s goods contained COGNAC brandy); *In re Shapely, Inc.*, 231 USPQ 72 (TTAB 1986) (SILKEASE held deceptive as applied to clothing not made of silk); *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984) (BAHIA held deceptive as applied to cigars having no connection with the Bahia province of Brazil, the record indicating that tobacco and cigars are important products in the Bahia region); *Evans Products Co. v. Boise Cascade Corp.*, 218 USPQ 160 (TTAB 1983) (CEDAR RIDGE held deceptive for embossed hardboard siding not made of cedar); *In re Intex Plastics Corp.*, 215 USPQ 1045 (TTAB 1982) (TEXHYDE held deceptive as applied to synthetic fabric for use in the manufacture of furniture, upholstery, luggage and the like); *Tanners’ Council of America, Inc. v. Samsonite Corp.*, 204 USPQ 150 (TTAB 1979) (SOFTHIDE held deceptive for imitation leather material); *In re Salem China Co.*, 157 USPQ 600 (TTAB 1968) (AMERICAN LIMOGES, used on dinnerware that was neither made in Limoges, France, nor made from Limoges clay, held deceptive because of the association of Limoges with fine quality china); *Company of Cutlers of Hallamshire in the County of York v. Regent-Sheffield, Ltd.*, 155 USPQ 597 (TTAB 1967) (SHEFFIELD, used on cutlery not made in Sheffield, England,

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

held deceptive because of the renowned status of Sheffield in relation to cutlery); *In re U.S. Plywood Corp.*, 138 USPQ 403 (TTAB 1963) (IVORY WOOD, for lumber and timber products, held deceptive since the goods were not made of ivorywood nor did they contain an ivorywood pattern).

Marks were found not to be deceptive in the following cases: *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487 (TTAB 1990) (PARK AVENUE held neither deceptive nor geographically deceptively misdescriptive as applied to applicant's cigarettes and smoking tobacco, the Board finding no goods/place association between Park Avenue in New York City, on which opposer's world headquarters was located, and tobacco products); *In re Fortune Star Products Corp.*, 217 USPQ 277 (TTAB 1982) (NIPPON, for radios, televisions and the like, found not deceptive in relation to the goods because, although the applicant was an American firm, the goods were actually made in Japan); *In re Sweden Freezer Mfg. Co.*, 159 USPQ 246, 249 (TTAB 1968) (SWEDEN and design, for which registration was sought under §2(f) for external artificial kidney units, held not deceptive, the Board finding the case to be in the category "where a geographical trademark may involve a degree of untruth but the deception may be perfectly innocent, harmless or negligible"); *A. F. Gallun & Sons Corp. v. Aristocrat Leather Products, Inc.*, 135 USPQ 459 (TTAB 1962) (COPY CALF, for wallets and billfolds of synthetic and plastic material made to simulate leather, found not deceptive, the Board noting that the mark, as an obvious play on the expression "copy cat," suggested to purchasers that the goods were imitations of items made of calf skin).

### **1203.03 Matter which May Disparage, Falsely Suggest a Connection, or Bring into Contempt or Disrepute**

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), bars the registration on either the Principal or the Supplemental Register of a designation that consists of or comprises matter which, with regard to persons, institutions, beliefs, or national symbols, does any of the following: (1) disparages them, (2) falsely suggests a connection with them, (3) brings them into contempt, or (4) brings them into disrepute.

Section 2(a) is distinctly different from §2(d), 15 U.S.C. §1052(d), for which the relevant test is likelihood of confusion. In *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 1375-76, 217 USPQ 505, 508-09 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982), the Court of Appeals for the Federal Circuit noted as follows:

A reading of the legislative history with respect to what became §2(a) shows that the drafters were concerned with protecting the name of an individual or institution which was not a technical "trademark" or "trade name" upon which an objection could be made under §2(d)....

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Although not articulated as such, it appears that the drafters sought by §2(a) to embrace concepts of the right to privacy, an area of the law then in an embryonic state (footnote omitted). Our review of case law discloses that the elements of a claim of invasion of one's privacy have emerged as distinctly different from those of trademark or trade name infringement. There may be no likelihood of such confusion as to the source of goods even under a theory of "sponsorship" or "endorsement," and, nevertheless, one's right of privacy, or the related right of publicity, may be violated.

The right to privacy protects a party's control over the use of its identity or "persona." A party acquires a protectible interest in a name or equivalent designation under §2(a) where the name or designation is unmistakably associated with, and points uniquely to, that party's personality or "persona." A party's interest in a name or designation does not depend upon adoption and use as a technical trademark or trade name. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d at 1376-77, 217 USPQ at 509; *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985).

See TMEP §§1203.03(c) and 1203.03(d) regarding disparagement, bringing into contempt and bringing into disrepute, and TMEP §§1203.03(e) and 1203.03(f) regarding false suggestion of a connection.

See *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 218 USPQ 1 (6<sup>th</sup> Cir. 1983), concerning the various forms of identity which have been protected under the rights of privacy and publicity.

### **1203.03(a) "Persons" Defined**

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), protects, *inter alia*, "persons, living or dead."

Section 45 of the Act, 15 U.S.C. §1127, defines "person" and "juristic person" as follows:

The term "person" and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this Act includes a juristic person as well as a natural person. The term "juristic person" includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.

The term "person" also includes the United States, any agency or instrumentality thereof, or any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States. The United States, any agency or

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

instrumentality thereof, and any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States, shall be subject to the provisions of this Act in the same manner and to the same extent as any nongovernmental entity.

The term “person” also includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this Act in the same manner and to the same extent as any non-governmental entity.

The term “persons” in §2(a) refers to real persons, not fictitious characters. In addition to natural persons, it includes juristic persons, *i.e.*, legally-created entities such as firms, corporations, unions, associations or any other organizations capable of suing and being sued in a court of law. See *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (C.C.P.A. 1969); *Popular Merchandise Co. v. “21” Club, Inc.*, 343 F.2d 1011, 145 USPQ 203 (C.C.P.A. 1965); *John Walker & Sons, Ltd. v. American Tobacco Co.*, 110 USPQ 249 (Comm’r Pats. 1956); *Copacabana, Inc. v. Breslauer*, 101 USPQ 467 (Comm’r Pats. 1954).

With respect to natural persons, they may be living or dead. However, §2(a) may not be applicable with regard to a deceased person when there is no longer anyone entitled to assert a proprietary right or right of privacy. *Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 314 F. Supp. 329, 165 USPQ 459 (S.D.N.Y. 1970) (DA VINCI held not to falsely suggest connection with deceased artist Leonardo Da Vinci).

A juristic person’s rights under §2(a) are extinguished when the juristic person ceases to exist.

Juristic persons or institutions do not have to be well known to be protected from the registration of a mark that falsely suggests a connection with or disparages them, or brings them into contempt or disrepute. *Gavel Club v. Toastmasters International*, 127 USPQ 88, 94 (TTAB 1960).

It is well settled that the United States Government is a juristic person. See *NASA v. Record Chemical Co. Inc.*, 185 USPQ 563, 566 (TTAB 1975), and cases cited therein.

A mark does not have to comprise a person’s full or correct name to be unregistrable; a nickname or other designation by which a person is known by the public may be unregistrable under this provision of the Act. *Buffett v. Chi-Chi’s, Inc.*, 226 USPQ 428, 430 (TTAB 1985) (evidence of record “sufficient to raise a genuine issue of material fact as to whether the term ‘MARGARITAVILLE’ is so uniquely and unmistakably associated with

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

opposer as to constitute opposer's name or identity such that when applicant's mark is used in connection with its [restaurant] services, a connection with opposer would be assumed").

### **1203.03(b) "National Symbols" Defined**

A "national symbol" is subject matter of unique and special significance that, because of its meaning, appearance and/or sound, immediately suggests or refers to the country for which it stands. *In re Consolidated Foods Corp.*, 187 USPQ 63 (TTAB 1975) (noted national symbols include the bald eagle, Statue of Liberty, American flag, Presidential symbol, designation "Uncle Sam" and the unique human representation thereof, and the heraldry and shield designs used in governmental offices). National symbols include the symbols of foreign countries as well as those of the United States. *In re Anti-Communist World Freedom Congress, Inc.*, 161 USPQ 304 (TTAB 1969).

The Trademark Act does not prohibit registration of marks comprising national symbols; it only prohibits registration of matter that may disparage national symbols, falsely suggest a connection with them, or hold them up to contempt or disrepute. *Liberty Mutual Insurance Co. v. Liberty Insurance Co. of Texas*, 185 F. Supp. 895, 908, 127 USPQ 312, 323 (E.D. Ark. 1960) (marks comprising portion of the Statue of Liberty found not to disparage, bring into contempt or disrepute, or falsely suggest a connection with the Statue of Liberty or the United States government, the Court "[a]ssuming without deciding" that the statue is a national symbol).

Designations have been held to be national symbols within the meaning of §2(a) in the following cases: *In re Anti-Communist World Freedom Congress, Inc.*, 161 USPQ 304 (TTAB 1969) (representation of a hammer and sickle held to be a national symbol of the Union of Soviet Socialist Republics (U.S.S.R.)); *In re National Collection & Credit Control, Inc.*, 152 USPQ 200, 201 n.2 (TTAB 1966) ("The American or bald eagle with wings extended is a well-known national symbol or emblem of the United States"); *In re Teasdale Packing Co., Inc.*, 137 USPQ 482 (TTAB 1963) (U. S. AQUA and design held unregistrable under §2(a) on the ground that purchasers of applicant's canned drinking water would be misled into assuming approval or sponsorship by the United States government in view of the nature of the mark, including a red, white and blue shield design, and the nature of the goods, the Board noting a program for stocking emergency supplies of water in fallout shelters and the setting of standards for drinking water by United States government agencies).

Designations have been held not to be national symbols in the following cases: *W. H. Snyder and Sons, Inc. v. Ladd*, 227 F. Supp. 185, 140 USPQ 647 (D.D.C. 1964) (HOUSE OF WINDSOR held not to be a national symbol of England, but merely the name of its present reigning family); *NASA v. Bully Hill Vineyards, Inc.*, 3 USPQ2d 1671 (TTAB 1987) (SPACE SHUTTLE found



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

not to constitute a national symbol on the evidence of record, the Board also finding “shuttle” to be a generic term for a space vehicle or system); *Jacobs v. International Multifoods Corp.*, 211 USPQ 165, 170-71 (TTAB 1981), *aff’d on other grounds*, 668 F.2d 1234, 212 USPQ 641 (C.C.P.A. 1982) (“[H]istorical events such as the ‘BOSTON TEA PARTY’..., although undoubtedly associated with the American heritage, do not take on that unique and special significance of a ‘national symbol’ designed to be equated with and associated with a particular country.”); *In re General Mills, Inc.*, 169 USPQ 244 (TTAB 1971) (UNION JACK, which applicant was using on packages of frozen fish marked “English cut cod” and in its restaurant near representations of the British national flag, found not to suggest a particular country, the Board noting that it could consider only the matter for which registration was sought); *In re Horwitt*, 125 USPQ 145, 146 (TTAB 1960) (U. S. HEALTH CLUB found registrable for vitamin tablets. “Considering both the nature of the mark and the goods, it is concluded that the purchasing public would not be likely to mistakenly assume that the United States Government is operating a health club, that it is distributing vitamins, or that it has approved applicant’s goods.”)

The name of a country is not a national symbol within the meaning of §2(a) of the Trademark Act, *In re Sweden Freezer Mfg. Co.*, 159 USPQ 246, 248-249 (TTAB 1968), nor does use of the name of a country as a mark, by itself, amount to deception, disparagement, or a “false connection” under §2(a). *In re Fortune Star Products Corp.*, 217 USPQ 277 (TTAB 1982).

The acronyms for, and names of, government agencies and bureaus are not considered to be national symbols. *Consolidated Foods Corp.*, 187 USPQ at 64 (OSS, acronym for the Office of Strategic Services, held not to be a national symbol, but merely to designate a particular (and long defunct) government agency, the Board contrasting national symbols with names and acronyms of government agencies: “National symbols’ ... are more enduring in time, ... and immediately conjure up the image of the country as a whole. Symbols of a country take on a special meaning and significance and are not so numerous as to dilute the special meaning and significance that each has.”)

“National symbols” cannot be equated with the “insignia” of nations. As noted in *Liberty Mutual Insurance Co.*, 185 F. Supp. at 908, 127 USPQ at 323:

The Act ... does not put national symbols on a par with the flag, coat of arms, or other insignia of the United States, which may not in any event be made the subject matter of a trade or service mark. With regard to national symbols the statute provides merely that they shall not be disparaged or held up to contempt or disrepute, and shall not be used as falsely to suggest a connection between the holder of the mark and the symbol.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

See TMEP §1204 regarding insignia.

While the prohibition of §2(a) against the registration of matter that may disparage or falsely suggest a connection with national symbols, or bring them into contempt or disrepute, may not be applicable to a particular designation, many names, acronyms, titles, terms, and symbols are protected by other statutes or rules. See TMEP §1205.01.

### **1203.03(c) Disparagement, Bringing into Contempt and Bringing into Disrepute**

Section 2(a) prohibits the registration of a mark that consists of or comprises matter that may disparage, or bring into contempt or disrepute, persons, institutions, beliefs or national symbols. See TMEP §1203.03(a) regarding persons, and TMEP §1203.03(b) regarding national symbols.

In sustaining an opposition on this ground, the Trademark Trial and Appeal Board stated as follows:

Disparagement is essentially a violation of one's right of privacy -- the right to be "let alone" from contempt or ridicule. See, *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 218 USPQ 1 (6<sup>th</sup> Cir. 1983). It has been defined as the publication of a statement which the publisher intends to be understood, or which the recipient reasonably should understand, as tending "to cast doubt upon the quality of another's land, chattels, or intangible things." Restatement (Second) of Torts §629 (1977). The two elements of such a claim are (1) that the communication reasonably would be understood as referring to the plaintiff; and (2) that the communication is disparaging, that is, would be considered offensive or objectionable by a reasonable person of ordinary sensibilities. *Id.* (citations omitted).

*Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1639 (TTAB 1988).

With regard to the first element set forth, the Board found that the applicant's design of a dog defecating strongly resembled the opposer's running dog symbol and that the evidence of record established that the symbol "points uniquely and unmistakably to opposer's persona." *Id.* at 1640.

With regard to the second element, the Board noted the negative nature of the design and stated as follows:

As it relates to opposer, ... the offensiveness of the design becomes even more objectionable because it makes a statement about opposer itself, and holds opposer up to ridicule and contempt.

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

*Id.*

### **1203.03(d) Disparagement, Bringing into Contempt and Bringing into Disrepute: Case References**

See *Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600 (TTAB 1999) (BLACK TAIL used on adult entertainment magazines, found not to be disparaging of women in general, or African-American women in particular, nor to bring those groups into contempt or disrepute); *Order Sons of Italy in America v. Memphis Mafia Inc.*, 52 USPQ2d 1364 (TTAB 1999) (THE MEMPHIS MAFIA for entertainment services found not to be matter that disparages Italian-Americans or bring them into contempt or disrepute); *Harjo v. Pro Football Inc.*, 50 USPQ2d 1705 (TTAB 1999) (REDSKINS, used in connection with presentation of professional football contests, found to be matter that may disparage Native Americans and bring them into contempt or disrepute, but not scandalous matter); *In re In Over Our Heads Inc.*, 16 USPQ2d 1653, 1654 (TTAB 1990) (MOONIES and design incorporating a “buttocks caricature,” for dolls whose pants can be dropped, held not to be disparaging matter that is unregistrable under §2(a), the Board finding that the mark “would, when used on a doll, most likely be perceived as indicating that the doll ‘moons,’ and would not be perceived as referencing members of The Unification Church.”); *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1639-40 (TTAB 1988) (design of dog defecating, for clothing, held to disparage, and bring into contempt or disrepute, opposer’s running dog symbol, the Board finding the evidence of record “sufficient to show prima facie that this design [the running dog symbol] is, in effect, an alter ego of opposer which points uniquely and unmistakably to opposer’s persona.”); *In re Anti-Communist World Freedom Congress, Inc.*, 161 USPQ 304 (TTAB 1969) (design of an “X” superimposed over a hammer and sickle held to disparage, and hold in contempt and disrepute, a national symbol of the U.S.S.R.).

### **1203.03(e) False Suggestion of a Connection**

Section 2(a) prohibits the registration of a mark that consists of or comprises matter that may falsely suggest a connection with persons, institutions, beliefs or national symbols. See TMEP §1203.03(a) regarding persons, TMEP §1203.03(b) regarding national symbols, and TMEP §1203.03 for information about the legislative history of §2(a).

To establish that a proposed mark falsely suggest a connection with a person or an institution, it must be shown that: (1) the mark is the same as, or a close approximation of, the name or identity of a person or institution; (2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution; (3) the person or institution named by the mark is not connected with the activities performed by applicant under the mark; and (4) the fame or reputation of the person or institution is such that, when the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

mark is used with the applicant's goods or services, a connection with the person or institution would be presumed. *In re White*, 73 USPQ2d 1713 (TTAB 2004); *In re Nuclear Research Corp.*, 16 USPQ2d 1316, 1317 (TTAB 1990); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985); *In re Cotter & Co.*, 228 USPQ 202, 204 (TTAB 1985).

In *In re Sloppy Joe's International Inc.*, 43 USPQ2d 1350, 1353-34 (TTAB 1997), the Trademark Trial and Appeal Board held that Ernest Hemingway's friendship with the original owner of applicant's bar, his frequenting the bar and his use of the back room as an office is not the kind of "connection" contemplated by §2(a). Rather, a commercial connection, such as an ownership interest or commercial endorsement or sponsorship of applicant's services would be necessary to entitle the applicant to registration.

If it is unclear whether the person or institution is connected with the goods sold or services performed by the applicant, the examining attorney should make an explicit inquiry under 37 C.F.R. §2.61(b).

A refusal on this basis requires, by implication, that the person or institution with which a connection is falsely suggested must be the prior user. *In re Nuclear Research Corp.*, 16 USPQ2d at 1317; *In re Mohawk Air Services Inc.*, 196 USPQ 851, 854-55 (TTAB 1977).

Intent to identify a party or trade on its goodwill is not a required element of a §2(a) claim of false suggestion of an association with such party. *S & L Acquisition Co. v. Helene Arpels, Inc.*, 9 USPQ2d 1221, 1224 (TTAB 1987); *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752, 754 (TTAB 1985). However, evidence of such an intent could be highly persuasive that the public would make the intended false association. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 1377, 217 USPQ 505, 509 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982).

### **1203.03(f) False Suggestion of a Connection: Case References**

See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 1377, 217 USPQ 505, 509 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982) (NOTRE DAME and design, for cheese, held not to falsely suggest a connection with the University of Notre Dame. "As the board noted, 'Notre Dame' is not a name solely associated with the University. It serves to identify a famous and sacred religious figure and is used in the names of churches dedicated to Notre Dame, such as the Cathedral of Notre Dame in Paris, France. Thus it cannot be said that the only 'person' which the name possibly identifies is the University and that the mere use of NOTRE DAME by another appropriates its identity."); *In re Sauer*, 27 USPQ2d 1073 (TTAB 1993), *aff'd*, 26 F.3d 140 (Fed. Cir. 1994) (registration of BO BALL for oblong shaped leather ball with white stitching properly refused under §2(a), since use of "Bo" would be recognized by

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

purchasers as reference to football and baseball player Bo Jackson, and there was no connection between Jackson and applicant); *In re White*, 73 USPQ2d 1713 (TTAB 2004) (APACHE, used for cigarettes, falsely suggests a connection with the nine federally recognized Apache tribes ); *In re Los Angeles Police Revolver and Athletic Club, Inc.*, 69 USPQ2d 1630 (TTAB 2004) (slogan TO PROTECT AND TO SERVE, used by applicant Los Angeles Police Revolver and Athletic Club, Inc., does not *falsely* suggest a connection with the Los Angeles Police Department, where evidence showed an actual longstanding commercial connection, publicly acknowledged and endorsed by both parties); *In re Urbano*, 51 USPQ2d 1776 (TTAB 1999) (SYDNEY 2000, used for advertising and business services and communication services, falsely suggests connection with Olympic Games, since general public would recognize phrase as referring unambiguously to Olympic Games to be held in Sydney, Australia, in 2000; entire organization that comprises Olympic games qualifies as “institution.”); *In re North American Free Trade Association*, 43 USPQ2d 1282 (TTAB 1997) (NAFTA, used on “promotion of trade and investment” services, falsely suggests connection with North American Free Trade Agreement; NAFTA qualifies as institution because it encompasses treaty, supplemental agreements, and various commissions, committees and offices created by those documents); *In re Sloppy Joe’s International Inc.*, 43 USPQ2d 1350 (TTAB 1997) (use of mark SLOPPY JOE’S, with design that includes portrait of Ernest Hemingway, falsely suggests connection with deceased writer); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435 (TTAB 1996) (cancellation petitioners failed to state claim for relief where they have not alleged, and cannot reasonably allege, that the term INTERNET points uniquely and unmistakably to their own identity or persona); *Ritz Hotel Ltd. v. Ritz Closet Seat Corp.*, 17 USPQ2d 1466, 1471 (TTAB 1990) (RIT-Z in stylized form, for toilet seats, held not to falsely suggest a connection with opposer, the Board observing that there was “no evidence of record directed to showing a connection of applicant’s mark with opposer corporation, The Ritz Hotel Limited”); *In re Nuclear Research Corp.*, 16 USPQ2d 1316 (TTAB 1990) (NRC and design, for radiation and chemical agent monitors, electronic testers and nuclear gauges, held not to falsely suggest a connection with the U.S. Nuclear Regulatory Commission in view of applicant’s use of NRC long prior to the inception of that agency); *NASA v. Bully Hill Vineyards, Inc.*, 3 USPQ2d 1671, 1676 (TTAB 1987) (opposition to the registration of SPACE SHUTTLE for wines dismissed, the Board finding “shuttle” to be a generic term for a space vehicle or system. “Where a name claimed to be appropriated does not point uniquely and unmistakably to that party’s personality or ‘persona,’ there can be no false suggestion.”); *Board of Trustees of University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408 (TTAB 1986) (petition to cancel registration of BAMA, for shoes, slippers, stockings, socks and insoles, granted, the Board finding that the evidence of record indicated that BAMA points uniquely to the University of Alabama and thus falsely suggests a connection with the University); *In re Cotter & Co.*,

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

228 USPQ 202 (TTAB 1985) (WESTPOINT, for shotguns and rifles, held to falsely suggest a connection with an institution, the United States Military Academy). For examples of findings of false suggestion of a connection prior to the decision of the Court of Appeals for the Federal Circuit in *Notre Dame, supra*, see *In re U.S. Bicentennial Society*, 197 USPQ 905 (TTAB 1978) (U.S. BICENTENNIAL SOCIETY, for ceremonial swords, held to falsely suggest a connection with the American Revolution Bicentennial Commission and the United States government); *In re National Intelligence Academy*, 190 USPQ 570 (TTAB 1976) (NATIONAL INTELLIGENCE ACADEMY, for educational and instructional services in intelligence gathering for law enforcement officers, held to falsely suggest a connection with the United States government).

### **1204 Refusal on Basis of Flag, Coat of Arms or Other Insignia of United States, State or Municipality, or Foreign Nation**

*Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.*

Section 2(b) of the Trademark Act, 15 U.S.C. §1052(b), bars the registration on either the Principal Register or the Supplemental Register of marks that consist of or comprise (whether consisting solely of, or having incorporated in them) the flag, coat of arms, or other insignia of the United States, of any state or municipality, or of any foreign nation. Section 2(b) also bars the registration of marks that consist of or comprise any simulation of such symbols.

Section 2(b) differs from the provision of §2(a) regarding national symbols (see TMEP §1203.03(b)) in that §2(b) requires no additional element, such as disparagement or a false suggestion of a connection, to preclude registration.

Flags and coats of arms are specific designs formally adopted to serve as emblems of governmental authority. The wording “other insignia” should not be interpreted broadly, but should be considered to include only those emblems and devices that also represent such authority and that are of the same general class and character as flags and coats of arms. The Trademark Trial and Appeal Board has construed the statutory language as follows:

[T]he wording “or other insignia of the United States” must be restricted in its application to insignia of the same general class as “the flag or coats of arms” of the United States. Since both the flag and coat of arms are emblems of national authority it

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

seems evident that other insignia of national authority such as the Great Seal of the United States, the Presidential Seal, and seals of government departments would be equally prohibited registration under Section 2(b). On the other hand, it appears equally evident that department insignia which are merely used to identify a service or facility of the Government are not insignia of national authority and that they therefore do not fall within the general prohibitions of this section of the Statute.

*In re U.S. Department of the Interior*, 142 USPQ 506, 507 (TTAB 1964) (logo comprising the words “NATIONAL PARK SERVICE” and “Department of the Interior,” with depiction of trees, mountains and a buffalo, surrounded by an arrowhead design, held not to be an insignia of the United States).

Letters that merely identify people and things associated with a particular agency or department of the United States government, instead of representing the authority of the government or the nation as a whole, are generally not considered to be “insignia of the United States” within the meaning of §2(b). The Board, in dismissing an opposition to the registration of “USMC” in a stylized presentation, for prostheses, fracture braces and orthopedic components, discussed the meaning of “insignia” under §2(b), as follows:

The letters “USMC” are nothing like a flag or coat of arms. These types of insignia are pictorial in nature, they can be described, but cannot be pronounced. Even if the letters could be construed to be an insignia, opposer has not shown that they would be seen as an insignia of the United States.

*U.S. Navy v. U.S. Mfg. Co.*, 2 USPQ2d 1254, 1256 (TTAB 1987). As a result of the enactment of Public Law 98-525 on October 19, 1984, the initials, seal and emblem of the United States Marine Corps are “deemed to be insignia of the United States,” under 10 U.S.C. §7881, pertaining to unauthorized use of Marine Corps insignia. However, “USMC” was not so protected when the applicant began using its stylized version of those letters as a mark. In view of the provision in Public Law 98-525 that the amendments adding Chapter 663 (10 U.S.C. §7881) shall not affect rights that vested before the date of its enactment, the majority of the Board found that enactment of the law did not adversely affect the mark’s registrability, stating that “opposer has not shown that applicant’s mark was an insignia of the United States prior to the law making it one, or that the law effectively bars registration to applicant.” *Id.* at 1260. (See TMEP §1205.01 regarding subject matter that is protected by statute.)

*See also Liberty Mutual Insurance Co. v. Liberty Insurance Co. of Texas*, 185 F. Supp. 895, 908, 127 USPQ 312, 323 (E.D. Ark. 1960) (“That the Statue of Liberty is not a part of the ‘insignia of the United States’ is too clear to require discussion.”)

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

As stated above, marks that consist of or comprise any simulation of the flag, coat of arms, or other insignia of the United States, of any state or municipality, or of any foreign nation are also unregistrable under §2(b). “Simulation,” as contemplated by §2(b), refers to “something that gives the appearance or effect or has the characteristics of an original item.” *In re Waltham Watch Co.*, 179 USPQ 59, 60 (TTAB 1973) (mark consisting of wording and the design of a globe and six flags for watches found registrable, the Board stating, “[A]lthough the flags depicted in applicant’s mark incorporate common elements of flag designs such as horizontal or vertical lines, crosses or stars, they are readily distinguishable from any of the flags of the nations alluded to by the examiner. In fact, applicant’s mark would be regarded as nothing more than a conglomeration of nondescript flags utilized to symbolize the significance of the globe design and the slogan ‘TIMING THE WORLD’ appearing thereon.”) Whether a mark comprises a simulation must be determined from a visual comparison of the mark vis-à-vis replicas of the flag, coat of arms or other insignia in question. *Id.*

The determination of whether a proposed mark consists of or comprises a flag, coat of arms or other insignia must be made “without a careful analysis and side-by-side comparison.” *In re Advance Industrial Security, Inc.*, 194 USPQ 344, 346 (TTAB 1977) (ADVANCE SECURITY and design consisting of an eagle on a triangular shield, in gold and brown, for detective and investigative services and providing security systems and services, found registrable, the Board stating, “When the mark of the applicant and the Coat of Arms or Great Seal of the United States are compared in their entireties, it is adjudged that applicant’s mark does not consist of or comprise the Coat of Arms of the United States or any simulation thereof ....”) The public should be considered to retain only a general or overall, rather than specific, recollection of the various elements or characteristics of design marks. *Id.*

The incorporation in a mark of individual or distorted features that are merely suggestive of flags, coats of arms or other insignia does not bar registration under §2(b). See *Knorr-Nahrmittel A.G. v. Havland International, Inc.*, 206 USPQ 827, 833 (TTAB 1980) (While applicant originally may have intended to include the flags of the Scandinavian countries in the mark, NOR-KING and design, “[a]ll that the record reflects is that the mark contains a representation of certain flags, but not the flag or flags of any particular nation.” Opposer’s cause of action under §2(b) found to be without merit; opposition sustained on other grounds); *In re National Van Lines, Inc.*, 123 USPQ 510 (TTAB 1959) (mark comprising words and the design of a shield with vertical stripes held registrable, the Board finding the design to be readily distinguishable from the shield of the Great Seal of the United States and, therefore, not a simulation of the seal or any portion thereof); *In re American Box Board Co.*, 123 USPQ 508 (TTAB 1959) (design mark comprising an eagle and shield held registrable, the Board finding that it did not involve a simulation of the Great Seal of the United States because the



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

eagle and shield of applicant's mark differed substantially from those on the seal in both appearance and manner of display).

See TMEP §§1205 *et seq.* regarding matter that is protected by statute or by Article 6*ter* of the Paris Convention.

To overcome a refusal under §2(a) or §2(b), deletion of the unregistrable matter is sometimes permitted. See TMEP §807.14(a) regarding removal of matter from drawings.

### **1205 Refusal on Basis of Matter Protected by Statute or Convention**

#### **1205.01 Statutory Protection**

Various federal statutes and regulations prohibit or restrict the use of certain words, names, symbols, terms, initials, marks, emblems, seals, insignia, badges, decorations, medals and characters adopted by the United States government or particular national and international organizations. These designations are reserved for the specific purposes prescribed in the relevant statute and must be free for use in the prescribed manner. See the listings of citations to sections of the United States Code and the Code of Federal Regulations in Appendix C of this Manual.

For example, Congress has created about 70 statutes that grant exclusive rights to use certain designations to federally created private corporations and organizations. Violation of some of these statutes may be a criminal offense, *e.g.*, 18 U.S.C. §§705 (regarding badges, medals, emblems or other insignia of veterans' organizations); 706 ("Red Cross," "Geneva Cross," and emblem of Greek red cross); 707 (4-H Club); 708 (coat of arms of the Swiss Confederation); 711 ("Smokey Bear"); and 711a ("Woodsy Owl" and slogan, "Give a Hoot, Don't Pollute"). Other statutes provide for civil enforcement, *e.g.*, 36 U.S.C. §§153104 (National Society of the Daughters of the American Revolution); 30905 (Boy Scouts); 80305 (Girl Scouts); 130506 (Little League); and 21904 (The American National Theater and Academy).

The following are examples of the protection of words and symbols by statute.

- (1) The Copyright Act of 1976 includes provisions regarding the use of appropriate notices of copyright. These include provisions concerning the use of the letter "C" in a circle - ©, the word "Copyright" and the abbreviation "Copr." to identify visually perceptible copies (17 U.S.C. §401); the use of the letter "P" in a circle to indicate phonorecords of sound recordings (17 U.S.C. §402); and the use of the words "mask work," the symbol \*M\* and the letter "M" in a circle to designate mask works (17 U.S.C. §909). The Act designates these symbols to perform the function of

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

indicating that the user of the symbol is asserting specific statutory rights.

- (2) Use of the Greek red cross other than by the American National Red Cross is proscribed by statute. 18 U.S.C. §706. Use of the coat of arms of the Swiss Confederation for trade or commercial purposes is proscribed by statute. 18 U.S.C. §708. See *In re Health Maintenance Organizations, Inc.*, 188 USPQ 473 (TTAB 1975) (mark comprising a dark cross with legs of equal length on which a caduceus is symmetrically imposed (representation of caduceus disclaimed) held registrable, the Board finding the mark readily distinguishable from the Greek red cross (on white background) and the Swiss confederation coat of arms (white cross on red background)).
- (3) False advertising or misuse of names to indicate a federal agency is proscribed by 18 U.S.C. §709. For example, this provision prohibits knowing use, without written permission of the Director of the Federal Bureau of Investigation, of the words “Federal Bureau of Investigation,” the initials “F.B.I.” or any colorable imitation, in various formats “in a manner reasonably calculated to convey the impression that such advertisement, ... publication, ... broadcast, telecast, or other production, is approved, endorsed, or authorized by the Federal Bureau of Investigation.” Thus, an examining attorney must refuse to register such matter, pursuant to 18 U.S.C. §709, if its use is reasonably calculated to convey an approval, endorsement or authorization by the Federal Bureau of Investigation.
- (4) Section 110 of the Amateur Sports Act of 1978, 36 U.S.C. §220506, protects various designations associated with the Olympics. Under 36 U.S.C. §220506(a), the United States Olympic Committee has the exclusive right to use the name “United States Olympic Committee,” its symbol and emblem, and the words “Olympic,” “Olympiad,” “Citius Altius Fortius,” “Pan American,” “Paralympiad,” “America Espirito Sport Fraternalite,” or any combination thereof. The United States Supreme Court has held that the grant by Congress to the United States Olympic Committee of the exclusive right to use the word “Olympic” does not violate the First Amendment. *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Committee*, 483 U.S. 522, 3 USPQ2d 1145 (1987) (concerning petitioner’s use of “Gay Olympic Games”). Under 36 U.S.C. §220506(c), a person is subject to suit in a civil action by the Committee if such person, without the Committee’s consent, uses for the purpose of trade, to induce the sale of goods or services, or to promote any theatrical exhibition, athletic performance, or competition, a designation noted above (listed in §220506(a)) or

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

“any trademark, trade name, sign, symbol, or insignia falsely representing association with, or authorization by, the International Olympic Committee or ... [the United States Olympic Committee]” or any simulation of the words “Olympic,” “Olympiad” or “Citius Altius Fortius” “tending to cause confusion, to cause mistake, to deceive, or to falsely suggest a connection with ... [the United States Olympic Committee] or any Olympic activity.”

*See U.S. Olympic Committee v. Toy Truck Lines Inc.*, 237 F.3d 1331, 57 USPQ2d 1380 (Fed. Cir. 2001); *O-M Bread, Inc. v. U.S. Olympic Committee.*, 65 F.3d 933, 36 USPQ2d 1041 (Fed. Cir. 1995); *U.S. Olympic Committee v. Intelicense Corp., S.A.*, 737 F.2d 263, 222 USPQ 766 (2d Cir. 1984), *cert. denied* 469 U.S. 982 (1984); *U.S. Olympic Committee v. Union Sport Apparel*, 220 USPQ 526 (E.D. Va. 1983); *U.S. Olympic Committee v. International Federation of Body Builders*, 219 USPQ 353 (D.D.C. 1982); *Stop the Olympic Prison v. U.S. Olympic Committee*, 489 F. Supp. 1112, 207 USPQ 237 (S.D.N.Y. 1980).

- (5) In chartering the Blinded Veterans Association, Congress granted it the sole right to use its name and such seals, emblems and badges as it may lawfully adopt. 36 U.S.C. §30306. This protection of its exclusive right to use “Blinded Veterans Association” does not extend to the term “blinded veterans,” which has been found generic. *Blinded Veterans Association v. Blinded American Veterans Foundation*, 872 F.2d 1035, 10 USPQ2d 1432 (D.C. Cir. 1989).

Usually the statute will define the appropriate use of a designation and will prescribe criminal penalties or civil remedies for improper use. However, the statutes themselves do not provide the basis for refusal of trademark registration. To determine whether registration should be refused in a particular application, the examining attorney should consult the relevant statute to determine the function of the designation and its appropriate use. If a statute provides that a specific party or government agency has the exclusive right to use a designation, and a party other than that specified in the statute has applied to register the designation, the examining attorney must refuse registration on the ground that the mark is not in lawful use in commerce, citing §§1 and 45 of the Trademark Act, 15 U.S.C. §§1051 and 1127, in addition to the relevant statute.

Depending on the nature and use of the mark, other sections of the Trademark Act may also bar registration and must be cited where appropriate. For example, it may be appropriate for the examining attorney to refuse registration under §2(a) of the Trademark Act, 15 U.S.C. §1052(a), on the ground that the mark comprises matter that may falsely suggest a connection with a national symbol, institution or person specified in the statute

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

(e.g., the United States Olympic Committee). See TMEP §1203.03(e). Other §2(a) bases for refusal could also apply. See TMEP §§1203 *et seq.* It may be appropriate to refuse registration under §2(b), 15 U.S.C. §1052(b), for matter that comprises a flag, coat of arms or other similar insignia. See TMEP §1204. It may be appropriate to refuse registration under §2(d), 15 U.S.C. §1052(d), if the party specified in the statute owns a registration for a mark that is the same or similar. *Cf. U.S. Olympic Committee v. Olymp-Herrenwaschefabriken Bezner GmbH & Co.*, 224 USPQ 497 (TTAB 1984) (opposition to the registration of OLYMP sustained on ground of likelihood of confusion with opposer's registered mark OLYMPIC under §2(d), the Board finding that the evidence of record did not show that OLYMP falsely suggests a connection with opposer under §2(a), and that the remedies provided in 36 U.S.C. §220506(c) for misuse of Olympic designations are not pertinent to opposition proceedings).

In some instances, it may be appropriate for the examining attorney to refuse registration pursuant to §§1, 2 (preamble) and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127, on the ground that the subject matter would not be perceived as a trademark. (For service mark applications, §3 of the Act, 15 U.S.C. §1053, should also be cited as a basis for refusal).

To determine what action is appropriate, the examining attorney should look to the particular use of a symbol or term by the applicant. For example, where it is evident that the applicant has merely included a copyright symbol in the drawing of the mark inadvertently, and the symbol is not a material portion of the mark, the examining attorney should indicate that the symbol is not part of the mark and require that the applicant amend the drawing to remove the symbol, instead of issuing statutory refusals of the types noted above.

Examining attorneys should also consider whether registration of matter as a trademark by the applicant may be prohibited by Article 6*ter* of the Paris Convention. See TMEP §1205.02.

### **1205.02 Article 6*ter* of the Paris Convention**

The United States is a member of the Paris Convention for the Protection of Industrial Property, as revised at Stockholm on July 14, 1967, the members of which constitute a Union for the protection of industrial property.

Under Article 6*ter* of the Paris Convention, the contracting countries have agreed to refuse or to invalidate the registration, and to prohibit the unauthorized use, as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems of the member countries, official signs and hallmarks indicating control and warranty adopted by member countries, and any imitation from a heraldic point of view. The provision applies equally to armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organizations of which one or more

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

countries of the Union are members, except for those that are already the subject of international agreements in force, intended to ensure their protection (e.g., “Red Cross” and emblems protected by the Geneva Convention of August 12, 1949).

Under Article 6*ter*, each member country shall communicate the list of emblems, official signs and hallmarks that it wishes to protect, and all subsequent modifications of its list, to the IB, who will transmit the communications to the other member countries. Within twelve months from receipt of the notification, a member country may transmit its objections, through the IB.

When the USPTO receives requests for protection under Article 6*ter* from the IB, they are assigned serial numbers in the “89” series code, *i.e.*, serial numbers beginning with the digits “89,” and are sometimes referred to as “non-registrations.” The USPTO searches its records for conflicting marks, but the requests are not subjected to a full examination by an examining attorney or published for opposition. Copies of the designations are filed in the paper records of the Trademark Search Library, and pertinent information is entered in the automated search records of the Office and should be discovered in an examining attorney’s search.

### ***Refusal Of Marks Because of an Article 6ter Designation***

The Paris Convention requires that the United States refuse to register designations that have been deposited pursuant to Article 6*ter* and to which the United States has transmitted no objections. Depending on the nature and use of the mark, §§2(a) and 2(b) of the Trademark Act, 15 U.S.C. §§1052(a) and 1052(b), may bar registration of these marks. A refusal under §2(d) of the Trademark Act is **not** appropriate. The issue is not whether the marks are confusingly similar, but whether registration of the mark would violate §§2(a) or 2(b) of the Trademark Act.

For example, it may be appropriate for the examining attorney to refuse registration under §2(a) of the Act on the ground that the mark comprises matter that may falsely suggest a connection with a national symbol of a member country or an international intergovernmental organization. See TMEP §1203.03(e). Other §2(a) bases for refusal could also apply. See TMEP §§1203 *et seq.* It may be appropriate to refuse registration under §2(b) of the Act if the proposed mark comprises a flag, coat of arms or other similar insignia. See TMEP §1204. In some instances, it may be appropriate to refuse registration under §§1, 2 (preamble) and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127, on the ground that the subject matter would not be perceived as a trademark. (For service mark applications, §3 of the Act, 15 U.S.C. §1053, should also be cited as a basis for refusal.)

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1206 Refusal on Basis of Name, Portrait or Signature of Particular Living Individual or Deceased U.S. President Without Consent

*Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.*

Section 2(c) of the Trademark Act, 15 U.S.C. §1052(c), bars the registration of a mark that consists of or comprises (whether consisting solely of, or having incorporated in the mark) a name, portrait or signature that identifies a particular living individual, or a deceased United States president during the life of his widow, except by the written consent of the individual or the president's widow.

Section 2(c) absolutely bars the registration of these marks on either the Principal Register or the Supplemental Register.

The purpose of requiring the consent of a living individual to the registration of his or her name, signature or portrait is to protect rights of privacy and publicity that living persons have in the designations that identify them. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 1376, 217 USPQ 505, 509 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982); *Canovas v. Venezia 80 S.R.L.*, 220 USPQ 660, 661 (TTAB 1983). See TMEP §1203.03 for a discussion of the right to control the use of one's identity, which underlies part of §2(a) as well as §2(c).

See TMEP §813 regarding when it is necessary for an examining attorney to inquire of the applicant as to whether a name, signature or portrait in a mark identifies a particular living individual, and regarding the entry of pertinent statements in the record for printing in the *Official Gazette* and on a registration certificate.

#### 1206.01 Name, Portrait or Signature

Section 2(c) explicitly pertains to any name, portrait or signature that identifies a particular living individual, or a deceased president of the United States during the life of the president's widow.

To identify a particular living individual, a name does not have to be the person's full name. See *Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269 (TTAB 1999) (registration of opposer's surname without consent prohibited by §2(c), where the record showed that because of opposer's

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

reputation as an inventor in the field of electrochemical analysis, the relevant public would associate the goods so marked with opposer); *In re Steak and Ale Restaurants of America, Inc.*, 185 USPQ 447 (TTAB 1975) (PRINCE CHARLES found to identify a particular living individual whose consent was not of record); *Laub v. Industrial Development Laboratories, Inc.*, 121 USPQ 595 (TTAB 1959) (LAUB, for flowmeters, found to identify the holder of a patent for flowmeters, whose written consent was not of record); *Reed v. Bakers Engineering & Equipment Co.*, 100 USPQ 196, 199 (PO Ex. Ch. 1954) (registration of REED REEL OVEN, for ovens, held to be barred by §2(c) without written consent of the designer and builder of the ovens, Paul N. Reed. “Name’ in §2(c) is not restricted to the full name of an individual but refers to any name regardless of whether it is a full name, or a surname or given name, or even a nickname, which identifies a particular living individual...”). *Cf. Société Civile Des Domaines Dourthe Frères v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 USPQ2d 1205, 1209 (TTAB 1988) (“Section 2(c) does not apply to surnames except in those cases where a particular individual is known by a surname alone.”)

Cases involving portraits include *In re McKee Baking Co.*, 218 USPQ 287 (TTAB 1983) (mark comprising a sign on which the portrait of a young girl appears below the words LITTLE DEBBIE); *In re Masucci*, 179 USPQ 829 (TTAB 1973) (mark comprising name and portrait of a deceased president of the United States, President Eisenhower); *Garden v. Parfumerie Rigaud, Inc.*, 34 USPQ 30 (Comm’r Pats. 1937) (marks comprising name and portrait of Mary Garden).

### **1206.02 Particular Living Individual or Deceased U.S. President**

Section 2(c) applies to marks that comprise matter that identify living individuals; it does not apply to marks that comprise matter that identifies deceased persons, except for a deceased president of the United States during the life of the president’s widow. *See McGraw-Edison Co. v. Thomas Edison Life Insurance Co.*, 160 USPQ 685 (TTAB 1969), *vacated on other grounds*, 162 USPQ 372 (N.D. Ill. 1969) (opposition to the registration of THOMAS EDISON dismissed, the Board finding §2(c) inapplicable, as the particular individual whom the name identifies is deceased); *In re Masucci*, 179 USPQ 829 (TTAB 1973) (affirming refusal to register mark consisting of the name EISENHOWER, a portrait of President Dwight D. Eisenhower and the words PRESIDENT EISENHOWER REGISTERED PLATINUM MEDALLION #13, for greeting cards, on the ground that the mark comprises the name, signature or portrait of a deceased United States president without the written consent of his widow, under §2(c)).

The fact that a name appearing in a mark may actually be the name of more than one person does not negate the requirement for a written consent to registration, if the mark identifies, to the relevant public, a particular living individual or deceased United States president whose spouse is living. *In re*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*Steak and Ale Restaurants of America, Inc.*, 185 USPQ 447 (TTAB 1975) (affirming refusal to register PRINCE CHARLES, for meat, in the absence of consent to register by Prince Charles, a member of the English royal family. “Even accepting the existence of more than one living ‘Prince Charles,’ it does not follow that each is not a particular living individual.”)

If it appears that a name, portrait or signature in a mark may identify a particular living individual but in fact the applicant devised the matter as fanciful, or believes it to be fanciful, a statement to that effect should be placed in the record. If appropriate, the statement that a name, portrait or signature does not identify a particular living individual will be printed in the *Official Gazette* and on the registration certificate. See TMEP §813. Additional relevant circumstances should also be explained. For example, if the matter identifies a certain character in literature, or a deceased historical person, then a statement of these facts in the record may be helpful; however, this information should not be printed in the *Official Gazette* or on a registration certificate.

Although a mark may have been devised to be fanciful or arbitrary and not to identify a particular living individual, it nevertheless may name or otherwise identify one or more living individuals. Whether a consent to registration is required depends on whether the public would recognize and understand the mark as identifying the person. Therefore, if the person is not generally known, or well known in the field relating to the relevant goods or services, it may be that the mark would not constitute the identification of a particular person under §2(c), and consent would not be required. The Trademark Trial and Appeal Board noted as follows in *Martin v. Carter Hawley Hale Stores, Inc.*, 206 USPQ 931, 933 (TTAB 1979):

[Section] 2(c) was not designed to protect every person from having a name which is similar or identical to his or her name registered as a trademark. Such a scope of protection would practically preclude the registration of a trademark consisting of a name since in most cases there would be someone somewhere who is known by the name and who might be expected to protest its registration. Rather, the Statute was intended to protect one who, for valid reasons, could expect to suffer damage from another’s trademark use of his name. That is, it is more than likely that any trademark which is comprised of a given name and surname will, in fact, be the name of a real person. But that coincidence, in and of itself, does not give rise to damage to that individual in the absence of other factors from which it may be determined that the particular individual bearing the name in question will be associated with the mark as used on the goods, either because that person is so well known that the public would reasonably assume the connection or because



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

the individual is publicly connected with the business in which the mark is used.

See also *Fanta v. Coca-Cola Co.*, 140 USPQ 674 (TTAB 1964) (dismissing a petition to cancel registrations of FANTA, for soft drinks and syrup concentrate, the Board noting no use by the petitioner, Robert D. Fanta, of his name in connection with the sale of soft drinks, nor any indication that petitioner had attained recognition in that field); *DeCecco v. Wright*, 120 USPQ 20 (TTAB 1958) (“The question whether the name ‘DECECCO’ as used by applicant in connection with his goods serves to identify opposer is a matter for proof.”); *Brand v. Fairchester Packing Co.*, 84 USPQ 97 (Comm’r Pats. 1950) (affirming dismissal of a petition to cancel the registration of ARNOLD BRAND, for fresh tomatoes, the Commissioner finding nothing in the record to indicate that the mark identified the petitioner, Arnold Brand, an attorney specializing in patent and trademark matters, with the tomato business, or that use of the mark would lead the public to make such a connection).

### **1206.03 Consent of Individual or President’s Widow Required**

#### **1206.03(a) Consent Must Be Written Consent to Registration**

When a name, portrait or signature in a mark identifies a particular living individual, or a deceased president of the United States during the life of his widow, the mark can be registered only if the written consent of the individual, or of the president’s widow, is filed in the application.

The consent must be a written consent to the registration of the identifying matter as a trademark. See *Reed v. Bakers Engineering & Equipment Co.*, 100 USPQ 196, 199 (PO Ex. Ch. 1954) (“Consent to register must be distinguished from consent to use. There may very well be consent to use without any consent to register. And neither is consent to register sufficient under the statute unless it is a written consent to register as specified in the statute.”) Permission to use a mark in connection with specific goods without specific written consent to also register that mark does not give a party the right to register the subject matter as a trademark. *Garden v. Parfumerie Rigaud, Inc.*, 34 USPQ 30, 31 (Comm’r Pats. 1937) (granting petition to cancel registrations of marks that named and portrayed the petitioner, Mary Garden, who, although she had consented to the use of her name and portrait in connection with a particular perfume, had not given written consent to register the marks for perfumes and other cosmetic items. “Permission to use one’s name and portrait in connection with a specified item of merchandise falls far short of consent to register one’s name and portrait as a trade mark for such merchandise generally.”) Consent to *register* a mark that makes no reference to consent to *use* is acceptable; the Office has no authority to regulate use of a mark.

Written consents for minors may be given by their guardians.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1206.03(b) Implicit Consent

When a particular individual identified by matter in a mark is also the person who signed the application, then his or her consent to registration will be presumed. *Alford Mfg. Co. v. Alfred Electronics*, 137 USPQ 250 (TTAB 1963), *aff'd*, 333 F.2d 912, 142 USPQ 168 (C.C.P.A. 1964) (“The written consent to the registration of the mark ‘ALFORD’ by Andrew Alford, the individual, is manifested by the fact that said person executed the application....”); *Ex parte Dallieux*, 83 USPQ 262, 263 (Comm’r Pats. 1949) (“By signing the application, the applicant here obviously consents....”).

An implied consent to register has been found in certain other limited situations. *Compare, In re D.B. Kaplan Delicatessen*, 225 USPQ 342, 344 (TTAB 1985) (consent to the use and registration of the mark D. B. KAPLAN’S DELICATESSEN, for restaurant services, found to be implicit in the terms of the “buy-out” agreement which relinquished all property rights in the name and forbade its use by the named party in any subsequent business) *with, In re New John Nissen Mannequins*, 227 USPQ 569 (TTAB 1985) (consent to register not implied from appearance of the name “John Nissen” in a deed of incorporation of applicant’s predecessor, nor from existence of foreign registrations incorporating the name).

An applicant does not have to submit a new consent if a consent to register is already part of the record in the file of a valid registration for a mark comprised in whole or in part of the same name, portrait or signature for the same goods or services. In this situation, the applicant only has to claim ownership of that existing registration. If an applicant has submitted a consent to register in an application that has not matured to registration, a new consent is not required for pertinent co-pending applications, but a copy of the consent must be placed in each pending application. *In re McKee Baking Co.*, 218 USPQ 287 (TTAB 1983) (applicant’s claim of ownership of a prior registration that includes a consent to register in the record held sufficient for purposes of complying with the consent requirement of the Act).

See TMEP §813 regarding a statement of consent of a living individual to the registration of his or her name or likeness.

### 1207 Refusal on Basis of Likelihood of Confusion, Mistake or Deception

*Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive....*

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), is the statutory basis for a refusal to register due to likelihood of confusion with another mark. Section 2(d) applies to both the Principal and the Supplemental Register.

### 1207.01 Likelihood of Confusion

In the *ex parte* examination of a trademark application, a refusal under §2(d) is normally based on the examining attorney's conclusion that the applicant's mark, as used on or in connection with the specified goods or services, so resembles a *registered* mark as to be likely to cause confusion. (See TMEP §1207.02 concerning §2(d) refusals to register marks that so resemble another mark as to be likely to deceive, and TMEP §1207.03 concerning §2(d) refusals based on unregistered marks. *Note:* Refusals based on unregistered marks are not issued in *ex parte* examination.)

The examining attorney must conduct a search of Office records to determine whether the applicant's mark so resembles any registered mark(s) as to be likely to cause confusion or mistake, when used on or in connection with the goods or services identified in the application. The examining attorney also searches pending applications for conflicting marks with earlier effective filing dates. See TMEP §§1208 *et seq.* regarding conflicting marks. The examining attorney must place a copy of the search strategy in the file.

If the examining attorney determines that there is a likelihood of confusion between applicant's mark and a previously registered mark, the examining attorney refuses registration under §2(d). Before citing a registration, the examining attorney must check the automated records of the Office to confirm that any registration that is the basis for a §2(d) refusal is an active registration. See TMEP §716.02(e) regarding suspension pending cancellation of a cited registration under §8 of the Act or expiration of a cited registration for failure to renew under §9 of the Act.

Also, if Office records indicate that an assignment of the conflicting registration has been recorded, the examining attorney should check the automated records of the Assignment Services Division of the Office to determine whether the conflicting mark has been assigned to applicant.

In *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the Court of Customs and Patent Appeals discussed the factors relevant to a determination of likelihood of confusion. In *ex parte* examination, the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services. The other factors listed in *du Pont* may be considered only if relevant evidence is contained in the record. See *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003) ("Not all of the *DuPont* factors may be relevant or of equal weight in a given case, and 'any

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

one of the factors may control a particular case,” quoting *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 640 (TTAB 1984). In an *ex parte* case, the following factors are usually the most relevant:

- The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- The relatedness of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- The similarity or dissimilarity of established, likely-to-continue trade channels.
- The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing.
- The number and nature of similar marks in use on similar goods.
- A valid consent agreement between the applicant and the owner of the previously registered mark.

The Court of Appeals for the Federal Circuit has provided the following guidance with regard to determining and articulating likelihood of confusion:

The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used (citations omitted). It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark (footnote omitted). On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties (footnote omitted). Indeed, this type of analysis appears to be unavoidable.

*In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985).

There is no mechanical test for determining likelihood of confusion. The issue is not whether the actual goods are likely to be confused but, rather, whether there is a likelihood of confusion as to the *source* of the goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993), and cases cited therein. Each case must be decided on its own facts.

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

The determination of likelihood of confusion under §2(d) in an intent-to-use application does not differ from the determination in any other type of application.

### **1207.01(a) Relatedness of the Goods or Services**

If the marks of the respective parties are identical, the relationship between the goods or services need not be as close to support a finding of likelihood of confusion as would be required in a case where there are differences between the marks. *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981).

In some instances, because of established marketing practices, the use of identical marks on seemingly unrelated goods and services could result in a likelihood of confusion. See *In re Phillips-Van Heusen Corporation*, 228 USPQ 949, 951 (TTAB 1986) (“The licensing of commercial trademarks for use on ‘collateral’ products (such as clothing, glassware, linens, etc.), that are unrelated in nature to those goods or services on which the marks are normally used, has become a common practice in recent years.”)

### **1207.01(a)(i) Goods or Services Need Not Be Identical**

The goods or services do not have to be identical or even competitive in order to determine that there is a likelihood of confusion. The inquiry is whether the goods are related, not identical. The issue is not whether the goods will be confused with each other, but rather whether the public will be confused about their source. See *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975). It is sufficient that the goods or services of the applicant and the registrant are so related that the circumstances surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that would give rise to the mistaken belief that they originate from the same source. See, e.g., *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000) (ON-LINE TODAY for Internet connection services held likely to be confused with ONLINE TODAY for Internet content); *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984) (MARTIN’S for wheat bran and honey bread held likely to be confused with MARTIN’S for cheese); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM for a buffered solution equilibrated to yield predetermined dissolved gas values in a blood gas analyzer held likely to be confused with CONFIRMCELLS for diagnostic blood reagents for laboratory use); *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984) (LAREDO for land vehicles and structural parts therefor held likely to be confused with LAREDO for pneumatic tires).

Conversely, if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

source, then, even if the marks are identical, confusion is not likely. See, e.g., *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (e.g., lamps, tubes) related to the photocopying field).

### **1207.01(a)(ii) Goods May Be Related to Services**

It is well recognized that confusion is likely to occur from the use of the same or similar marks for goods, on the one hand, and for services involving those goods, on the other. See, e.g., *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (BIGG'S (stylized) for retail grocery and general merchandise store services held likely to be confused with BIGGS and design for furniture); *In re H.J. Seiler Co.*, 289 F.2d 674, 129 USPQ 347 (C.C.P.A. 1961) (SEILER for catering services held likely to be confused with SEILER'S for smoked and cured meats); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE (stylized) for retail women's clothing store services and clothing held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986) (design for distributorship services in the field of health and beauty aids held likely to be confused with design for skin cream); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB for various items of men's, boys', girls' and women's clothing held likely to be confused with THE "21" CLUB (stylized) for restaurant services and towels); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (STEELCARE INC. for refinishing of furniture, office furniture, and machinery held likely to be confused with STEELCASE for office furniture and accessories); *Corinthian Broadcasting Corporation v. Nippon Electric Co., Ltd.*, 219 USPQ 733 (TTAB 1983) (TVS for transmitters and receivers of still television pictures held likely to be confused with TVS for television broadcasting services); *In re Industrial Expositions, Inc.*, 194 USPQ 456 (TTAB 1977) (POLLUTION ENGINEERING EXPOSITION for programming and conducting of industrial trade shows held likely to be confused with POLLUTION ENGINEERING for a periodical magazine).

### **1207.01(a)(ii)(A) Food and Beverage Products Versus Restaurant Services**

While likelihood of confusion has often been found in situations where similar marks are used in connection with both food or beverage products and restaurant services, there is no per se rule to this effect. To establish

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

likelihood of confusion, a party must show “something more than that similar or even identical marks are used for food products and for restaurant services.” *In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003) (no likelihood of confusion between applicant’s BLUE MOON and design for beer and the registered mark BLUE MOON and design for restaurant services); *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 1236, 212 USPQ 641, 642 (C.C.P.A. 1982) (no likelihood of confusion between BOSTON SEA PARTY for restaurant services and BOSTON TEA PARTY for tea).

The determination of the relatedness of the goods and services is based on the evidence provided by the applicant and the examining attorney. In *Coors*, the examining attorney introduced evidence from several sources discussing the practice of some restaurants to offer private label or house brands of beer; evidence that brewpubs who brew their own beer often feature restaurant services; and copies of third-party registrations showing that a single mark had been registered for beer and restaurants services. However, applicant countered with evidence that while there are about 1,450 brewpubs and microbreweries in the United States, there are over 800,000 restaurants, which means that brewpubs and microbreweries account for only about 18 one-hundredths of one percent of all restaurants. Noting that “[t]here was no contrary evidence introduced on those points,” the court found that:

While there was evidence that some restaurants sell private label beer, that evidence did not suggest that such restaurants are numerous. And although the Board had before it a few registrations for both restaurant services and beer, the very small number of such dual use registrations does nothing to counter *Coors*’ showing that only a very small percentage of restaurants actually brew their own beer or sell house brands of beer; instead, the small number of such registrations suggests that it is quite uncommon for restaurants and beer to share the same trademark. Thus, the evidence before the Board indicates not that there is a substantial overlap between restaurant services and beer with respect to source, but rather that the degree of overlap between the sources of restaurant services and the sources of beer is *de minimis*. We therefore disagree with the Board’s legal conclusion that *Coors*’ beer and the registrant’s restaurant services are sufficiently related to support a finding of a likelihood of confusion.

343 F.3d at 1340, 68 USPQ2d at 1063-1064.

*See also Lloyd’s Food Products, Inc. v. Eli’s, Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993) (Board erred in failing to consider evidence of third party use of service marks in telephone directories); *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001) (likelihood of confusion between OPUS ONE used on both wine and restaurant services, where the evidence showed that it

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

is common in the industry for restaurants to offer and sell private label wines named after the restaurant, and that registrant's wines were actually served at applicant's restaurant); *In re Comexa Ltda.*, 60 USPQ2d 1118, 1123 (TTAB 2001) (likelihood of confusion between AMAZON for restaurant services and AMAZON and design for chili sauce and pepper sauce, where 50 third-party registrations (48 based on use) showing registration of the same mark for sauces and restaurant services were probative to the extent that they served to suggest that the goods and services were of a kind that may emanate from a single source); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209, 1211 (TTAB 1999) (likelihood of confusion between AZTECA MEXICAN RESTAURANT for restaurant services held likely to be confused with AZTECA for tortillas, taco shells and salsa, where the evidence indicated that the goods at issue were "Mexican food items" of a type that were "often principal items of entrees served by ... Mexican restaurants"); *In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074 (TTAB 1990) (likelihood of confusion between GOLDEN GRIDDLE for table syrup and GOLDEN GRIDDLE PANCAKE HOUSE for restaurant that serves pancakes and syrup); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1469 (TTAB 1988), *aff'd*, 864 F.2d 149 (Fed. Cir. 1988) (likelihood of confusion between MUCKY DUCK and duck design for mustard and THE MUCKY DUCK and duck design for restaurant services, the Board finding that "[a]lthough these goods and services obviously differ, mustard is ... a condiment which is commonly utilized in restaurants by their patrons, especially in such restaurants as delicatessens, fast food houses, steak houses, taverns, inns, and the like, and we think it is common knowledge that restaurants sometimes market their house specialties, including items such as salad dressings, through retail outlets"); *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477, 1478 (TTAB 1987) (no likelihood of confusion between STEVE'S for ice cream and STEVE'S for restaurant featuring hot dogs, where the marks differed and "there [was] no evidence in the record before us that applicant makes or sells ice cream, or that any one business makes and sells ice cream under the same mark in connection with which it renders restaurant services").

### **1207.01(a)(iii) Reliance on Identification of Goods/Services in Registration and Application**

The nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration. *See, e.g., Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula*



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

*Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973).

If the cited registration describes goods or services broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all normal channels of trade, and that they are available to all classes of purchasers. Therefore, if the cited registration has a broad identification of goods or services, an applicant does not avoid likelihood of confusion merely by more narrowly identifying its related goods. See, e.g., *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992) (where a registrant's goods are broadly identified as "computer programs recorded on magnetic disks," without any limitation as to the kind of programs or the field of use, it is necessary to assume that the registrant's goods encompass all such computer programs, and that they travel in the same channels of trade and are available to all classes of prospective purchasers of those goods); *In re Diet Center Inc.*, 4 USPQ2d 1975 (TTAB 1987) (VEGETABLE SVELTES for wheat crackers sold through franchised outlets offering weight reduction services held likely to be confused with SVELTE for low calorie frozen dessert); *In re Uncle Sam Chemical Co., Inc.*, 229 USPQ 233 (TTAB 1986) (SPRAYZON for cleaning preparations and degreasers for industrial and institutional use held likely to be confused with SPRA-ON and design for preparation for cleaning woodwork and furniture). Similarly, there is a likelihood of confusion if an applicant identifies its goods or services so broadly that the identification encompasses the goods or services identified in the registration of a similar mark. See, e.g., *In re Americor Health Services*, 1 USPQ2d 1670 (TTAB 1986) (RESOLVE for corporate employee assistance services, namely, providing confidential mental health counseling services, held likely to be confused with RESOLVE for counseling services in the field of infertility); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986) (RESPONSE for banking services held likely to be confused with RESPONSE CARD for banking services rendered through 24-hour teller machines).

An applicant may not restrict the scope of its goods and/or the scope of the goods covered in the registration by extrinsic argument or evidence, for example, as to the quality or price of the goods. See, e.g., *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986).

Where the terminology in the identification is unclear, the Trademark Trial and Appeal Board has permitted an applicant to provide extrinsic evidence to show that the registrant's identification has a specific meaning to members of the trade. The Board noted that in light of such evidence it is improper to consider the identification in a vacuum and attach all possible interpretations to it. *In re Trackmobile Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1207.01(a)(iv) No “Per Se” Rule**

The facts in each case vary and the weight to be given each factor may be different in light of the varying circumstances; therefore, there can be no rule that certain goods or services are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto. See, e.g., *Information Resources Inc. v. X\*Press Information Services*, 6 USPQ2d 1034, 1038 (TTAB 1988) (regarding computer hardware and software); *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169, 1171 (TTAB 1987) (regarding food products); *In re Quadram Corp.*, 228 USPQ 863, 865 (TTAB 1985) (regarding computer hardware and software); *In re British Bulldog, Ltd.*, 224 USPQ 854, 855-56 (TTAB 1984) and cases cited therein (regarding clothing).

### **1207.01(a)(v) Expansion of Trade Doctrine**

The examining attorney must consider any goods or services in the registrant’s normal fields of expansion to determine whether the registrant’s goods or services are related to the applicant’s identified goods or services under §2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). A trademark owner is entitled to protection against the registration of a similar mark on products that might reasonably be expected to be produced by him in the normal expansion of his business. The test is whether purchasers would believe the product or service is within the registrant’s logical zone of expansion. *CPG Products Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983).

### **1207.01(a)(vi) Evidence Showing Relatedness of Goods or Services**

The examining attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion. Evidence of relatedness might include news articles and/or evidence from computer databases showing that the relevant goods or services are used together or used by the same purchasers; advertisements showing that the relevant goods or services are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant’s goods and services and the goods and services listed in the cited registration. See TMEP §1207.01(d)(iii) and cases cited therein regarding the probative value of third-party registrations.

The identification of goods/services in the subject application and the cited registration(s) may in itself constitute evidence of the relatedness of the goods or services. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (Board erred in finding that there was insufficient evidence of relatedness, “because the Board did not consider the important evidence already before it, namely the ITU application and [opposer’s multiple] registrations”).

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### 1207.01(b) Similarity of the Marks

If it appears that confusion may be likely as a result of the contemporaneous use of similar marks by the registrant and the applicant with the identified goods or services, the next step is to evaluate the marks themselves, in relation to the goods and services. Under *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973), the first factor requires examination of “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods or services. When considering the similarity of the marks, “[a]ll relevant facts pertaining to the appearance and connotation must be considered.” *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). In evaluating the similarities between marks, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Where the goods are identical, “the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), cert. denied 506 U.S. 1034 (1992); *ECI Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980).

### 1207.01(b)(i) Word Marks

The points of comparison for a word mark are appearance, sound, meaning, and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005), citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Similarity of the marks in one respect -- sight, sound or meaning -- will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related. Rather, the rule is that taking into account all of the relevant facts of a particular case, similarity as to one factor alone *may* be sufficient to support a holding that the marks are confusingly similar. *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987).

### 1207.01(b)(ii) Similarity In Appearance

Similarity in appearance is one factor in determining whether there is a likelihood of confusion between marks. Marks may be confusingly similar in appearance despite the addition, deletion or substitution of letters or words.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

See, e.g., *Weiss Associates Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (TMM held confusingly similar to TMS, both for systems software); *Canadian Imperial Bank of Commerce, N.A., v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH held likely to be confused with COMMUNICASH, both for banking services); *In re Lamson Oil Co.*, 6 USPQ2d 1041 (TTAB 1987) (TRUCOOL for synthetic coolant held likely to be confused with TURCOOL for cutting oil); *In re Curtice-Burns, Inc.*, 231 USPQ 990 (TTAB 1986) (MCKENZIE'S (stylized) for processed frozen fruits and vegetables held likely to be confused with McKenzie for canned fruits and vegetables); *In re Pix of America, Inc.*, 225 USPQ 691 (TTAB 1985) (NEWPORTS for women's shoes held likely to be confused with NEWPORT for outer shirts); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON for microprocessor used in commercial laundry machines held likely to be confused with MILLTRONICS (stylized) for electronic control devices for machinery); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL for resinous chemicals used in dyeing textiles held likely to be confused with LUTEX for non-resinous chemicals used in the textile industry).

### **1207.01(b)(iii) Comparing Marks That Contain Additional Matter**

It is a general rule that likelihood of confusion is not avoided between otherwise confusingly similar marks merely by adding or deleting a house mark or matter that is descriptive or suggestive of the named goods or services. Sometimes the rule is expressed in terms of the dominance of the common term. Therefore, if the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences. See, e.g., *In re Chatam International Inc.*, 380 F.3d 1340, 1343, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) ("Viewed in their entireties with non-dominant features appropriately discounted, the marks [GASPAR'S ALE for beer and ale and JOSE GASPAR GOLD for tequila] become nearly identical"); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002) (even though applicant's mark PACKARD TECHNOLOGIES (with "TECHNOLOGIES" disclaimed) does not incorporate every feature of opposer's HEWLETT PACKARD marks, similar overall commercial impression is created); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO COMBOS (with "COMBOS" disclaimed) held likely to be confused with MACHO (stylized), both for food items as a part of restaurant services); *In re Computer Systems Center Inc.*, 5 USPQ2d 1378 (TTAB 1987) (CSC ADVANCED BUSINESS SYSTEMS for retail computer stores held likely to be confused with CSC for computer time sharing and computer programming services); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986) (RESPONSE held likely to be confused with RESPONSE CARD (with "CARD" disclaimed), both for banking services); *In re The U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE (stylized) for clothing held likely to be confused with CREST CAREER IMAGES (stylized)

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

for uniforms); *In re Apparel Ventures, Inc.*, 229 USPQ 225 (TTAB 1986) (SPARKS BY SASSAFRAS (stylized) for clothing held likely to be confused with SPARKS (stylized) for footwear); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM for a buffered solution equilibrated to yield predetermined dissolved gas values in a blood gas analyzer held likely to be confused with CONFIRMCELLS for diagnostic blood reagents for laboratory use); *In re Energy Images, Inc.*, 227 USPQ 572 (TTAB 1985) (SMART-SCAN (stylized) for optical line recognition and digitizing processors held likely to be confused with SMART for remote data gathering and control systems); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (RICHARD PETTY'S ACCU TUNE and design for automotive service stations held likely to be confused with ACCUTUNE for automotive testing equipment); *In re Denisi*, 225 USPQ 624 (TTAB 1985) (PERRY'S PIZZA held likely to be confused with PERRY'S, both for restaurant services); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and design (with "CALIFORNIA" disclaimed) held likely to be confused with COLLEGIENNE, both for items of clothing); *In re Pierre Fabre S.A.*, 188 USPQ 691 (TTAB 1975) (PEDI-RELAX for foot cream held likely to be confused with RELAX for antiperspirant).

Exceptions to the above stated general rule regarding additions or deletions to marks may arise if: (1) the marks in their entireties convey significantly different commercial impressions, or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. See, e.g., *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with "CATFISH" disclaimed) for fish held not likely to be confused with BOBBER for restaurant services); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

### **1207.01(b)(iv) Similarity in Sound – Phonetic Equivalent**

Similarity in sound is one factor in determining whether there is a likelihood of confusion between marks. There is no "correct" pronunciation of a trademark because it is impossible to predict how the public will pronounce a particular mark. Therefore, "correct" pronunciation cannot be relied on to avoid a likelihood of confusion. See, e.g., *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461 (TTAB 1985) (SEYCOS and design for watches held likely to be confused with SEIKO for watches and clocks); *In re Great Lakes Canning, Inc.*, 227 USPQ 483 (TTAB 1985) (CAYNA (stylized) for soft drinks

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

held likely to be confused with CANA for, *inter alia*, canned and frozen fruit and vegetable juices); *In re Energy Telecommunications & Electrical Association*, 222 USPQ 350 (TTAB 1983) (ENTELEC and design for association services in the telecommunication and energy industries held likely to be confused with INTELECT for conducting expositions for the electrical industry); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963) (CRESCO and design for leather jackets held likely to be confused with KRESSCO for hosiery).

### **1207.01(b)(v) Similarity in Meaning**

Similarity in meaning or connotation is another factor in determining whether there is a likelihood of confusion between marks. The focus is on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. See, e.g., *In re M. Serman & Company, Inc.*, 223 USPQ 52 (TTAB 1984) (CITY WOMAN held likely to be confused with CITY GIRL, both for clothing); *Gastown Inc., of Delaware v. Gas City, Ltd.*, 187 USPQ 760 (TTAB 1975) (GAS CITY (with “GAS” disclaimed) held likely to be confused with GASTOWN, both for gasoline); *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696 (TTAB 1971) (AQUA-CARE (stylized) held likely to be confused with WATERCARE (stylized), both for water conditioning products).

The meaning or connotation of a mark must be determined in relation to the named goods or services. Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion. See, e.g., *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies' sportswear, the Board finding that the term was suggestive of the construction of applicant's bras, but was likely to be perceived by purchasers either as an entirely arbitrary designation or as being suggestive of sportswear that “crosses over” the line between informal and more formal wear when applied to ladies' sportswear); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men's underwear held not likely to be confused with PLAYERS for shoes, the Board finding that the term PLAYERS implies a fit, style, color and durability adapted to outdoor activities when applied to shoes, but “implies something else, primarily indoors in nature” when applied to men's underwear); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (BOTTOMS UP for ladies' and children's underwear held not likely to be confused with BOTTOMS UP for men's clothing, the Board finding that the term connotes the drinking phrase “Drink Up” when applied to men's suits, coats and trousers, but does not have this connotation when applied to ladies' and children's underwear).

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### 1207.01(b)(vi) Doctrine of Foreign Equivalentents

Under the doctrine of foreign equivalentents, a foreign word (from a language familiar to an appreciable segment of American consumers) and the English equivalent may be held to be confusingly similar. See, e.g., *Continental Nut Co. v. Cordon Bleu, Ltee*, 494 F.2d 1397, 181 USPQ 647 (C.C.P.A. 1974); *In re American Safety Razor Co.*, 2 USPQ2d 1459 (TTAB 1987) (BUENOS DIAS for soap held likely to be confused with GOOD MORNING and design for latherless shaving cream); *In re Ithaca Industries, Inc.*, 230 USPQ 702 (TTAB 1986) (LUPO for men's and boys' underwear held likely to be confused with WOLF and design for various items of clothing); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983) (EL SOL for clothing and footwear held likely to be confused with SUN and design for footwear).

Although words from modern languages are generally translated into English, the doctrine of foreign equivalentents is not an absolute rule, but merely a guideline. The doctrine should be applied only when it is likely that the ordinary American purchaser would stop and translate the foreign word into its English equivalent. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689 (Fed. Cir. 2005).

Compare the following decisions involving marks found not confusingly similar, based on consideration of factors such as the overall appearance and pronunciation of the marks, the extent to which the terms are “equivalent,” and the relatedness of the named goods and/or services: *In re Sarkli Ltd.*, 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983) (REPECHAGE for various skin care products held not likely to be confused with SECOND CHANCE for face creams and other toiletries); *In re Buckner Enterprises Corp.*, 6 USPQ2d 1316 (TTAB 1987) (DOVE and design for solid fuel burning stoves and furnaces held not likely to be confused with PALOMA for various forms of gas heating apparatus); *In re L'Oreal S.A.*, 222 USPQ 925 (TTAB 1984) (HAUTE MODE for hair coloring cream shampoo held not likely to be confused with HI-FASHION SAMPLER (with “SAMPLER” disclaimed) for finger nail enamel); *In re Tia Maria, Inc.*, 188 USPQ 524 (TTAB 1975) (TIA MARIA for restaurant services held not likely to be confused with AUNT MARY'S for canned fruits and vegetables).

The doctrine of foreign equivalentents is not normally invoked if the marks alleged to be confusingly similar are both foreign words. See *Safeway Stores Inc. v. Bel Canto Fancy Foods Ltd.*, 5 USPQ2d 1980, 1982 (TTAB 1987) (“[T]his Board does not think it proper to take the French expression ‘bel air’ and the Italian expression ‘bel aria’ and then convert both into English and compare the English translations...”). However, application of the doctrine of foreign equivalentents is not barred in every case where the respective marks consist of terms from different foreign languages. *Miguel Torres S.A. v. Casa Vinicola Gerardo Cesari S.R.L.*, 49 USPQ2d 2018 (TTAB 1998) (likelihood of confusion between the Italian DUE TORRI and design for wines, and the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Spanish TORRES and design for wines and brandy and TRES TORRES for brandy).

While foreign words are generally translated into English for trademark comparison purposes, words from dead or obscure languages may be so unfamiliar to the American buying public that they should not be translated into English. See *Enrique Bernat F. S.A. v. Guadalajara Inc.*, 210 F.3d 439, 54 USPQ2d 1497 (5<sup>th</sup> Cir. 2000), *reh'g denied* 218 F.3d 745 (2000). The test is whether, to those American buyers familiar with the foreign language, the word would denote its English equivalent. See *In re Zazzara*, 156 USPQ 348 (TTAB 1967). The determination of whether a language is “dead” must be made on a case-by-case basis, based upon the meaning that the term would have to the relevant purchasing public.

*Example:* Latin is generally considered a dead language. However, if there is evidence that a Latin term is still in use by the relevant purchasing public (e.g., if the term appears in current dictionaries or news articles), then a Latin term is not considered dead. The same analysis should be applied to other uncommon languages.

### **1207.01(b)(vii) Transposition of Terms**

Where the primary difference between marks is the transposition of the elements that compose the marks and where this transposition does not change the overall commercial impression, there may be a likelihood of confusion. See, e.g., *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989) (THE WINE SOCIETY OF AMERICA and design, for “wine club membership services including the supplying of printed materials, sale of wines to members, conducting wine tasting sessions and recommending specific restaurants offering wines sold by applicant,” held likely to be confused with AMERICAN WINE SOCIETY 1967 and design, for a newsletter, bulletin and journal of interest to members of the registrant); *In re Nationwide Industries Inc.*, 6 USPQ2d 1882 (TTAB 1988) (RUST BUSTER (with “RUST” disclaimed) for rust-penetrating spray lubricant held likely to be confused with BUST RUST for penetrating oil); *In re General Tire & Rubber Co.*, 213 USPQ 870 (TTAB 1982) (SPRINT STEEL RADIAL (with “STEEL” and “RADIAL” disclaimed) for tires held likely to be confused with RADIAL SPRINT (with “RADIAL” disclaimed) for tires).

However, if the transposed mark creates a distinctly different commercial impression, then confusion is not likely. See, e.g., *In re Best Products Co., Inc.*, 231 USPQ 988 (TTAB 1986) (BEST JEWELRY and design (with “JEWELRY” disclaimed) for retail jewelry store services held not likely to be confused with JEWELERS’ BEST for jewelry).



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### 1207.01(b)(viii) Marks Consisting of Multiple Words

When assessing the likelihood of confusion between compound word marks, one must determine whether there is a portion of the word mark that is dominant in terms of creating a commercial impression. Although there is no mechanical test to select a “dominant” element of a compound word mark, consumers would be more likely to perceive a fanciful or arbitrary term rather than a descriptive or generic term as the source-indicating feature of the mark. Accordingly, if two marks for related goods or services share the same dominant feature and the marks, when viewed in their entireties, create similar overall commercial impressions, then confusion is likely. See *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987) (JM ORIGINALS (with “ORIGINALS” disclaimed) for various items of apparel held likely to be confused with JM COLLECTABLES for “knitwear -- namely, sport shirts”).

If the common element of two marks is “weak” in that it is generic, descriptive or highly suggestive of the named goods or services, consumers typically will be able to avoid confusion unless the overall combinations have other commonality. See, e.g., *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes held not likely to be confused with BED & BREAKFAST INTERNATIONAL for room booking agency services); *The U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (COBBLER’S OUTLET for shoes held not likely to be confused with CALIFORNIA COBBLERS (stylized) for shoes); *In re Istituto Sieroterapico E Vaccinogeno, Toscano “SCLAVO” S.p.A.*, 226 USPQ 1035 (TTAB 1985) (ASO QUANTUM (with “ASO” disclaimed) for diagnostic laboratory reagents held not likely to be confused with QUANTUM I for laboratory instrument for analyzing body fluids). See also TMEP §1207.01(b)(ix).

In a sense the public can be said to rely more on the nondescriptive portions of each mark. On the other hand, this does not mean that the public looks only at the differences, or that the descriptive words play no role in creating confusion. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985) (THE CASH MANAGEMENT EXCHANGE (with “CASH MANAGEMENT” disclaimed) for computerized cash management services held likely to be confused with CASH MANAGEMENT ACCOUNT for various financial services).

### 1207.01(b)(ix) Weak or Descriptive Marks

The Trademark Trial and Appeal Board and the courts have recognized that merely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. *In re Central Soya Company, Inc.*, 220 USPQ 914 (TTAB 1984). However, even a weak mark is entitled to protection against the registration of a similar mark for

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

closely related goods or services. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (C.C.P.A. 1974).

In *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975), the Board stated:

[R]egistration on the Supplemental Register may be considered to establish prima facie that, at least at the time of registration, the registered mark possessed a merely descriptive significance. (citation omitted.) This is significant because it is well established that the scope of protection afforded a merely descriptive or even a highly suggestive term is less than that accorded an arbitrary or coined mark. That is, terms falling within the former category have been generally categorized as “weak” marks, and the scope of protection extended to these marks has been limited to the substantially identical notation and/or to the subsequent use and registration thereof for substantially similar goods.

However, even marks that are registered on the Supplemental Register may be cited under §2(d). *In re Clorox Company*, 578 F.2d 305, 198 USPQ 337 (C.C.P.A. 1978).

### **1207.01(b)(x) Parody Marks**

Parody is not a defense to a likelihood of confusion refusal. There are confusing parodies and non-confusing parodies. See J. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §31.153 (4<sup>th</sup> ed. 2004). A true parody actually decreases the likelihood of confusion because the effect of the parody is to create a distinction in the viewer's mind between the actual product and the joke. While a parody must call to mind the actual product to be successful, the same success also necessarily distinguishes the parody from the actual product. *Mutual of Omaha Insurance Co. v. Novak*, 648 F. Supp. 905, 231 USPQ 963 (D. Neb. 1986).

Another example of parody can be found in *Columbia Pictures Industries Inc., v. Miller*, 211 USPQ 816 (TTAB 1981) (CLOTHES ENCOUNTERS held likely to be confused with CLOSE ENCOUNTERS OF THE THIRD KIND, for men's and women's clothing); *Cf., Jordache Enterprises, Inc. v. Hogg Wyld, Inc.*, 828 F.2d 1482, 4 USPQ2d 1216 (10<sup>th</sup> Cir. 1987) (LARDASHE for pants was not an infringement of the JORDACHE mark).

### **1207.01(c) Design Marks**

When the marks at issue are both design marks, the issue of the similarity of the marks must be decided primarily on the basis of visual similarity. In this situation, consideration must be given to the fact that a purchaser's recollection of design marks is often of a general and hazy nature. See, e.g.,

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

*Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404 (TTAB 1988) (stylized house design for service of management of real estate properties for others held not likely to be confused with stylized house design for real estate brokerage services); *In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986) (silhouette of two profiles facing right within a teardrop background for distributorship services in the field of health and beauty aids held likely to be confused with silhouette of two profiles facing left within an oval background for skin cream); *Ocean Spray Cranberries, Inc. v. Ocean Garden Products, Inc.*, 223 USPQ 1027 (TTAB 1984) (abstract circular design mark for seafood held not likely to be confused with oval breaking wave design for various food items including juices and fruits); *In re Steury Corp.*, 189 USPQ 353 (TTAB 1975) (design comprised of three generally horizontal bars for boats and camper trailers held likely to be confused with design comprised of two generally horizontal bars for boats and campers); *Matsushita Electric Industrial Co., Ltd. v. Sanders Associates, Inc.*, 177 USPQ 720 (TTAB 1973) (triangular arrow design within a square border for various items of electrical and electronic equipment held likely to be confused with triangular arrow design for various items of electrical and electronic components and equipment).

### **1207.01(c)(i) Legal Equivalents - Comparison of Words and Their Equivalent Designs**

Under the doctrine of legal equivalents, a pictorial representation and its literal equivalent may be found to be confusingly similar. This doctrine is based on a recognition that a pictorial depiction and equivalent wording are likely to impress the same mental image on purchasers. See, e.g., *In re Rolf Nilsson AB*, 230 USPQ 141 (TTAB 1986) (design comprising the silhouette of the head of a lion and the letter "L" for shoes held likely to be confused with LION for shoes); *Puma-Sportschuhfabriken Rudolf Dassler KG v. Garan, Inc.*, 224 USPQ 1064 (TTAB 1984) (designs of mountain lion, for shirts and tops, held confusingly similar to PUMA, for items of clothing; the design of a puma, for items of sporting goods and clothing; and PUMA and design, for T-shirts); *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974) (design of eagle lined for the color gold, for various items of sports apparel, held likely to be confused with GOLDEN EAGLE and design of an eagle, for various items of clothing).

### **1207.01(c)(ii) Composite Marks Consisting of Both Words and Designs**

Often, the examining attorney must determine whether a likelihood of confusion exists between composite marks that consist of a design element as well as words and/or letters. Frequently the marks at issue are similar in only one element. Although it is not proper to dissect a mark, if one feature of a mark is more significant than another feature, greater weight may be given to the dominant feature for purposes of determining likelihood of confusion.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). However, the fundamental rule in this situation is that the marks must be considered in their entireties. See *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272 (C.C.P.A. 1974).

If a mark comprises both a word and a design, greater weight is often given to the word, because it is the word that purchasers would use to refer to or request the goods or services. *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (APPETITO and design of two broad stripes lined for the colors red and green, for Italian sausage, held likely to be confused with A APPETITO'S and design and A APPETITO'S INC. and design of a sandwich (with "INC." and sandwich design disclaimed), both for restaurant services). The Court of Appeals for the Federal Circuit has cautioned, however, that "[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue." *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (K+ and design for dietary potassium supplement held not likely to be confused with K+EFF (stylized) for dietary potassium supplement).

The comparison of composite marks must be done on a case-by-case basis without reliance on mechanical rules of construction. See, e.g., *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984) (finding a likelihood of confusion between SPICE VALLEY and SPICE ISLANDS, both for tea); *Spice Islands, Inc. v. The Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (C.C.P.A. 1974) (SPICE TREE and tree design held not confusingly similar to SPICE ISLANDS and tree design, both for spices); *In re Sun Supermarkets, Inc.*, 228 USPQ 693 (TTAB 1986) (SUN SUPERMARKETS and design of sun held likely to be confused with SUNSHINE and design of sun and SUNRISE and design of sun, all for retail grocery store services).

### **1207.01(c)(iii) Comparison of Standard Character Marks and Special Form Marks**

If a mark (in either an application or a registration) is presented in standard characters, the owner of the mark is not limited to any particular depiction. The rights associated with a mark in standard characters reside in the wording (or other literal element, e.g., letters, numerals, punctuation) and not in any particular display. Therefore, an applicant cannot, by presenting its mark in special form, avoid likelihood of confusion with a mark that is registered in standard characters because the registered marks presumably could be used in the same manner of display. See, e.g., *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988); *Sunnen Products Co. v. Sunex*

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

*International Inc.*, 1 USPQ2d 1744, 1751 (TTAB 1987); *In re Hester Industries, Inc.*, 231 USPQ 881, 883, n.6 (TTAB 1986).

### **1207.01(d) Miscellaneous Considerations**

#### **1207.01(d)(i) Doubt Resolved in Favor of Registrant**

If there is any doubt as to whether there is a likelihood of confusion, that doubt must be resolved in favor of the prior registrant. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio), Inc.* 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

#### **1207.01(d)(ii) Absence of Actual Confusion**

It is well settled that the relevant test is *likelihood of confusion*, not actual confusion. It is unnecessary to show actual confusion to establish likelihood of confusion. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990), and cases cited therein.

#### **1207.01(d)(iii) Third-Party Registrations and Evidence of Third-Party Use**

Generally, the existence of third-party registrations cannot justify the registration of another mark that is so similar to a previously registered mark as to create a likelihood of confusion, or to cause mistake, or to deceive. Third-party registrations may be relevant to show that the mark or a portion of the mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. *See, e.g., AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (C.C.P.A. 1973); *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983). Properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used. *See, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 675, 223 USPQ 1281, 1285-86 (Fed. Cir. 1984); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1976); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1911 (TTAB 1988); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172, 1174 (TTAB 1987).

Third-party registrations that cover a number of different goods or services have some probative value to the extent that they may serve to suggest that goods or services are of a type that may emanate from a single source, if the registrations are based on use in commerce. However, registrations issued under 15 U.S.C. §1126(e), based on a foreign registration, have very little, if any, persuasive value. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

(TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988), *aff'd*, 864 F.2d 149 (Fed. Cir. 1988).

The submission of a list of registrations or a copy of a search report is not proper evidence of third-party registrations. To make registrations of record, soft copies of the registrations or the electronic equivalent thereof (*i.e.*, printouts or electronic copies of the registrations taken from the electronic search records of the USPTO) must be submitted. *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n. 3 (TTAB 1994); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). See TMEP §710.03.

Evidence of third-party use falls under the sixth *du Pont* factor – the “number and nature of similar marks in use on similar goods.” *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, this evidence “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

### **1207.01(d)(iv) Collateral Attack on Registration Improper in *Ex Parte* Proceeding**

Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant’s ownership of the mark and of the registrant’s exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate. During *ex parte* prosecution, an applicant will not be heard on matters that constitute a collateral attack on the cited registration (*e.g.*, a registrant’s nonuse of the mark). See *In re Dixie Restaurants*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *Cosmetically Yours, Inc. v. Clairol Inc.*, 424 F.2d 1385, 1387, 165 USPQ 515, 517 (C.C.P.A. 1970); *In re Peebles Inc.* 23 USPQ2d 1795, 1797 n. 5 (TTAB 1992); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2014-15 (TTAB 1988).

It is also inappropriate for the applicant to place the burden of showing a likelihood of confusion on the owner of the cited registration. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1318, 65 USPQ2d 1201, 1206 (Fed. Cir. 2003) (“[I]t is the duty of the PTO and this court to determine whether there is a likelihood of confusion between two marks.... [I]t is no answer for the applicant to ask that the application be passed to publication to see whether the owner of the cited mark will oppose the registration.” quoting *Dixie Restaurants*, *supra*, 105 F.3d at 1408, 41 USPQ2d at 1535.)

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### **1207.01(d)(v) Classification of Goods/Services**

The classification of goods and services has no bearing on the question of likelihood of confusion. Rather, it is the manner in which the applicant and/or registrant have identified their goods or services that is controlling. *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771 (Fed. Cir. 1993); *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 n.5 (TTAB 1990).

### **1207.01(d)(vi) Prior Decisions of Examining Attorneys**

Each case must be decided on its own merits. Previous decisions by examining attorneys in approving other marks are without evidentiary value and are not binding on the agency or the Board. *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984).

### **1207.01(d)(vii) Sophisticated Purchasers**

The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). However, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion.

### **1207.01(d)(viii) Consent Agreements**

The term “consent agreement” generally refers to an agreement in which a party (e.g., a prior registrant) consents to the use and/or registration of a mark by another party (e.g., an applicant for registration of the same mark or a similar mark), or in which each party consents to the use and/or registration of the same mark or a similar mark by the other party.

A consent agreement may be submitted by the applicant to overcome a refusal of registration under §2(d) of the Act, or in anticipation of a refusal to register. When a consent agreement is submitted, the examining attorney will consider the agreement, and all other evidence in the record, to determine likelihood of confusion. The examining attorney should not solicit a consent agreement.

Consents come in different forms and under circumstances in infinite variety. They are, however, but one factor to be taken into account with all of the other relevant circumstances bearing on the likelihood of confusion referred to in §2(d). *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

In *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1363, 177 USPQ 563, 568 (C.C.P.A. 1973), the Court of Customs and Patent Appeals stated as follows:

[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere *assumption* that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.

A consent agreement that is not merely a “naked” consent typically details reasons why no likelihood of confusion exists and/or arrangements undertaken by the parties to avoid confusing the public. *In re Permagrain Products, Inc.*, 223 USPQ 147 (TTAB 1984) (consent agreement found to be “naked” because the agreement did not restrict the markets in such a way as to avoid confusion).

The Court of Appeals for the Federal Circuit has made it clear that consent agreements should be given great weight, and that the Office should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other factors clearly dictate a finding of likelihood of confusion. *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); *Bongrain International (American) Corp. v. Delice de France Inc.*, 811 F.2d 1479, 1 USPQ2d 1775 (Fed. Cir. 1987); and *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985).

*Compare In re Mastic Inc.*, 829 F.2d 1114, 4 USPQ2d 1292 (Fed. Cir. 1987) (refusal to register affirmed even with a consent to register where applicant had not used the mark in commerce and consent agreement contained contradictory statements).

The examining attorney should give great weight to a proper consent agreement. The examining attorney should not interpose his or her own judgment concerning likelihood of confusion when an applicant and registrant have entered into a *credible* consent agreement and, *on balance*, the other factors do not dictate a finding of likelihood of confusion.

A consent agreement is not the same as a “concurrent use” agreement. The term “concurrent use” is a term of art that refers to a geographical restriction on the registration. See TMEP §§1207.04 *et seq.* regarding concurrent use.



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### 1207.01(d)(ix) Fame of Mark

The fame of a registered mark is a factor to be considered in determining likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Famous marks enjoy a wide latitude of legal protection because they are more likely to be remembered and associated in the public mind than a weaker mark. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1374, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002) (Trademark Trial and Appeal Board erred in discounting the fame of opposer's marks ACOUSTIC WAVE and WAVE); *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (Board erred in limiting the weight accorded to the fame of opposer's FRITO-LAY mark); *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 352, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 862 (1992) (Board erred in discounting the fame of opposer's mark PLAY-DOH). The Court of Appeals for the Federal Circuit has stated:

[A] mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark.

Achieving fame for a mark in a marketplace where countless symbols clamor for public attention often requires a very distinct mark, enormous advertising investments, and a product of lasting value. After earning fame, a mark benefits not only its owner, but the consumers who rely on the symbols to identify the source of a desired product. Both the mark's fame and the consumer's trust in that symbol, however, are subject to exploitation by free riders.

*Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456.

Fame for likelihood of confusion purposes and fame for dilution purposes, 15 U.S.C. §1125(c), are distinct concepts. Fame for dilution purposes is an either/or proposition, whereas the "fame" factor in the likelihood of confusion analysis varies along a spectrum. *Palm Bay Imports*, 396 F.3d at 1374-75, 73 USPQ2d at 1694.

When present, the fame of the mark is "a dominant factor in the likelihood of confusion analysis for a famous mark, independent of the consideration of the relatedness of the goods." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1328, 54 USPQ2d 1894, 1898. However, like the other *du Pont* factors, the fame of a mark may be considered only if there is relevant evidence of record. See TMEP §1207.01 and cases cited therein.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

It is not necessary to show recognition by every segment of the population. When determining likelihood of confusion, fame is measured with regard to “the class of customers and potential customers of a product or service, and not the general public.” *Palm Bay Imports*, at 396 F.3d 1375, 73 USPQ2d 1695. Thus, the Federal Circuit affirmed the finding that VEUVE CLICQUOT had achieved fame among purchasers of champagne and sparkling wine, where the record showed that sales volume and advertising expenditures over a 15-year period were “substantial;” that VEUVE CLICQUOT was the second leading brand sold in the United States, sold in 8,000 restaurants nationwide, and in liquor stores, wine shops and other establishments; that the product was advertised in general interest and wine specialty magazines, on the radio, on the Internet, and through point-of-sale displays, wine tastings and sponsorship of events; and that the product had been featured in articles and reviews in both specialized and general interest magazines. *Id.*

Direct evidence of consumer recognition of a mark is not necessary. The “fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.” See *Bose*, 293 F.3d at 1371, 63 USPQ2d at 1305, and cases cited therein. It is important to consider the context of how the proposed mark is presented in sales and advertising materials. In *Bose*, the Court found that evidence of extensive sales and advertising expenses established the fame of opposer’s WAVE and ACOUSTIC WAVE marks, noting that opposer’s sales literature, advertisements, and promotional materials included frequent and prominent references to the marked product separate and apart from the house mark BOSE. In *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983), the court found that the mark GIANT FOOD was famous based on 45 years of use, sales in excess of \$1 billion per year, extensive media exposure and prominent display on the facade of supermarkets. However, in *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004), the court found that evidence of more than \$5 million annual sales of products bearing the mark, over 100 years of use, and advertising expenditure of hundreds of thousands of dollars per year was insufficient to establish that RITZ had achieved the extensive public recognition of a famous mark.

In *Tiffany & Broadway v. Commissioner*, 167 F. Supp.2d 949 (S.D. Tex. 2001), the fame of four registered marks cited against the applicant was a significant factor in finding a likelihood of confusion between applicant’s TIFFANY for ladies’ dress shoes and registrant’s TIFFANY and TIFFANY & CO. for a variety of goods, including jewelry, china, silverware, glassware, leather goods, belt buckles, ties, scarves, clocks, watches, brushes and lamps, and for retail store services specializing in the sale of jewelry, watches, clocks, and gift items. The *ex parte* record included excerpts from 18 news articles where the registrant Tiffany & Company was identified as a famous business; citations to three published decisions in which the fame of

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

the TIFFANY mark had been judicially recognized; and evidence that the registrant's goods were sold at over 60 Tiffany locations worldwide--including 34 in the United States--and through independently-owned retail stores and mail order outlets.

### **1207.01(d)(x) Conflicting Marks Owned by Different Parties**

During the examination of an application, the examining attorney should consider separately each registration found in a search of the marks registered in the Office that may bar registration of the applicant's mark under §2(d). If the examining attorney finds registrations that appear to be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no likelihood of confusion. However, the examining attorney must cite all the marks that are considered to be a bar to registration of the mark presented in the application, even if they are owned by different parties. The examining attorney should always explain the reason that the mark in each cited registration is grounds for refusal under §2(d).

### **1207.02 Marks That Are Likely to Deceive**

In addition to referring to a mark that so resembles another mark as to be likely to cause confusion or mistake, §2(d) refers to a mark being likely "to deceive." As a practical matter, this provision is rarely applied in examination, because deceptiveness involves intent and would be difficult to prove in an *ex parte* proceeding.

### **1207.03 Marks Previously Used in United States but Not Registered**

As a basis for refusal, §2(d) refers not only to registered marks but also to "a mark or trade name previously used in the United States by another and not abandoned." Refusal on the basis of an unregistered mark or trade name has sometimes been referred to as refusal on the basis of a "known mark." This provision is not applied in *ex parte* examination because of the practical difficulties with which an examining attorney is faced in attempting to locate "previously used" marks and attempting to determine whether anyone has rights in them and whether they are "not abandoned."

### **1207.04 Concurrent Use Registration**

#### **1207.04(a) Concurrent Use – In General**

Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), contains a proviso under which an eligible applicant may request issuance of a registration concurrent with the registration of a conflicting mark.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

In a concurrent use application, the applicant normally requests a geographically restricted registration. The applicant seeks registration for a specified geographical area of the United States and lists one or more parties who concededly have rights in the mark in other geographical areas of the United States. These other parties may own applications or registrations, or they may have common law rights in a mark, but no application or registration. “Incontestable” registrations (*i.e.*, where the registrant’s right to use the mark has become incontestable pursuant to 15 U.S.C. §1065) are subject to concurrent use registration proceedings. See *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (C.C.P.A. 1976); *Thrifftmart, Inc. v. Scot Lad Foods, Inc.*, 207 USPQ 330 (TTAB 1980). However, registrations and applications to register on the Supplemental Register and registrations under the Act of 1920 (see TMEP §1601.05) are not subject to concurrent use registration proceedings. 37 C.F.R. §2.99(g).

Concurrent use registration is requested by the applicant; it should not be suggested or initiated by the examining attorney.

### **1207.04(b) Filing Basis of Application Seeking Concurrent Use**

In an application based on use in commerce under 15 U.S.C. §1051(a), the applicant may seek concurrent use registration at the time the application is filed or in a subsequent amendment. See 37 C.F.R. §2.73(a).

In an application based on a bona fide intent to use the mark in commerce under 15 U.S.C. §1051(b), the applicant may not amend to seek concurrent use registration until the applicant files an acceptable amendment to allege use or statement of use. 37 C.F.R. §§2.73(b) and 2.99(g).

In an application under §44 or §66(a) of the Trademark Act, 15 U.S.C. §1126 or §1141f(a), the applicant may seek concurrent use registration, if the mark meets the requirements of the statute and rules for concurrent use registration. Concurrent use applications under §§44 and §66(a) are very rare.

### **1207.04(c) Basis for Concurrent Use Registration**

If an applicant requests a concurrent use registration, the examining attorney must first determine the basis for seeking such a registration. An application for registration as a concurrent user is either: (1) subject to a concurrent use registration proceeding before the Trademark Trial and Appeal Board, or (2) pursuant to the final determination by a court of competent jurisdiction of the concurrent rights of the parties to use the same or similar marks in commerce. See 15 U.S.C. §1052(d); 37 C.F.R. §2.99.

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### 1207.04(d) Determining Eligibility for Concurrent Use

An applicant is eligible to request a registration subject to concurrent use if it meets one or more of the following criteria:

- (1) The concurrent use request is sought pursuant to a decree of a court of competent jurisdiction reflecting its final determination of the rights of the concurrent user;
- (2) The owner of the registration consents to the grant of a concurrent use registration to the applicant; or
- (3) The applicant's date of first use in commerce is before the *filing date* of the pending applications or of any registrations issued under the Trademark Act of 1946. When a party specified as an excepted user does not own an application or registration, the applicant's date of first use in commerce is before the filing date of any application to register the mark that may be filed by the excepted user.

The applicant has the burden of proving that it is entitled to a concurrent use registration. 37 C.F.R. §2.99(e).

### 1207.04(d)(i) Requirements for All Concurrent Use Applications

An application for registration as a lawful concurrent user is generally examined in the same manner as any other application for registration. 37 C.F.R. §2.99(a). The examining attorney must examine the application to determine whether it complies with the relevant requirements for a non-restricted application (see 37 C.F.R. §§2.32 – 2.41). Additionally, the applicant must comply with the following requirements in a concurrent use application:

- (1) The applicant must specify the goods and the geographic area for which the applicant seeks registration of the mark. 15 U.S.C. §1051(a)(3)(D); 37 C.F.R. §2.42. The applicant must also set forth the mode of use. 15 U.S.C. §1052(d); 37 C.F.R. §2.42.
- (2) The applicant must specify, to the extent of its knowledge, the exceptions to its claim of exclusive use, listing any concurrent use by others and the relevant goods, geographic areas and periods of this use. 15 U.S.C. §1051(a)(3)(D); 37 C.F.R. §2.42.
- (3) The applicant must also list the names and addresses of the concurrent users, the registrations issued to or applications filed by them (if any), and the mode of such use. 37 C.F.R. §2.42.
- (4) The verification for concurrent use should be modified to indicate an exception, that no one else *except as specified in the application*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

has the right to use the mark. 15 U.S.C. §1051(a)(3)(D). See TMEP §804.02.

The applicant does not have to insert the stated exceptions in the verification or declaration; the exceptions may be set forth anywhere in the application.

In addition to the requirements noted above, which apply to all applications for concurrent use registration, concurrent use applications must meet other conditions, depending on whether the application is subject to a concurrent use before the Board (see TMEP §§1207.04(e) *et seq.*) or pursuant to the decree of a court (see TMEP §§1207.04(f) *et seq.*).

### **1207.04(e) Applications Subject to Concurrent Use Proceeding Before the Trademark Trial and Appeal Board**

If an application for concurrent use registration complies with the above requirements and it appears that the applicant is entitled to registration but for the question of concurrent rights, the examining attorney will approve the application for publication subject to a concurrent use registration proceeding. 15 U.S.C. §1062(a).

Ordinarily, the examining attorney should not require an applicant for concurrent use registration to submit evidence in support of its claim to concurrent rights. However, the examining attorney should refuse registration under §2(d) if the applicant has requested a concurrent use registration and information in the record suggests that the applicant has not met the basic requirements for concurrent use registration (*e.g.*, if the application indicates that the applicant adopted and used the mark with knowledge of the rights of a person specified as an excepted user, or that actual confusion has resulted from the concurrent use of the marks of the parties in their respective geographic areas). See *In re Place for Vision, Inc.*, 196 USPQ 267, 269-70 (TTAB 1977). *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987), *aff'g* 229 USPQ 474 (TTAB 1986).

### **1207.04(e)(i) Preparing the File for Publication**

When the examining attorney determines that the mark in an application that is subject to a concurrent use proceeding is ready for publication, the examining attorney should prepare the file as follows:

- (1) The application must contain a concurrent use statement that will be printed in the *Official Gazette*. The statement may be submitted by the applicant or prepared by the examining attorney. The statement must be in the following form:

Subject to Concurrent Use Proceeding with \_\_\_\_\_  
[specifying the application serial number(s) or registration  
number(s), if any, of each other party; otherwise, the name and

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

address of each other party].

Applicant claims the exclusive right to use the mark in the area comprising \_\_\_\_\_ [specifying the area for which the applicant seeks registration].

- (2) To aid in the preparation of the file by the Legal Instruments Examiner (“LIE”), the examining attorney should prepare a brief summary of the relevant concurrent use information. The information on the summary page should be set forth in the following manner:

### CONCURRENT USE SUMMARY

Applicant:

Address:

Mark:

Goods or services:

Other Reg. or Serial Nos.:

Dates of use:

Areas of use:

### EXCEPTIONS TO EXCLUSIVE USE

Name:

Address:

Mark:

Goods or Services:

Reg. or Serial No.:

Dates of Use:

Area of use:

After publication, if no opposition is filed, or if any opposition that is filed is dismissed or withdrawn, the Trademark Trial and Appeal Board will institute the concurrent use proceeding. The Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding. 37 C.F.R. §2.99(h). See 37 C.F.R. §2.99; TMEP §1506.

*See, generally, Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) Chapter 1100.*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1207.04(f) Application for Concurrent Use Registration Pursuant to Court Decree**

Under the last two sentences of §2(d), the Office may issue a concurrent use registration pursuant to the final determination of a court of competent jurisdiction that more than one person is entitled to use the same or similar marks in commerce. An applicant who seeks a concurrent use registration on the basis of a court determination does not have to claim use in commerce prior to the specified dates or obtain the consent of the owner of the involved mark, and the registration may be issued notwithstanding the possibility of public confusion. See *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (C.C.P.A. 1976). Cf. *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412 (C.C.P.A. 1961), cert. denied, 369 U.S. 864, 133 USPQ 702 (1962).

When examining an application for concurrent use registration pursuant to the decree of a court, the examining attorney must determine whether the application complies with the specific requirements for concurrent use applications (see TMEP §§1207.04(d) and (d)(i)) and the requirements that would apply to an unrestricted application.

In addition, under 37 C.F.R. §2.99(f), all of the following conditions must be met, or a concurrent use proceeding before the Board must be prepared and instituted:

- (1) The applicant is entitled to registration subject only to the concurrent lawful use of a party to the court proceeding;
- (2) The court decree specifies the rights of the parties;
- (3) A true copy of the court decree is submitted to the examining attorney;
- (4) The concurrent use application complies fully and exactly with the court decree; and
- (5) The excepted use specified in the concurrent use application does not involve a registration, or any involved registration has been restricted by the Director in accordance with the court decree.

If any of the above conditions are *not* satisfied, the examining attorney will approve the application for publication subject to a concurrent use registration proceeding (see TMEP §§1207.04(e) and (e)(i)), rather than pursuant to the court decree. 37 C.F.R. §2.99(f).

### **1207.04(f)(i) Preparing the File for Publication**

If the application complies with all of the conditions listed in TMEP §1207.04(f) and all other relevant requirements, and is otherwise entitled to



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

registration, the examining attorney will approve the application for publication of the mark. The examining attorney should prepare the file as follows:

The application must contain a concurrent use statement to be printed in the *Official Gazette*. The statement may be submitted by the applicant or prepared by the examining attorney. The statement will delineate the concurrent rights of the parties as determined by the court, in the following form:

Registration limited to the area comprising \_\_\_\_\_  
[specifying the area granted to the applicant by the court and any other restriction designated by the court] pursuant to the decree of \_\_\_\_\_ [specifying the name of the court, proceeding number and date of the decree].

Concurrent registration with \_\_\_\_\_ [specifying the application serial number(s) or registration number(s), if any, of each other party; otherwise, the name and address of each other party].

After publication, if no opposition is filed, or if any opposition that is filed is dismissed or withdrawn, the application will mature into a registration.

### **1208                      Conflicting Marks in Pending Applications**

*37 C.F.R. §2.83. Conflicting marks.*

*(a) Whenever an application is made for registration of a mark which so resembles another mark or marks pending registration as to be likely to cause confusion or mistake or to deceive, the mark with the earliest effective filing date will be published in the "Official Gazette" for opposition if eligible for the Principal Register, or issued a certificate of registration if eligible for the Supplemental Register.*

*(b) In situations in which conflicting applications have the same effective filing date, the application with the earliest date of execution will be published in the "Official Gazette" for opposition or issued on the Supplemental Register.*

*(c) Action on the conflicting application which is not published in the Official Gazette for opposition or not issued on the Supplemental Register will be suspended by the Examiner of Trademarks until the published or issued application is registered or abandoned.*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1208.01 Priority for Publication or Issue Based on Effective Filing Date**

In *ex parte* examination, priority among conflicting pending applications is determined based on the effective filing dates of the applications, without regard to whether the dates of use in a later-filed application are earlier than the filing date or dates of use of an earlier-filed application, whether the applicant in a later-filed application owns a registration of a mark that would be considered a bar to registration of the earlier-filed application, or whether an application was filed on the basis of use of the mark in commerce or a bona fide intent to use the mark in commerce.

When two or more applications contain marks that are conflicting, the mark in the application that has the *earliest effective filing date* will be published for opposition if it is eligible for registration on the Principal Register, or will be registered if it is eligible for registration on the Supplemental Register. 37 C.F.R. §2.83(a). See TMEP §§206 *et seq.* regarding effective filing dates.

The examining attorney cannot refuse registration under §2(d) of the Trademark Act based on an earlier-filed application for a conflicting mark until the mark registers. Therefore, when the examining attorney has examined the later-filed application and determined that it is in condition to be approved for publication or issue or in condition for a final refusal, but for the conflict between the marks, the examining attorney will *suspend* action on the later-filed application until the earlier-filed application matures into a registration or is abandoned. 37 C.F.R. §2.83(c); TMEP §§716.02(c) and 1208.02(c).

### **1208.01(a) What Constitutes Conflict Between Pending Applications**

Marks in applications filed by different parties are in conflict when the registration of one of the marks would be a bar to the registration of the other under §2(d) of the Trademark Act, 15 U.S.C. §1052(d). Therefore, the term “conflicting application” refers to an application to register a mark that so resembles the mark in another application as to be likely to cause confusion. See TMEP §702.03(b). See TMEP §§1207 *et seq.* regarding likelihood of confusion. There may be several conflicting pending applications.

### **1208.01(b) What Constitutes Effective Filing Date**

The *filing date* of an application under §1 or §44 of the Trademark Act is the date when all the elements designated in 37 C.F.R. §2.21(a) are received at the Office. In an application under §66(a) of the Trademark Act, 15 U.S.C. §1141f(a), the filing date is (1) the international registration date, if the request for extension of protection to the United States is made in an international application; or (2) the date that the subsequent designation was recorded by

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

the IB, if the request for extension of protection to the United States is made in a subsequent designation. TMEP §201.

While this is generally the *effective filing date* for purposes of determining priority among conflicting applications, in certain situations another date is treated as the effective filing date. See TMEP §§206 *et seq.* For example, in an application claiming priority under §44(d) or §67 of the Trademark Act based on a foreign application, the effective filing date is the date of filing the foreign application. TMEP §206.02. In a §1(b) application that is amended to the Supplemental Register on the filing of an acceptable allegation of use, the effective filing date is the date of filing the allegation of use. TMEP §206.01.

If two or more applications conflict, the application with the earliest effective filing date will be approved for publication for opposition or for issuance of a registration on the Supplemental Register, as appropriate. 37 C.F.R. §2.83(a); TMEP §1208.01.

If conflicting applications have the same effective filing date, the application with the earliest date of execution will be published for opposition or issued on the Supplemental Register. 37 C.F.R. §2.83(b). An application that is unexecuted will be treated as having a later date of execution.

Occasionally, conflicting applications will have the same date of filing and execution. If this situation occurs, the application with the lowest serial number will have priority for publication or issuance. When determining which serial number is the lowest, the examining attorney should disregard the series code (*e.g.*, “76,” “78” or “79”) and look only to the six digit serial number.

### **1208.01(c) Change in Effective Filing Date During Examination**

If the effective filing date in an application containing a conflicting mark changes, the examining attorney should review all the application(s) involved to determine which application has the earliest effective filing date as a result of the change.

The examining attorney should conduct a new search of the mark whenever the effective filing date of an application changes to a date that is later than the original filing date.

### **1208.01(d) Examination of Conflicting Marks After Reinstatement or Revival**

When an abandoned application is revived or reinstated (see TMEP §§1712.01, 1713 and 1714 *et seq.*), the examining attorney must conduct a new search to determine whether any later-filed applications for conflicting marks have been approved for publication or registration, and place the search strategy in the file.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If a later-filed application has been approved, the examining attorney should inform the examining attorney who approved the later-filed application that the earlier-filed application has been revived, if necessary. If the later-filed application has been published, the examining attorney handling that application should request jurisdiction (see TMEP §1504.04(a)) and suspend the application pending disposition of the earlier-filed application that was revived or reinstated.

If a later-filed application for a conflicting mark has matured into registration, the examining attorney must refuse registration of the revived or reinstated application under §2(d), even though the application for the registered mark was filed after the revived or reinstated application. The Office does not have the authority to cancel the registration.

### **1208.02            Conflicting Applications Examination Procedure**

#### **1208.02(a)        Examination of Application with Earliest Effective Filing Date**

When the application with the earliest effective filing date is first reviewed for action, the examining attorney should approve the application for publication or for issuance of a registration on the Supplemental Register, if appropriate. 37 C.F.R. §2.83(a).

If the application with the earliest effective filing date is not in condition for publication or issue, the examining attorney should issue an Office action that includes all relevant refusals and requirements.

The Office does not notify applicants of potentially conflicting later-filed applications.

See TMEP §§206 *et seq.* and 1208.01(b) regarding what constitutes an effective filing date.

#### **1208.02(b)        Action on Later-Filed Application: Giving Notice of the Earlier Application or Applications**

If, when the later-filed conflicting application is first reviewed for action, it is not in condition for publication or issue, the examining attorney should, in addition to treating other matters, send with the Office action an electronic copy or a printout from the Office's automated search system of the information for the mark in each earlier-filed application. The examining attorney's letter should also advise the applicant that the earlier application, if and when it matures into a registration, may be cited against the applicant's later-filed application. The applicant should be notified of all conflicting applications with earlier effective filing dates.

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

See TMEP §1208.02(c) regarding suspension of later-filed conflicting applications that are otherwise in condition to be approved for publication or issue.

### **1208.02(c) Suspension of Later-Filed Application**

When the later-filed application is in condition for publication or issue except for the conflicting mark in an earlier-filed application, either because no action was necessary on the application as filed or because examination on other matters has been brought to a conclusion, the examining attorney should suspend the later-filed application until the mark in the earlier-filed application is registered or the earlier-filed application is abandoned. 37 C.F.R. §2.83(c). *In re Direct Access Communications (M.C.G.) Inc.*, 30 USPQ2d 1393 (Comm'r Pats. 1993). If the examining attorney discovers that a previously-filed pending application was abandoned, but that a petition to revive is pending, the examining attorney should suspend the later-filed application pending disposition of the petition to revive.

Action on the later-filed application should also be suspended when the application is in condition for a final action but for the conflict with the earlier-filed application. The letter of suspension should repeat the outstanding issues, but these issues should not be made final.

If the Office action informing the applicant of the suspension is the first action in the case, the examining attorney should include an electronic copy or a printout from the Office automated search system of the information for the mark in each earlier-filed conflicting application.

### **1208.02(d) Action on Later-Filed Application upon Disposition of the Earlier Application or Applications**

If all conflicting earlier-filed applications have either matured into registrations or become abandoned, and there are no other grounds for suspension, the examining attorney should remove the later-filed application from suspension and take appropriate action as follows.

The examining attorney should cite the registration or registrations that issued from the earlier-filed conflicting application or applications, if there is a likelihood of confusion. This will be a first refusal under §2(d) of the Trademark Act, 15 U.S.C. §1052(d). Any other outstanding issues should be repeated at this time.

If all earlier-filed applications have become abandoned, the examining attorney should either approve the later-filed application for publication or issue, or repeat and make final any remaining issues, as appropriate.

If some, but not all of the earlier-filed conflicting applications have matured into registrations, the examining attorney will normally not issue a refusal of

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

registration until the remaining conflicting application(s) are registered or abandoned, in order to avoid issuing piecemeal refusals. TMEP §716.02(c).

### **1208.02(e) Applicant's Argument on Issues of Conflict**

If an applicant with a later-filed application files a request to remove the later-filed application from suspension (see TMEP §716.03), arguing that there is no conflict in relation to the application with the earlier effective filing date, the examining attorney should consider the merits of that argument and determine whether or not the earlier-filed application constitutes a potential bar to registration under §2(d) of the Act.

If the examining attorney concludes that the earlier-filed application is not a potential bar, the examining attorney should remove the application from suspension and take appropriate action on any other outstanding issues.

However, if the examining attorney concludes that the earlier-filed application is a potential bar, the examining attorney should issue an action for the later-filed application (e.g., a new letter of suspension if there are no other issues that are not in condition for final action), in which the examining attorney explains why the applicant's argument is not persuasive.

### **1208.02(f) Conflicting Mark Mistakenly Published or Approved for Issuance on the Supplemental Register**

If a later-filed conflicting mark is mistakenly published for opposition, it may be necessary for the examining attorney to obtain jurisdiction of the application to take appropriate action. See TMEP §§1504 *et seq.* concerning obtaining jurisdiction of an application after publication.

The examining attorney does not lose jurisdiction of an application forwarded for issuance on the Supplemental Register until the day of issuance of the registration.

### **1208.03 Procedure Relating to Possibility of Interference**

An interference will not be declared except upon petition to the Director. The Director will declare an interference only upon a showing of extraordinary circumstances that would result in a party being unduly prejudiced without an interference. These cases are extremely rare. In ordinary circumstances, the availability of an opposition or cancellation proceeding is deemed to remove any undue prejudice. 37 C.F.R. §2.91(a). Interferences are generally limited to situations where a party would otherwise be required to engage in a series of opposition or cancellation proceedings, and where the issues are substantially the same. See TMEP §1208.03(b). The potential need to file two notices of opposition that could be consolidated if the issues were

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

sufficiently similar, is not considered an extraordinary circumstance that will unduly prejudice a petitioner without an interference.

All petitions, or requests for interference are to be forwarded to the Commissioner for Trademarks for decision. The examining attorney does not make a determination on a request for interference.

See TBMP Chapter 1000.

### **1208.03(a) Procedures on Request for Interference**

The request for interference should be in a separate document in the form of a petition, and should be captioned as a petition. The petition fee indicated in 37 C.F.R. §2.6 should accompany the request. A petition to declare an interference should not be filed before the application has been examined and the mark has been found to be registrable but for the existence of one or more conflicting pending applications.

Any petition or request for interference should be referred to the Office of the Commissioner for Trademarks.

A request for interference does not make an application “special” or alter the normal order of examination.

See TBMP Chapter 1000.

### **1208.03(b) Decision on Request for Interference**

Section 16 of the Trademark Act, 15 U.S.C. §1066, states that, upon petition showing extraordinary circumstances, the Director may declare that an interference exists when application is made for the registration of a mark that so resembles a mark previously registered by another, or for the registration of which another has previously applied, as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion or mistake or to deceive. No interference shall be declared between an application and a registration that has become incontestable.

The Director will declare an interference only upon a showing of extraordinary circumstances that would result in a party being unduly prejudiced in the absence of an interference. 37 C.F.R. §2.91(a). The availability of opposition and cancellation procedures provides a remedy and ordinarily precludes the possibility of undue prejudice to a party. The request for interference must show that there is some extraordinary circumstance that would make the remedy of opposition or cancellation inadequate or prejudicial to the party's rights. See *In re Family Inns of America, Inc.*, 180 USPQ 332 (Comm'r Pats. 1974).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The fact that an earlier-filed application based on intent to use the mark in commerce under §1(b) or based on §44 or §66(a) has been cited against a later-filed application based on use in commerce under §1(a) is not an extraordinary circumstance that warrants declaration of an interference. An opposition proceeding is the proper forum for determining priority between an applicant and another party. Priority for purposes of examination of an application is determined by filing date. 37 C.F.R. §2.83(a); TMEP §1208.02(a).

Although §16 of the Act permits the declaration of an interference between an application and a registration, the practice of declaring an interference in these cases has been discontinued. The reason is that the applicant cannot obtain a registration if the interfering registration remains on the register. Therefore, even if the applicant prevailed in the interference, the applicant would still have to petition to cancel the interfering registration. See *In re Kimbell Foods, Inc.*, 184 USPQ 172 (Comm'r Pats. 1974); *Ex parte H. Wittur & Co.*, 153 USPQ 362 (Comm'r Pats. 1966); 37 C.F.R. §2.96.

See TBMP Chapter 1000.

### **1208.03(c) Procedure When Interference Is to be Declared**

If the Director grants a petition requesting an interference, the examining attorney must determine that each mark is registrable but for the interfering mark before the interference will be instituted. 37 C.F.R. §2.92.

All marks must be published for opposition before interference proceedings are instituted; if possible, the marks should be published simultaneously.

Each application that is to be the subject of an interference must contain the following statement to be printed in the *Official Gazette*:

This application is being published subject to declaration of interference with:

Serial No.:

Filed:

Applicant:

(Address, if there is no attorney)

Attorney and Address:

Mark:

The examining attorney should prepare the statement.

If an application that is published subject to declaration of interference is opposed by a party other than the applicant(s) in the interfering application(s), the opposition will be determined first. If still necessary and appropriate, the interference will be instituted. If an opposition is filed by the applicant in the



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

interfering application, the interference proceeding will not be instituted. The rights of the parties will be determined in the opposition proceeding.

If, during the pendency of an interference, another application appears involving substantially the same registrable subject matter, the examining attorney may request suspension of the interference for the purpose of adding that application. If the application is not added, the examining attorney should suspend further action on the application pending termination of the interference proceeding. 37 C.F.R. §2.98.

See TBMP Chapter 1000.

### 1209 Refusal on Basis of Descriptiveness

*Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it .... (e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them....*

Matter that “merely describes” the goods or services on or in connection with which it is used is not registrable on the Principal Register. As noted in *In re Abcor Development Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978):

The major reasons for not protecting such marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.

#### 1209.01 Distinctiveness/Descriptiveness Continuum

With regard to trademark significance, matter may be categorized along a continuum, ranging from marks that are highly distinctive to matter that is a generic name for the goods or services. The degree of distinctiveness -- or, on the other hand, descriptiveness -- of a designation can be determined only by considering it in relation to the specific goods or services. *Remington Products, Inc. v. North American Philips Corp.*, 892 F.2d 1576, 13 USPQ2d 1444, 1448 (Fed. Cir. 1990) (the mark must be considered in context, *i.e.*, in connection with the goods).

At one extreme are marks that, when used in relation to the goods or services, are completely arbitrary or fanciful. Next on the continuum are suggestive marks, followed by merely descriptive matter. Finally, generic

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

terms for the goods or services are at the opposite end of the continuum from arbitrary or fanciful marks. As stated in *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986), “[t]he generic name of a thing is in fact the ultimate in descriptiveness.”

Fanciful, arbitrary and suggestive marks, often referred to as “inherently distinctive” marks, are registrable on the Principal Register without proof of acquired distinctiveness. See TMEP §1209.01(a).

Marks that are merely descriptive of the goods or services may not be registered on the Principal Register absent a showing of acquired distinctiveness under 15 U.S.C. §1052(f). See TMEP §1209.01(b) regarding merely descriptive marks, and TMEP §§1212 *et seq.* regarding acquired distinctiveness. Merely descriptive marks may be registrable on the Supplemental Register. 15 U.S.C. §1091.

Matter that is generic for the goods or services is not registrable on either the Principal or the Supplemental Register under any circumstances. See TMEP §§1209.01(c) *et seq.*

### **1209.01(a) Fanciful, Arbitrary and Suggestive Marks**

Fanciful marks comprise terms that have been invented for the sole purpose of functioning as a trademark or service mark. Such marks comprise words that are either unknown in the language (*e.g.*, PEPSI, KODAK, EXXON) or are completely out of common usage (*e.g.*, FLIVVER).

Arbitrary marks comprise words that are in common linguistic use but, when used to identify particular goods or services, do not suggest or describe a significant ingredient, quality or characteristic of the goods or services (*e.g.*, APPLE for computers; OLD CROW for whiskey).

Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services. See *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool). See also *In re Quik-Print Copy Shop, Inc.*, 203 USPQ 624 (TTAB 1979), *aff'd*, 616 F.2d 523, 205 USPQ 505 (C.C.P.A. 1980) (QUIK-PRINT held merely descriptive of printing services); *In re Aid Laboratories, Inc.*, 223 USPQ 357 (TTAB 1984) (BUG MIST held merely descriptive of insecticide). Suggestive marks, like fanciful and arbitrary marks, are registrable on the Principal Register without proof of secondary meaning. Therefore, a designation does not have to be devoid of all meaning in relation to the goods and services to be registrable.

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### 1209.01(b) Merely Descriptive Marks

To be refused registration on the Principal Register under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), a mark must be merely descriptive or deceptively misdescriptive of the goods or services to which it relates. A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE held merely descriptive of potpourri); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY held merely descriptive of lodging reservations services); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984) (MALE-P.A.P. TEST held merely descriptive of clinical pathological immunoassay testing services for detecting and monitoring prostatic cancer); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) (COASTER-CARDS held merely descriptive of a coaster suitable for direct mailing).

The determination of whether or not a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

It is not necessary that a term describe all of the purposes, functions, characteristics or features of a product to be considered merely descriptive; it is enough if the term describes one significant function, attribute or property. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (“A mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services,” citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); *In re Gyulay*, 820 F.2d at 1218, 3 USPQ2d at 1010.

The great variation in facts from case to case prevents the formulation of specific rules for specific fact situations. Each case must be decided on its own merits. See *In re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985); *In re Venturi, Inc.*, 197 USPQ 714 (TTAB 1977).

See TMEP §§1209.03(a) *et seq.* regarding factors that often arise in determining whether a mark is merely descriptive or generic.

See also TMEP §§1213 *et seq.* concerning disclaimer of merely descriptive matter within a mark.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1209.01(c) Generic Terms

Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001); *In re American Fertility Society*, 188 F.3d 1341, 1346, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999). These terms are incapable of functioning as registrable trademarks denoting source, and are not registrable on the Principal Register under §2(f) or on the Supplemental Register.

### 1209.01(c)(i) Test

There is a two-part test used to determine whether a designation is generic: (1) What is the class of goods or services at issue? and (2) Does the relevant public understand the designation primarily to refer to that class of goods or services? *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986). The test turns upon the primary significance that the term would have to the relevant public.

The examining attorney has the burden of proving that a term is generic by clear evidence. *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the public's understanding of a term can be obtained from any competent source, including dictionary definitions, research databases, newspapers and other publications. See *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985) (BUNDT, a term that designates a type of cake, held generic for ring cake mix); *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989) (ANALOG DEVICES held generic for devices having analog capabilities).

When a term is a compound word, the examining attorney may establish that a term is generic by producing evidence that each of the constituent words is generic, and that the separate words retain their generic significance when joined to form a compound that has "a meaning identical to the meaning common usage would ascribe to those words as a compound." *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111-1112 (Fed. Cir. 1987) (SCREENWIPE held generic as applied to premoistened antistatic cloths for cleaning computer and television screens).

However, the Court of Appeals for the Federal Circuit has expressly limited the holding in *Gould* to "compound terms formed by the union of words" where the public understands the individual terms to be generic for a genus of goods or services, and the joining of the individual terms into one compound word lends "no additional meaning to the term." *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001) (citing *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999)). Where the mark is a phrase, the examining attorney cannot simply cite definitions and generic uses of the individual components

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

of the mark, but must provide evidence of the meaning of the composite mark as a whole.

In *American Fertility Society*, the court held that evidence that the components “Society” and “Reproductive Medicine” were generic was not enough to establish that the composite phrase SOCIETY FOR REPRODUCTIVE MEDICINE was generic for association services in the field of reproductive medicine. The court held that the examining attorney must show: (1) the genus of services that the applicant provides; and (2) that the relevant public understands the proposed composite mark to primarily refer to that genus of services. 51 USPQ2d at 1836-37.

In *Dial-A-Mattress*, the court held that an alphanumeric phone number “bears closer conceptual resemblance to a phrase than a compound word.” 57 USPQ2d at 1811. The court found that 1-888-M-A-T-R-E-S-S was not generic as applied to “telephone shop-at-home retail services in the field of mattresses,” because there was no evidence of record that the public understood the term to refer to shop-at-home telephone mattress retailers. Therefore, to establish that a mnemonic phone number is generic, the examining attorney must show that the relevant public would understand the mark as a whole to have generic significance.

With respect to top level domain indicators (TLDs), the Trademark Trial and Appeal Board held that, unlike an alphanumeric telephone number, a generic term combined with a TLD “cannot be characterized as a mnemonic phrase.” The Board stated:

[The designation CONTAINER.COM] is instead a compound word, a generic term combined with the top level domain indicator, “.COM.” In proving genericness, the Office may satisfy its burden by showing that these separate generic words have a meaning identical to the meaning common usage would ascribe to those words as a compound. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987). In a similar sense, neither the generic term nor the domain indicator has the capability of functioning as an indication of source, and combining the two does not result in a compound term that has somehow acquired this capability.

*In re Martin Container, Inc.*, 65 USPQ2d 1058, 1061 (TTAB 2002).

The Board has also noted that mnemonic telephone numbers differ from TLDs in that telephone numbers comprise unique ten-digit numbers that can be used by only a single entity, whereas the precise generic term and TLD combination employed by one entity can be incorporated into other domain names. *In re Eddie Z's Blinds and Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005) (BLINDSANDDRAPERY.COM generic for retail store services featuring blinds, draperies and other wall coverings, sold via the Internet); *In re*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*CyberFinancial.Net, Inc.*, 65 USPQ2d 1789, 1793 (TTAB 2002) (BONDS.COM, used in an offer of services, generic for providing information regarding financial products and services via the Internet). See also TMEP §§1209.03(m) and 1215.05 regarding domain names.

When examining an application for a mark that includes a TLD, the examining attorney must include evidence such as dictionary definitions to establish that the TLD lacks trademark significance.

### **1209.01(c)(ii) Terminology**

As specifically amended by the Trademark Law Revision Act of 1988, §14 of the Trademark Act provides for the cancellation of a registration of a mark at any time if the mark “becomes the generic name for the goods or services, or a portion thereof, for which it is registered....” 15 U.S.C. §1064(3). Previously, that provision had pertained to a mark that “becomes the common descriptive name of an article or substance....” Cases previously distinguished between generic names and “apt or common descriptive names,” which referred to matter that, while not characterized as “generic,” had become so associated with the product that it was recognized in the applicable trade as another name for the product, serving as a term of art for all goods of that description offered by different manufacturers rather than identifying the goods of any one producer. See *Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358, 364 (TTAB 1978), *aff’d*, 599 F.2d 1009, 202 USPQ 100 (C.C.P.A. 1979). In addition, the Trademark Law Revision Act of 1988 amended §15 of the Trademark Act to adopt the term “generic name” to refer to generic designations. 15 U.S.C. §1065(4). In view of the amendment of §§14 and 15, a distinction between “generic” names and “apt or common descriptive” names should not be made. Rather, the terminology of the Act should be consistently used, e.g., in refusals to register matter that is a generic name for the goods or services, or a portion thereof. See *In re K-T Zoe Furniture Inc.*, 16 F.3d 390, 29 USPQ2d 1787 (Fed. Cir. 1994).

Similarly, cases have distinguished between “generic” terms and terms that were deemed “so highly descriptive as to be incapable of exclusive appropriation as a trademark.” See *In re Harcourt Brace Jovanovich, Inc.*, 222 USPQ 820 (TTAB 1984) (LAW & BUSINESS held so highly descriptive as to be incapable of distinguishing applicant’s services of arranging and conducting seminars in the field of business law); *In re Industrial Relations Counselors, Inc.*, 224 USPQ 309 (TTAB 1984) (INDUSTRIAL RELATIONS COUNSELORS, INC. held an apt name or so highly descriptive of educational services in the industrial relations field that it is incapable of exclusive appropriation and registration, notwithstanding *de facto* source recognition capacity). Regarding current practice for refusing registration of such matter, the Trademark Trial and Appeal Board noted as follows in *In re Women’s Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 n.2 (TTAB 1992):

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

The Examining Attorney's refusal that applicant's mark is "so highly descriptive that it is incapable of acting as a trademark" is not technically a statutory ground of refusal. Where an applicant seeks registration on the Principal Register, the Examining Attorney may refuse registration under Section 2(e)(1) of the Act, 15 USC 1052(e)(1), on the basis that the mark sought to be registered is generic (citations omitted). Alternatively, an Examining Attorney may refuse registration under the same section if he or she believes that the mark is merely descriptive and that applicant's showing of acquired distinctiveness is unpersuasive of registrability.

In essence, the Board was merely emphasizing the need to use precise statutory language in stating grounds for refusal. While the decision does not explicitly bar the use of the terminology "so highly descriptive that it is incapable of acting as a trademark" under all circumstances, the case illustrates that the use of this terminology may lead to confusion and should be avoided. It is particularly important in this context to use the precise statutory language to avoid doctrinal confusion. See generally McLeod, *The Status of So Highly Descriptive and Acquired Distinctiveness*, 82 Trademark Rep. 607 (1992). Therefore, examining attorneys should not state that a mark is "so highly descriptive that it is incapable of acting as a trademark" in issuing refusals. Rather, in view of the amendments of the Trademark Act noted above, the terminology "generic name for the goods or services" should be used in appropriate refusals, and use of the terminology "so highly descriptive" should be discontinued when referring to incapable matter.

This does not mean that designations that might formerly have been categorized as "so highly descriptive" should not be regarded as incapable. The Court of Appeals for the Federal Circuit has specifically stated that "a phrase or slogan can be so highly laudatory and descriptive as to be incapable of acquiring distinctiveness as a trademark." *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA for beer and ale held to be "so highly laudatory and descriptive of the qualities of [applicant's] product that the slogan does not and could not function as a trademark to distinguish Boston Beer's goods and serve as an indication of origin").

The Court of Appeals for the Federal Circuit has also stated that "[t]he critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be registered to refer to the genus of goods or services in question." *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 989-990, 228 USPQ 528, 530 (Fed. Cir. 1986). Also note that it is entirely appropriate to consider whether a particular designation is "highly descriptive" in evaluating registrability under §2(f), or in similar circumstances.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The expression “generic name for the goods or services” is not limited to noun forms but also includes “generic adjectives,” that is, adjectives that refer to a genus, species, category or class of goods or services. *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991) (PERMA PRESS generic for soil and stain removers for use on permanent press products).

### **1209.01(c)(iii) Generic Matter: Case References**

In the following cases, the matter sought to be registered was found generic: *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA for beer and ale held to be “so highly laudatory and descriptive of the qualities of [applicant’s] product that the slogan does not and could not function as a trademark to distinguish Boston Beer’s goods and serve as a indication of origin”); *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE held generic as applied to premoistened antistatic cloths for cleaning computer and television screens); *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985) (BUNDT, a term that designates a type of cake, held generic for ring cake mix); *In re Eddie Z’s Blinds and Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005) (BLINDSANDDRAPERY.COM generic for retail store services featuring blinds, draperies and other wall coverings, conducted via the Internet); *In re Candy Bouquet International, Inc.*, 73 USPQ2d 1883 (TTAB 2004) (CANDY BOUQUET generic for “retail, mail, and computer order services in the field of gift packages of candy”); *In re Cell Therapeutics Inc.*, 67 USPQ2d 1795 (TTAB 2003) (CELL THERAPEUTICS INC. generic for pharmaceutical preparations and laboratory research and development services); *In re American Institute of Certified Public Accountants*, 65 USPQ2d 1972 (TTAB 2003) (CPA EXAMINATION held generic for “printed matter, namely, practice accounting examinations; accounting exams; accounting exam information booklets; and prior accounting examination questions and answers”); *In re American Academy of Facial Plastic and Reconstructive Surgery*, 64 USPQ2d 1748 (TTAB 2002) (FACIAL PLASTIC SURGERY held generic for training, association, and collective membership services, where evidence showed that the phrase “facial plastic surgery” is a recognized field of surgical specialization); *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART generic for dealership services in the field of fine art, antiques, furniture and jewelry); *Continental Airlines Inc. v. United Airlines Inc.*, 53 USPQ2d 1385 (TTAB 1999) (E-TICKET generic for computerized reservation and ticketing of transportation services); *In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999) (LOG CABIN HOMES generic for architectural design of buildings and retail outlets selling kits for building log homes); *In re Web Communications*, 49 USPQ2d 1478 (TTAB 1998) (WEB COMMUNICATIONS generic for consulting services to businesses seeking to establish sites on a global computer network); *In re Central Sprinkler Co.*, 49 USPQ2d 1194



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

(TTAB 1998) (ATTIC generic for sprinklers installed primarily in attics); *In re Stanbel Inc.*, 16 USPQ2d 1469 (TTAB 1990), *aff'd*, 20 USPQ2d 1319 (Fed. Cir. 1991) (ICE PAK for reusable ice substitute for use in food and beverage coolers held generic; even assuming a contrary holding, evidence submitted by applicant deemed insufficient to establish acquired distinctiveness); *In re The Paint Products Co.*, 8 USPQ2d 1863 (TTAB 1988) (PAINT PRODUCTS CO. for “interior and exterior paints and coatings, namely, alkyd, oil, latex, urethane and epoxy based paints and coatings” held so highly descriptive as to be incapable of becoming distinctive; even assuming the term could function as a mark, applicant’s evidence deemed insufficient to establish acquired distinctiveness); *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989) (ANALOG DEVICES held generic for devices having analog capabilities); *In re Mortgage Bankers Association of America*, 226 USPQ 954 (TTAB 1985) (CERTIFIED MORTGAGE BANKER (“MORTGAGE BANKER” disclaimed) for “educational services, namely providing qualifying examinations, testing and grading in the field of real estate finance” held so highly descriptive as to be incapable of functioning as a mark notwithstanding evidence of acquired distinctiveness); *In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219, 222 (TTAB 1984) (HALF PRICE BOOKS RECORDS MAGAZINES for retail book and record store services “is incapable of designating origin and any evidence of secondary meaning can only be viewed as ‘de facto’ in import and incapable of altering the inability of the subject matter for registration to function as a service mark”).

In the following cases, the matter sought to be registered was found not to be generic: *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) (1-888-M-A-T-R-E-S-S not generic for “telephone shop-at-home retail services in the field of mattresses”); *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999) (SOCIETY FOR REPRODUCTIVE MEDICINE not generic for association services in the field of reproductive medicine); *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) (CASH MANAGEMENT ACCOUNT for “stock brokerage services, administration of money market fund services, and providing loans against securities services” held merely descriptive, rather than generic, and remanded to Board to consider sufficiency of §2(f) evidence); *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986) (FIRE CHIEF not generic for publications); *In re Federated Dept. Stores Inc.*, 3 USPQ2d 1541 (TTAB 1987) (THE CHILDREN’S OUTLET (“OUTLET” disclaimed), while merely descriptive of applicant’s “retail children’s clothing store services,” held capable of functioning as a mark, with evidence submitted by applicant sufficient to establish acquired distinctiveness pursuant to §2(f)); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996 (TTAB 1986) (SYSTEMS USER for periodic trade journal held merely descriptive, rather than generic, and applicant’s evidence held sufficient to establish acquired distinctiveness pursuant to

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

§2(f)); *In re Failure Analysis Associates*, 1 USPQ2d 1144 (TTAB 1986) (FAILURE ANALYSIS ASSOCIATES, for “consulting services in the field of mechanical, structural, metallurgical, and metal failures, fires and explosions; engineering services in the field of mechanical design and risk analysis” and “consulting engineering services in the metallurgical field,” found to be merely descriptive of applicant’s services rather than incapable of distinguishing them from those of others; evidence submitted by applicant held sufficient to demonstrate acquired distinctiveness under §2(f)).

### **1209.02 Procedure for Descriptiveness and/or Genericness Refusal**

The examining attorney must consider the evidence of record to determine whether a mark is merely descriptive or whether it is suggestive or arbitrary. *See In re Noble Co.*, 225 USPQ 749, 750 (TTAB 1985). The examining attorney may request that the applicant submit additional explanations or materials to clarify the nature of the goods or services. 37 C.F.R. §2.61(b); TMEP §814. The examining attorney should also do any necessary research to determine the nature of the use of the designation in the marketplace. If the examining attorney refuses registration, he or she should support the refusal with appropriate evidence.

In all cases the examining attorney should try to make the Office action as complete as possible, so that the applicant may respond appropriately.

A designation that is merely descriptive should be refused registration under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). When issuing any refusal under §2(e)(1), if the designation appears to be a generic name for the goods or services, the examining attorney should provide an advisory statement that the subject matter appears to be a generic name for the goods or services, in conjunction with the refusal on the ground that the matter is merely descriptive. If, on the other hand, the mark appears to be capable, the examining attorney should provide appropriate advice concerning a possible amendment to the Supplemental Register or assertion of a claim of acquired distinctiveness. *See* TMEP §1102.03 concerning ineligibility of the proposed mark in a §1(b) application for the Supplemental Register prior to filing an acceptable amendment to allege use under 15 U.S.C. §1051(c) or statement of use under 15 U.S.C. §1051(d). If the record is unclear as to whether the designation is capable of functioning as a mark, the examining attorney should refrain from giving any advisory statement. In general, the Office should make every effort to apprise applicants as early as possible of the prospects for registration through appropriate amendments, if feasible.

An examining attorney should not issue a refusal in an application for the Principal Register on the ground that a mark is a generic name for the goods or services unless the applicant asserts that the mark has acquired distinctiveness under 15 U.S.C. §1052(f). Even if it appears that the mark is

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

generic, the proper basis for refusal is §2(e)(1). If there is strong evidence that the proposed mark is generic, a statement that the subject matter appears to be a generic name for the goods or services can be included as part of the §2(e)(1) refusal. It has been said that a generic term is “the ultimate in descriptiveness.” *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986).

If, in response to a first-action refusal under §2(e)(1), the applicant merely argues that the mark is registrable on the Principal Register without claiming acquired distinctiveness or amending to the Supplemental Register, the examining attorney should issue a final refusal under §2(e)(1), on the ground that the proposed mark is merely descriptive, if he or she is not persuaded by the applicant’s arguments.

If the applicant responds to a §2(e)(1) refusal by amending its application to the Supplemental Register, this amendment presents a new issue requiring consideration by the examining attorney (unless the amendment is irrelevant to the outstanding refusal—see TMEP §714.05(a)(i)). If the examining attorney determines that the designation is a generic name for the applicant’s goods or services, the examining attorney should then refuse registration on the Supplemental Register. The statutory basis for such a refusal is §23 of the Trademark Act, 15 U.S.C. §1091. This action must be nonfinal. See TMEP §§815 *et seq.* and 816 *et seq.* concerning applications for registration on the Supplemental Register.

If the applicant amends an application to assert acquired distinctiveness under §2(f), this raises a new issue. See TMEP §1212.02(h). If the examining attorney determines that the designation is a generic name for the applicant’s goods or services, the examining attorney should continue the refusal of registration on the Principal Register under §2(e)(1). The examining attorney should also explain why the showing of acquired distinctiveness is insufficient. The action must be nonfinal. See TMEP §§1212 *et seq.* regarding distinctiveness under §2(f), and TMEP §1212.02(i) regarding assertion of §2(f) claims with respect to generic matter.

To the fullest extent possible, the examining attorney will examine §1(b) intent-to-use applications for registrability under §2(e)(1) according to the same procedures and standards that apply to any other application. See *In re American Psychological Association*, 39 USPQ2d 1467 (Comm’r Pats. 1996); TMEP §§1102 and 1102.01.

### **1209.03                    Considerations Relevant to Determination of                                          Descriptiveness**

The following sections discuss factors and situations that often arise during a determination of whether a mark is descriptive or generic.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1209.03(a) Third-Party Registrations**

Third-party registrations are not conclusive on the question of descriptiveness. Each case must stand on its own merits, and a mark that is merely descriptive should not be registered on the Principal Register simply because other such marks appear on the register. *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977) (SCHOLASTIC held merely descriptive of devising, scoring and validating tests for others). The question of whether a mark is merely descriptive must be determined based on the evidence of record at the time registration is sought. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS held merely descriptive of computer software for use in development and deployment of application programs on a global computer network).

### **1209.03(b) No Dictionary Listing**

The fact that a term is not found in a dictionary is not controlling on the question of registrability if the examining attorney can show that the term has a well understood and recognized meaning. *See In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977) (BREADSPRED held merely descriptive of jellies and jams).

### **1209.03(c) First or Only User**

The fact that an applicant may be the first and only user of a merely descriptive or generic designation does not justify registration if the only significance conveyed by the term is merely descriptive. *See In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983) (SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE held apt descriptive name for conducting and arranging trade shows in the hunting, shooting and outdoor sports products field). *See also* TMEP §1212.06(e)(i) and cases cited therein.

### **1209.03(d) Combined Terms**

When two descriptive terms are combined, the determination of whether the composite mark also has a descriptive significance turns upon the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d1370 (Fed. Cir. 2004) (PATENTS.COM merely descriptive of computer software for managing a database of records and for tracking the status of the records by means of the Internet); *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111-1112 (Fed. Cir. 1987) (SCREENWIPE held generic as applied to premoistened antistatic cloths for cleaning computer and television screens);

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

*In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER merely descriptive of “commercial and industrial cooling towers and accessories therefor, sold as a unit”); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer software for use in development and deployment of application programs on global computer network); *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE held to be merely descriptive of news and information service for the food processing industry); *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of “facsimile terminals employing electrophoretic displays”); *In re Entenmann’s Inc.*, 15 USPQ2d 1750 (TTAB 1990), *aff’d per curiam*, 928 F.2d 411 (Fed. Cir. 1991) (OATNUT held to be merely descriptive of bread containing oats and hazelnuts); *In re Serv-A-Portion Inc.*, 1 USPQ2d 1915 (TTAB 1986) (SQUEEZE N SERV held to be merely descriptive of ketchup and thus subject to disclaimer); *In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986) (EXPRESSERVICE held to be merely descriptive of banking and trust services); *In re Uniroyal, Inc.*, 215 USPQ 716 (TTAB 1982) (STEELGLAS BELTED RADIAL held merely descriptive of vehicle tires containing steel and glass belts); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) (COASTER-CARDS held merely descriptive of coasters suitable for direct mailing).

However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods. See *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE held not merely descriptive of bakery products); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool).

When there is evidence that the composite mark itself has been used together to form a phrase that is descriptive of the goods or services, it is unnecessary to engage in an analysis of each individual component. *In re Shiva Corp.*, 48 USPQ2d 1957 (TTAB 1998) (TARIFF MANAGEMENT merely descriptive of computer hardware and computer programs to control, reduce and render more efficient wide area network usage).

The Trademark Trial and Appeal Board has held that the addition of the prefix “e” does not change the merely descriptive significance of a term in relation to goods or services sold or rendered electronically, where the record showed that the “e” prefix has become commonly recognized as a designation for goods or services sold and/or delivered electronically. *In re SPX Corp.*, 63 USPQ2d 1592 (TTAB 2002) (E-AUTODIAGNOSTICS merely descriptive of an “electronic engine analysis system comprised of a hand-held computer and related computer software”); *In re Styleclick.com Inc.*, 57 USPQ2d 1445 (TTAB 2000) (E FASHION merely descriptive of software used to obtain beauty and fashion information, and for electronic retailing services);

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*Continental Airlines Inc. v. United Airlines Inc.*, 53 USPQ2d 1385 (TTAB 1999) (E-TICKET generic for computerized reservation and ticketing of transportation services). Similarly, the prefix “i” or “I” would be understood by purchasers to signify Internet, when used in relation to Internet-related products or services. See *In re Zanova, Inc.*, 59 USPQ2d 1300 (TTAB 2000) (ITOOOL merely descriptive of computer software for use in creating web pages, and custom designing websites for others).

The addition of an entity designator (e.g., Corporation, Corp., Co., Inc., Ltd., etc.) to a descriptive term does not alter the term’s descriptive significance, because an entity designation has no source-indicating capacity. See *In re Cell Therapeutics Inc.*, 67 USPQ2d 1795 (TTAB 2003) (CELL THERAPEUTICS INC. generic for pharmaceutical preparations and laboratory research and development services); *In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213, 1215 (TTAB 2000) (“PRESS,” as applied to a printing or publishing establishment, “is in the nature of a generic entity designation which is incapable of serving a source-indicating function”); *In re The Paint Products Co.*, 8 USPQ2d 1863, 1866 (TTAB 1988) (“PAINT PRODUCTS CO.’ is no more registrable for goods emanating from a company that sells paint products than it would be as a service mark for the retail paint store services offered by such a company.”); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 919 (TTAB 1984) (the element ‘INC.’ [in PACKAGING SPECIALISTS, INC.] has “no source indication or distinguishing capacity”). See TMEP §1213.03(d) regarding disclaimer of entity designators.

### **1209.03(e) More Than One Meaning**

The fact that a term may have meanings other than the one relevant to a particular application is not controlling, because descriptiveness must be determined in relation to the goods or services for which registration is sought. See *In re Chopper Industries*, 222 USPQ 258 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Champion International Corp.*, 183 USPQ 318 (TTAB 1974).

See TMEP §1213.05(c) regarding wording that constitutes a “double entendre.”

### **1209.03(f) Picture or Illustration**

A visual representation that consists merely of an illustration of the goods, or of an article that is an important feature or characteristic of the goods or services, is merely descriptive under §2(e)(1) of the Act. See *In re Society for Private and Commercial Earth Stations*, 226 USPQ 436 (TTAB 1985) (representation of satellite dish held merely descriptive of services of an association promoting the interests of members of the earth station industry); *In re Underwater Connections, Inc.*, 221 USPQ 95 (TTAB 1983) (pictorial

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

representation of a compressed air gas tank held merely descriptive of travel tour services involving underwater diving). *But see In re LRC Products Ltd.*, 223 USPQ 1250 (TTAB 1984) (stylized hand design found not merely an illustration of the goods, *i.e.*, gloves; thus not merely descriptive).

### **1209.03(g) Foreign Equivalents/Dead or Obscure Languages**

The foreign equivalent of a merely descriptive English word is no more registrable than the English word itself. Words from modern languages are translated into English to determine descriptiveness or genericness. *In re Northern Paper Mills*, 64 F.2d 998, 17 USPQ 492 (C.C.P.A. 1933). The test is whether, to those American buyers familiar with the foreign language, the word would have a descriptive or generic connotation. *In re Zazzara*, 156 USPQ 348 (TTAB 1967) (PIZZA FRITTE, the Italian equivalent of “fried buns,” held incapable for fried dough). *See In re Oriental Daily News, Inc.*, 230 USPQ 637 (TTAB 1986) (Chinese characters that translate as ORIENTAL DAILY NEWS held merely descriptive of newspapers); *In re Geo. A. Hormel & Co.*, 227 USPQ 813 (TTAB 1985) (SAPORITO, an Italian word meaning “tasty,” held merely descriptive because it describes a desirable characteristic of applicant’s dry sausage); *In re Optica International*, 196 USPQ 775 (TTAB 1977) (OPTIQUE, a French word meaning “optic,” held merely descriptive of eyeglass frames).

While foreign words are generally translated into English for purposes of determining descriptiveness, foreign words from dead or obscure languages may be so unfamiliar to the American buying public that they should not be translated into English for descriptiveness purposes. *See Enrique Bernat F. S.A. v. Guadalajara Inc.*, 210 F.3d 439, 54 USPQ2d 1497 (5<sup>th</sup> Cir. 2000), *reh’g denied* 218 F.3d 745 (2000); *cf. General Cigar Co. Inc. v. G.D.M. Inc.*, 988 F. Supp. 647, 45 USPQ2d 1481 (S.D.N.Y. 1997). The determination of whether a language is “dead” must be made on a case-by-case basis, based upon the meaning that the term would have to the relevant purchasing public.

*Example:* Latin is generally considered a dead language. However, if there is evidence that a Latin term is still in use by the relevant purchasing public (*e.g.*, if the term appears in current dictionaries or news articles), then a Latin term is not considered dead. The same analysis should be applied to other uncommon languages.

### **1209.03(h) Incongruity**

Arbitrary and incongruous combinations of English terms with terms from a foreign language have been found registrable. *See In re Johanna Farms Inc.*, 8 USPQ2d 1408 (TTAB 1988) (LA YOGURT for yogurt held registrable on Principal Register, with a disclaimer of “YOGURT”); *In re Universal Package Corp.*, 222 USPQ 344 (TTAB 1984) (LE CASE held not merely descriptive of

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

jewelry boxes and gift boxes and, therefore, registrable with a disclaimer of “CASE”).

### **1209.03(i) Intended Users**

A term that identifies a group to whom the applicant directs its goods or services is merely descriptive. See *In re Planalytics, Inc.*, 70 USPQ2d 1453 (TTAB 2004) (GASBUYER merely descriptive of risk management services in the field of pricing and purchasing natural gas); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996 (TTAB 1986) (SYSTEMS USER found merely descriptive of a trade journal directed toward users of large data processing systems; evidence sufficient to establish distinctiveness under §2(f)); *In re Camel Mfg. Co., Inc.*, 222 USPQ 1031 (TTAB 1984) (MOUNTAIN CAMPER held merely descriptive of retail mail order services in the field of outdoor equipment and apparel).

### **1209.03(j) Phonetic Equivalent**

A slight misspelling of a word will not turn a descriptive or generic word into a non-descriptive mark. See *C-Thru Ruler Co. v. Needleman*, 190 USPQ 93 (E.D. Pa. 1976) (C-THRU held to be the equivalent of “see-through” and therefore merely descriptive of transparent rulers and drafting aids); *In re Hubbard Milling Co.*, 6 USPQ2d 1239 (TTAB 1987) (MINERAL-LYX held generic for mineral licks for feeding livestock).

### **1209.03(k) Laudatory Terms**

Laudatory terms, those that attribute quality or excellence to goods or services, are merely descriptive under §2(e)(1). See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) (THE ULTIMATE BIKE RACK found to be merely descriptive and therefore subject to disclaimer); *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness); *In re Best Software Inc.*, 58 USPQ2d 1314 (TTAB 2001) (the words BEST and PREMIER in mark BEST! SUPPORTPLUS PREMIER held merely descriptive of computer consultation and support services and thus subject to disclaimer); *In re Dos Padres Inc.*, 49 USPQ2d 1860 (TTAB 1998) (QUESO QUESADILLA SUPREME merely descriptive of cheese); *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995) (SUPER BUY held merely descriptive of tobacco products); *General Foods Corp. v. Ralston Purina Co.*, 220 USPQ 990 (TTAB 1984) (ORIGINAL BLEND held merely descriptive of cat food).



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### 1209.03(l) Telephone Numbers

If an applicant applies to register a designation that consists of a merely descriptive term with numerals in the form of an alphanumeric telephone number (e.g., 800, 888 or 900 followed by a word), the examining attorney should refuse registration under §2(e)(1). See *In re Page*, 51 USPQ2d 1660 (TTAB 1999) (888 PATENTS merely descriptive of patent-related legal services). The fact that a designation is in the form of a telephone number is insufficient, by itself, to render it distinctive.

If the relevant term is merely descriptive, but not generic, the mark may be registered on the Principal Register with a proper showing of acquired distinctiveness under §2(f), or on the Supplemental Register. See *Express Mortgage Brokers Inc. v. Simpson Mortgage Inc.*, 31 USPQ2d 1371 (E.D. Mich. 1994) (369-CASH held merely descriptive but shown to have acquired distinctiveness as applied to mortgage brokering and mortgage-related services). Of course, the designation must also be used in the manner of a mark. See TMEP §§1202 *et seq.* regarding use as a mark.

If the proposed mark is generic, the designation is unregistrable on either the Principal or the Supplemental Register. However, to support a refusal of registration on the ground that a telephone number is generic, the Court of Appeals for the Federal Circuit has held that it is not enough to show that the telephone number consists of a non-source-indicating area code and a generic term. The examining attorney must show evidence of the meaning the relevant purchasing public accords the proposed alphanumeric mark as a whole. See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001). See also *Dial-A-Mattress Franchise Corp. v. Page*, 880 F.2d 675, 11 USPQ2d 1644 (2d Cir. 1989) (use of confusingly similar telephone number enjoined). But see *Dranoff-Perlstein Associates v. Sklar*, 967 F.2d 852, 23 USPQ2d 1174, 1178 (3d Cir. 1992) (“[W]e decline to adopt the position espoused by the Second Circuit that telephone numbers which correlate to generic terms may be protectible as trademarks.... If telephone numbers that correlate to generic terms were granted protection, the first firm in a given market to obtain such a telephone number would, merely by winning the race to the telephone company, gain an unfair advantage over its competitors.”) (footnotes omitted); *800 Spirits Inc. v. Liquor By Wire, Inc.*, 14 F. Supp.2d 675 (D.N.J. 1998) (800 SPIRITS generic for “gift delivery service of alcohol beverages”).

### 1209.03(m) Domain Names

Internet domain names raise some unique trademark issues. A mark comprised of an Internet domain name is registrable as a trademark or service mark only if it functions as an identifier of the source of goods or services. Portions of the uniform resource locator (URL) including the beginning, (“http://www.”) and the top level Internet domain name (TLD) (e.g.,

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

“.com,” “.org,” “.edu,”) function to indicate an address on the World Wide Web, and therefore generally serve no source-indicating function. See TMEP §§1215 *et seq.* regarding marks comprising domain names. TLDs may also signify abbreviations for the type of entity for whom use of the cyberspace has been reserved. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1176, 71 USPQ2d1370, 1373 (Fed. Cir. 2004) (“[T]he Board is correct that the overall impression of ‘.com’ conveys to consumers the impression of a company or commercial entity on the Internet.”). For example, the TLD “.com” signifies to the public that the user of the domain name constitutes a commercial entity. *In re Martin Container, Inc.*, 65 USPQ2d 1058, 1060-1061 (TTAB 2002) (“[T]o the average customer seeking to buy or rent containers, ‘CONTAINER.COM’ would immediately indicate a commercial web site on the Internet which provides containers.”). See also *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602 (1888) (“The addition of the word ‘Company’ [to an otherwise generic mark] only indicates that parties have formed an association or partnership to deal in such goods . . . .” and does not render the generic mark registrable).

If a proposed mark includes a TLD such as “.com”, “.biz”, “.info”, the examining attorney must provide evidence that the term is a TLD, and, if available, evidence of the significance of the TLD as an abbreviation (e.g. “.edu” signifies an educational institution, “.biz” signifies a business).

Because TLDs generally serve no source-indicating function, their addition to an otherwise unregistrable mark typically cannot render it registrable. *Oppedahl*, 373 F.3d at 1174, 71 USPQ2d at 1372 (PATENTS.COM merely descriptive of computer software for managing a database of records and for tracking the status of the records by means of the Internet); *In re Microsoft Corp.*, 68 USPQ2d 1195, 1203 (TTAB 2003) (“The combination of the specific term and TLD at issue, i.e., OFFICE and .NET, does not create any double entendre, incongruity, or any other basis upon which we can find the composite any more registrable than its separate elements. The combination immediately informs prospective purchasers that the software includes ‘office suite’ type software and is from a Internet business, i.e., a ‘.net’ type business.”); *In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789, 1792 (TTAB 2002) (“Applicant seeks to register the generic term ‘bonds,’ which has no source-identifying significance in connection with applicant’s services, in combination with the top level domain indicator “.com,” which also has no source-identifying significance. And combining the two terms does not create a term capable of identifying and distinguishing applicant’s services.”); *In re Martin Container*, 65 USPQ2d at 1061 (“[N]either the generic term nor the domain indicator has the capability of functioning as an indication of source, and combining the two does not result in a compound term that has somehow acquired this capability.”). See also *Goodyear*, 128 U.S. at 602 (the incorporation of a term with no source-indicating function into an otherwise generic mark cannot render it registrable). For example, if a proposed mark is composed of merely descriptive term(s) combined with a TLD, the

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

examining attorney must refuse registration on the Principal Register under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that the mark is merely descriptive. See TMEP §1215.04.

Similarly, if a proposed mark is composed of generic term(s) for the applicant's goods or services and a TLD, the examining attorney generally must refuse registration on the ground that the mark is generic. See TMEP §§1209.01(c)(i) and 1215.05.

When examining domain name marks, it is important to evaluate the commercial impression of the mark as a whole, including the TLD indicator. In *Oppedahl*, the Court of Appeals for the Federal Circuit cautioned that, while "[t]he addition of a TLD such as '.com' or '.org' to an otherwise unregistrable mark will typically not add any source-identifying significance," this "is not a bright-line, per se rule. In exceptional circumstances, a TLD may render an otherwise descriptive term sufficiently distinctive for trademark registration." 373 F.3d at 1177, 71 USPQ2d at 1374.

See also *In re Eddie Z's Blinds and Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005) (BLINDSANDDRAPERY.COM generic for retail store services featuring blinds, draperies and other wall coverings, sold via the Internet).

### **1209.03(n) "America" or "American"**

If "AMERICA" or "AMERICAN" appears in a phrase or slogan, the examining attorney must evaluate the entire mark to determine whether it is merely descriptive as laudatory or even incapable. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness); *In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984) (AMERICA'S FRESHEST ICE CREAM held incapable); *In re Wileswood, Inc.*, 201 USPQ 400 (TTAB 1978) (AMERICA'S FAVORITE POPCORN held merely descriptive). Typically these marks primarily extol the quality or popularity of the goods or services and secondarily denote geographic origin. The examining attorney must look at each mark to determine whether it is capable, considering all relevant circumstances and case law. See TMEP §1210.02(b)(iv) and cases cited therein regarding use of terms such as "AMERICA," "AMERICAN," and "USA" in a way that is primarily geographically descriptive under 15 U.S.C. §1052(e)(2), primarily geographically deceptively misdescriptive under 15 U.S.C. §1052(e)(3), or deceptive under 15 U.S.C. §1052(a).

### **1209.03(o) "National" or "International"**

The terms "NATIONAL" and "INTERNATIONAL" have been held to be merely descriptive of services that are nationwide or international in scope. See *Jefferson Bankshares Inc. v. Jefferson Savings Bank*, 14 USPQ2d 1443

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

(W.D. Va. 1989) (NATIONAL BANK merely descriptive of banking services); *National Automobile Club v. National Auto Club, Inc.*, 365 F. Supp. 879, 180 USPQ 777 (S.D.N.Y. 1973), *aff'd*, 502 F.2d 1162 (2d Cir. 1974) (NATIONAL merely descriptive of auto club services); *In re Institutional Investor, Inc.*, 229 USPQ 614 (TTAB 1986) (INTERNATIONAL BANKING INSTITUTE for organizing seminars for bank leaders of major countries held incapable); *In re Billfish International Corp.*, 229 USPQ 152 (TTAB 1986) (BILLFISH INTERNATIONAL CORPORATION merely descriptive of corporation involved with billfish on an international scale); *In re National Rent A Fence, Inc.*, 220 USPQ 479 (TTAB 1983) (NATIONAL RENT A FENCE merely descriptive of nationwide fence rental services); *BankAmerica Corp. v. International Travelers Cheque Co.*, 205 USPQ 1233 (TTAB 1979) (INTERNATIONAL TRAVELERS CHEQUE merely descriptive of financial consulting services that are international in scope); *National Fidelity Life Insurance v. National Insurance Trust*, 199 USPQ 691 (TTAB 1978) (NATIONAL INSURANCE TRUST merely descriptive of services of handling administrative matters in locating suitable insurance coverage for attorneys).

### **1209.03(p) Function or Purpose**

Terms that identify the function or purpose of a product or service may be merely descriptive or generic under 15 U.S.C. §1052(e)(1). *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE held generic for an anti-static cloth used for cleaning computer and television screens); *In re Central Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998) (ATTIC generic for sprinklers installed primarily in attics); *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991) (PERMA PRESS generic for soil and stain removers for use on permanent press products); *In re Wallyball, Inc.*, 222 USPQ 87 (TTAB 1984) (WALLYBALL held descriptive of sports clothing and game equipment); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977) (BURGER held merely descriptive of cooking utensils); *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977) (BREADSPRED held merely descriptive of jams and jellies).

### **1209.03(q) Source or Provider of Goods or Services**

Terms that identify the source or provider of a product or service may be merely descriptive under 15 U.S.C. §1052(e)(1) or generic. *In re Major League Umpires*, 60 USPQ2d 1059 (TTAB 2001) (MAJOR LEAGUE UMPIRE merely descriptive of clothing, face masks, chest protectors and skin guards); *In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213 (TTAB 2000) (PSYCHOLOGY PRESS merely descriptive of books in field of psychology); *In re The Paint Products Co.*, 8 USPQ2d 1863 (TTAB 1988) (PAINT PRODUCTS COMPANY incapable for paint); *In re The Phone Co., Inc.*, 218 USPQ 1027 (TTAB 1983) (THE PHONE COMPANY merely descriptive of telephones).

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### 1209.03(r) Retail Store and Distributorship Services

A term that is generic for goods is descriptive of retail store services featuring those goods, when the goods are not a significant item typically sold in the type of store in question. *In re Pencils Inc.*, 9 USPQ2d 1410 (TTAB 1988) (PENCILS held merely descriptive of office supply store services). However, where the matter sought to be registered identifies the primary articles of a store or distributorship service, the term is considered generic. *In re Eddie Z's Blinds and Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005) (BLINDSANDDRAPERY.COM generic for retail store services featuring blinds, draperies and other wall coverings, conducted via the Internet); *In re Candy Bouquet International, Inc.*, 73 USPQ2d 1883 (TTAB 2004) (CANDY BOUQUET generic for "retail, mail, and computer order services in the field of gift packages of candy"); *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART generic for dealership services in the field of fine art, antiques, furniture and jewelry); *In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999) (LOG CABIN HOMES generic for retail outlets selling kits for building log homes); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987) (LA LINGERIE held generic for retail stores specializing in the sale of lingerie); *In re Wickerware, Inc.*, 227 USPQ 970 (TTAB 1985) (WICKERWARE generic for mail order and distributorship services in the field of products made of wicker); *In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219 (TTAB 1984) (HALF PRICE BOOKS RECORDS MAGAZINES generic for retail book and record store services). The examining attorney, therefore, must analyze the term in relation to the services recited, the context in which it is used and the possible significance it would have to the recipient of the services. *Pencils*, 9 USPQ2d at 1411.

### 1209.03(s) Slogans

Slogans that are considered to be merely informational in nature or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry are not registrable. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness). See TMEP §1202.04 and cases cited therein.

### 1209.04 Deceptively Misdescriptive Marks

Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), also prohibits registration of designations that are deceptively misdescriptive of the goods or services to which they are applied. The examining attorney must consider the mark in relation to the applicant's goods or services to determine whether a mark is deceptively misdescriptive.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The examining attorney must first determine whether a term is misdescriptive as applied to the goods or services. A term that conveys an immediate idea of an ingredient, quality, characteristic, function or feature of the goods or services with which it is used is merely descriptive. See TMEP §1209.01(b). If a term immediately conveys such an idea but the idea is false, although plausible, then the term is deceptively misdescriptive and is unregistrable under §2(e)(1). See *In re Woodward & Lothrop Inc.*, 4 USPQ2d 1412 (TTAB 1987) (CAMEO held deceptively misdescriptive of jewelry); *In re Ox-Yoke Originals, Inc.*, 222 USPQ 352 (TTAB 1983) (G.I. held deceptively misdescriptive of gun cleaning patches, rods, brushes, solvents and oils).

The Trademark Act does not prohibit the registration of misdescriptive terms unless they are deceptively misdescriptive, that is, unless persons who encounter the mark, as used on or in connection with the goods or services in question, are likely to believe the misrepresentation. See *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003 (TTAB 1984) (LIQUID CRAYON held neither common descriptive name, nor merely descriptive, nor deceptively misdescriptive of coloring kits or markers).

As explained in the case of *In re Quady Winery Inc.*, 221 USPQ 1213, 1214 (TTAB 1984):

The test for deceptive misdescriptiveness has two parts. First we must determine if the matter sought to be registered misdescribes the goods. If so, then we must ask if it is also deceptive, that is, if anyone is likely to believe the misrepresentation. *Gold Seal Co. v. Weeks*, 129 F. Supp. 928 (D.D.C. 1955), *aff'd sub nom. S.C. Johnson & Son v. Gold Seal Co.*, 230 F.2d 832 (D.C. Cir.) (*per curiam*), *cert. denied*, 352 U.S. 829 (1956). A third question, used to distinguish between marks that are deceptive under Section 2(a) and marks that are deceptively misdescriptive under Section 2(e)(1), is whether the misrepresentation would materially affect the decision to purchase the goods. *Cf. In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983).

If the misdescription represented by the mark is material to the decision to purchase the goods or use the services, then the mark should be refused registration under §2(a) of the Trademark Act, 15 U.S.C. §1052(a). See TMEP §1203.02 regarding deceptive marks, and 1203.02(a) regarding the distinction between deceptive marks and deceptively misdescriptive marks.

The examining attorney should consider and make of record, or require the applicant to make of record, all available information that shows the presence or absence, and the materiality, of a misrepresentation. The mere fact that the true nature of the goods or services is revealed by other matter on the labels, advertisements or other materials to which the mark is applied does not preclude a determination that a mark is deceptively misdescriptive. See

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

*R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d 786, 140 USPQ 276 (C.C.P.A. 1964) (DURA-HYDE held deceptive and deceptively misdescriptive of plastic material of leather-like appearance made into shoes); *In re Woolrich Woolen Mills Inc.*, 13 USPQ2d 1235 (TTAB 1989) (WOOLRICH for clothing not made of wool found not to be deceptive under §2(a)); *Tanners' Council of America, Inc. v. Samsonite Corp.*, 204 USPQ 150 (TTAB 1979) (SOFTHIDE held deceptive within the meaning of §2(a) for imitation leather material).

See also *Northwestern Golf Co. v. Acushnet Co.*, 226 USPQ 240 (TTAB 1985); *R.J. Reynolds Tobacco Co. v. Brown & Williamson Tobacco Corp.*, 226 USPQ 169 (TTAB 1985); and *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798 (TTAB 1984) regarding the issue of deceptive misdescriptiveness.

Marks that have been refused registration pursuant to §2(e)(1) on the ground of deceptive misdescriptiveness may be registrable under §2(f) upon a showing of acquired distinctiveness, or on the Supplemental Register. 15 U.S.C. §§1052(f) and 1091. Marks that are deceptive under §2(a) are not registrable on either the Principal Register or the Supplemental Register under any circumstances.

### 1210 Refusal on Basis of Geographic Significance

*Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it--*

*(a) Consists of or comprises ... deceptive ... matter;... or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after [January 1, 1996].*

...

*(e) Consists of a mark which ... (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 4, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them....*

Section 2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2), prohibits registration on the Principal Register of a mark that is primarily geographically descriptive of the goods or services named in the application. See TMEP §1210.01(a).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Section 2(e)(3) of the Trademark Act, 15 U.S.C. §1052(e)(3), prohibits registration of a mark that is primarily geographically deceptively misdescriptive of the goods or services named in the application. See TMEP §1210.01(b). Prior to the amendment of the Trademark Act on January 1, 1994, by the North American Free Trade Agreement (“NAFTA”) Implementation Act, Public Law 103-182, 107 Stat. 2057, the statutory basis for refusal to register primarily geographically deceptively misdescriptive marks was §2(e)(2).

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), prohibits registration of a designation that consists of or comprises deceptive matter, as well as geographical indications which, when used on or in connection with wines or spirits, identify a place other than the origin of the goods. See TMEP §1210.01(c).

See TMEP §1210.05(a) regarding the distinction between marks that are primarily geographically deceptively misdescriptive under §2(e)(3) and marks that are deceptive under §2(a).

### **1210.01 Elements**

#### **1210.01(a) Geographically Descriptive Marks - Test**

To establish a *prima facie* case for refusal to register a mark as primarily geographically descriptive, the examining attorney must show that:

- (1) the primary significance of the mark is a generally known geographic location (see TMEP §§1210.02 *et seq.*);
- (2) the goods or services originate in the place identified in the mark (see TMEP §1210.03); and
- (3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark (see TMEP §§1210.04 *et seq.*). *Note:* If the mark is remote or obscure, the public is unlikely to make a goods/place or services/place association (see TMEP §1210.04(c)).

#### **1210.01(b) Geographically Deceptively Misdescriptive Marks - Test**

To support a refusal to register a mark as primarily geographically deceptively misdescriptive, the examining attorney must show that:

- (1) the primary significance of the mark is a generally known geographic location (see TMEP §§1210.02 *et seq.*);
- (2) the goods or services do not originate in the place identified in the mark (see TMEP §1210.03);



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

- (3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark (see TMEP §§1210.04 *et seq.*). *Note:* If the mark is remote or obscure, the public is unlikely to make a goods/place or services/place association (see TMEP §1210.04(c)); and
- (4) the misrepresentation is a material factor in the consumer's decision to buy the goods or use the services (see TMEP §§1210.05(b) *et seq.*).

*In re Les Halles De Paris J.V.*, 334 F.3d 1371, 67 USPQ2d 1539 (Fed. Cir. 2003); *In re California Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003), *reh'g denied*, 2003 U.S. App. LEXIS 18883 (Fed. Cir. Aug. 20, 2003).

Prior to the amendment of the Trademark Act by the NAFTA Implementation Act, it was not necessary to show that the misrepresentation was likely to be a material factor in the consumer's decision to buy the goods or use the services in order to establish that a mark was primarily geographically deceptively misdescriptive. However, in *California Innovations*, the Court of Appeals for the Federal Circuit held that in view of the NAFTA amendments, a showing of public deception is required to establish that a mark is unregistrable under §2(e)(3).

See TMEP §1210.05(a) for further information regarding the distinction between marks comprising deceptive matter under §2(a) and marks comprising primarily geographically deceptively misdescriptive matter under §2(e)(3), and TMEP §§1210.05(b) *et seq.* regarding the showing that a misrepresentation of the origin of the goods or services is likely to affect the purchaser's decision to buy the goods or use the services.

### **1210.01(c) Geographically Deceptive Marks - Test**

As noted in TMEP §1210.05(a), the test for determining whether a mark is primarily geographically deceptively misdescriptive under §2(e)(3) is now the same as the test for determining whether a mark is deceptive under §2(a). To support a refusal of registration on the ground that a geographic term is deceptive under §2(a), the examining attorney must show that:

- (1) the primary significance of the mark is a generally known geographic location (see TMEP §§1210.02 *et seq.*);
- (2) the goods or services do not originate in the place named in the mark (see TMEP §1210.03);
- (3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark (see TMEP §§1210.04 *et seq.*). *Note:* If the mark is remote or obscure, the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

public is unlikely to make a goods/place or services/place association (see TMEP §1210.04(c)); and

- (4) the misrepresentation is a material factor in the consumer's decision to buy the goods or use the services (see TMEP §§1210.05(b) *et seq.*).

*Institut National des Appellations D'Origine v. Vintners Int'l Co., Inc.*, 958 F.2d 1574, 1580, 22 USPQ2d 1190, 1195 (Fed. Cir. 1992); *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984). See also *In re California Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003), *reh'g denied*, 2003 U.S. App. LEXIS 18883 (Fed. Cir. Aug. 20, 2003).

See TMEP §1210.05(a) for further information regarding the distinction between marks comprising deceptive matter under §2(a) and marks comprising primarily geographically deceptively misdescriptive matter under §2(e)(3), and TMEP §§1210.05(b) *et seq.* regarding the showing that a misrepresentation of the origin of the goods or services is likely to affect the purchaser's decision to buy the goods or use the services.

### **1210.02 Primarily Geographic Significance**

A mark is primarily geographic if it identifies a real and significant geographic location, and the primary meaning of the mark is the geographic meaning.

#### **1210.02(a) Geographic Locations**

A geographic location may be any term identifying a country, city, state, continent, locality, region, area or street.

*Region.* A particular, identifiable region (e.g., "Midwest" or "Mid-Atlantic") is a geographic location. *In re Pan-O-Gold Baking Co.*, 20 USPQ2d 1761 (TTAB 1991) (primary significance of "New England" is geographic). On the other hand, vague geographic terms (e.g., "Global," "National," "International," or "World") are *not* considered to be primarily geographic, though they may be merely descriptive or deceptively misdescriptive under §2(e)(1). See TMEP §1209.03(o).

*Nicknames.* A geographic nickname (e.g., "Big Apple" or "Motown"), or an abbreviation or other variant of the name of a geographic location is treated the same as the actual name of the geographic location if it is likely to be perceived as such by the purchasing public. See *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998) (CAROLINA APPAREL primarily geographically descriptive of retail clothing store services, where the evidence showed that "Carolina" is used to indicate either the state of North Carolina or the state of South Carolina). Cf. *In re Trans Continental Records, Inc.*, 62 USPQ2d 1541 (TTAB 2002) (O-TOWN found to be a "relatively obscure term" that would *not*

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

be perceived by a significant portion of the purchasing public as a geographic reference to Orlando, Florida).

*Adjectives.* The adjectival form of the name of a geographic location is considered primarily geographic if it is likely to be perceived as such by the purchasing public. See *In re Jack's Hi-Grade Foods, Inc.*, 226 USPQ 1028 (TTAB 1985) (NEAPOLITAN held primarily geographically deceptively misdescriptive of sausage emanating from the United States, where the term is defined as "of or pertaining to Naples in Italy"); *American Paper & Plastic Products, Inc. v. American Automatic Vending Corp.*, 152 USPQ 117 (TTAB 1966) (AMERICAN AUTOMATIC VENDING held primarily geographically descriptive).

*Maps.* A map or outline of a geographic area is also treated the same as the actual name of the geographic location if it is likely to be perceived as such. See *In re Canada Dry Ginger Ale, Inc.*, 86 F.2d 830, 32 USPQ 49 (C.C.P.A. 1936) (map of Canada held to be the equivalent of the word "Canada"). Cf. *In re Texsun Tire and Battery Stores, Inc.*, 229 USPQ 227 (TTAB 1986) (indicating that if the depiction of a map is fanciful or so integrated with other elements of a mark that it forms a unitary whole, then the map should not be considered primarily geographically descriptive).

*Coined Locations.* The mere fact that a term may be the name of a place that has a physical location does not necessarily make that term geographic under §2(e)(2). For example, names of amusement parks, residential communities, and business complexes, which are coined by the applicant, should not be refused. *In re Pebble Beach Co.*, 19 USPQ2d 1687 (TTAB 1991) (17 MILE DRIVE not a geographic term, where it refers to a specific location wholly owned by applicant, and was coined by applicant to refer both to applicant's services and the place where the services were performed).

### **1210.02(b) Primary Significance**

To support a refusal to register geographic matter, the Trademark Act requires that the mark be *primarily* geographic, that is, that its primary significance be that of a geographic location. 15 U.S.C. §§1052(e)(2) and (3). See, e.g., *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (primary significance of NEW YORK held to geographic; Court was not persuaded by assertions that the composite NEW YORK WAYS GALLERY evokes a gallery that features New York "ways" or "styles"); *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987) (evidence insufficient to establish that public in United States would perceive VITTEL as the name of a place where cosmetic products originate; Vittel, France found to be obscure); *In re Cotter & Co.*, 228 USPQ 202 (TTAB 1985) (the primary significance of WESTPOINT is as the name of the United States Military Academy rather than the town in New York).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The fact that the proposed mark has meaning or usage other than as a geographic term does not necessarily alter its primarily geographic significance. See TMEP §1210.02(b)(i) *et seq.*

When a geographic term is combined with additional matter (e.g., wording and/or a design element), the examining attorney must determine the primary significance of the composite. See TMEP §§1210.02(c) *et seq.*

See TMEP §1210.04(c) regarding obscure or remote geographic marks.

### **1210.02(b)(i) Other Meanings**

The fact that the mark has meaning or usage other than as a geographic term does not necessarily alter its primarily geographic significance. Thus, if a geographic term has another meaning, the examining attorney must determine whether the *primary* significance is geographic. If so, refusal of registration under §2(e)(2), §2(e)(3), or §2(a) is appropriate. See, e.g., *In re Opryland USA Inc.*, 1 USPQ2d 1409 (TTAB 1986) (THE NASHVILLE NETWORK held primarily geographically descriptive of television program production and distribution services, the Board finding that the primary significance of the term was Nashville, Tennessee, and not that of a style of music); *In re Cookie Kitchen, Inc.*, 228 USPQ 873, 874 (TTAB 1986) (the fact that MANHATTAN identifies an alcoholic cocktail does not alter the primary significance of that term as a borough of New York City); *In re Jack's Hi-Grade Foods, Inc.*, 226 USPQ 1028, 1029 (TTAB 1985) (the fact that NEAPOLITAN identifies, among other things, a type of ice cream does not alter the primary significance of that term as meaning “of or pertaining to Naples in Italy”).

However, if the most prominent meaning or significance of the mark is not geographic, or if the mark creates a separate readily understood meaning that is not geographic, then a refusal under §2(e)(2), §2(e)(3), or §2(a) is not appropriate. See *Hyde Park Clothes, Inc. v. Hyde Park Fashions, Inc.*, 93 USPQ 250 (S.D.N.Y. 1951), *aff'd*, 204 F.2d 223, 97 USPQ 246 (2d Cir. 1953), *cert. denied*, 346 U.S. 827, 99 USPQ 491 (1953) (primary significance of HYDE PARK for men's suits is to suggest that the product is stylish or of high quality rather than to provide information about geographic origin); *In re International Taste Inc.*, 53 USPQ2d 1604, 1605-06 (TTAB 2000) (because of other prominent, significant meaning of HOLLYWOOD as referring to the entertainment industry in general, doubt about the primary significance of HOLLYWOOD was resolved in favor of the applicant); *In re Urbano*, 51 USPQ2d 1776, 1780 (TTAB 1999) (primary significance of SYDNEY 2000, used for advertising and business services and communication services, is as a reference to the Olympic Games, not to the name of a place); *In re Municipal Capital Markets Corp.*, 51 USPQ2d 1369, 1371 (TTAB 1999) (primary significance of COOPERSTOWN is that of “an institution, namely, the Baseball Hall of Fame” rather than a geographic location); *In re Jim*

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

*Crockett Promotions Inc.*, 5 USPQ2d 1455 (TTAB 1987) (primary significance of THE GREAT AMERICAN BASH for promoting, producing and presenting professional wrestling matches, is to suggest something of desirable quality or excellence rather than to describe the geographic origin of the services); *In re Dixie Insurance Co.*, 223 USPQ 514, 516 (TTAB 1984) (DIXIE held not primarily geographically descriptive of property and casualty underwriting services, where the examining attorney provided no evidence to show that the geographical significance of DIXIE was its primary significance).

### **1210.02(b)(i)(A) Surname Significance**

A term's geographic significance may not be its primary significance if the term also has surname significance. *Cf. In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939, 1943 (TTAB 1993) (HAMILTON held primarily merely a surname, even though the term had some geographical connotations); *In re Colt Industries Operating Corp.*, 195 USPQ 75 (TTAB 1977) (FAIRBANKS held not primarily merely a surname because the geographical significance of the mark was determined to be just as dominant as its surname significance).

### **1210.02(b)(ii) More Than One Geographic Location With Same Name**

The fact that the mark identifies more than one geographic location does not necessarily detract from the term's primary geographic significance. *See, e.g., In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (DURANGO held primarily geographically deceptively misdescriptive of chewing tobacco not grown in Durango, Mexico, where the evidence of record showed that tobacco is a crop produced and marketed in that area, even though there is more than one place named Durango); *In re Cambridge Digital Systems*, 1 USPQ2d 1659, 1662 (TTAB 1986) (CAMBRIDGE DIGITAL and design held primarily geographically descriptive of computer systems and parts thereof, where applicant's place of business is Cambridge, Massachusetts, even though there is more than one Cambridge).

### **1210.02(b)(iii) Non-Geographic Characteristics of Goods or Services**

Geographic matter may serve to designate a kind or type of goods or services, or to indicate a style or design that is a feature of the goods or services, rather than to indicate their geographic origin. For example, the geographic components in terms such as "dotted swiss," "Boston baked beans," "Swiss cheese," "Early American design" and "Italian spaghetti" are not understood as indicating the geographic origin of the goods but, rather, a particular type or style of product (regardless of where the product is produced). *See Forschner Group Inc. v. Arrow Trading Co. Inc.*, 30 F.3d 348, 31 USPQ2d 1614 (2d Cir. 1994) (SWISS ARMY KNIFE); *Institut National des Appellations D'Origine v. Vintners Int'l Co., Inc.*, 958 F.2d 1574, 1580, 22 USPQ2d 1190, 1195 (Fed. Cir. 1992) (evidence showing that Chablis is the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

name of a region in France insufficient to establish that CHABLIS WITH A TWIST is geographically deceptive of wine under §2(a), where evidence showed that the term “Chablis” would be perceived by consumers in the United States as the generic name for a type of wine with the general characteristics of French chablis); *Hyde Park Clothes, Inc. v. Hyde Park Fashions, Inc.*, 93 USPQ 250 (S.D.N.Y. 1951), *aff'd*, 204 F.2d 223, 97 USPQ 246 (2d Cir. 1953), *cert. denied*, 346 U.S. 827, 99 USPQ 491 (1953) (primary significance of HYDE PARK for men’s suits is to suggest that the product is stylish or of high quality rather than to provide information about geographic origin).

When geographic terms are used in circumstances in which it is clear that they are meant to convey some meaning other than geographic origin, registration should not be refused on the basis of geographical descriptiveness or misdescriptiveness. However, there may be some other basis for refusal; for example, the terms may be merely descriptive or deceptively misdescriptive of the goods or services under §2(e)(1) of the Act, 15 U.S.C. §1052(e)(1). *In re MBNA America Bank, N.A.*, 340 F.3d 1328, 67 USPQ2d 1778 (Fed. Cir. 2003), *reh’g denied*, 2004 U.S. App. LEXIS 2187 (Fed. Cir. Jan. 12, 2004) (MONTANA SERIES and PHILADELPHIA SERIES are merely descriptive of “credit card services featuring credit cards depicting scenes or subject matter of, or relating to” the places named in the marks); *In re Busch Entertainment Corp.*, 60 USPQ2d 1130 (TTAB 2000) (EGYPT merely descriptive of subject matter or motif of amusement park services). See TMEP §§1209 *et seq.* regarding marks that are merely descriptive or deceptively misdescriptive under §2(e)(1).

If it is unclear whether the primary significance of the term is geographic or merely descriptive or deceptively misdescriptive, the examining attorney may refuse registration on both grounds in the alternative.

### **1210.02(b)(iv) “America” or “American” and Similar Terms in Marks**

When terms such as “AMERICA,” “AMERICAN” and “USA” appear in marks, the determination as to whether the term or the entire mark should be considered geographic can be a particularly difficult one. There is no simple or mechanical answer to the question of how to treat “AMERICA” or “AMERICAN” in a mark. The examining attorney must evaluate each mark on a case-by-case basis. The examining attorney must consider the entire context, the type of goods or services at issue, the geographic origin of the goods or services and, most importantly, the overall commercial impression engendered by the mark at issue. The following principles, developed in the case law, should provide guidance in reaching a judgment in a given case.

- (1) If “AMERICA” or “AMERICAN” is used in a way that primarily denotes the United States origin of the goods or services, then the term is primarily geographically descriptive. See, *e.g.*, *American*

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

*Diabetes Association, Inc. v. National Diabetes Association*, 533 F. Supp. 16, 214 USPQ 231 (E.D. Pa. 1981), *aff'd*, 681 F.2d 804 (3d Cir. 1982) (AMERICAN DIABETES ASSOCIATION held primarily geographically descriptive); *In re Monograms America, Inc.*, 51 USPQ2d 1317 (TTAB 1999) (MONOGRAMS AMERICA primarily geographically descriptive of consultation services for owners of monogramming shops); *In re BankAmerica Corp.*, 231 USPQ 873 (TTAB 1986) (BANK OF AMERICA held primarily geographically descriptive); *American Paper & Plastic Products, Inc. v. American Automatic Vending Corp.*, 152 USPQ 117 (TTAB 1966) (AMERICAN AUTOMATIC VENDING held primarily geographically descriptive). One commentator refers to such marks as exhibiting an “unadorned” use of “AMERICA” or “AMERICAN.” J. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §14:11 (4<sup>th</sup> ed. 2004). Many service marks (e.g., association-type marks) fall squarely into this category. See also *In re U.S. Cargo, Inc.*, 49 USPQ2d 1702 (TTAB 1998) (U.S. CARGO primarily geographically descriptive of towable trailers carrying cargo and vehicles).

- (2) If a composite mark does not primarily convey geographic significance overall, or if “AMERICA” or “AMERICAN” is used in a nebulous or suggestive manner, then it is inappropriate to treat “AMERICA” or “AMERICAN” as primarily geographically descriptive. See, e.g., *Hamilton-Brown Shoe Co. v. Wolf Brothers & Co.*, 240 U.S. 251 (1916) (THE AMERICAN GIRL held not primarily geographically descriptive for shoes); *American Plan Corp. v. State Loan & Finance Corp.*, 365 F.2d 635, 150 USPQ 767 (3d Cir. 1966), *cert. denied*, 385 U.S. 1011, 152 USPQ 844 (1967) (AMERICAN PLAN CORPORATION held not primarily geographically descriptive); *Wilco Co. v. Automatic Radio Mfg. Co., Inc.*, 255 F. Supp. 625, 151 USPQ 24 (D. Mass. 1966) (ALL AMERICAN held not primarily geographically descriptive); *In re Jim Crockett Promotions Inc.*, 5 USPQ2d 1455 (TTAB 1987) (THE GREAT AMERICAN BASH held not primarily geographically descriptive of wrestling exhibitions). The introduction of a nuance, even a subtle one, may remove a mark from the primarily geographically descriptive category. This area calls for the most difficult analysis. The examining attorney must determine whether the overall commercial impression is something other than primarily geographic -- for example, due to double meanings or shades of suggestive meanings.
- (3) If “AMERICA” or “AMERICAN” is used in virtually any manner with goods or services that are not from the United States, then the examining attorney should determine whether the term is primarily geographically deceptively misdescriptive under §2(e)(3) and/or

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

deceptive under §2(a). See, e.g., *Singer Mfg. Co. v. Birginal-Bigsby Corp.*, 319 F.2d 273, 138 USPQ 63 (C.C.P.A. 1963) (AMERICAN BEAUTY held primarily geographically deceptively misdescriptive when used on Japanese-made sewing machines); *In re Biessecci S.p.A.*, 12 USPQ2d 1149 (TTAB 1989) (AMERICAN SYSTEM and design (“AMERICAN” disclaimed) held deceptive for clothing manufactured in Italy). Cf. *In re Salem China Co.*, 157 USPQ 600 (TTAB 1968) (AMERICAN LIMOGES held deceptive under §2(a) when used on china not made in Limoges, France). In this situation, even marks that arguably convey a non-geographic commercial impression must be viewed with great skepticism.

- (4) If “AMERICA” or “AMERICAN” appears in a phrase or slogan, the examining attorney must evaluate the entire mark to determine whether it is merely descriptive as laudatory, or even incapable. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness); *In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984) (AMERICA’S FRESHEST ICE CREAM held incapable); *In re Wileswood, Inc.*, 201 USPQ 400 (TTAB 1978) (AMERICA’S FAVORITE POPCORN held merely descriptive); *Kotzin v. Levi Strauss & Co.*, 111 USPQ 161 (Comm’r Pats. 1956) (AMERICA’S FINEST JEANS and AMERICA’S FINEST for overalls held not confusingly similar and incapable by inference). Typically these marks primarily extol the quality or popularity of the goods or services and secondarily denote geographic origin. See TMEP §1209.03(n) regarding use of terms such as “AMERICA” and “AMERICAN” in a way that is merely descriptive or generic.

### **1210.02(c) Geographic Terms Combined With Additional Matter**

A geographic composite mark is one composed of geographic matter coupled with additional matter (e.g., wording and/or a design element). When examining such a mark, the examining attorney must determine the primary significance of the composite. See *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001) (THE VENICE COLLECTION and SAVE VENICE INC. with an image of the winged Lion of St. Mark, for various goods, held primarily geographically deceptively misdescriptive of products that do not originate in Venice, Italy); *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (NEW YORK WAYS GALLERY (“NEW YORK” disclaimed) held primarily geographically deceptively misdescriptive of backpacks, handbags, purses and similar items); *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031 (TTAB 1997) (HAVANA SELECT, HAVANA CLASICO, OLD HAVANA, HAVANA PRIMO, and HAVANA CLIPPER primarily geographically deceptively misdescriptive of rum); *In re Perry Mfg. Co.*, 12 USPQ2d 1751



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

(TTAB 1989) (PERRY NEW YORK and design (“NEW YORK” disclaimed) held deceptive for various items of clothing that originate in North Carolina, and have no connection with New York, because of the renown of New York in the apparel industry); *In re Biessecci S.p.A.*, 12 USPQ2d 1149 (TTAB 1989) (AMERICAN SYSTEM and design of running man, for clothing manufactured in Italy, held deceptive).

See TMEP §1210.06 regarding the procedure for examining geographic composites.

### **1210.02(c)(i) Two Geographic Terms Combined**

When two geographic terms are combined in the same mark, the primary significance of the composite may still be geographic, if purchasers would believe that the goods or services originate from or are rendered in both of the locations named in the mark. See *In re Narada Productions, Inc.*, 57 USPQ2d 1801, 1803 (TTAB 2001) (CUBA L.A. primarily geographically deceptively misdescriptive of musical recordings and live musical performances that do not originate in Cuba or Los Angeles, the Board finding that purchasers would understand the composite as a reference to the two places named rather than to “some mythical place called ‘Cuba L.A.’”); *In re London & Edinburgh Insurance Group Ltd.*, 36 USPQ2d 1367 (TTAB 1995) (LONDON & EDINBURGH INSURANCE primarily geographically descriptive of insurance and underwriting services that are rendered or originate in the cities of London and Edinburgh).

Repeating a geographical term does not alter the geographical significance of that term. *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992) (LONDON LONDON held deceptive for clothing having no connection with London, given the renown of London as a center for contemporary as well as traditional fashions).

### **1210.02(c)(ii) Geographic Terms Combined With Descriptive or Generic Matter**

Generally, the addition of a highly descriptive or generic term to the name of a geographic place does not alter its primarily geographic significance. *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001) (MINNESOTA CIGAR COMPANY primarily geographically descriptive of cigars); *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998) (CAROLINA APPAREL primarily geographically descriptive of retail clothing store services); *In re Chalk’s International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991) (PARADISE ISLAND AIRLINES held primarily geographically descriptive of the transportation of passengers and goods by air); *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989) (THE WINE SOCIETY OF AMERICA held primarily geographically descriptive of wine club membership services); *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988)

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

(CALIFORNIA PIZZA KITCHEN (“PIZZA KITCHEN” disclaimed) held primarily geographically descriptive of restaurant services); *In re Cambridge Digital Systems*, 1 USPQ2d 1659 (TTAB 1986) (CAMBRIDGE DIGITAL and design (“DIGITAL” disclaimed) held primarily geographically descriptive of computer systems and parts thereof).

### **1210.02(c)(iii) Arbitrary, Fanciful or Suggestive Composites**

If, when viewed as a whole, a composite mark would not be likely to be perceived as identifying the geographic origin of the goods or services (*i.e.*, the mark as a whole is not primarily geographically descriptive, primarily geographically deceptively misdescriptive, or deceptive), then the mark is regarded as arbitrary, fanciful or suggestive. See *In re Sharky’s Drygoods Co.*, 23 USPQ2d 1061 (TTAB 1992) (PARIS BEACH CLUB, applied to T-shirts and sweatshirts, not deceptive under §2(a), the Board reasoning that because Paris is not located on an ocean or lake, and does not have a beach, the juxtaposition of “Paris” with “Beach Club” results in an incongruous phrase which purchasers would view as a humorous mark, a take off on the fact that Paris is known for haute couture. Thus purchasers would not expect T-shirts and sweatshirts to originate in the city of Paris).

### **1210.03 Geographic Origin of the Goods or Services**

The question of whether a term is primarily geographically descriptive under §2(e)(2), primarily geographically deceptively misdescriptive under §2(e)(3), or geographically deceptive under §2(a) depends on whether or not the mark identifies the place from which the goods or services originate. Goods or services may be said to “originate” from a geographic location if, for example, they are manufactured, produced or sold there. See *Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc.*, 38 USPQ2d 1691 (TTAB 1996) (RODEO DRIVE held primarily geographically deceptively misdescriptive of perfume, where opposer’s evidence showed that a significant number of Rodeo Drive retailers sell “prestige” fragrances, and that the public would be likely to make the requisite goods/place association between perfume and Rodeo Drive). *Cf. In re Jacques Bernier Inc.*, 894 F.2d 389, 13 USPQ2d 1725 (Fed. Cir. 1990) (RODEO DRIVE held not primarily geographically deceptively misdescriptive of perfume because of the lack of persuasive evidence of a goods/place association in the *ex parte* record).

A geographic designation for a large city (*e.g.*, Washington, D.C., Boston, San Francisco) may include locations in the metropolitan area.

A wide variety of factors must be considered in determining the origin of a product or service. For example, a product might be found to originate from a place if the main component or ingredient is made in that place.

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

Goods and services do not always originate in the applicant's place of business. See *In re John Harvey & Sons Ltd.*, 32 USPQ2d 1451, 1455 (TTAB 1994) (HARVEYS BRISTOL CREAM not primarily geographically descriptive of cakes flavored with sherry wine, the Board finding that neither applicant's sherry wines nor applicant's cakes come from Bristol, England, where "the only connection appears to be that applicant's headquarters are located there and that applicant's sherry wine was bottled there at one time"); *In re Nantucket Allserve Inc.*, 28 USPQ2d 1144 (TTAB 1993) (NANTUCKET NECTARS held primarily geographically descriptive of soft drinks, even though the goods were manufactured elsewhere, where the record showed that applicant's headquarters and research and development division were on Nantucket; the distributor of the goods was located on Nantucket; the goods were sold in the applicant's store on Nantucket; and the specimens were labels that bore a picture of Nantucket, stated that the goods were "born" or "created" on Nantucket and mentioned no other geographic location); *In re Chalk's International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991) (PARADISE ISLAND AIRLINES held primarily geographically descriptive of the transportation of passengers and goods by air, because the applicant's services included flights to and from Paradise Island, Bahamas, even though the flights were not based there); *In re Fortune Star Products Corp.*, 217 USPQ 277 (TTAB 1982) (NIPPON held not deceptive of, *inter alia*, radios and televisions because, although the applicant is an American corporation, the goods are made in Japan).

When the goods or services may be said to originate both in the geographic place named in the mark and outside that place, registration will normally be refused on the ground that the mark is primarily geographically descriptive under §2(e)(2) of the Trademark Act. *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1706 n.2 (TTAB 1988) (CALIFORNIA PIZZA KITCHEN for restaurant services held primarily geographically descriptive, where the services were rendered both in California and elsewhere).

### **1210.04 Goods/Place or Services/Place Association**

Refusal of registration under §2(e)(2), §2(e)(3), or §2(a) requires that there be a goods/place or services/place association such that the public is likely to believe that the goods or services originate in the place identified in the mark.

To show that there is a goods/place or services/place association, the examining attorney may provide such evidence as excerpts from telephone directories, gazetteers, encyclopedias, geographic dictionaries, the LEXIS-NEXIS® database, or the results of an Internet search.

The examining attorney should also examine the specimen(s) and any other evidence in the record that shows the context in which the applicant's mark is used. See *In re Broyhill Furniture Industries, Inc.*, 60 USPQ2d 1511, 1517 (TTAB 2001), where the Board noted that applicant's point of purchase

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

display catalogs “foster a goods/place association between its furniture and Tuscany by referring to ‘Europe’s Mediterranean coast’ and ‘European sensibility;’” and *In re Nantucket Allserve Inc.*, 28 USPQ2d 1144 (TTAB 1993), where the Board noted that the applicant’s product labels bore a picture of Nantucket, stated that the goods were “born” or “created” on Nantucket and “[embody] the wholesome quality of the Island whose name they bear,” and mentioned no other geographic location).

When the geographic significance of a term is its primary significance and the geographic place is neither obscure nor remote, for purposes of §2(e)(2) the goods/place or services/place association may ordinarily be presumed from the fact that the applicant’s goods or services originate in the place named in the mark. *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001) (MINNESOTA CIGAR COMPANY primarily geographically descriptive of cigars); *In re U.S. Cargo, Inc.*, 49 USPQ2d 1702 (TTAB 1998) (U.S. CARGO primarily geographically descriptive of towable trailers carrying cargo and vehicles); *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998) (CAROLINA APPAREL primarily geographically descriptive of retail clothing store services); *In re Chalk’s International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991) (PARADISE ISLAND AIRLINES held primarily geographically descriptive of the transportation of passengers and goods by air); *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988) (CALIFORNIA PIZZA KITCHEN held primarily geographically descriptive of restaurant services that originate in California); *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848, 849-50 (TTAB 1982) (DENVER WESTERNS held primarily geographically descriptive of western-style shirts originating in Denver). This presumption is rebuttable. See TMEP §1210.04(c) regarding obscure or remote places, and TMEP §§1210.02 *et seq.* regarding the primary significance of a geographic term.

It is more difficult to establish a services/place association than a goods/place association when making a refusal under §2(e)(3) and §2(a). *In re Les Halles De Paris J.V.*, 334 F.3d 1371, 67 USPQ2d 1539 (Fed. Cir. 2003). See TMEP §1210.04(a) regarding establishment of a goods/place association, and TMEP §1210.04(b) regarding establishment of a services/place association.

### **1210.04(a) Establishing Goods/Place Association**

To establish a goods/place association, it is not necessary to show that the place identified in the mark is well known or noted for the goods. *In re Les Halles De Paris J.V.*, 334 F.3d 1371, 1374, 67 USPQ2d 1539, 1541 (Fed. Cir. 2003) (“[T]he goods-place association often requires little more than a showing that the consumer identifies the place as a known source of the product.”). See *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001) (THE VENICE COLLECTION and design held primarily geographically deceptively misdescriptive of products that do not originate in Venice, Italy, where an atlas and a gazetteer showed that Venice was a large

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

metropolitan area where fine art objects, glassware and decorative items had been made and sold for centuries, and a popular tourist destination); *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (NEW YORK WAYS GALLERY held primarily geographically deceptively misdescriptive where manufacturing listings and Nexis® excerpts showed that handbags and luggage are designed and manufactured in New York); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (evidence from a gazeteer and dictionary showing that tobacco is a crop produced and marketed in Durango, Mexico held sufficient to establish a *prima facie* goods/place association); *In re Broyhill Furniture Industries, Inc.*, 60 USPQ2d 1511 (TTAB 2001) (evidence that Tuscany, Italy is an important industrial center that produces a variety of products including furniture, and that several businesses advertise the sale of furniture from Tuscany on the Internet, held sufficient to establish a goods/place association between Tuscany and furniture, even though Tuscany is not famous for its furniture); *In re Boyd Gaming Corp.*, 57 USPQ2d 1944 (TTAB 2000) (HAVANA RESORT & CASINO and ROYAL HAVANA RESORT & CASINO held primarily geographically deceptively misdescriptive of wearing apparel, beauty products and perfume that do not come from Havana, Cuba, where the record showed that Havana produces a variety of goods, including clothing and cosmetic items); *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031 (TTAB 1997) (HAVANA SELECT, HAVANA CLASICO, OLD HAVANA, HAVANA PRIMO, and HAVANA CLIPPER all held primarily geographically deceptively misdescriptive of rum that does not originate in Havana, Cuba, where the evidence showed that Havana is a major city and rum is a significant product).

In *Save Venice*, the court noted that in the modern marketing context, geographic regions that are noted for certain products or services are likely to expand from their traditional goods or services into related goods or services, and that this would be expected by consumers. Accordingly, the court held that "the registrability of a geographic mark may be measured against the public's association of that region with both its traditional goods and any related goods or services that the public is likely to believe originate there." 259 F.3d at 1355, 59 USPQ2d at 1784.

However, a showing that the geographic place is known to the public and could be the source of the goods or services may not be enough in itself to establish a goods/place or services/place association in all cases. See *In re John Harvey & Sons Ltd.*, 32 USPQ2d 1451 (TTAB 1994) (HARVEYS BRISTOL CREAM not primarily geographically descriptive of cakes flavored with sherry wine, the Board finding evidence that applicant's headquarters are located in Bristol, England and that applicant's sherry wine was once bottled there insufficient to show that American consumers are likely to think that Bristol refers to a place from which the goods originate); *In re Gale Hayman Inc.*, 15 USPQ2d 1478 (TTAB 1990) (SUNSET BOULEVARD held not primarily geographically descriptive of perfume and cologne, the Board

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

holding that the mere fact that applicant's principal offices are in Century City, close to Sunset Boulevard, does not mandate a finding that a goods/place association should be presumed, determining that the public would not make a goods/place association, and noting that there was no evidence that any perfume or cologne is manufactured or produced on Sunset Boulevard or that applicant's goods are sold there); *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487 (TTAB 1990) (PARK AVENUE held neither deceptive nor geographically deceptively misdescriptive as applied to cigarettes and smoking tobacco, the Board finding no goods/place association between tobacco products and Park Avenue in New York City, on which opposer's world headquarters was located); *In re Venice Maid Co., Inc.*, 222 USPQ 618, 619 (TTAB 1984) (VENICE MAID held *not* primarily geographically deceptively misdescriptive of canned foods, including, *inter alia*, lasagna and spaghetti, where the evidence of a goods/place association was found insufficient, the Board stating that "we are unwilling to sustain the refusal to register in this case simply on the basis that Venice is a large Italian city that could, conceivably, be the source of a wide range of goods, including canned foods").

The question of whether there is a goods/place association is determined on a case-by-case basis, based on the evidence in the record. *Compare Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc.*, 38 USPQ2d 1691 (TTAB 1996) (RODEO DRIVE held primarily geographically deceptively misdescriptive of perfume, where opposer's evidence showed that a significant number of Rodeo Drive retailers sell "prestige" fragrances, and that the public would be likely to make the requisite goods/place association between perfume and Rodeo Drive) *with In re Jacques Bernier Inc.*, 894 F.2d 389, 13 USPQ2d 1725 (Fed. Cir. 1990) (RODEO DRIVE held *not* primarily geographically deceptively misdescriptive of perfume because of the lack of persuasive evidence of a goods/place association in the *ex parte* record).

### **1210.04(b) Establishing Services/Place Association**

It is more difficult, with respect to refusals under §2(e)(3) and §2(a), to establish a services/place association than a goods/place association. The Court of Appeals for the Federal Circuit has provided the following guidance for refusals under §2(e)(3):

Application of the second prong of this test - the services-place association - requires some consideration. A customer typically receives services, particularly in the restaurant business, at the location of the business. Having chosen to come to that place for the services, the customer is well aware of the geographic location of the service. This choice necessarily implies that the customer is less likely to associate the services with the geographic location invoked by the mark rather than the geographic location of the service, such as a restaurant. In this

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

case, the customer is less likely to identify the services with a region of Paris when sitting in a restaurant in New York.

[T]he services-place association operates somewhat differently than a goods-place association.... In a case involving goods, the goods-place association often requires little more than a showing that the consumer identifies the place as a known source of the product [citations omitted]. Thus, to make a goods-place association, the case law permits an inference that the consumer associates the product with the geographic location in the mark because that place is known for producing the product.... In the case of a services-place association, however, a mere showing that the geographic location in the mark is known for performing the service is not sufficient. Rather the second prong of the test requires some additional reason for the consumer to associate the services with the geographic location invoked by the mark. See *In re Municipal Capital Markets, Corp.*, 51 USPQ2d 1369, 1370-71 (TTAB 1999) (“Examining Attorney must present evidence that does something more than merely establish that services as ubiquitous as restaurant services are offered in the pertinent geographic location.”). Thus, a services-place association in a case dealing with restaurant services ... requires a showing that the patrons of the restaurant are likely to believe the restaurant services have their origin in the location indicated by the mark. In other words, to refuse registration under section 2(e)(3), the PTO must show that patrons will likely be misled to make some meaningful connection between the restaurant (the service) and the relevant place.

For example, the PTO might find a services-place association if the record shows that patrons, though sitting in New York, would believe the food served by the restaurant was imported from Paris, or that the chefs in New York received specialized training in the region in Paris, or that the New York menu is identical to a known Parisian menu, or some other heightened association between the services and the relevant place....

*In re Les Halles De Paris J.V.*, 334 F.3d 1371, 1373-74, 67 USPQ2d 1539, 1541-42 (Fed. Cir. 2003) (LE MARAIS held not primarily geographically deceptively misdescriptive of restaurant services. Evidence that “Le Marais” was a fashionable Jewish area in Paris was insufficient to establish that the public would believe that “Le Marais” was the source of New York restaurant services featuring a kosher cuisine).

What constitutes a “heightened association” between the services and the place will vary depending on the nature of the services. There may be situations where the fact that the geographic location is known or famous for

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

performing the service would be sufficient to establish a services/place association (e.g., “Texas” for cattle breeding services).

The burden is greater for restaurant services, due to their ubiquitous nature. In *In re Consolidated Specialty Restaurants, Inc.*, 71 USPQ2d 1921 (TTAB 2004) (COLORADO STEAKHOUSE and design held primarily geographically deceptively misdescriptive of restaurant services), the Board found that the examining attorney had established an “additional reason” why purchasers would mistakenly believe that the food served in the restaurant was from Colorado, where the record contained the following evidence: gazetteer and dictionary definitions of “Colorado” and “steakhouse;” a United States Department of Agriculture report on cattle inventory; stories excerpted from the LEXIS-NEXIS® database; and Internet excerpts showing that Colorado was one of the 11 top cattle states in the United States, that Colorado was known for its steaks, that “Colorado steaks” are featured food items in restaurants outside the state, and that politicians from Colorado use “Colorado steaks” as the basis for wagers on sporting events.

### **1210.04(c)      Obscure or Remote Geographic Marks**

Geographic matter may be so obscure or remote that it would not be recognized as an indication of the geographic source of the goods or services. In such a case, the mark is treated as an arbitrary designation because its geographic meaning is likely to be lost on consumers. Thus consumers will not perceive the geographic significance of the term as its primary significance and will not make a goods/place or services/place association. See *ConAgra Inc. v. Saavedra*, 4 USPQ2d 1245 (TTAB 1987) (TAPATIO held not primarily geographically deceptively misdescriptive of meatless hot sauce, despite the fact that the mark is a Spanish term meaning “of or pertaining to Guadalajara, Mexico” and the goods did not originate from Guadalajara, the Board finding that the significance of the term is lost on the public because of its obscurity); *In re Bavaria St. Pauli Brauerei AG*, 222 USPQ 926 (TTAB 1984) (reversing examining attorney’s requirement for disclaimer of “JEVER” in application to register JEVER and design for beer originating in Jever, West Germany, where the sole evidence of a goods/place association was an entry from a 32-year-old geographic index); *In re Brauerei Aying Franz Inselkammer KG*, 217 USPQ 73 (TTAB 1983) (AYINGER BIER (“BIER” disclaimed) held not primarily geographically descriptive of beer emanating from Aying, West Germany, a hamlet of 500 inhabitants, where the examining attorney’s only evidence of a goods/place association was the specimen label identifying Aying as the place of origin).

Remoteness or obscurity is determined from the perspective of the average American consumer. See *In re Societe Generale des Eaux Minerales de Vittel, S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987) (VITTEL and design held not primarily geographically descriptive of cosmetic products because of lack of goods/place association between the goods and the



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

applicant's place of business in Vittel, France). However, the examining attorney does not necessarily have to show that the nationwide general public would associate the mark with the place. The significance of the term is determined not in the abstract, but from the point of view of the consumers of the particular goods or services identified in the application. *In re MCO Properties Inc.*, 38 USPQ2d 1154 (TTAB 1995) (FOUNTAIN HILLS held primarily geographically descriptive of real estate development services rendered in Fountain Hills, Arizona, where the record showed that Fountain Hills was the name of the town where the applicant was located and rendered its services, and that the purchasers who came in contact with the mark would associate that place with the services).

### **1210.04(d) Arbitrary Use of Geographic Terms**

The name of a geographic location that has no significant relation to commercial activities or the production of the relevant goods or services, such as ALASKA for bananas, is treated as an arbitrary mark because it is unlikely that consumers would believe that the mark identifies the place from which the goods originate.

Often names of mountains or rivers are arbitrary for goods because no commercial activity is performed there. For example, "Colorado River" for candy bars or "Mount Rushmore" for automobiles would be arbitrary. See *In re Nantucket, Inc.*, 677 F.2d 95, 105, 213 USPQ 889, 897 (C.C.P.A. 1982) (Nies, J., concurring) ("Thus, the names of places devoid of commercial activity are arbitrary usage. In this category are names of places such as ANTARCTICA, MOUNT EVEREST, or GALAPAGOS, at least when used for ordinary commercial products, such as beer and shoes. Names such as SUN, WORLD, GLOBE, MARS, or MILKY WAY are also arbitrary, not informational; competitors do not need to use the terms to compete effectively.").

### **1210.05 Geographically Deceptive Marks**

#### **1210.05(a) Basis for Refusal**

*Past Practice.* Prior to the amendment of the Trademark Act by the NAFTA Implementation Act, the test for determining whether a mark was primarily geographically deceptively misdescriptive under §2(e)(3) of the Trademark Act differed from the test for determining whether a mark was deceptive under §2(a) of the Act, 15 U.S.C. §1052(a). To establish that a mark was primarily geographically deceptively misdescriptive under §2(e)(3), the examining attorney had to show that the primary significance of the mark was geographic, that purchasers would be likely to believe that the goods or services originated in the place named in the mark, and that the goods or services did not originate in that place. *In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889 (C.C.P.A. 1982). An additional showing of "materiality" was

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

required to establish that a mark was deceptive under §2(a), *i.e.*, a showing that a goods/place or services/place association made by purchasers was “material” to the decision to purchase the goods or services. *Bureau National Interprofessionnel Du Cognac v. International Better Drinks Corp.*, 6 USPQ2d 1610 (TTAB 1988); *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984).

*Current Practice.* The Court of Appeals for the Federal Circuit has held that with the NAFTA amendments, §2 of the Act “no longer treats geographically deceptively misdescriptive marks differently from geographically deceptive marks,” and that a showing of public deception is required to establish that a mark is unregistrable under §2(e)(3). *In re California Innovations Inc.*, 329 F.3d 1334, 1339, 66 USPQ2d 1853, 1856 (Fed. Cir. 2003), *reh’g denied*, 2003 U.S. App. LEXIS 18883 (Fed. Cir. Aug. 20, 2003). Thus, the test for determining whether, post-NAFTA, a mark is primarily geographically deceptively misdescriptive under §2(e)(3) is now the same as the test for determining whether a mark is deceptive under §2(a). *Id.*, 329 F.3d at 1340, 66 USPQ2d at 1857.

Although the test for determining whether a mark is primarily geographically deceptively misdescriptive under §2(e)(3) is now the same as the test for determining whether a mark is deceptive under §2(a), the statutory provisions with respect to registrability on the Supplemental Register and on the Principal Register under §2(f) are different:

- Under §23(a) of the Trademark Act, a mark that is primarily geographically deceptively misdescriptive may be registered on the Supplemental Register if the mark has been in lawful use in commerce since before December 8, 1993 (the date of enactment of the NAFTA Implementation Act), while a mark that is deceptive may not be registered on the Supplemental Register; and
- Under §2(f) of the Trademark Act, a mark that is primarily geographically deceptively misdescriptive may be registered if the mark became distinctive of the goods or services in commerce before December 8, 1993, while a mark that is deceptive may not be registered on the Principal Register even upon a showing of acquired distinctiveness.

Accordingly, because the statute expressly prohibits registration of deceptive marks on the Supplemental Register or on the Principal Register under §2(f), the examining attorney will initially refuse registration of geographically deceptive marks under both §§2(a) and 2(e)(3). If the applicant alleges use in commerce prior to December 8, 1993 and amends to the Supplemental Register, or establishes that the proposed mark acquired distinctiveness under §2(f) before December 8, 1993, the examining attorney will withdraw the §2(e)(3) refusal, but will not withdraw the §2(a) refusal.

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### **1210.05(b) Materiality of Deception**

To establish that a geographic term is primarily geographically deceptively misdescriptive under 15 U.S.C. §1052(e)(3) or deceptive under §2(a), it must be shown that the goods/place or services/place association made by a consumer is material to the consumer's decision to purchase those goods/services. *In re California Innovations Inc.*, 329 F.3d 1334, 1340, 66 USPQ2d 1853, 1856 (Fed. Cir. 2003), *reh'g denied*, 2003 U.S. App. LEXIS 18883 (Fed. Cir. Aug. 20, 2003). See TMEP §§1210.01(b) and 1210.01(c).

### **1210.05(b)(i) Materiality of Deception In Cases Involving Goods**

In a case involving goods, if there is evidence that the relevant goods, or related goods, are a principal product of the geographical area named by the mark, then the deception will most likely be found to be material. *In re California Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003), *reh'g denied*, 2003 U.S. App. LEXIS 18883 (Fed. Cir. Aug. 20, 2003); *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001) (THE VENICE COLLECTION and design held primarily geographically deceptively misdescriptive of products that do not originate in Venice, Italy, where an atlas and a gazetteer showed that Venice was a well known center for the manufacture of glass, lace, art objects, jewelry, cotton and silk textiles); *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (NEW YORK WAYS GALLERY held primarily geographically deceptively misdescriptive where manufacturing listings and Nexis® excerpts showed that New York was well known as a place where leather goods and handbags are designed and manufactured); *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992) (LONDON LONDON held deceptive for clothing having no connection with London, given the renown of London as a center for contemporary as well as traditional fashions); *In re Perry Mfg. Co.*, 12 USPQ2d 1751 (TTAB 1989) (PERRY NEW YORK and design ("NEW YORK" disclaimed) held deceptive for various items of clothing that originate in North Carolina, and have no connection with New York, because of the renown of New York in the apparel industry); *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984) (BAHIA held deceptive of cigars that do not originate in the Bahia province of Brazil, where the evidence of record was "unequivocal" that tobacco and cigars are important products in the Bahia region).

### **1210.05(b)(ii) Materiality of Deception In Cases Involving Services**

In a case involving services, a showing that the geographic location in the mark is known for performing the service is not sufficient, unless it rises to the level of fame. The Court of Appeals for the Federal Circuit has provided the following guidance:

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

To raise an inference of deception or materiality for a service mark, the examining attorney must show some heightened association between the services and the relevant geographic denotation.... For restaurant services, the materiality prong might be satisfied by a particularly convincing showing that identifies the relevant place as famous for providing the specialized culinary training exhibited by the chef, and that this fact is advertised as a reason to choose this restaurant. In other words, an inference of materiality arises in the event of a very strong services-place association. Without a particularly strong services-place association, an inference would not arise, leaving the PTO to seek direct evidence of materiality. In any event, the record might show that customers would patronize the restaurant because they believed the food was imported from, or the chef was trained in, the place identified by the restaurant's mark. The importation of food and culinary training are only examples, not exclusive methods of analysis....

*In re Les Halles De Paris J.V.*, 334 F.3d 1371, 1374-75, 67 USPQ2d 1539, 1542 (Fed. Cir. 2003).

In *In re Consolidated Specialty Restaurants, Inc.*, 71 USPQ2d 1921 (TTAB 2004) (COLORADO STEAKHOUSE and design held primarily geographically deceptively misdescriptive of restaurant services), the Board found that a mistaken belief that the steaks served in applicant's restaurant were from Colorado would be material to the customer's decision to patronize the restaurant, where the record contained the following evidence: gazetteer and dictionary definitions of "Colorado" and "steakhouse;" a United States Department of Agriculture report on cattle inventory; stories excerpted from the LEXIS-NEXIS® database; and Internet excerpts showing that Colorado was one of the 11 top cattle states in the United States, that Colorado was known for its steaks, that "Colorado steaks" are featured food items in restaurants outside the state, and that politicians from Colorado use "Colorado steaks" as the basis for wagers on sporting events. The Board stated that "an inference of materiality arises where there is a showing of a 'heightened association' between the services and the geographic place or, in other words, a showing of 'a very strong services-place association.'" 71 USPQ2d at 1928.

See also TMEP §§1203.02 *et seq.* regarding deceptive marks, and TMEP §1210.08 regarding geographical designations used on or in connection with wines or spirits that identify a place other than the origin of the goods.

### **1210.06 Procedure for Examining Geographic Composite Marks**

A geographic composite mark is one composed of geographic matter coupled with additional matter (*e.g.*, wording and/or a design element). When

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

examining such a mark, the examining attorney must first determine the primary significance of the composite. See TMEP §§1210.02(c) *et seq.*

Depending on the primary significance of the composite, the examining attorney will handle the geographic issue in a geographic composite mark in one of the following ways:

- (1) If the examining attorney finds that the mark, when viewed as a whole, is arbitrary, fanciful or suggestive, he or she will approve the mark for publication without evidence that the mark has acquired distinctiveness under §2(f);
- (2) If the examining attorney finds that the mark is primarily geographically descriptive under §2(e)(2) without a showing of acquired distinctiveness, primarily geographically deceptively misdescriptive under §2(e)(3), or deceptive under §2(a), he or she will refuse registration of the mark as a whole; or
- (3) If the examining attorney finds that the geographic matter is a separable part of the mark, the examining attorney's action will depend on whether the matter is primarily geographically descriptive, primarily geographically deceptively misdescriptive, or deceptive. See TMEP §1210.06(a) regarding primarily geographically descriptive composites, TMEP §1210.06(b) regarding primarily geographically deceptively misdescriptive and deceptive composites.

### **1210.06(a) Marks That Include Primarily Geographically Descriptive Terms Combined With Additional Matter**

If a composite mark comprises a geographic term that is primarily geographically descriptive of the goods or services under §2(e)(2), and the mark as a whole would be likely to be perceived as indicating the geographic origin of the goods or services, then the examining attorney must consider:

- (1) whether the geographic term is a separable element in the mark, and
- (2) the nature of the additional matter that makes up the composite mark.

If the geographic term is not a separable element or if none of the additional matter that makes up the composite mark is inherently distinctive (*e.g.*, it is merely descriptive or incapable), then the examining attorney should refuse registration of the entire mark on the Principal Register pursuant to §2(e)(2).

If the geographic term is a separable element and the additional matter making up the mark is inherently distinctive as applied to the goods or services (*i.e.*, coined, arbitrary, fanciful or suggestive), the applicant may either: (1) register the mark on the Principal Register with a disclaimer of the geographic term, or (2) establish that the geographic term has acquired distinctiveness under §2(f).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

A disclaimer is appropriate where the geographic component is a separable feature of the mark, and the composite mark includes an inherently distinctive, non-disclaimed component (*e.g.*, coined, arbitrary, fanciful or suggestive wording or design). The composite mark must include a nondisclaimed component because a mark cannot be registered if all the components have been disclaimed. See TMEP §§1213 *et seq.* regarding disclaimer.

When the examining attorney requires a disclaimer of primarily geographically descriptive matter, the applicant may seek to overcome the disclaimer requirement by submitting a showing that the geographic term has become distinctive under §2(f). See TMEP §§1210.07(b) and 1212.02(f) regarding §2(f) claims as to a portion of the mark.

A term that is primarily geographically descriptive of the goods or services under §2(e)(2) may be registered on the Supplemental Register, if it is not barred by other section(s) of the Act. See TMEP §1210.07(a).

### **1210.06(b)      Marks That Include Primarily Geographically Deceptively Misdescriptive and Deceptive Terms Combined With Additional Matter**

If a composite mark includes matter that is primarily geographically deceptively misdescriptive within the meaning of §2(e)(3) or deceptive under §2(a), and the mark as a whole would be likely to be perceived as indicating the geographic origin of the goods or services, then the examining attorney should refuse registration of the mark as a whole under both §2(e)(3) and §2(a). See TMEP §1210.05(a).

A composite mark that is deceptive under §2(a) cannot be registered, even with a disclaimer of the geographic component. *In re Perry Mfg. Co.*, 12 USPQ2d 1751, 1751-52 (TTAB 1989).

A disclaimer of the geographic matter will not overcome a §2(e)(3) refusal, even if the mark was in use prior to December 8, 1993. *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001); *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999).

See TMEP §1210.05(a) regarding the basis for refusal of marks that are primarily geographically deceptively misdescriptive.

### **1210.07            Supplemental Register and Section 2(f)**

#### **1210.07(a)        Registrability of Geographic Terms on the Supplemental Register**

*Primarily Geographically Descriptive Marks.* A term that is primarily geographically descriptive of the goods or services under §2(e)(2) may be

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

registered on the Supplemental Register, if it is not barred by other section(s) of the Act.

*Primarily Geographically Deceptively Misdescriptive Marks.* A mark that is found to be primarily geographically deceptively misdescriptive under §2(e)(3) may not be registered on the Supplemental Register unless the mark has been in lawful use in commerce since before December 8, 1993, the date of enactment of the NAFTA Implementation Act. Section 23(a) of the Trademark Act; 15 U.S.C. §1091(a).

*Geographically Deceptive Marks.* A mark that is deceptive under §2(a) may not be registered on the Supplemental Register. *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992).

### **1210.07(b) Registrability of Geographic Terms Under Section 2(f)**

*Primarily Geographically Descriptive Marks.* A term that is primarily geographically descriptive of the goods or services under §2(e)(2) may be registered on the Principal Register if it is shown to have acquired distinctiveness under §2(f). See TMEP §§1212 *et seq.* regarding §2(f).

*Primarily Geographically Deceptively Misdescriptive Marks.* A mark that is primarily geographically deceptively misdescriptive under §2(e)(3) may not be registered under §2(f) unless the mark became distinctive of the goods or services in commerce before December 8, 1993, the date of enactment of the NAFTA Implementation Act. See *In re Boyd Gaming Corp.*, 57 USPQ2d 1944 (TTAB 2000); *Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc.*, 38 USPQ2d 1691 (TTAB 1996).

*Geographically Deceptive Marks.* A mark that is deceptive under §2(a) may not be registered on the Principal Register even under §2(f).

*Section 2(f) in Part.* An applicant may claim that a geographic component of a mark has acquired distinctiveness under §2(f). See TMEP §1212.02(f) regarding claims of acquired distinctiveness as to a portion of a mark. Thus, if the examining attorney requires a disclaimer of matter that is primarily geographically descriptive under §2(e)(2), the applicant may seek to overcome the disclaimer requirement by submitting a showing that the geographic component has acquired distinctiveness under §2(f). If the applicant is able to establish to the satisfaction of the examining attorney that the geographic component has acquired distinctiveness, the examining attorney will approve the mark for publication with a notation that there is a claim of distinctiveness under §2(f) as to the geographic component, if appropriate.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1210.08 Wines and Spirits

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), prohibits the registration of a designation that consists of or comprises “a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after [January 1, 1996].” This provision was added by the Uruguay Round Agreements Act, implementing the Trade Related Intellectual Property (“TRIPs”) portions of the General Agreement on Tariffs and Trade (“GATT”). It applies only to geographic indications that were first used in commerce on or after January 1, 1996, one year after the effective date of the legislation implementing GATT. This provision does not apply to designations used on or in connection with beer.

The examining attorney must refuse registration under §2(a) of any geographical designation that was first used in commerce on or in connection with wines or spirits on or after January 1, 1996, if it identifies a place other than the origin of the goods.

Section 2(a) is an absolute bar to the registration of these geographical designations on either the Principal Register or the Supplemental Register. Neither a disclaimer of the geographical designation nor a claim that it has acquired distinctiveness under §2(f) can obviate a §2(a) refusal if the mark consists of or comprises a geographical indication that identifies a place other than the origin of the wines or spirits.

### 1210.09 Geographic Certification Marks

Under certain circumstances the name of the place from which goods or services originate may function as a certification mark. When geographic terms are used to certify regional origin (e.g. “Idaho” used to certify that potatoes are grown in Idaho), registration of certification marks should not be refused and, in applications to register composite certification marks, disclaimers of these geographic terms should *not* be required on the ground of geographical descriptiveness. See TMEP §§1306.02 *et seq.* concerning procedures for registration of certification marks that certify regional origin.

When a geographical term used in a composite certification mark is not used to certify regional origin (e.g., “California” used to certify that fruit is organically grown), appropriate refusals pursuant to §§2(e)(2), 2(e)(3) or 2(a) should be made.

### 1211 Refusal on Basis of Surname

*Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (e)*



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

*Consists of a mark which ... (4) is primarily merely a surname.*

Under §2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4), a mark that is primarily merely a surname is not registrable on the Principal Register absent a showing of acquired distinctiveness under §2(f), 15 U.S.C. §1052(f). See TMEP §§1212 *et seq.* regarding acquired distinctiveness. Formerly §2(e)(3) of the Act, this section was designated §2(e)(4) when the NAFTA Implementation Act took effect on January 1, 1994. A mark that is primarily merely a surname may be registrable on the Supplemental Register.

The Trademark Act, in §2(e)(4), reflects the common law that exclusive rights in a surname *per se* cannot be established without evidence of long and exclusive use that changes its significance to the public from that of a surname to that of a mark for particular goods or services. The common law also recognizes that surnames are shared by more than one individual, each of whom may have an interest in using his surname in business; and, by the requirement for evidence of distinctiveness, the law, in effect, delays appropriation of exclusive rights in the name. *In re Etablissements Darty et Fils*, 759 F.2d 15, 17, 225 USPQ 652, 653 (Fed. Cir. 1985).

The question of whether a mark is primarily merely a surname depends on the mark's *primary* significance to the purchasing public. See, e.g., *Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Comm'r Pats. 1955). Each case must be decided on its own facts, based upon the evidence in the record.

### 1211.01 “Primarily Merely a Surname”

The legislative history of the Trademark Act of 1946 indicates that the word “primarily” was added to the existing statutory language “merely” with the intent to exclude registration of names such as “Johnson” or “Jones,” but not registration of names such as “Cotton” or “King” which, while surnames, have a primary significance other than as a surname. See *Sears, Roebuck & Co. v. Watson*, 204 F.2d 32, 33-34, 96 USPQ 360, 362 (D.C. Cir. 1953), *cert. denied*, 346 U.S. 829, 99 USPQ 491 (1953); *Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Comm'r Pats. 1955).

The question of whether a term is primarily merely a surname depends on the primary, not the secondary, significance to the purchasing public. The Trademark Trial and Appeal Board has identified five factors to be considered in making this determination:

- (1) whether the surname is rare (see TMEP §1211.01(a)(v));
- (2) whether the term is the surname of anyone connected with the applicant (see TMEP §1211.02(b)(iii));

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- (3) whether the term has any recognized meaning other than as a surname (see TMEP §§1211.01(a) *et seq.*);
- (4) whether it has the “look and feel” of a surname (see TMEP §1211.01(a)(vi)); and
- (5) whether the stylization of lettering is distinctive enough to create a separate commercial impression (see TMEP §1211.01(b)(ii).

*In re Benthin Management GmbH*, 37 USPQ2d 1332, 1333-1334 (TTAB 1995).

### **1211.01(a) Non-Surname Significance**

Often a word will have a meaning or significance in addition to its significance as a surname. The examining attorney must determine the primary meaning of the term to the public. See TMEP §§1211.01(a)(i) *et seq.* regarding considerations that often arise in determining whether a term is primarily merely a surname.

#### **1211.01(a)(i) Ordinary Language Meaning**

If there is a readily recognized meaning of a term, apart from its surname significance, such that the primary significance of the term is not that of a surname, registration should be granted on the Principal Register without evidence of acquired distinctiveness. See *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000) (the relatively rare surname HACKLER held not primarily merely a surname, in light of dictionary meaning); *Fisher Radio Corp. v. Bird Electronic Corp.*, 162 USPQ 265 (TTAB 1969) (BIRD held not primarily merely a surname despite surname significance); *In re Hunt Electronics Co.*, 155 USPQ 606 (TTAB 1967) (HUNT held not primarily merely a surname despite surname significance). However, this does not mean that an applicant only has to uncover a non-surname meaning of the proposed mark to obviate a refusal under §2(e)(4). See *In re Nelson Souto Major Piquet*, 5 USPQ2d 1367, 1368 (TTAB 1987) (N. PIQUET (stylized) held primarily merely a surname despite significance of the term “piquet” as “the name of a relatively obscure card game”).

#### **1211.01(a)(ii) Phonetic Equivalent of Term With Ordinary Language Meaning**

A term may be primarily merely a surname even if it is the phonetic equivalent of a word that has an ordinary meaning (e.g., Byrne/burn; Knott/not or knot; Chappell/chapel). See *In re Pickett Hotel Co.*, 229 USPQ 760 (TTAB 1986) (PICKETT SUITE HOTEL held primarily merely a surname despite applicant’s argument that PICKETT is the phonetic equivalent of the word “picket”). Cf. *In re Monotype Corp. PLC*, 14 USPQ2d 1070, 1071 (TTAB 1989) (CALISTO

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

held not primarily merely a surname, the Board characterizing the telephone directory evidence of surname significance as “minimal” and in noting the mythological significance of the name “Callisto,” stating that it is common knowledge that there are variations in the rendering of mythological names transliterated from the Greek alphabet (distinguishing *In re Pickett Hotel Co.*, *supra*). Similarly, the fact that a word that has surname significance is also a hybrid or derivative of another word having ordinary language meaning is insufficient to overcome the surname significance unless the perception of non-surname significance would displace the primary surname import of the word. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985) (DARTY held primarily merely a surname despite applicant’s argument that the mark is a play on the word “dart”); *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986) (PETRIN held primarily merely a surname despite applicant’s argument that the mark represents an abbreviation of “petroleum” and “insulation”).

### **1211.01(a)(iii) Geographical Significance**

A term with surname significance may not be primarily merely a surname if that term also has a well-known geographical meaning. *In re Colt Industries Operating Corp.*, 195 USPQ 75 (TTAB 1977) (FAIRBANKS held not primarily merely a surname because the geographical significance of the mark was determined to be just as dominant as its surname significance). However, the fact that a term is shown to have some minor significance as a geographical term will not dissipate its primary significance as a surname. *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939, 1943 (TTAB 1993) (HAMILTON held primarily merely a surname).

### **1211.01(a)(iv) Historical Place or Person**

A term with surname significance may not be primarily merely a surname if that term also identifies a historical place or person. See *Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 314 F. Supp. 329, 165 USPQ 459 (S.D.N.Y. 1970) (DA VINCI found not primarily merely a surname because it primarily connotes Leonardo Da Vinci); *In re Pyro-Spectaculars, Inc.*, 63 USPQ2d 2022, 2024 (TTAB 2002) (SOUSA for fireworks and production of events and shows featuring pyrotechnics held not primarily merely a surname, where the evidence showed present day recognition and continuing fame of John Philip Sousa as a composer of patriotic music, and the applicant’s goods and services were of a nature that “would be associated by potential purchasers with patriotic events such as the Fourth of July, patriotic figures, and patriotic music”); *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132 (TTAB 2000) (primary significance of M. C. ESCHER is that of famous deceased Dutch artist). Cf. *In re Pickett Hotel Co.*, 229 USPQ 760 (TTAB 1986) (PICKETT SUITE HOTEL held primarily merely a surname despite applicant’s evidence that PICKETT was the name of a famous Civil

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

War general); *In re Champion International Corp.*, 229 USPQ 550 (TTAB 1985) (McKINLEY held primarily merely a surname despite being the name of a deceased president).

### 1211.01(a)(v) Rare Surnames

The rarity of a surname is a factor to be considered in determining whether a term is primarily merely a surname. *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995) (the fact that BENTHIN was a rare surname found to be a factor weighing against a finding that the term would be perceived as primarily merely a surname); *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994) (SAVA not primarily merely a surname, where there was evidence that the term had other meaning, no evidence that the term was the surname of anyone connected with applicant, and the term's use as a surname was very rare); *In re Garan Inc.*, 3 USPQ2d 1537 (TTAB 1987) (GARAN held not primarily merely a surname). However, the fact that a surname is rare does not *per se* preclude a finding that a term is primarily merely a surname. Even a rare surname may be held primarily merely a surname if its primary significance to purchasers is that of a surname. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985) (DARTY held primarily merely a surname); *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314 (TTAB 1990) (REBO held primarily merely a surname); *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB 1986) (POSTEN held primarily merely a surname). Regardless of the rarity of the surname, the test is whether the primary significance of the term to the purchasing public is that of a surname.

An issue to be considered in determining how rarely a term is used is the media attention or publicity accorded to public personalities who have the surname. A surname rarely appearing in birth records may nonetheless appear more routinely in news reports, so as to be broadly exposed to the general public. *In re Gregory*, 70 USPQ2d 1792 (TTAB 2004).

### 1211.01(a)(vi) “Look And Feel” of a Surname

There are some names which by their very nature have only a surname significance even though they are rare surnames. See *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988), *aff'd*, 883 F.2d 1026 (Fed. Cir. 1989) (PIRELLI held primarily merely a surname, the Board stating that “certain rare surnames look like surnames and certain rare surnames do not and ... ‘PIRELLI’ falls into the former category....”); *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986) (PETRIN held primarily merely a surname). Conversely, there is a category of surnames that are so rare that they do not even have the appearance of surnames. Where these are involved, even in the absence of non-surname significance, a reasonable application of the test of “primary significance to the purchasing public” could result in a finding that such a surname, when used as a mark, would be perceived as arbitrary or

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

fanciful. *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000) (HACKLER does not have the look and feel of a surname).

### **1211.01(b) Surname Combined with Additional Matter**

Often a mark will be comprised of a word that, standing by itself, would be primarily merely a surname, coupled with additional matter (*e.g.*, letters, words, designs). The question remains whether the mark sought to be registered would be perceived by the public primarily merely as a surname. *In re Hutchinson Technology Inc.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988). See TMEP §§1211.01(b)(i) *et seq.* for additional information about surnames combined with additional matter.

### **1211.01(b)(i) Double Surnames**

A combination of two surnames is not primarily merely a surname, within the meaning of §2(e)(4), unless there is evidence of record showing that the combination would be perceived by the public primarily merely as a surname. See *In re Standard Elektrik Lorenz A.G.*, 371 F.2d 870, 152 USPQ 563 (C.C.P.A. 1967) (SCHAUB-LORENZ held not primarily merely a surname, the Court noting that there was no evidence submitted that the mark sought to be registered was primarily merely a surname; that the only evidence of surname significance related to the individual “SCHAUB” and “LORENZ” portions of the mark; and that the mark must be considered in its entirety rather than dissected).

### **1211.01(b)(ii) Stylization or Design Elements**

A mark comprised of a word that, standing by itself, would be considered primarily merely a surname, but which is coupled with a distinctive stylization or design element, is not considered primarily merely a surname. *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995) (stylized display of term BENTHIN found to be a factor weighing against a finding that the term would be perceived as primarily merely a surname). However, the addition of a nondistinctive design element or stylization to a term that, standing by itself, is primarily merely a surname does not remove the term from that category. The primary significance of the mark, in its entirety, would be merely that of a surname. See *In re Pickett Hotel Co.*, 229 USPQ 760, 763 (TTAB 1986) (PICKETT SUITE HOTEL held primarily merely a surname despite the stylization of the lettering, which was considered “insignificant, in that it is clearly not so distinctive as to create any separate commercial impression in the minds of purchasers of appellant’s services”).

The display of a term in lower-case lettering does not detract from its surname significance. *In re Directional Marketing Corp.*, 204 USPQ 675 (TTAB 1979).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1211.01(b)(iii) Surname Combined with Initials**

The addition of initials to a term that, standing by itself, is primarily merely a surname does not remove the term from that category. In fact, the use of the first name initial followed by a surname has been held to reinforce, rather than diminish, the surname significance of a term. See *In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204, 98 USPQ 265 (C.C.P.A. 1953) (S. SEIDENBERG & CO'S. held primarily merely a surname); *In re Nelson Souto Major Piquet*, 5 USPQ2d 1367 (TTAB 1987) (N. PIQUET held primarily merely a surname); *In re Taverniti, SARL*, 225 USPQ 1263 (TTAB 1985), *recon. denied* 228 USPQ 975 (TTAB 1985) (J. TAVERNITI held primarily merely a surname); *Ex parte Sears, Roebuck & Co.*, 87 USPQ 400 (PO Ex. Ch. 1950) (J.C. HIGGINS held primarily merely a surname).

### **1211.01(b)(iv) Surname Combined with Title**

A title, such as "Mr.," "Mrs.," or "Mlle.," does not diminish the surname significance of a term; rather, it may enhance the surname significance of a term. *In re Revillon*, 154 USPQ 494 (TTAB 1967) (MLLE. REVILLON held primarily merely a surname). Cf. *In re Hilton Hotels Corp.*, 166 USPQ 216 (TTAB 1970) (LADY HILTON held not primarily merely a surname because it suggests a person or lady of nobility).

### **1211.01(b)(v) Surname in Plural or Possessive Form**

The surname significance of a term is not diminished by the fact that the term is presented in its plural or possessive form. See *In re Woolley's Petite Suites*, 18 USPQ2d 1810 (TTAB 1991) (WOOLLEY'S PETITE SUITES for hotel and motel services held primarily merely a surname); *In re McDonald's Corp.*, 230 USPQ 304, 306 (TTAB 1986) (MCDONALD'S held primarily merely a surname based on a showing of surname significance of "McDonald," the Board noting that "it is clear that people use their surnames in possessive and plural forms to identify their businesses or trades"); *In re Luis Caballero, S.A.*, 223 USPQ 355 (TTAB 1984) (BURDONS held primarily merely a surname based in part on telephone listings showing surname significance of "Burdon"); *In re Directional Marketing Corp.*, 204 USPQ 675 (TTAB 1979) (DRUMMONDS held primarily merely a surname based on a showing of surname significance of "Drummond").

### **1211.01(b)(vi) Surname Combined with Wording**

The treatment of marks that include wording in addition to a term that, standing by itself, is primarily merely a surname, depends on the significance of the non-surname wording.

If the wording combined with the surname is incapable of functioning as a mark (*i.e.*, a generic name for the goods or services), the examining attorney

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

should refuse registration on the ground that the entire mark is primarily merely a surname under §2(e)(4). If the policy were otherwise, one could evade §2(e)(4) by the easy expedient of adding the generic name of the goods or services to a word that is primarily merely a surname. *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939 (TTAB 1993) (HAMILTON PHARMACEUTICALS for pharmaceutical products held primarily merely a surname); *In re Cazes*, 21 USPQ2d 1796, 1797 (TTAB 1991) (BRASSERIE LIPP held primarily merely a surname where “brasserie” is a generic term for applicant’s restaurant services”); *In re Woolley’s Petite Suites*, 18 USPQ2d 1810 (TTAB 1991) (WOOLLEY’S PETITE SUITES for hotel and motel services held primarily merely a surname); *In re Possis Medical, Inc.*, 230 USPQ 72, 73 (TTAB 1986) (POSSIS PERFUSION CUP held primarily merely a surname, the Board finding that “[a]pplicant’s argument that PERFUSION CUP is not a generic name for its goods ... is contradicted by the evidence the Examining Attorney has pointed to”); *In re E. Martinoni Co.*, 189 USPQ 589, 590-91 (TTAB 1975) (LIQUORE MARTINONI (stylized) for liqueur held primarily merely a surname, with “liqueure” being the Italian word for “liqueur”).

If the wording combined with the surname is capable of functioning as a mark (*i.e.*, matter that is arbitrary, suggestive or merely descriptive of the goods or services), the mark is not considered to be primarily merely a surname under §2(e)(4). However, if the additional wording is merely descriptive or the equivalent, and a disclaimer is otherwise proper, the examining attorney should require a disclaimer of the additional wording. *See In re Hutchinson Technology Inc.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988) (HUTCHINSON TECHNOLOGY for computer components held not primarily merely a surname when the mark is considered as a whole, the Court remanding the case for entry of a disclaimer of “TECHNOLOGY” before publication).

### **1211.01(b)(vii) Surname Combined With Domain Name**

A surname combined with a top-level domain name (*e.g.*, JOHNSON.COM) is primarily merely a surname under §2(e)(4). *See* TMEP §1215.03.

### **1211.02 Evidence Relating to Surname Refusal**

#### **1211.02(a) Evidentiary Burden - Generally**

The burden is initially on the examining attorney to establish a *prima facie* case that a mark is primarily merely a surname. The burden then shifts to the applicant to rebut this showing. *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986). The evidence submitted by the examining attorney was found insufficient to establish a *prima facie* case in the following decisions: *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421 (C.C.P.A. 1975); *In re BDH Two Inc.*, 26 USPQ2d 1556 (TTAB 1993); *In re Raivico*,

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

9 USPQ2d 2006 (TTAB 1988); *In re Garan Inc.*, 3 USPQ2d 1537 (TTAB 1987).

There is no rule as to the kind or amount of evidence necessary to make out a *prima facie* showing that a term is primarily merely a surname. This question must be resolved on a case-by-case basis. See, e.g., *In re Monotype Corp. PLC*, 14 USPQ2d 1070 (TTAB 1989); *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB 1986). The entire record is examined to determine the surname significance of a term. The following are examples of evidence that may be relevant: telephone directory listings; excerpted articles from computerized research databases; evidence in the record that the term is a surname; the manner of use on specimens; dictionary definitions of the term and evidence from dictionaries showing no definition of the term. The quantum of evidence that is persuasive in finding surname significance in one case may be insufficient in another because of the differences in the names themselves. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 17, 225 USPQ 652, 653 (Fed. Cir. 1985).

See TMEP §§710 *et seq.* and 1211.02(b) *et seq.* for additional information about evidence.

### **1211.02(b) Evidentiary Considerations**

In appropriate cases, the examining attorney may present evidence that may appear contrary to his or her position, with an appropriate explanation as to why, in view of other evidence presented, this evidence was not considered controlling. In some cases, this may foreclose objections from an applicant and present a more complete picture in the event of an appeal.

See TMEP §§1211.02(b)(i) *et seq.* regarding types of evidence that may be relevant to a refusal of registration under §2(e)(4).

### **1211.02(b)(i) Telephone Directory Listings**

Telephone directory listings from telephone books or electronic databases are one type of credible evidence of the surname significance of a term. The Trademark Trial and Appeal Board has declined to hold that a minimum number of listings in telephone directories must be found to establish a *prima facie* showing that the mark is primarily merely a surname. See, e.g., *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986); *In re Wickuler-Kupper-Brauerei KGaA*, 221 USPQ 469 (TTAB 1983).

It is the American public's perception of a term that is determinative. Therefore, foreign telephone directory listings are not probative of the significance of a term to the purchasing public in the United States, regardless of whether the applicant is of foreign origin. See, e.g., *Société Civile Des Domaines Dourthe Frères v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 USPQ2d 1205 (TTAB 1988); *In re*



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

*Stromsholmens Mekaniska Verkstad AB*, 228 USPQ 968 (TTAB 1986); *In re Wickuler-Kupper-Brauerei*, *supra*.

### **1211.02(b)(ii) LEXIS-NEXIS® Research Database Evidence**

Excerpted articles from the LEXIS-NEXIS® research database are one type of credible evidence of the surname significance of a term. There is no requirement that the examining attorney make of record every story found in a LEXIS-NEXIS® search. However, the examining attorney is presumed to make the best case possible. See *In re Federated Department Stores Inc.*, 3 USPQ2d 1541, 1542 n.2 (TTAB 1987). See also *In re Monotype Corp. PLC*, 14 USPQ2d 1070, 1071 (TTAB 1989) (“We must conclude that, because the Examining Attorney is presumed to have made the best case possible, the 46 stories not made of record [the search yielded 48 stories] do not support the position that CALISTO is a surname and, indeed, show that CALISTO has non surname meanings.”) An Office action that includes any evidence obtained from a research data base should include a citation to the research service and a clear record of the specific search that was conducted, indicating the libraries or files that were searched and the date of the search (e.g., LEXIS®, New and Business, All News, Jan. 5, 2005). The electronic record or printout summarizing the search should be made a part of the record. Relevant information not included on the summary, such as the number of documents viewed, should be stated in narrative in the Office action. See TMEP §710.01(a).

Since it is the American public’s perception of a term that is determinative, evidence from foreign publications is given little or no weight. See *In re BDH Two Inc.*, 26 USPQ2d 1556 (TTAB 1993).

### **1211.02(b)(iii) Surname of Person Associated with Applicant**

The fact that a term is the surname of an individual associated with the applicant (e.g., an officer or founder) is evidence of the surname significance of the term. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314 (TTAB 1990); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988), *aff’d*, 883 F.2d 1026 (Fed. Cir. 1989); *In re Taverniti, SARL*, 225 USPQ 1263 (TTAB 1985), *recon. denied*, 228 USPQ 975 (TTAB 1985).

### **1211.02(b)(iv) Specimens Confirming Surname Significance of Term**

The fact that a term appears on the specimens of record in a manner that confirms its surname significance is evidence of the surname significance of a term. See *Société Civile Des Domaines Dourthe Frères v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 USPQ2d 1205, 1208 (TTAB 1988) (DOURTHE found primarily merely a surname, the Board noting applicant’s

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

references to “Dourthe” as the name of a particular family and finding the surname significance of the term to be reinforced by the appearance on applicant’s wine labels of the name and/or signature of an individual named Pierre Dourthe); *In re Taverniti, SARL*, 225 USPQ 1263, 1264 (TTAB 1985), *recon. denied*, 228 USPQ 975 (TTAB 1985) (J. TAVERNITI held primarily merely a surname, the Board considering, among other factors, the presentation of the mark on the specimens in signature form); *In re Luis Caballero, S.A.*, 223 USPQ 355, 356-57 (TTAB 1984) (BURDONS held primarily merely a surname, the Board weighting heavily the applicant’s use of “Burdon” on the specimens as a surname, albeit of a fictitious character (“John William Burdon”)).

### **1211.02(b)(v) Negative Dictionary Evidence**

Negative dictionary evidence (*i.e.* evidence that a term is absent from dictionaries or atlases) may demonstrate the lack of non-surname significance of a term. See *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986).

### **1211.02(b)(vi) Evidence of Fame of a Mark**

Evidence of the fame of a mark (*e.g.*, evidence of consumer recognition of a mark, or expenditures made in promoting or advertising a mark) is not relevant unless registration is sought under §2(f). *In re McDonald’s Corp.*, 230 USPQ 304, 307 (TTAB 1986) (McDONALD’S held primarily merely a surname in spite of strong secondary meaning, with the Board stating that. “the word ‘primarily’ refers to the primary significance of the term, that is, the ordinary meaning of the word, and not to the term’s strength as a trademark due to widespread advertising and promotion of the term as a mark to identify goods and/or services.”) See also *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988), *aff’d*, 883 F.2d 1026 (Fed. Cir. 1989); *In re Nelson Souto Major Piquet*, 5 USPQ2d 1367 (TTAB 1987).

### **1212 Acquired Distinctiveness or Secondary Meaning**

*15 U.S.C. §1052(f). Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant’s goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant’s goods in commerce before the date of the enactment of the North*

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### *American Free Trade Agreement Implementation Act.*

If a proposed mark is not inherently distinctive, it may be registered on the Principal Register only upon proof of acquired distinctiveness, or “secondary meaning,” that is, proof that it has become distinctive as applied to the applicant’s goods or services in commerce. If the applicant establishes, to the satisfaction of the examining attorney, that the matter in question has acquired distinctiveness as a mark in relation to the named goods or services, then the mark is registrable on the Principal Register under §2(f) of the Trademark Act, 15 U.S.C. §1052(f).

Within the context of the Trademark Act, §2(f) may be described as follows:

[U]nlike the first five sections of 15 U.S.C. §1052 which define the grounds upon which a trademark registration is to be refused, Section 2(f) serves as an exception to a rejection under the provisions of one of the other sections, Section 2(e) (citation omitted). Section 2(f) permits registration of marks that, despite not qualifying for registration in light of Section 2(e), have nevertheless “become distinctive of the applicant’s goods in commerce.” Thus, “Section 2(f) is not a provision on which registration can be refused,” ... but is a provision under which an applicant has a chance to prove that he is entitled to a federal trademark registration which would otherwise be refused.

*Yamaha Int’l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1580, 6 USPQ2d 1001, 1007 (Fed. Cir. 1988), quoting *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 n.2 (TTAB 1983).

The purpose and significance of secondary meaning may be described as follows:

A term which is descriptive ... may, through usage by one producer with reference to his product, acquire a special significance so that to the consuming public the word has come to mean that the product is produced by that particular manufacturer. 1 Nims, *Unfair Competition and Trademarks* at §37 (1947). This is what is known as secondary meaning.

The crux of the secondary meaning doctrine is that the mark comes to identify not only the goods but the source of those goods. To establish secondary meaning, it must be shown that the *primary* significance of the term in the minds of the consuming public is not the product but the producer (citations omitted). This may be an anonymous producer, since consumers often buy goods without knowing the personal identity or actual name of the manufacturer.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*Ralston Purina Co. v. Thomas J. Lipton, Inc.*, 341 F. Supp. 129, 133, 173 USPQ 820, 823 (S.D.N.Y. 1972).

There are three basic types of evidence that may be used to establish acquired distinctiveness under §2(f):

- (1) A claim of ownership of one or more prior registrations on the Principal Register of the same mark for goods or services that are the same as or related to those named in the pending application (see 37 C.F.R. §2.41(b); TMEP §§1212.04 *et seq.*);
- (2) A statement verified by the applicant that the mark has become distinctive of the applicant's goods or services by reason of substantially exclusive and continuous use in commerce by the applicant for the five years before the date when the claim of distinctiveness is made (see 37 C.F.R. §2.41(b); TMEP §§1212.05 *et seq.*);
- (3) Actual evidence of acquired distinctiveness (see 37 C.F.R. §2.41(a); TMEP §§1212.06 *et seq.*).

The applicant may submit one or any combination of these types of evidence, which are discussed below. Depending on the mark and the facts in the record, the examining attorney may determine that a claim of ownership of a prior registration(s) or a claim of five years' substantially exclusive and continuous use in commerce is insufficient to establish a *prima facie* case of acquired distinctiveness. The applicant may then submit actual evidence of acquired distinctiveness.

### **1212.01            General Evidentiary Matters**

Whether acquired distinctiveness has been established is a question of fact. See *In re Loew's Theatres, Inc.*, 769 F.2d 764, 769, 226 USPQ 865, 869 (Fed. Cir. 1985), and cases cited therein. The record must contain facts or evidence of acquired distinctiveness.

The burden of proving that a mark has acquired distinctiveness is on the applicant. See *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1578-79, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 122 USPQ 372 (C.C.P.A. 1959).

The applicant may present any competent evidence to establish that a mark has acquired distinctiveness. Actual evidence of acquired distinctiveness may be submitted regardless of the length of time the mark has been used. *Ex parte Fox River Paper Corp.*, 99 USPQ 173 (Comm'r Pats. 1953).

The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. See *Roux Laboratories, Inc. v.*

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

*Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); *In re Gammon Reel, Inc.*, 227 USPQ 729 (TTAB 1985).

Typically, more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods or services would be less likely to believe that it indicates source in any one party. See, e.g., *In re Bongrain International Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); *In re Seaman & Associates, Inc.*, 1 USPQ2d 1657 (TTAB 1986); *In re Packaging Specialists, Inc.*, 221 USPQ 917 (TTAB 1984).

Facts based on events that occurred subsequent to the filing date of the application may be considered. Whether acquired distinctiveness has been established is determined in view of the facts that exist at the time registrability is being considered. *McCormick & Co., Inc. v. Summers*, 354 F.2d 668, 148 USPQ 272 (C.C.P.A. 1966); *General Foods Corp. v. MGD Partners*, 224 USPQ 479 (TTAB 1984); *Kaiser Aluminum & Chemical Corp. v. American Meter Co.*, 153 USPQ 419 (TTAB 1967); *In re Hoffman House Sauce Co.*, 137 USPQ 486 (TTAB 1963).

### **1212.02 General Procedural Matters**

#### **1212.02(a) Situations in which a Claim of Distinctiveness under §2(f) Is Appropriate**

A claim of distinctiveness by the applicant under §2(f) is usually made either in response to a statutory refusal to register or in anticipation of such a refusal. A claim of distinctiveness is appropriately made in response to, or in anticipation of, only certain statutory refusals to register. For example, it is inappropriate to assert acquired distinctiveness to contravene a refusal under §2(a), (b), (c), (d) or (e)(5), 15 U.S.C. §§1052(a), (b), (c), (d) or (e)(5). Furthermore, acquired distinctiveness may not be asserted to contravene a refusal under §2(e)(3), 15 U.S.C. §1052(e)(3), unless the mark became distinctive of the applicant's goods in commerce before December 8, 1993, the date of enactment of the NAFTA Implementation Act (see TMEP §1210.07(b)).

In *In re Soccer Sport Supply Co., Inc.*, 507 F.2d 1400, 1403 n.3, 184 USPQ 345, 347 n.3 (C.C.P.A. 1975), the Court of Customs and Patent Appeals noted as follows:

[T]he judicially developed concept of "secondary meaning," codified by section 2(f) (15 U.S.C. 1052(f)), relates to descriptive, geographically descriptive, or surname marks which earlier had a primary meaning which did not indicate a single source and were, therefore, unregistrable because of section 2(e) (citation omitted). Additionally, section 2(f) has been

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

applied to permit registration of a mark consisting solely of a design and, therefore, not within the purview of section 2(e).

### **1212.02(b) Section 2(f) Claim Is, for Procedural Purposes, a Concession that Matter Is Not Inherently Distinctive**

For procedural purposes, a claim of distinctiveness under §2(f), whether made in the application as filed or in a subsequent amendment, may be construed as conceding that the matter to which it pertains is not inherently distinctive (and thus not registrable on the Principal Register absent proof of acquired distinctiveness). Once an applicant has claimed that matter has acquired distinctiveness under §2(f), the issue to be determined is not whether the matter is inherently distinctive but, rather, whether it has acquired distinctiveness. See, e.g., *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1577, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *In re Cabot Corp.*, 15 USPQ2d 1224, 1229 (TTAB 1990); *In re Professional Learning Centers, Inc.*, 230 USPQ 70, 71 (TTAB 1986); *In re Chopper Industries*, 222 USPQ 258, 259 (TTAB 1984). However, claiming distinctiveness in the alternative is *not* an admission that the proposed mark is not inherently distinctive. TMEP §1212.02(c).

For the purposes of establishing that the subject matter is not inherently distinctive, the examining attorney should not rely on this concession alone, but should rely on other appropriate evidence.

See TMEP §1212.02(d) regarding unnecessary §2(f) claims.

### **1212.02(c) Claiming §2(f) Distinctiveness in the Alternative**

An applicant may argue the merits of an examining attorney's refusal and, in the alternative, claim that the matter sought to be registered has acquired distinctiveness under §2(f). Unlike the situation in which an applicant initially seeks registration under §2(f) or amends its application without objection, the alternative claim does not constitute a concession that the matter sought to be registered is not inherently distinctive. See *In re E S Robbins Corp.*, 30 USPQ2d 1540 (TTAB 1992); *In re Professional Learning Centers, Inc.*, 230 USPQ 70, 71 n.2 (TTAB 1986).

When an applicant claims acquired distinctiveness in the alternative, the examining attorney should treat separately the questions of (1) the underlying basis of refusal and; (2) assuming the matter is determined to be registrable, whether acquired distinctiveness has been established. In the event of an appeal, the Board will use the same analysis, provided the evidence supporting the §2(f) claim is in the record and the alternative grounds have been considered and finally decided by the examining attorney. *In re Harrington*, 219 USPQ 854, 855 n.1 (TTAB 1983).

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

In *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 918 (TTAB 1983), the Board outlined its procedure in situations where the applicant maintains the position that the underlying refusal is improper and alternatively seeks registration pursuant to §2(f) in the interest of advancing the prosecution of the application:

If we decide that the mark as applied to the services is arbitrary or suggestive of the services, as applicant claims, we must reverse the refusal of registration under Section 2(e)(1) and we need not consider any of the affidavits or other material made of record by applicant in support of its Section 2(f) claim of distinctiveness. If, on the other hand, we find the mark to be merely descriptive of the services and, in fact, so highly descriptive of them that no amount of evidence could persuade us that the mark has become distinctive, we must affirm the refusal of registration. Similarly, in this situation, we need not consider any of the affidavits or other material made of record by applicant in its Section 2(f) claim of distinctiveness. If we find that the mark is merely descriptive of the goods for purposes of Section 2(e)(1), but not so highly descriptive as to be incapable of functioning as a service mark to identify applicant's services and distinguish them from like services of others, we must determine whether the evidence in support of applicant's claim of distinctiveness is sufficient to warrant registration under the provisions of Section 2(f) of the Trademark Act.

Similarly, the applicant may seek registration on the Principal Register under §2(f) and, in the alternative, on the Supplemental Register. Depending on the facts of the case, this approach may have limited practical application. If the examining attorney finds that the matter sought to be registered is not a mark within the meaning of §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127 (*e.g.*, is generic or purely ornamental), the examining attorney will refuse registration on both registers.

However, if the issues are framed in the alternative (*i.e.*, whether the matter sought to be registered has acquired distinctiveness under §2(f) or, in the alternative, whether it is capable of registration on the Supplemental Register), and it is ultimately determined that the matter is a mark within the meaning of the Act (*e.g.*, that the matter is merely descriptive rather than generic), then the evidence of secondary meaning will be considered. If it is determined that the applicant's evidence is sufficient to establish that the mark has acquired distinctiveness, the application will be approved for publication on the Principal Register under §2(f). If the evidence is determined to be insufficient, the mark may be registered on the Supplemental Register.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Accordingly, the applicant may submit an amendment to the Supplemental Register, and continue to argue entitlement to registration on the Principal Register in an appeal.

If the applicant files a notice of appeal in such a case, the Trademark Trial and Appeal Board will institute the appeal, suspend action on the appeal and remand the application to the examining attorney to determine registrability on the Supplemental Register.

If the examining attorney determines that the applicant is entitled to registration on the Supplemental Register, the examining attorney should send a letter notifying the applicant of the acceptance of the amendment and telling the applicant that the application is being referred to the Board for resumption of the appeal. If the examining attorney determines that the applicant is not entitled to registration on the Supplemental Register, the examining attorney will issue a nonfinal action refusing registration on the Supplemental Register. If the applicant fails to overcome the refusal, the examining attorney will issue a final action, and refer the application to the Board to resume action on the appeal with respect to entitlement to registration on either the Principal or the Supplemental Register.

Rather than framing the issues in the alternative (*i.e.*, whether the matter has acquired distinctiveness pursuant to §2(f) or, in the alternative, whether it is capable of registration on the Supplemental Register), the applicant may amend its application between the Principal and Supplemental Registers. 37 C.F.R. §2.75. See generally *In re Educational Communications, Inc.*, 231 USPQ 787 (TTAB 1986); *In re Broco*, 225 USPQ 227 (TTAB 1984).

See TMEP §§816.02 and 1102.03 regarding amending a §1(b) application to the Supplemental Register.

### **1212.02(d) Unnecessary §2(f) Claims**

If the applicant specifically requests registration under §2(f), but the examining attorney considers the entire mark to be inherently distinctive and the claim of acquired distinctiveness to be unnecessary, the examining attorney should so inform the applicant and inquire whether the applicant wishes to delete the statement or to rely on it.

If the applicant specifically requests registration of the entire mark under §2(f), but the examining attorney believes that part of the mark is inherently distinctive, the examining attorney should give the applicant the option of limiting the §2(f) claim to the matter that is not inherently distinctive. (See TMEP §1212.02(f) regarding claims of §2(f) distinctiveness as to a portion of a mark.) However, if the applicant wishes, a claim of acquired distinctiveness under §2(f) may be made as to an entire mark or phrase that contains both inherently distinctive matter and matter that is not inherently distinctive. *In re Del E. Webb Corp.*, 16 USPQ2d 1232, 1234 (TTAB 1990).



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

If the application contains statements that seem to relate to acquired distinctiveness or §2(f) but do not actually amount to a request for registration under §2(f), and the examining attorney does not believe that resort to §2(f) is necessary, the examining attorney may treat the statements as surplusage. If it is necessary to communicate with the applicant about another matter, the examining attorney should inform the applicant that the statements are being treated as surplusage. If it is otherwise unnecessary to communicate with the applicant, the examining attorney may delete the statements from the TRAM database, enter a note to the file that this has been done, and approve the application for publication. The documents containing the unnecessary §2(f) claim will remain in the record, but the claim will not be printed in the *Official Gazette* or on the certificate of registration. See TMEP §817 regarding preparation of applications for publication or issuance.

### **1212.02(e) Disclaimers in Applications Claiming Distinctiveness under §2(f)**

Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), states, in part, “The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.” See *In re Creative Goldsmiths of Washington, Inc.*, 229 USPQ 766, 768 (TTAB 1986) (“[W]e conclude that it is within the discretion of an Examining Attorney to require the disclaimer of an unregistrable component (such as a common descriptive, or generic, name) of a composite mark sought to be registered on the Principal Register under the provisions of Section 2(f).”).

### **1212.02(f) Section 2(f) Claim in Part (as to a Portion of the Mark)**

A claim of acquired distinctiveness may apply to a portion of a mark. The applicant must clearly identify the portion of the mark for which distinctiveness is claimed. The standards for establishing acquired distinctiveness are the same whether the claim of distinctiveness pertains to the entire mark or to a portion of it. See TMEP §§1212.09 *et seq.* regarding claims of acquired distinctiveness in intent-to-use applications under §1(b) of the Act.

Generally, the element that is the subject of the §2(f) claim must present a distinct commercial impression apart from the other elements of the mark. That is, it must be a separable element.

If the examining attorney determines that the claim of distinctiveness as to a portion of the mark is appropriate, the examining attorney should ensure that the record reflects that the §2(f) claim applies to the mark “in part” and that the relevant portion of the mark is identified.

If a claim of distinctiveness applies to only part of a mark and the examining attorney determines (1) that the claimed portion of the mark is unregistrable even under §2(f) (e.g., because it is generic or functional), or (2) that,

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

although the claimed portion is registrable, the applicant has failed to establish acquired distinctiveness, the examining attorney may require a disclaimer of that portion of the mark, if a disclaimer is otherwise appropriate. See *In re Lillian Vernon Corp.*, 225 USPQ 213 (TTAB 1985) (requirement for disclaimer of PROVENDER affirmed in application to register PROVENDER and design for “mail order services in the gourmet, bath and gift item field,” “provender” meaning “food” (claim of §2(f) distinctiveness in part held unacceptable)). Cf. *In re Chopper Industries*, 222 USPQ 258 (TTAB 1984) (requirement for disclaimer of CHOPPER reversed in application to register CHOPPER 1 and design for wood log splitting axes (claim of §2(f) distinctiveness in part held acceptable)).

### **1212.02(g) Examining Attorney’s Role in Suggesting §2(f) or Appropriate Kind/Amount of Evidence**

In a first action refusing registration, the examining attorney should suggest, where appropriate, that the applicant amend its application to seek registration under §2(f). For example, this should be done as a matter of course, if otherwise appropriate, in cases where registration is refused under §2(e)(4), on the ground that the mark is primarily merely a surname, and the applicant has recited dates of use that indicate that the mark has been in use in commerce for at least five years.

If the examining attorney determines that an applicant’s evidence is insufficient to establish that the mark has acquired distinctiveness, the examining attorney should suggest, where appropriate, that the applicant submit additional evidence. See *In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219, 220 n.2 (TTAB 1984) (Noting that applicant was specifically invited to seek registration pursuant to §2(f) but, after amending its application to do so, was refused registration on the ground that the mark was incapable of acquiring distinctiveness, the Board stated that, in fairness to applicant, this practice should be avoided where possible).

The examining attorney should not “require” that the applicant submit evidence of secondary meaning. There would be no practical standard for a proper response to this requirement; nor would there be a sound basis for appeal from the requirement. See *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 n.2 (TTAB 1983) (“Section 2(f) is not a provision on which registration can be refused.”).

The examining attorney should not specify the kind or the amount of evidence sufficient to establish that a mark has acquired distinctiveness. It is the responsibility of the applicant to submit evidence to establish that the mark has acquired distinctiveness. See TMEP §1212.01. However, the examining attorney may make a suggestion as to a course of action if the examining attorney believes this would further the prosecution of the application.

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### 1212.02(h) Non-Final and Final Refusals

If an application is filed under §2(f) of the Trademark Act and the examining attorney determines that (1) the mark is not inherently distinctive, and (2) the applicant's evidence of secondary meaning is insufficient to establish that the mark has acquired distinctiveness, the examining attorney will issue a non-final action refusing registration on the Principal Register pursuant to the appropriate section of the Trademark Act (e.g., §2(e)(1)), with a finding that the applicant's evidence of secondary meaning is insufficient to overcome the stated refusal. The examining attorney should suggest, where appropriate, that the applicant submit additional evidence. See TMEP §1212.02(g) concerning the examining attorney's role in suggesting a claim of distinctiveness under §2(f).

If an application is not filed under §2(f) and the examining attorney determines that the mark is not inherently distinctive, the examining attorney should issue a non-final action refusing registration on the Principal Register under the appropriate section of the Act (e.g., §2(e)(1)). The examining attorney should suggest, where appropriate, that the applicant amend its application to claim distinctiveness under §2(f).

Thereafter, if the applicant amends its application to seek registration under §2(f), a new issue is raised as to the sufficiency of the applicant's evidence of secondary meaning (see TMEP §714.05(a)(1)). The underlying statutory basis for refusal remains the same (e.g., §2(e)(1)), but the issue changes from whether the underlying refusal is warranted to whether the matter has acquired distinctiveness. If the examining attorney is persuaded that a *prima facie* case of acquired distinctiveness has been established, the examining attorney will approve the application for publication under §2(f). If the examining attorney determines that the applicant's evidence is insufficient to establish that the matter has acquired distinctiveness, the examining attorney will issue a second non-final action repeating the underlying statutory basis for refusal (e.g., §2(e)(1)), and explaining that the applicant's evidence is insufficient to overcome the stated refusal.

The examining attorney cannot issue a final refusal on the underlying statutory basis of the original refusal, upon an applicant's initial assertion of a §2(f) claim. The mere assertion of distinctiveness under §2(f) raises a new issue. See *In re Educational Communications, Inc.*, 231 USPQ 787, 787 n.2 (TTAB 1986). Even if the applicant has submitted, in support of the §2(f) claim, a statement of five years' use that is technically defective (e.g., not verified or comprising incorrect language), the assertion of §2(f) distinctiveness still constitutes a new issue.

*Exception:* The examining attorney may issue a final refusal upon an applicant's initial assertion of a §2(f) claim if the amendment is irrelevant to the outstanding refusal. See TMEP §714.05(a)(1). See also TMEP §§1212.02(a) and 1212.02(i)

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

regarding situations where it is and is not appropriate to submit a claim of acquired distinctiveness to overcome a refusal.

After the examining attorney has issued a non-final action refusing registration on the Principal Register with a finding that the applicant's evidence of secondary meaning is insufficient to overcome the stated refusal, the applicant may elect to submit additional arguments and/or evidence regarding secondary meaning. If, after considering this submission, the examining attorney is persuaded that the applicant has established a *prima facie* case of acquired distinctiveness, the examining attorney will approve the application for publication under §2(f). If the examining attorney is not persuaded that the applicant has established a *prima facie* case of acquired distinctiveness, and the application is otherwise in condition for final refusal, the examining attorney will issue a final refusal pursuant to the appropriate section of the Act (e.g., §2(e)(1)), with a finding that the applicant's evidence of acquired distinctiveness is insufficient to overcome the stated refusal. See *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 n.2 (TTAB 1983).

In any action in which the examining attorney indicates that the evidence of record is insufficient to establish that the mark has acquired distinctiveness, the examining attorney should specify the reasons for this determination. See *In re Interstate Folding Box Co.*, 167 USPQ 241, 242 (TTAB 1970); *In re H. A. Friend & Co., Inc.*, 158 USPQ 609 (TTAB 1968).

### **1212.02(i) Section 2(f) Claim with Respect to Incapable Matter**

If matter is generic, functional or purely ornamental, or otherwise fails to function as a mark, the matter is unregistrable. See, e.g., *In re Bongrain International Corp.*, 894 F.2d 1316, 1317 n.4, 13 USPQ2d 1727, 1728 n.4 (Fed. Cir. 1990) ("If a mark is generic, incapable of serving as a means 'by which the goods of the applicant may be distinguished from the goods of others' ... it is not a trademark and can not be registered under the Lanham Act."); *H. Marvin Ginn Corp. v. International Association of Fire Chiefs*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986), and cases cited therein ("A generic term ... can never be registered as a trademark because such a term is 'merely descriptive' within the meaning of §2(e)(1) and is incapable of acquiring *de jure* distinctiveness under §2(f). The generic name of a thing is in fact the ultimate in descriptiveness."). See also *In re Melville Corp.*, 228 USPQ 970, 972 (TTAB 1986) (BRAND NAMES FOR LESS, for retail store services in the clothing field, "should remain available for other persons or firms to use to describe the nature of their competitive services.").

An underlying basis of refusal common in each of the situations referred to above is the failure of the matter to function as a mark within the meaning of the Trademark Act (15 U.S.C. §§1051, 1052 and 1127). *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

It is axiomatic that matter may not be registered unless it is used as a mark, namely, “in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods in question.” *In re Remington Products Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987). *See, e.g., In re Melville Corp.*, 228 USPQ 970, 970 n.2 (TTAB 1986) (“If matter proposed for registration does not function as a mark, it is not registrable in accordance with Sections 1 and 2 of the Act because the preambles of those sections limit registration to subject matter within the definition of a trademark.”); *In re Whataburger Systems, Inc.*, 209 USPQ 429, 430 (TTAB 1980) (“[A] designation may not be registered either as a trademark or as a service mark unless it is used as a mark, in such a manner that its function as an indication of origin may be readily perceived by persons encountering the goods or services in connection with which it is used.”).

Therefore, where the examining attorney has determined that matter sought to be registered is not registrable because it is not a mark within the meaning of the Trademark Act, a claim that the matter has acquired distinctiveness under §2(f) as applied to the applicant’s goods or services does not overcome the refusal. *See, e.g., TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1007 (2001) (“Functionality having been established, whether MDI’S dual spring design has acquired secondary meaning need not be considered.”); *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484-85, 222 USPQ 1, 3 (Fed. Cir. 1984) (“Evidence of distinctiveness is of no avail to counter a de jure functionality rejection.”); *In re Tilcon Warren, Inc.*, 221 USPQ 86, 88 (TTAB 1984) (“Long use of a slogan which is not a trademark and would not be so perceived does not, of course, transform the slogan into a trademark.”); *In re Mancino*, 219 USPQ 1047, 1048 (TTAB 1983) (“Since the refusal ... was based on applicant’s failure to demonstrate technical service mark use, the claim of distinctiveness under Section 2(f) was of no relevance to the issue in the case.”).

As discussed above, evidence of acquired distinctiveness will not alter the determination that matter is unregistrable. Nevertheless, the evidence submitted by the applicant should be reviewed to determine whether it has any bearing on the underlying basis of refusal.

*See also In re Wakefern Food Corp.*, 222 USPQ 76, 79 (TTAB 1984) (the Board, while finding applicant’s evidence relating to public perception of WHY PAY MORE! entitled to relatively little weight, noting that the evidence is relevant to the issue of whether the slogan functions as a mark for applicant’s supermarket services).

### **1212.03 Evidence of Distinctiveness Under §2(f)**

*37 C.F.R. §2.41. Proof of distinctiveness under section 2(f).*

*(a) When registration is sought of a mark which would be unregistrable by reason of section 2(e) of the Act but which is said by applicant to have become*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*distinctive in commerce of the goods or services set forth in the application, applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, affidavits, or declarations in accordance with §2.20, depositions, or other appropriate evidence showing duration, extent and nature of use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and affidavits, or declarations in accordance with §2.20, letters or statements from the trade or public, or both, or other appropriate evidence tending to show that the mark distinguishes such goods.*

*(b) In appropriate cases, ownership of one or more prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness. Also, if the mark is said to have become distinctive of applicant's goods by reason of substantially exclusive and continuous use in commerce thereof by applicant for the five years before the date on which the claim of distinctiveness is made, a showing by way of statements which are verified or which include declarations in accordance with §2.20, in the application may, in appropriate cases, be accepted as prima facie evidence of distinctiveness. In each of these situations, however, further evidence may be required.*

“To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.” *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 851 n. 11, 214 USPQ 1, 4 n. 11 (1982).

### **1212.04 Prior Registrations as Proof of Distinctiveness**

Trademark Rule 2.41(b), 37 C.F.R. §2.41(b), provides that the examining attorney may accept, as *prima facie* evidence of acquired distinctiveness, ownership by the applicant of one or more prior registrations of the same mark on the Principal Register or under the Act of 1905. See TMEP §1212.04(b) as to what constitutes the “same mark,” and TMEP §§1212.09 *et seq.* concerning §1(b) applications.

The rule states that ownership of existing registrations to establish acquired distinctiveness “may” be considered acceptable in “appropriate cases,” and that the Office may, at its option, require additional evidence of distinctiveness. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985).

The following are general guidelines regarding claiming ownership of prior registrations as a method of establishing acquired distinctiveness.

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### 1212.04(a) Sufficiency of Claim vis-à-vis Nature of the Mark

The examining attorney has the discretion to determine whether the nature of the mark sought to be registered is such that a claim of ownership of a prior registration for the same or similar goods or services is enough to establish acquired distinctiveness. For example, if the mark sought to be registered is deemed to be highly descriptive or misdescriptive of the goods or services named in the application, the examining attorney may require additional evidence of acquired distinctiveness. See *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (claim of ownership of a prior registration held insufficient to establish acquired distinctiveness where registration was refused as primarily geographically deceptively misdescriptive); *In re Kerr-McGee Corp.*, 190 USPQ 204 (TTAB 1976) (claim of ownership of prior registrations held insufficient to establish acquired distinctiveness where registration was refused on ground that the subject matter was merely an ornamental border or "carrier" for words and symbols appearing within).

### 1212.04(b) "Same Mark"

A proposed mark is the "same mark as a previously-registered mark for the purpose of 37 C.F.R. §2.41(b) if it is the "legal equivalent" of such a mark. A mark is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001). See also *Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 6 USPQ2d 1475, 1477 (TTAB 1988) ("The words GOLDEN RING, while they are used to describe the device, are by no means identical to or substantially identical to the gold ring device trademark."); *In re Best Products Co., Inc.*, 231 USPQ 988, 989 n.6 (TTAB 1986) ("[W]e infer in the instant case that the differences between the marks BEST & Des. and BEST JEWELRY & Des., and between the identifications of services in their respective registrations, were deemed to be immaterial differences."); *In re Loew's Theatres, Inc.*, 223 USPQ 513, 514 n.5 (TTAB 1984), *aff'd*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) ("We do not, however, agree with the Examining Attorney that a minor difference in the marks (*i.e.*, here, merely that the mark of the existing registration is in plural form) is a proper basis for excluding any consideration of this evidence under the rule."); *In re Flex-O-Glass, Inc.*, 194 USPQ 203, 205-06 (TTAB 1977) ("[P]ersons exposed to applicant's registered mark ... would, upon encountering [applicant's yellow rectangle and red circle design] ..., be likely to accept it as the same mark or as an inconsequential modification or modernization thereof.... [A]pplicant may 'tack on' to its use of the mark in question, the use of the registered mark ... and therefore may properly rely upon its registration in support of its claim of distinctiveness herein.").

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

See, e.g., *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991) regarding the concept of “tacking” with reference to prior use of a legally equivalent mark.

### **1212.04(c) Relatedness of Goods or Services**

The examining attorney should determine whether the goods or services named in the application are sufficiently similar to the goods or services named in the prior registration(s). See *Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 6 USPQ2d 1475, 1478 (TTAB 1988) (“Applicant’s almost total reliance on the distinctiveness which its gold ring device has achieved vis-à-vis rifle scopes and handgun scopes is simply not sufficient by itself to establish that the same gold ring device has become distinctive vis-à-vis binoculars and spotting scopes.”); *In re Best Products Co., Inc.*, 231 USPQ 988, 989 n.6 (TTAB 1986) (“[W]e infer in the instant case that the differences between the marks BEST & Des. and BEST JEWELRY & Des., and between the identifications of services in their respective registrations [‘mail order and catalog showroom services’ and ‘retail jewelry store services’], were deemed to be immaterial differences.”); *In re Owens-Illinois Glass Co.*, 143 USPQ 431, 432 (TTAB 1964) (applicant’s ownership of prior registration of LIBBEY for cut-glass articles held acceptable as *prima facie* evidence of distinctiveness of identical mark for plastic tableware, the Board stating, “Cut-glass and plastic articles of tableware are customarily sold in the same retail outlets, and purchasers of one kind of tableware might well be prospective purchasers of the other.”); *In re Lytle Engineering & Mfg. Co.*, 125 USPQ 308, 309 (TTAB 1960) (applicant’s ownership of prior registration of LYTLE for various services, including the planning, preparation and production of technical publications, held acceptable as *prima facie* evidence of distinctiveness of identical mark for brochures, catalogues and bulletins).

### **1212.04(d) Registration Must Be in Full Force and Effect and on Principal Register or under Act of 1905**

Trademark Rule 2.41(b), 37 C.F.R. §2.41(b), states that ownership of a prior registration “on the Principal Register or under the Act of 1905” may be accepted as *prima facie* evidence of distinctiveness. Therefore, claims of acquired distinctiveness under §2(f) cannot be based on ownership of registrations on the Supplemental Register. See *In re Cannon, Inc.*, 219 USPQ 820 (TTAB 1983).

Moreover, a claim of acquired distinctiveness cannot be based on a registration that is cancelled or expired. See *In re BankAmerica Corp.*, 229 USPQ 852, 853 (TTAB 1986). When an examining attorney considers a §2(f) claim based on ownership of one or more prior registrations, the examining attorney should confirm, in the records of the Office, that the claimed registrations were issued on the Principal Register or under the Act of 1905 and that they are in full force and effect.



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### 1212.04(e) Form of §2(f) Claim Based on Ownership of Prior Registrations

The following language may be used to claim distinctiveness under §2(f) on the basis of ownership of one or more prior registrations:

The mark has become distinctive of the goods (or services) as evidenced by ownership of U.S. Registration No(s).  
\_\_\_\_\_ on the Principal Register for the same mark for related goods or services.

37 C.F.R. §2.41(b).

If the applicant is relying solely on its ownership of one or more prior registrations as proof of acquired distinctiveness, the §2(f) claim does not have to be verified. Therefore, an applicant or an applicant's attorney may authorize amendment of an application to add such a claim through an examiner's amendment, if otherwise appropriate.

### 1212.05 Five Years of Use as Proof of Distinctiveness

Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), provides that "proof of substantially exclusive and continuous use" of a designation "as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made" may be accepted as *prima facie* evidence that the mark has acquired distinctiveness as used with the applicant's goods in commerce. See also 37 C.F.R. §2.41(b).

The Trademark Act previously required that the relevant five-year period precede the filing date of the application. The Trademark Law Revision Act of 1988, Public Law 100-667, 102 Stat. 3935, revised §2(f) of the Act to provide for a *prima facie* showing of acquired distinctiveness based on five years' use running up to the date the claim is made. Under the revised provision, any five-year claim submitted on or after November 16, 1989, is subject to the new time period. This applies even if the application was filed prior to that date.

Section 2(f) of the Act and 37 C.F.R. §2.41(b) state that reliance on a claim of five years' use to establish acquired distinctiveness "may" be acceptable in "appropriate cases." The Office may, at its option, require additional evidence of distinctiveness. Whether a claim of five years' use will be deemed acceptable to establish that the mark has acquired distinctiveness depends largely on the nature of the mark in relation to the specified goods or services.

The following are general guidelines regarding the statutorily suggested proof of five years' use as a method of establishing acquired distinctiveness.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1212.05(a) Sufficiency of Claim Vis-à-Vis Nature of the Mark

For most surnames, the statement of five years' use will be sufficient to establish acquired distinctiveness.

The amount of evidence necessary to establish secondary meaning varies -- "the greater the degree of description a term has, the heavier the burden to prove it has attained secondary meaning." *In re Bongrain International Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1728 n. 4 (Fed. Cir. 1990); *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1581, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988).

Accordingly, for marks refused under §§2(e)(1) or 2(e)(2), whether the statement of five years' use is sufficient in and of itself to establish acquired distinctiveness depends on the degree to which the mark is descriptive or misdescriptive. If the mark is highly descriptive or misdescriptive of the goods or services named in the application, the statement of five years' use alone will be deemed insufficient to establish acquired distinctiveness. See *In re Kalmbach Publishing Co.*, 14 USPQ2d 1490 (TTAB 1989) (applicant's sole evidence of acquired distinctiveness, a claim of use since 1975, held insufficient to establish that the highly descriptive, if not generic, designation RADIO CONTROL BUYERS GUIDE had become distinctive of applicant's magazines); *In re Gray Inc.*, 3 USPQ2d 1558, 1559 (TTAB 1987) ("[T]o support registration of PROTECTIVE EQUIPMENT [for burglar and fire alarms and burglar and fire alarm surveillance services] on the Principal Register a showing considerably stronger than a prima facie statement of five years' substantially exclusive use is required."). Cf. *In re Synergistics Research Corp.*, 218 USPQ 165 (TTAB 1983) (applicant's declaration of five years' use held sufficient to support registrability under §2(f) of BALL DARTS for equipment sold as a unit for playing a target game, in view of lack of evidence that the term is highly descriptive (e.g., no dictionary evidence of any meaning of BALL DARTS and no evidence of use of the term by competitors or the public)).

For matter that does not inherently function as a mark because of its nature (e.g., nondistinctive product container shapes, overall color of a product, mere ornamentation), evidence of five years' use is not sufficient to show acquired distinctiveness. In such a case, actual evidence that the mark is perceived as a mark for the relevant goods or services would be required to establish distinctiveness. See generally *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985) (color pink as uniformly applied to applicant's fibrous glass residential insulation); *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1 (Fed. Cir. 1984) (configuration of pistol grip water nozzle for water nozzles); *Edward Weck Inc. v. IM Inc.*, 17 USPQ2d 1142 (TTAB 1990) (color green for medical instruments); *In re Cabot Corp.*, 15 USPQ2d 1224 (TTAB 1990) (configuration of a pillow-pack container for ear plugs and configuration of a pillow-pack container with trade dress (white circle surrounded by blue border) for ear plugs); *In re Star Pharmaceuticals*,

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

*Inc.*, 225 USPQ 209 (TTAB 1985) (color combination of drug capsule and seeds therein for methyltestosterone); *In re Craigmyle*, 224 USPQ 791 (TTAB 1984) (configuration of halter square for horse halters).

### 1212.05(b) “Substantially Exclusive and Continuous”

The five years of use does not have to be exclusive, but may be “substantially” exclusive. This makes allowance for use by others that may be inconsequential or infringing, which does not necessarily invalidate the applicant’s claim. *L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 52 USPQ2d 1307 (Fed. Cir. 1999).

The existence of other applications to register the same mark, or other known uses of the mark, does not automatically eliminate the possibility of using this method of proof, but the examining attorney should inquire as to the nature of such use and be satisfied that it is not substantial or does not nullify the claim of distinctiveness. See *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 1403, 222 USPQ 939, 940-41 (Fed. Cir. 1984) (“When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.”); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1357-58 (TTAB 1989) (“[T]he existence of numerous third party users of a mark, even if junior, might well have a material impact on the Examiner’s decision to accept a party’s claim of distinctiveness.”); *Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1588-89 (TTAB 1987) (“[L]ong and continuous use alone is insufficient to show secondary meaning where the use is not substantially exclusive.”); *Ex parte The Kalart Co. Inc.*, 88 USPQ 221 (PO Ex. Ch. 1951).

The use of the mark during the five years must be continuous, without a period of “nonuse” or suspension of trade in the goods or services in connection with which the mark is used.

### 1212.05(c) Use “as a Mark”

The substantially exclusive and continuous use must be “as a mark.” 15 U.S.C. §1052(f). See *In re Craigmyle*, 224 USPQ 791 (TTAB 1984) (registrability under §2(f) not established by sales over a long period of time where there was no evidence that the subject matter had been used as a mark); *In re Kwik Lok Corp.*, 217 USPQ 1245, 1248 (TTAB 1983) (declarations as to sales volume and advertising expenditures held insufficient to establish acquired distinctiveness. “The significant missing element in appellant’s case is evidence persuasive of the fact that the subject matter has been used as a mark.”).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1212.05(d) Form of the Proof of Five Years' Use

If the applicant chooses to seek registration under §2(f), 15 U.S.C. §1052(f), by using the statutory suggestion of five years of use as proof of distinctiveness, the applicant should submit a claim of distinctiveness that reads as follows, if accurate:

The mark has become distinctive of the goods (or services) through the applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement.

The claim of five years of use is generally required to be supported by an affidavit or declaration under 37 C.F.R. §2.20, signed by the applicant. See 37 C.F.R. §2.41(b). The affidavit or declaration can be signed by a person properly authorized to sign on behalf of applicant under 37 C.F.R. §2.33(a). See TMEP §804.04.

The following are guidelines regarding the form and language appropriate for a claim of five years of use:

- (1) Use of the precise statutory wording is desirable, but variations may be accepted if they do not affect the essential allegations.
- (2) The wording "substantially exclusive and continuous use in commerce" is essential.
- (3) It must be clear from the record that the five years of use has been in commerce that may lawfully be regulated by Congress. See *Blanchard & Co., Inc. v. Charles Gilman & Son, Inc.*, 145 USPQ 62 (D. Mass. 1965), *aff'd*, 353 F.2d 400, 147 USPQ 263 (1<sup>st</sup> Cir. 1965), *cert. denied* 383 U.S. 968, 149 USPQ 905 (1966).
- (4) The use of the mark must cover the five years before the date of the statement of five years' use. Thus wording that indicates that the use referred to is before the date of the statement is essential. Its omission can only be excused if the facts in the record clearly show that the use includes the five years before the date of the statement.
- (5) The affidavit or declaration should include a statement that the mark has become distinctive or that the applicant believes that the mark has become distinctive, but absence of this statement is not fatal. See TMEP §1212.07 for examples of various ways in which an applicant may assert a §2(f) claim.
- (6) The affidavit or declaration should contain a reference to distinctiveness as applied to the applicant's goods or services, or to use with the applicant's goods or services, because the

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

distinctiveness created by the five years' use must relate to the goods or services specified in the application. If there is doubt that the distinctiveness pertains to either all or any of the goods or services specified in the application, the examining attorney should inquire regarding that issue. While a clarifying response does not have to be verified, a substitute statement must be verified, *i.e.*, supported by an affidavit or a declaration under 37 C.F.R. §2.20, signed by the applicant.

### 1212.06 Establishing Distinctiveness by Actual Evidence

Under Trademark Rule 2.41(a), 37 C.F.R. §2.41(a), an applicant may, in support of registrability, submit affidavits, declarations under 37 C.F.R. §2.20, depositions or other appropriate evidence showing the duration, extent and nature of the applicant's use of a mark in commerce that may lawfully be regulated by Congress, advertising expenditures in connection with such use, letters or statements from the trade and/or public, or other appropriate evidence tending to show that the mark distinguishes the goods or services.

Establishing acquired distinctiveness by actual evidence was explained as follows in *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1125, 227 USPQ 417, 422 (Fed. Cir. 1985):

An evidentiary showing of secondary meaning, adequate to show that a mark has acquired distinctiveness indicating the origin of the goods, includes evidence of the trademark owner's method of using the mark, supplemented by evidence of the effectiveness of such use to cause the purchasing public to identify the mark with the source of the product.

The kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods or services depends on the nature of the mark and the circumstances surrounding the use of the mark in each case. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988); *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); *In re Capital Formation Counselors*, 219 USPQ 916 (TTAB 1983).

In considering a claim of acquired distinctiveness, the issue is whether acquired distinctiveness of the mark in relation to the goods or services has in fact been established in the minds of the purchasing public, not whether the mark is capable of becoming distinctive. *In re Redken Laboratories, Inc.*, 170 USPQ 526 (TTAB 1971); *In re Fleet-Wing Corp.*, 122 USPQ 335 (TTAB 1959).

The following are some examples of different types of evidence that have been used, alone or in combination, to establish acquired distinctiveness. No

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

single evidentiary factor is determinative. The value of a specific type of evidence and the amount necessary to establish acquired distinctiveness will vary according to the facts of the specific case.

### **1212.06(a) Long Use of the Mark**

Long use of the mark is one relevant factor to consider in determining whether a mark has acquired distinctiveness. See *In re Uncle Sam Chemical Co., Inc.*, 229 USPQ 233 (TTAB 1986) (§2(f) claim of acquired distinctiveness of SPRAYZON for “cleaning preparations and degreasers for industrial and institutional use” found persuasive where applicant had submitted declaration of its president supporting sales figures and attesting to over eighteen years of substantially exclusive and continuous use); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984) (evidence submitted by applicant held insufficient to establish acquired distinctiveness of PACKAGING SPECIALISTS, INC., for contract packaging services, notwithstanding, *inter alia*, continuous and substantially exclusive use for sixteen years, deemed “a substantial period but not necessarily conclusive or persuasive”).

### **1212.06(b) Advertising Expenditures**

Large scale expenditures in promoting and advertising goods and services under a particular mark are significant to indicate the extent to which a mark has been used. However, proof of an expensive and successful advertising campaign is not in itself enough to prove secondary meaning. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars -- two million of which were spent on promotions and promotional items which included the phrase THE BEST BEER IN AMERICA -- found insufficient to establish distinctiveness, in view of the highly descriptive nature of the proposed mark); *Mattel, Inc. v. Azrak-Hamway International, Inc.*, 724 F.2d 357, 221 USPQ 302, 305 n. 2 (2d Cir. 1983). The ultimate test in determining whether a designation has acquired distinctiveness is applicant’s success, rather than its efforts, in educating the public to associate the proposed mark with a single source. The examining attorney must examine the advertising material to determine how the term is being used, the commercial impression created by such use, and what the use would mean to purchasers. *In re Redken Laboratories, Inc.*, 170 USPQ 526, 529 (TTAB 1971) (evidence adduced by applicant pursuant to §2(f) held insufficient to establish acquired distinctiveness of THE SCIENTIFIC APPROACH, for lectures concerning hair and skin treatment, notwithstanding ten years of use, over \$500,000 in promotion and sponsorship expenses, and the staging of over 300 shows per year). See also *In re E.I. Kane, Inc.*, 221 USPQ 1203, 1206 (TTAB 1984) (refusal to register OFFICE MOVERS, INC., for moving services, affirmed notwithstanding §2(f) claim based on, *inter alia*, evidence of substantial

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

advertising expenditures. “There is no evidence that any of the advertising activity was directed to creating secondary meaning in applicant’s highly descriptive trade name.”); *In re Kwik Lok Corp.*, 217 USPQ 1245 (TTAB 1983) (evidence held insufficient to establish acquired distinctiveness for configuration of bag closures made of plastic, notwithstanding applicant’s statement that advertising of the closures involved several hundred thousands of dollars, where there was no evidence that the advertising had any impact on purchasers in perceiving the configuration as a mark). *Cf. In re Haggard Co.*, 217 USPQ 81, 84 (TTAB 1982) (background design of a black swatch held registrable pursuant to §2(f) for clothing where applicant had submitted, *inter alia*, evidence of “very substantial advertising and sales,” the Board finding the design to be, “because of its serrated left edge, something more than a common geometric shape or design”).

If the applicant prefers not to specify the extent of its expenditures in promoting and advertising goods and services under the mark because this information is confidential, the applicant may indicate the types of media through which the goods and services have been advertised (*e.g.*, national television) and how frequently the advertisements have appeared.

### **1212.06(c) Affidavits or Declarations Asserting Recognition of Mark as Source Indicator**

Affidavits or declarations that assert recognition of the mark as a source indicator are relevant in establishing acquired distinctiveness. The value of the affidavits or declarations depends on the statements made and the identity of the affiant or declarant. *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988) (conclusionary declaration from applicant’s vice-president held insufficient without the factual basis for the declarant’s belief that the design had become distinctive). Proof of distinctiveness requires more than proof of the existence of a relatively small number of people who associate a mark with the applicant. *In re The Paint Products Co.*, 8 USPQ2d 1863, 1866 (TTAB 1988) (“Because these affidavits were sought and collected by applicant from ten customers who have dealt with applicant for many years, the evidence is not altogether persuasive on the issue of how the average customer for paints perceives the words ‘PAINT PRODUCTS CO.’ in conjunction with paints and coatings.”). *See also In re Gray Inc.*, 3 USPQ2d 1558, 1560 (TTAB 1987) (affidavit of applicant’s counsel expressing his belief that the mark has acquired secondary meaning accorded “no probative value whatsoever” because, among other reasons, the statement is subject to bias); *In re Petersen Mfg. Co.*, 2 USPQ2d 2032 (TTAB 1987) (declarations from customers which stated that designs used by applicant indicate to the declarant that the applicant is the source of the goods, but which did not refer to or identify the designs with any specificity, not considered persuasive); *In re Bose Corp.*, 216 USPQ 1001, 1005 (TTAB 1983), *aff’d*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985) (retailer’s statement that he has been in contact with many purchasers of loudspeaker systems of

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

whom a substantial number would recognize depicted design as originating with applicant deemed competent evidence of secondary meaning); *In re Flex-O-Glass, Inc.*, 194 USPQ 203, 206 (TTAB 1977) (“[T]he fact that the affidavits may be similar in format and expression is of no particular significance ... since the affiants have sworn to the statements contained therein.”).

### **1212.06(d) Survey Evidence, Market Research and Consumer Reaction Studies**

Survey evidence, market research and consumer reaction studies are relevant in establishing acquired distinctiveness and secondary meaning. *Yankee Candle Co., Inc. v. Bridgewater Candle Co., LLC*, 259 F.3d 25, 37, 59 USPQ2d 1720, 1730 (1<sup>st</sup> Cir. 2001) (“Although survey evidence is not required, ‘it is a valuable method of showing secondary meaning,’” citing *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 41, 49 USPQ2d 1225, 1235 (1<sup>st</sup> Cir. 1998)).

To show secondary meaning, the survey must show that the public views the proposed mark as an indication of the source of the product or service. *Boston Beer Co. L.P. v. Slesar Bros. Brewing Co., Inc.*, 9 F.3d 175, 28 USPQ2d 1778 (1<sup>st</sup> Cir. 1993) (survey found insufficient to establish acquired distinctiveness where survey demonstrates product-place association rather than product-source association). The applicant must document the procedural and statistical accuracy of this type of evidence and carefully frame the questions contained therein. See *In re E.I. Kane, Inc.*, 221 USPQ 1203, 1206 (TTAB 1984) (“[T]he survey asked the wrong question. The issue is not whether the term ‘Office Movers’ identifies a specific company. Rather, it is whether the term ‘OFFICE MOVERS, INC.’ identifies services which emanate from a single source.”); *General Foods Corp. v. Ralston Purina Co.*, 220 USPQ 990, 994 n.7 (TTAB 1984) (“[W]here ... [reports of market research, consumer reaction studies] have been conducted for marketing reasons rather than directly to assist in resolving the issues in proceedings before us, their value will almost always depend on interpretations of their significance by witnesses or other evidence.”); *Specialty Brands, Inc. v. Spiceseas, Inc.*, 220 USPQ 73, 74 n.4 (TTAB 1983) (testimony concerning survey results, unsupported by documentation, considered unreliable hearsay).

### **1212.06(e) Miscellaneous Considerations Regarding Evidence Submitted to Establish Distinctiveness**

#### **1212.06(e)(i) First or Only User**

When the applicant is the only source of the goods or services, use alone does not automatically represent trademark recognition and acquired distinctiveness. See, e.g., *J. Kohnstam, Ltd. v. Louis Marx & Co., Inc.*, 280



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

F.2d 437, 126 USPQ 362 (C.C.P.A. 1960); *In re Mortgage Bankers Association of America*, 226 USPQ 954 (TTAB 1985); *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983); *In re Meier's Wine Cellars, Inc.*, 150 USPQ 475 (TTAB 1966); *In re G. D. Searle & Co.*, 143 USPQ 220 (TTAB 1964), *aff'd*, 360 F.2d 650, 149 USPQ 619 (C.C.P.A. 1966).

### **1212.06(e)(ii) State Trademark Registrations**

State trademark registrations are of relatively little probative value. See, e.g., *In re Vico Products Mfg. Co., Inc.*, 229 USPQ 364, 370 (TTAB 1985), *recon. denied*, 229 USPQ 716 (TTAB 1986) (“While applicant’s design may be registrable under the provisions of California trademark law, it is the federal trademark statute and the cases interpreting it by which we must evaluate the registrability of applicant’s asserted mark.”); *In re Craigmyle*, 224 USPQ 791, 794 (TTAB 1984).

### **1212.06(e)(iii) Design Patent**

The fact that a device is the subject of a design patent does not, without more, mean that it functions as a mark or has acquired distinctiveness. See, e.g., *In re Vico Products Mfg. Co., Inc.*, 229 USPQ 364, 370 (TTAB 1985), *recon. denied*, 229 USPQ 716 (TTAB 1986).

### **1212.06(e)(iv) Acquiescence to Demands of Competitors**

Acquiescence to demands of competitors to cease use of a term can be equally viewed as simply a desire to avoid litigation. See, e.g., *In re Wella Corp.*, 565 F.2d 143, 144 n.2, 196 USPQ 7, 8 n.2 (C.C.P.A. 1977); *In re Consolidated Cigar Corp.*, 13 USPQ2d 1481 (TTAB 1989).

### **1212.07 Form of Application Asserting Distinctiveness**

To base a registration on acquired distinctiveness under §2(f), 15 U.S.C. §1052(f), an applicant must indicate its intent to do so.

The indication of the applicant’s intent to rely on §2(f) can take a variety of forms, for example, a statement that registration is requested under §2(f); a statement that the mark has become distinctive, or that the applicant believes the mark has become distinctive of the goods or services in commerce; the statement relating to five years’ use in commerce as suggested in §2(f); or a statement that evidence is being submitted in support of acquired distinctiveness.

If it is unclear from the application whether a claim of distinctiveness under §2(f) has been made, the examining attorney should inquire whether the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

applicant is seeking registration under §2(f). See TMEP §1212.02(d) concerning unnecessary §2(f) claims.

If the statement requesting registration under §2(f) and the evidence submitted to establish acquired distinctiveness are in the application when filed, the §2(f) statement and proof are supported by the verification of the application.

If a claim of distinctiveness pursuant to §2(f) is submitted as an amendment, or if additional evidence is added in an amendment, the nature of the proof submitted to establish acquired distinctiveness determines whether a verification is necessary.

A claim of ownership of one or more prior registrations as proof of distinctiveness does not have to be verified. See TMEP §1212.04(e).

If the applicant claims that the mark has become distinctive of the applicant's goods or services through substantially exclusive and continuous use of the mark in commerce by the applicant for the five years before the date on which the claim of distinctiveness is made, the applicant must submit this claim in the form of an affidavit, or a declaration in accordance with 37 C.F.R. §2.20, signed by the applicant. 15 U.S.C. §1052(f); 37 C.F.R. §2.41(b); TMEP §1212.05(d). See 37 C.F.R. §2.33(a) and TMEP §804.04 regarding persons properly authorized to sign on behalf of applicant.

If an application is amended to add a §2(f) claim relying on other types of evidence, there may be considerable flexibility as to form. While statements by the applicant regarding advertising or sales figures or other facts that may show acquired distinctiveness would normally be presented in the form of affidavits, or declarations under 37 C.F.R. §2.20, signed by the applicant, verification may not be required for other types of evidence. The examining attorney will determine whether the evidence relied on is of a nature that requires that it be verified by the applicant.

### **1212.08 Section 44 and §66(a) Applications and Distinctiveness**

In applications based on §44(d), §44(e), or §66(a) of the Trademark Act, registration may be sought under §2(f) on a showing that the mark has acquired distinctiveness in commerce that may lawfully be regulated by Congress. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985). Dates of first use do not have to be stated in an application based solely on §44 or §66. However, reference to length of use or information as to specific dates of use will be important as part of the evidence presented in support of the claim of acquired distinctiveness.

The applicant may not rely on use other than use in commerce that may be regulated by the United States Congress in establishing acquired distinctiveness. Use solely in a foreign country is not evidence of acquired

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

distinctiveness in the United States. *In re Rogers*, 53 USPQ2d 1741 (TTAB 1999).

### **1212.09 Intent-to-Use Applications and Distinctiveness**

#### **1212.09(a) Section 2(f) Claim Requires Prior Use**

Section 2(f), 15 U.S.C. §1052(f), is limited by its terms to “a mark used by the applicant.” A claim of distinctiveness under §2(f) is normally not filed in a §1(b) application before the applicant files an amendment to allege use or a statement of use, because a claim of acquired distinctiveness, by definition, requires prior use.

However, an intent-to-use applicant who has used the mark on related goods or services may file a claim of acquired distinctiveness under §2(f) before filing an amendment to allege use or statement of use, if the applicant can establish that, as a result of the applicant’s use of the mark on other goods or services, the mark has become distinctive of the goods or services in the intent-to-use application, and that this previously created distinctiveness will transfer to the goods and services in the intent-to-use application when use in commerce begins. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001).

The Trademark Trial and Appeal Board has set forth the requirements for showing that a mark in an intent-to-use application has acquired distinctiveness:

The required showing is essentially twofold. First, applicant must establish, through the appropriate submission, the acquired distinctiveness of the same mark in connection with specified other goods and/or services in connection with which the mark is in use in commerce. All of the rules and legal precedent pertaining to such a showing in a use-based application are equally applicable in this context.... Second, applicant must establish, through submission of relevant evidence rather than mere conjecture, a sufficient relationship between the goods or services in connection with which the mark has acquired distinctiveness and the goods or services recited in the intent-to-use application to warrant the conclusion that the previously created distinctiveness will transfer to the goods or services in the application upon use.

*In re Rogers*, 53 USPQ2d 1741, 1744 (TTAB 1999).

To satisfy the first element, the applicant must establish acquired distinctiveness as to the other goods or services by appropriate evidence, such as ownership of a prior registration for the same mark for related goods or services (see TMEP §§1212.04 *et seq.*), a *prima facie* showing of acquired

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

distinctiveness based on five years' use of the same mark with related goods or services (see TMEP §§1212.05 *et seq.*), or actual evidence of acquired distinctiveness for the same mark with respect to the other goods or services (see TMEP §§1212.06 *et seq.*).

To satisfy the second element, applicant must submit evidence showing “the extent to which the goods or services in the intent-to-use application are related to the goods or services in connection with which the mark is distinctive, and that there is a strong likelihood that the mark’s established trademark function will transfer to the related goods or services when use in commerce occurs.” *In re Rogers*, 53 USPQ2d at 1745.

The fact that a mark is famous in connection with certain goods or services does *not* necessarily lead to the conclusion that, upon use, distinctiveness will transfer to use of the mark in connection with unrelated goods or services in an intent-to-use application. In *Rogers*, the Board stated that:

The owner of a famous mark must still establish a strong likelihood of transference of the trademark function to the goods or services identified in the intent-to-use application. This factually-based determination will still involve establishing some degree of relationship between the goods or services for which the mark is famous and the goods or services in the intent-to-use application.

53 USPQ2d at 1745-1746.

An applicant whose application is based on use in commerce under 15 U.S.C. §1051(a) may also base a claim of acquired distinctiveness under §2(f) on long use of the mark on related goods or services, if the applicant meets the requirements set forth above.

### **1212.09(b) Claim of §2(f) “in Part” in §1(b) Application**

An intent-to-use applicant may also file a claim of acquired distinctiveness under §2(f) of the Trademark Act as to part of a mark before filing an acceptable amendment to allege use or statement of use. The claim must indicate that the applicant has already used the relevant part of the mark in commerce on or in connection with the specified goods or services or other goods or services as discussed above. See TMEP §1212.02(f) regarding claims of §2(f) distinctiveness “in part.”

Evidence in support of such a claim may consist of (1) ownership of a prior registration covering the relevant part of the mark and the same or related goods or services (see TMEP §§1212.04 *et seq.*); (2) a *prima facie* showing of distinctiveness based on five years' use of the relevant part of the mark with the same or related goods or services (see TMEP §§1212.05 *et seq.*); or (3) actual evidence of acquired distinctiveness of the relevant part of the mark

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

with respect to the same or related goods or services (see TMEP §§1212.06 *et seq.*). The examining attorney should consider the claim in the same manner as any other claim under §2(f).

If the examining attorney determines that the applicant has established acquired distinctiveness as to the relevant part of the mark, the examining attorney should withdraw any refusal related to the nondistinctive character of that part of the mark.

### 1212.10 Printing “§2(f)” Notations

Currently, when a mark is registered under §2(f), the Office prints a “2(f)” notation in the *Official Gazette* and on the certificate of registration. However, there was a period of time in the past when the Office did not print this notation. Therefore, the absence of a “§2(f)” notation on an older registration does not necessarily mean that the mark was registered without resort to §2(f).

The examining attorney should ensure that the §2(f) claim has been entered into the TRAM database, so that it will be printed in the *Official Gazette* and on the certificate of registration. See TMEP §817 regarding preparation of an application for publication or issuance.

### 1213 Disclaimer of Elements in Marks

*15 U.S.C. §1056. Disclaimers.*

*(a) The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered.*

*(b) No disclaimer, including those made under subsection (e) of section 7 of this Act, shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall have become distinctive of his goods or services.*

In a trademark application or registration, a disclaimer is a statement that the applicant or registrant does not claim the exclusive right to use a specified element or elements of the mark. A disclaimer may be included in an application as filed or may be added by amendment, *e.g.*, to comply with a requirement by the examining attorney.

The purpose of a disclaimer is to permit the registration of a mark that is registrable as a whole but contains matter that would not be registrable standing alone, without creating a false impression of the extent of the registrant's right with respect to certain elements in the mark. As stated in

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*Horlick's Malted Milk Co. v. Borden Co.*, 295 F. 232, 234, 1924 C.D. 197, 199 (D.C. Cir. 1924):

[T]he fact that a mark contains descriptive words is not enough to warrant a refusal to register it. Unless it consists only of such words, it may not be refused a place on the registry of the Patent Office.

The significance of a disclaimer is conveyed in the following statement:

As used in trade mark registrations, a disclaimer of a component of a composite mark amounts merely to a statement that, in so far as that particular registration is concerned, no rights are being asserted in the disclaimed component standing alone, but rights are asserted in the composite; and the particular registration represents only such rights as flow from the use of the composite mark.

*Sprague Electric Co. v. Erie Resistor Corp.*, 101 USPQ 486, 486-87 (Comm'r Pats. 1954).

A disclaimer may be limited to pertain to only certain classes, or to only certain goods or services.

### **1213.01 History of Disclaimer Practice**

There was no statutory authority for disclaimer prior to 1946. As various court decisions were rendered, Office practice fluctuated from, first, registering the composite mark without a qualifying statement; later, requiring a statement in the application disclaiming the unregistrable matter in the mark; and, finally, requiring removal of the unregistrable matter from the mark on the drawing. This fluctuation ended with the decision of *Estate of P.D. Beckwith v. Comm'r of Pats.*, 252 U.S. 538, 1920 C.D. 471 (1920), in which the United States Supreme Court held that to require the removal of descriptive matter from a composite mark was erroneous, and commended the practice of a statement of disclaimer. Thus the practice of disclaimer was established officially in the Office, although still without statutory support.

The Trademark Act of 1946 created a statutory basis for the practice of disclaimer in §6, 15 U.S.C. §1056.

#### **1213.01(a) Discretion in Requiring Disclaimer**

When first incorporated in the Trademark Act in 1946, §6 stated that the Director *shall* require unregistrable matter to be disclaimed. Under the impetus of the mandatory word "shall," it became customary to require a disclaimer for every occurrence, in any type of combination, of every term or

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

symbol which by itself might be refused registration in the first instance under the 1946 Act.

In 1962, §6 was amended to state that the Director *may* require the applicant to disclaim an unregistrable component of a mark otherwise registrable. The change from “shall” to “may” justifies the exercise of greater discretion by examining attorneys in determining whether a disclaimer is necessary.

Examining attorneys should keep in mind the basic purpose of disclaimers, which is to indicate in the record that a significant element of a composite mark is not being appropriated apart from the composite. The examining attorney should not require that an element of a mark be disclaimed when a disclaimer would be unnecessary, *e.g.*, when the form or degree of integration of an element in the composite makes it obvious that no claim is being made in any element apart from the composite.

### **1213.01(b) Refusal to Register Because of Failure to Disclaim**

Failure to comply with a requirement to disclaim was held to be a basis for refusal to register before the Act of 1946. See *In re American Cyanamid & Chemical Corp.*, 99 F.2d 964, 39 USPQ 445 (C.C.P.A. 1938). Failure to comply with a requirement to disclaim also was held to justify a refusal after the 1946 Act. See *In re Hercules Fasteners, Inc.*, 203 F.2d 753, 97 USPQ 355 (C.C.P.A. 1953); *Ex parte Knomark Mfg. Co., Inc.*, 118 USPQ 182 (PO Ex. Ch. 1958). Even after amendment of the pertinent language of §6 of the 1946 Act to the discretionary wording “may require the applicant to disclaim,” registration may be refused if an applicant does not comply with a requirement for a disclaimer made by the examining attorney. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (C.C.P.A. 1975); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

If an applicant fails to comply with the examining attorney’s requirement for a disclaimer, the examining attorney should make the requirement final if the application is otherwise in condition for a final action.

### **1213.01(c) Voluntary Disclaimer of Registrable or Unregistrable Matter**

Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), was amended in 1962 to add the sentence, “An applicant may voluntarily disclaim a component of a mark sought to be registered.” Disclaimers volunteered by applicants generally should conform to the guidelines set forth in this Manual. See TMEP §§1213.08 *et seq.*

In *In re MCI Communications Corp.*, 21 USPQ2d 1534 (Comm’r Pats. 1991), the Commissioner held that §6 of the Act permits an applicant to disclaim

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

matter voluntarily, regardless of whether the matter is registrable or unregistrable. The Commissioner specifically overruled all previous Office authority holding otherwise. (Previous practice prohibited the entry of disclaimers of registrable components of marks.) Therefore, if an applicant offers a disclaimer of any matter in a mark, the Office will accept the disclaimer.

The *MCI* decision states emphatically that the entry of a voluntary disclaimer does *not* render registrable a mark that is otherwise unregistrable under relevant sections of the Trademark Act, such as §2(d) and §2(e). The examining attorney must evaluate the entire mark, including any disclaimed matter, to determine registrability. Furthermore, the decision states that the applicant may not disclaim the entire mark. See TMEP §1213.06.

An applicant may volunteer a disclaimer in the mistaken belief that a disclaimer would be required when, in fact, Office policy would not require a disclaimer. If this appears to be the case, the examining attorney should offer the applicant the opportunity to withdraw the disclaimer.

### **1213.02 “Composite” Marks**

A “composite” mark may consist of a word or words combined with a design or designs; it may consist solely of words, when there are separable word elements; or it may consist solely of separable design elements. An unregistrable component of a composite mark is subject to disclaimer. However, if a composite mark (or portion thereof) is “unitary,” an individual component of the mark (or of the unitary portion) that would otherwise be unregistrable need not be disclaimed. See TMEP §§1213.05 *et seq.*

The same principles apply to disclaimer of an unregistrable component of a composite mark, whether the mark is a combination of wording and designs or consists entirely of wording or entirely of designs.

### **1213.03 Disclaimer of Unregistrable Components of Marks**

#### **1213.03(a) “Unregistrable Components” in General**

*Estate of P.D. Beckwith v. Comm’r of Pats.*, 252 U.S. 538, 1920 C.D. 471 (1920), and other disclaimer decisions before the Trademark Act of 1946 dealt with disclaiming descriptive or generic matter. Section 6 of the Act referred initially to “unregistrable matter” and, since the 1962 amendment, now refers to “an unregistrable component.”

Typically an unregistrable component of a registrable mark is the name of the goods or services, other matter that does not indicate source, or matter that is merely descriptive or deceptively misdescriptive of the goods or services, or primarily geographically descriptive of them.



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

Office practice does not require disclaimer of a surname. *Ex parte Norquist Products, Inc.*, 109 USPQ 399 (Comm'r Pats. 1956) (disclaimer of "NORQUIST" found unnecessary in application to register mark comprising "NORQUIST CORONET" on an oval background featuring a coronet, for tables and chairs). In that decision, the Commissioner stated as follows:

Section [2(e)(4)] of the statute does not contemplate the dissection of a composite mark to determine whether a word which constitutes an integral part of the mark is primarily merely a surname. Rather, it contemplates an examination of the mark in its entirety and an evaluation of the commercial impression created by the entire mark. A word which is primarily merely a surname may lose that significance when it appears in a distinctive composite.

*Norquist*, at 400. The addition of other registrable matter creates a composite mark with an overall impression that is not primarily merely that of a surname. If the additional matter is minimal or unregistrable, then the mark is primarily merely a surname and refusal under §2(e)(4) of the Act, 15 U.S.C. §1052(e)(4) (formerly §2(e)(3), 15 U.S.C. §1052(e)(3)), should be made. See *In re E. Martinoni Co.*, 189 USPQ 589 (TTAB 1975). See TMEP §§1211.01(b) *et seq.* regarding the combination of a surname with additional matter.

In cases where registration of a mark is barred under the Trademark Act (*e.g.*, under §§2(a), 2(b), 2(c), 2(d) and 2(e)(3)), a disclaimer of an unregistrable component will not render the mark registrable. See, *e.g.*, *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798, 808 (TTAB 1984) ("While the disclaimer is appropriate to indicate that respondent claims no proprietary right in the disclaimed words, the disclaimer does not affect the question of whether the disclaimed matter deceives the public, since one cannot avoid the Section 2(a) deceptiveness prohibition by disclaiming deceptive matter apart from the mark as a whole."). See TMEP §1213.10 concerning disclaimers with regard to likelihood of confusion, and TMEP §§1210.06(a) and (b) regarding disclaimer of geographic terms in composite marks.

### **1213.03(b) Generic Matter and Matter Which Does Not Function as a Mark**

If a mark is comprised in part of matter that, as applied to the goods/services, is generic or does not function as a mark, the matter must be disclaimed to permit registration on the Principal Register (including registration under §2(f) of the Act) or on the Supplemental Register. If, however, matter that would otherwise be generic or would not function as a mark is part of a unitary mark or part of a separable unitary element of a mark, the examining attorney should not require a disclaimer of the matter. See TMEP §1213.05.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

See TMEP §1212.02(e) regarding disclaimers of unregistrable components in applications to register marks on the Principal Register under §2(f). See also *In re Creative Goldsmiths of Washington, Inc.*, 229 USPQ 766, 768 (TTAB 1986) (“[I]t is within the discretion of an Examining Attorney to require the disclaimer of an unregistrable component (such as a common descriptive, or generic, name) of a composite mark sought to be registered on the Principal Register under the provisions of Section 2(f).”).

Regarding disclaimers of unregistrable components in applications to register marks on the Supplemental Register, see *In re Water Gremlin Co.*, 635 F.2d 841, 845 n.6, 208 USPQ 89, 91 n.6 (C.C.P.A. 1980) (“Section 6 is equally applicable to the Supplemental Register.”); *In re Wella Corp.*, 565 F.2d 143, 196 USPQ 7 (C.C.P.A. 1977) (mark comprising stylized lettering of BALSAM, with disclaimer of “BALSAM,” found registrable on Supplemental Register for hair conditioner and hair shampoo); *In re Carolyn’s Candies, Inc.*, 206 USPQ 356, 360 (TTAB 1980) (“Section 6 of the Trademark Act of 1946, which provides for the disclaimer of ‘unregistrable matter’, does not limit the disclaimer practice to marks upon the Principal Register.”).

### **1213.03(c) Pictorial Representations of Descriptive Matter**

An accurate pictorial representation of descriptive matter is equivalent to the written expression and, therefore, must be disclaimed pursuant to the same rules applicable to merely descriptive wording. See *Thistle Class Association v. Douglass & McLeod, Inc.*, 198 USPQ 504 (TTAB 1978) (thistle design found synonymous to the word “thistle,” which is used in a descriptive sense to designate a class of sailboats).

No disclaimer of highly stylized pictorial representations of descriptive matter should be required because the design element creates a distinct commercial impression. See *In re LRC Products Ltd.*, 223 USPQ 1250, 1252 (TTAB 1984) (outline of two gloved hands held arbitrary and fanciful), and cases cited therein.

### **1213.03(d) Entity Designations**

Words or abbreviations in a trade name designating the legal character of an entity (e.g., Corporation, Corp., Co., Inc., Ltd., etc.) must be disclaimed because an entity designation has no source-indicating capacity. *In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213, 1215 (TTAB 2000) (“PRESS,” as applied to a printing or publishing establishment, “is in the nature of a generic entity designation which is incapable of serving a source-indicating function”); *In re The Paint Products Co.*, 8 USPQ2d 1863, 1866 (TTAB 1988) (“PAINT PRODUCTS CO.’ is no more registrable for goods emanating from a company that sells paint products than it would be as a service mark for the retail paint store services offered by such a company”); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 919 (TTAB 1984) (“the element ‘INC.’ [in

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

PACKAGING SPECIALISTS, INC.] being recognized, in trademark evaluation, to have no source indication or distinguishing capacity”).

The only exception to this practice is where the entity designation is used in an arbitrary manner (e.g., “THE LTD.” or “KIDS INC.” for clothing). In this case the term has trademark significance and a disclaimer should not be required.

### 1213.04 Trade Names

Unregistrable components of trade names or company names shall be disclaimed pursuant to the same rules that apply generally to trademarks. See *In re Martin’s Famous Pastry Shoppe, Inc.*, 221 USPQ 364 (TTAB 1984), *aff’d on other grounds*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

### 1213.05 “Unitary” Marks

A mark or portion of a mark is considered “unitary” when it creates a commercial impression separate and apart from any unregistrable component. That is, the elements are so merged together that they cannot be divided to be regarded as separable elements. If the matter that comprises the mark or relevant portion of the mark is unitary, no disclaimer of an element, whether descriptive, generic or otherwise, is required.

The examining attorney must consider a number of factors in determining whether matter is part of a single or unitary mark: whether it is physically connected by lines or other design features; the relative location of the respective elements; and the meaning of the terminology as used on or in connection with the goods or services. *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 1561, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991).

For example, a descriptive word can be combined with nondescriptive wording in such a way that the descriptive significance of the word in relation to the goods is lost and the combination functions as a unit. This happens when the combination itself has a new meaning. An example is the term “Black Magic,” which has a distinct meaning of its own as a whole. The word “black” is not intended to have color significance in relation to the goods, and should not be disclaimed even if the mark is applied to goods that are black in color.

In the following cases, marks were considered unitary: *B. Kuppenheimer & Co., Inc. v. Kayser-Roth Corp.*, 326 F.2d 820, 822, 140 USPQ 262, 263 (C.C.P.A. 1964) (KUPPENHEIMER and SUP-PANTS combined so that they shared the double “P,” making “an indivisible symbol rather than two divisible words”); *In re Hampshire-Designers, Inc.*, 199 USPQ 383 (TTAB 1978) (DESIGNERS PLUS+ for sweaters held unitary; thus, no disclaimer of “DESIGNERS” deemed necessary); *In re J.R. Carlson Laboratories, Inc.*,

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

183 USPQ 509 (TTAB 1974) (E GEM for bath oil containing vitamin E held unitary; thus, no disclaimer of “E”).

In the following cases, where marks were found *not* to be unitary: *Dena Corp., supra* (EUROPEAN FORMULA above a circular design on a dark square or background considered not unitary); *In re Lean Line, Inc.*, 229 USPQ 781 (TTAB 1986) (LEAN LINE for low calorie foods considered not unitary; requirement for disclaimer of “LEAN” held proper); *In re IBP, Inc.*, 228 USPQ 303 (TTAB 1985) (IBP SELECT TRIM for pork considered not unitary; refusal of registration in the absence of a disclaimer of “SELECT TRIM” affirmed); *In re Uniroyal, Inc.*, 215 USPQ 716 (TTAB 1982) (UNIROYAL STEEL/GLAS for vehicle tires considered not unitary; requirement for disclaimer of “STEEL/GLAS” deemed appropriate); *In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981) (PHACTS POCKET PROFILE, for personal medication history summary and record forms, considered not unitary; refusal to register in the absence of a disclaimer of “POCKET PROFILE” affirmed. “A disclaimer of a descriptive portion of a composite mark is unnecessary only where the form or degree of integration of that element in the composite makes it obvious that no claim other than of the composite would be involved. That is, if the elements are so merged together that they cannot be regarded as separable elements, the mark is a single unitary mark and not a composite mark and no disclaimer is necessary.”); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977) (PRESTO BURGER for electrical cooking utensils not unitary; requirement for disclaimer of “BURGER” affirmed).

The examining attorney must exercise discretion in determining whether a mark or portion of a mark is unitary, in which case a disclaimer of a nondistinctive component should not be required. It is not always easy to articulate why matter is unitary. However, if one cannot spell out exactly why a mark is unitary, then the mark is probably not unitary and nondistinctive elements within the mark must be disclaimed. In general, a mark is unitary if the whole is something more than the sum of its parts.

See TMEP §§1213.05(a) *et seq.* for examples of different types of unitary marks.

### **1213.05(a) Compound Word Marks**

A compound word mark is comprised of two or more distinct words (or words and syllables) that are represented as one word (*e.g.*, BOOKCHOICE, PROSHOT, MAXIMACHINE, PULSAIR).

If a compound word mark consists of an unregistrable component and a registrable component combined into a single word, no disclaimer of the unregistrable component of the compound word will be required.

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

If a composite mark consists of a compound word combined with arbitrary matter, and the compound word is unregistrable, a disclaimer of the compound word may be required.

See TMEP §807.12(e) regarding drawings of compound word marks.

### **1213.05(a)(i) Telescoped Words**

A telescoped mark is one that comprises two or more words that share letters (e.g., HAMERICAN, ORDERRECORDER, SUPERINSE, VITAMINSURANCE, POLLENERGY). See TMEP §807.12(e) regarding drawings for telescoped marks.

A telescoped word is considered unitary. Therefore, no disclaimer of an individual portion of a telescoped word is required, regardless of whether the mark is shown in a standard character or special form drawing.

However, if a telescoped word is itself unregistrable, a disclaimer of the telescoped word may be required. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) (affirming refusal to register FIRSTIER and design for banking services in the absence of a disclaimer of "FIRST TIER," in view of evidence that the term describes a class of banks). See TMEP §1213.08(c) regarding disclaimers of misspelled words in general.

### **1213.05(a)(ii) Compound Words Formed with Hyphen or Other Punctuation**

When a compound word is formed by hyphenating two words or terms, one of which would be unregistrable alone, no disclaimer is necessary. "X" *Laboratories, Inc. v. Odorite Sanitation Service of Baltimore, Inc.*, 106 USPQ 327, 329 (Comm'r Pats. 1955) (requirement for a disclaimer of "TIRE" deemed unnecessary in application to register TIRE-X for a tire cleaner).

Word marks consisting of two terms joined by an asterisk (e.g., RIB\*TYPE), a slash (e.g., RIB/TYPE) or a raised period (e.g., RIB°TYPE) are analogous to hyphenated words. Therefore no disclaimer of portions of marks formed by asterisks, slashes or raised periods is necessary.

### **1213.05(b) Slogans**

A registrable slogan is one that is used in a trademark sense. A registrable slogan is considered unitary and should not be broken up for purposes of requiring a disclaimer.

If an unregistrable slogan is a component of a registrable mark, then the examining attorney should require that the slogan be disclaimed.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If a mark consists entirely of a slogan that is merely descriptive or that is not being used as a mark, then registration should be refused. See *In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984) (AMERICA'S FRESHEST ICE CREAM for flavored ices, etc., held incapable of distinguishing applicant's goods and unregistrable on the Supplemental Register); *In re Wakefern Food Corp.*, 222 USPQ 76 (TTAB 1984) (WHY PAY MORE! held to be an unregistrable common commercial phrase).

### 1213.05(c) "Double Entendre"

A "double entendre" is a word or expression capable of more than one interpretation. For trademark purposes, a "double entendre" is an expression that has a double connotation or significance *as applied to the goods or services*. The mark that comprises the "double entendre" will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services.

A true "double entendre" is unitary by definition. An expression that is a "double entendre" should not be broken up for purposes of requiring a disclaimer. See *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983), where the Board found inappropriate a requirement for a disclaimer of "LIGHT" apart from the mark "LIGHT N' LIVELY" for reduced calorie mayonnaise, stating as follows:

The mark "LIGHT N' LIVELY" as a whole has a suggestive significance which is distinctly different from the merely descriptive significance of the term "LIGHT" per se. That is, the merely descriptive significance of the term "LIGHT" is lost in the mark as a whole. Moreover, the expression as a whole has an alliterative lilted cadence which encourages persons encountering it to perceive it as a whole.

See also *In re Symbra'ette, Inc.*, 189 USPQ 448 (TTAB 1975) (SHEER ELEGANCE for panty hose held to be a registrable unitary expression; thus, no disclaimer of "SHEER" considered necessary).

The following cases illustrate situations where marks were considered to be "double entendres" and, therefore, registrable unitary marks: *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE for bakery products); *In re Simmons Co.*, 189 USPQ 352 (TTAB 1976) (THE HARD LINE for mattresses and bed springs); *In re Delaware Punch Co.*, 186 USPQ 63 (TTAB 1975) (THE SOFT PUNCH for noncarbonated soft drink); *In re National Tea Co.*, 144 USPQ 286 (TTAB 1965) (NO BONES ABOUT IT for fresh pre-cooked ham).

The multiple interpretations that make an expression a "double entendre" must be associations that the public would make fairly readily. See *In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986) (EXPRESSERVICE held

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

merely descriptive for banking services, despite applicant's argument that the term also connotes the Pony Express, the Board finding that, in the relevant context, the public would not make that association).

If all meanings of a "double entendre" are merely descriptive in relation to the goods, then the mark comprising the "double entendre" should be refused registration as merely descriptive.

### **1213.05(d) Incongruity**

If two or more terms are combined in a mark to create an incongruity (e.g., URBAN SAFARI, MR. MICROWAVE, DR. GRAMMAR), the mark is unitary and no disclaimer of nondistinctive individual elements is necessary.

### **1213.05(e) Sound Patterns**

At times a mark will form a unitary whole through a rhyming pattern, use of alliteration or some other use of sound that creates a distinctive impression. In such a case, the mark is regarded as unitary and individual elements should not be disclaimed. See *In re Kraft, Inc.*, 218 USPQ 571 (TTAB 1983) (LIGHT N' LIVELY found to be a unitary term not subject to disclaimer). Compare *In re Lean Line, Inc.*, 229 USPQ 781, 782 (TTAB 1986) (LEAN LINE not considered unitary; "there is nothing in the record to suggest that the mere fact that both words which form the mark begin with the letter 'L' would cause purchasers to miss the merely descriptive significance of the term 'LEAN' or consider the entire mark to be a unitary expression.")

### **1213.05(f) Display of Mark**

The visual presentation of a mark may be such that the words and/or designs form a unitary whole. In such a case, disclaimer of individual nondistinctive elements is unnecessary. See, e.g., *In re Texsun Tire and Battery Stores, Inc.*, 229 USPQ 227, 229 (TTAB 1986) ("[T]he portion of the outline of the map of Texas encircled as it is with the representation of a tire and surrounded by a rectangular border results in a unitary composite mark which is unique and fanciful.").

### **1213.06 Entire Mark May Not Be Disclaimed**

An entire mark may not be disclaimed. If a mark is not registrable as a whole, a disclaimer will not make it registrable. There must be something in the combination of elements in the mark, or something of sufficient substance or distinctiveness over and above the matter being disclaimed, that would make the composite registrable. See *In re Anchor Hocking Corp.*, 223 USPQ 85 (TTAB 1984); *Ex parte Ste. Pierre Smirnoff Fls, Inc.*, 102 USPQ 415 (Comm'r Pats. 1954).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*In Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991), the Court of Appeals for the Federal Circuit stated as follows:

[U]nder traditional disclaimer practice, an applicant could not disclaim all elements of a composite mark. Section 1056(a) codified this policy. A mark which must be entirely disclaimed has no ‘unregistrable component,’ but is instead entirely nonregistrable. In other words, a mark which must be entirely disclaimed has no ‘otherwise registrable’ parts. Therefore, such marks do not qualify as composite marks for which the Commissioner may require a disclaimer.

### **1213.07 Removal Rather than Disclaimer**

When it is not clear that matter forms part of a mark, the examining attorney must consider whether it is appropriate for the applicant to amend the drawing of the mark to remove the matter, rather than to disclaim it. See TMEP §807.14(a) regarding deletion of matter from the mark on a drawing. An applicant may not amend the drawing if the amendment would constitute a material alteration of the mark. 37 C.F.R. §2.72; TMEP §§807.14 *et seq.*

There are circumstances under which the applicant may omit or remove matter from the mark shown in the drawing, if the overall commercial impression is not altered. See *Institut National Des Appellations D’Origine v. Vintners International Co. Inc.*, 958 F.2d 1574, 1582, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992); *In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257 (C.C.P.A. 1950). However, matter may not be omitted from the drawing if the omission would result in an incomplete representation of the mark, sometimes referred to as “mutilation.” See TMEP §807.12(d). In other words, the matter presented for registration must convey a single distinct commercial impression. If a mark is not unitary in this sense, it cannot be registered. *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991).

### **1213.08 Form of Disclaimers**

#### **1213.08(a) Wording of Disclaimer**

##### **1213.08(a)(i) Standardized Printing Format for Disclaimer**

Since November 9, 1982, disclaimers for marks published for opposition and those registered on the Supplemental Register are printed in a standardized form in the *Official Gazette*, regardless of the text submitted. Disclaimers are in the standardized format in certificates of registration on the Supplemental Register issued as of that date. Disclaimers are in the standardized format in certificates of registration on the Principal Register issued as of February 1, 1983. The disclaimed matter is taken from the disclaimer of record and



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

inserted into the standardized disclaimer format for printing and data base purposes. The standardized disclaimer text is as follows:

No claim is made to the exclusive right to use \_\_\_\_\_,  
apart from the mark as shown.

See notice at 1022 TMOG 44 (September 28, 1982). See also *In re Owatonna Tool Co.*, 231 USPQ 493, 495 (Comm'r Pats. 1983) (“[T]he use of the standardized form is solely for the purpose of printing and data base purposes, not for the limitation of registrant’s rights.”).

For the record only, examining attorneys will accept disclaimers with additional statements pertaining to reservation of common law rights, although §6 of the Trademark Act of 1946 states that no disclaimer shall prejudice or affect the applicant’s or registrant’s rights then existing or thereafter arising in the disclaimed matter. Disclaimers with these additional statements can be entered by examiner’s amendment. The examining attorney must inform the applicant or attorney who authorizes the amendment that the disclaimer will be printed in the standardized format.

### **1213.08(a)(ii) Unacceptable Wording for Disclaimer**

Wording that claims matter, rather than disclaims it, is not acceptable. A disclaimer should be no more than a statement that identifies matter to which the applicant may not have exclusive rights apart from what is shown on the drawing.

Therefore, statements that the applicant “claims” certain matter in the association shown are not acceptable. The examining attorney should require correction of this wording and of variations that amount to the same thing. Likewise, a statement that the mark is “not claimed except in the association shown,” or similar wording, is not acceptable, and the examining attorney should require correction. See *Textron Inc. v. Pilling Chain Co., Inc.*, 175 USPQ 621, 622 (TTAB 1972), concerning an application which included the statement, “The mark is not to be claimed except in the setting presented.” The Board found this wording unacceptable, noting, “The alleged disclaimer filed by applicant is in such vague terms that it actually disclaims nothing.”

### **1213.08(b) Disclaimer of Unregistrable Matter in Its Entirety**

Unregistrable matter must be disclaimed in its entirety. For example, when requiring a disclaimer of terms that form a grammatically or otherwise unitary expression (e.g., “SHOE FACTORY, INC.”), the examining attorney must require that they be disclaimed in their entirety. See, e.g., *In re Wanstrath*, 7 USPQ2d 1412, 1413 (Comm’r Pats. 1987) (denying petitioner’s request to substitute separate disclaimers of “GLASS” and “TECHNOLOGY” for the disclaimer of “GLASS TECHNOLOGY” in its registration of GT GLASS

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

TECHNOLOGY in stylized form, the Commissioner finding “GLASS TECHNOLOGY” to be a unitary expression and noting, “Disclaimers of individual components of complete descriptive phrases are improper.”); *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798, 804 n.3 (TTAB 1984) (“CERTIFIED HEARING AID AUDIOLOGIST” found to be “a unitary expression that should be disclaimed in its entirety”); *In re Surelock Mfg. Co., Inc.*, 125 USPQ 23, 24 (TTAB 1960) (proposed disclaimer of “THE” and “RED” and “CUP” held unacceptable to comply with requirement for disclaimer of “THE RED CUP,” the Board concluding, “A disclaimer of the individual components of the term ‘THE RED CUP,’ under the circumstances, is meaningless and improper.”).

This standard should be construed strictly; therefore, disclaimer of individual words separately will usually be appropriate only when the words being disclaimed are separated by registrable wording.

### **1213.08(c) Disclaimer of Misspelled Words**

Marks often comprise words that may be characterized as “misspelled.” For example, marks may comprise terms that are “telescoped” (see TMEP §1213.05(a)(i)) or terms that are phonetic equivalents of particular words but spelled in a manner that varies from the ordinary spelling of such words.

If a mark comprises a word or words that are misspelled but nonetheless must be disclaimed, the examining attorney should require disclaimer of the word or words in the correct spelling. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Newport Fastener Co. Inc.*, 5 USPQ2d 1064, 1067 n. 4 (TTAB 1987). The entry of a disclaimer does not necessarily render registrable a mark that is otherwise unregistrable.

If the examining attorney has not required any disclaimer of misspelled wording because a disclaimer is not necessary under Office policy, the applicant may provide a disclaimer of the wording as spelled in the mark or in its correct spelling voluntarily. In such a case, the examining attorney should accept the disclaimer. Again, the disclaimer does not necessarily render an otherwise unregistrable mark registrable. The examining attorney must consider the entire mark, including the disclaimed matter, to determine whether the entire mark is registrable.

### **1213.08(d) Disclaimer of Non-English Words**

Non-English wording that comprises an unregistrable component of a mark is subject to disclaimer. See *Bausch & Lomb Optical Co. v. Overseas Finance & Trading Co. Inc.*, 112 USPQ 6, 8 (Comm’r Pats. 1956) (noting that “Kogaku,” the transliteration of the Japanese word for “optical,” was properly disclaimed).

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

If translated non-English wording must be disclaimed, the actual non-English wording should be disclaimed, not the English translation. The applicant must disclaim the wording that actually appears in the mark, not the translated version. For non-Latin characters, the following formats are suggested:

No claim is made to the exclusive right to use “[specify transliteration of non-Latin characters]” apart from the mark as shown.

or

No claim is made to the exclusive right to use the non-Latin characters that mean “[specify English translation]” apart from the mark as shown.

See TMEP §§809 *et seq.* regarding translation of non-English wording in marks.

### **1213.09 Mark of Another May Not Be Registered with Disclaimer**

Normally, a mark that includes a mark registered by another person must be refused registration under 15 U.S.C. §1052(d) based on likelihood of confusion. A refusal of registration under §2(d) may not be avoided by disclaiming the mark of another. *Cf. In re Franklin Press, Inc.*, 597 F.2d 270, 201 USPQ 662 (C.C.P.A. 1979) (permitting disclaimer of informational phrase indicating that applicant’s employees are represented by certain labor organizations). See TMEP §1213.10 regarding disclaimer in relation to likelihood of confusion.

### **1213.10 Disclaimer in Relation to Likelihood of Confusion**

A disclaimer does not remove the disclaimed matter from the mark. The mark must still be regarded as a whole, including the disclaimed matter, in evaluating similarity to other marks. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 672, 223 USPQ 1281, 1282 (Fed. Cir. 1984); *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed. Cir. 1983); *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 USPQ 433 (C.C.P.A. 1965); *In re MCI Communications Corp.*, 21 USPQ2d 1534, 1538-39 (Comm’r Pats. 1991).

Typically, disclaimed matter will not be regarded as the dominant, or most significant, feature of a mark. However, since the Trademark Act permits an applicant to voluntarily disclaim registrable matter (see TMEP §1213.01(c)), disclaimed matter may be dominant or significant in some cases. As noted in *In re MCI Communications Corp.*, 21 USPQ2d at 1539, “Examining Attorneys will continue to consider the question of likelihood of confusion,

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

under Section 2(d) of the statute, in relation to the marks as a whole, including any voluntarily disclaimed matter.”

### 1213.11 Acquiring Rights in Disclaimed Matter

In *Estate of P.D. Beckwith v. Comm’r of Pats.*, 252 U.S. 538, 545, 1920 C.D. 471, 477 (1920), the United States Supreme Court stated, regarding registration of a mark with a disclaimer, that “the registrant would be precluded by his disclaimer from setting up in the future any exclusive right to the disclaimed part of it.” Subsequently, that principle was applied literally; registrants were prohibited from asserting that disclaimed matter had acquired secondary meaning. See *Shaler Co. v. Rite-Way Products, Inc.*, 43 USPQ 425 (6<sup>th</sup> Cir. 1939).

The situation was changed by the Trademark Act of 1946, which provided that “disclaimer shall not prejudice or affect the applicant’s or owner’s rights then existing or thereafter arising in the disclaimed matter, nor shall such disclaimer prejudice or affect the applicant’s or owner’s rights of registration on another application of later date if the disclaimed matter has become distinctive of the applicant’s or owner’s goods or services.” In 1962, the statutory provision was amended to read, “No disclaimer ... shall prejudice or affect the applicant’s or registrant’s rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall have become distinctive of his goods or services.” 15 U.S.C. §1056(b).

It is now clear that, aside from generic matter, disclaimed matter is not forever barred from registration, and it can subsequently be considered for registration on either the Principal Register or the Supplemental Register. When an application is filed seeking registration of matter previously disclaimed, it should be examined in the same manner as other applications. See *Quaker Oil Corp. v. Quaker State Oil Refining Corp.*, 161 USPQ 547 (TTAB 1969), *aff’d*, 453 F.2d 1296, 172 USPQ 361 (C.C.P.A. 1972); *Victor Tool & Machine Corp. v. Sun Control Awnings, Inc.*, 299 F. Supp. 868, 162 USPQ 389 (E.D. Mich. 1968), *aff’d*, 411 F.2d 792, 162 USPQ 387 (6<sup>th</sup> Cir. 1969).

Whether or not previously disclaimed matter has become eligible for registration depends on the circumstances and the evidence adduced in the examination process. *Helena Rubinstein, Inc. v. Ladd*, 219 F. Supp. 259, 138 USPQ 106 (D.D.C. 1963), *aff’d*, 141 USPQ 623 (D.C. Cir. 1964); *Roux Distributing Co., Inc. v. Duart Mfg. Co. Ltd.*, 114 USPQ 511 (Comm’r Pats. 1957).

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### 1214 “Phantom” Elements in Marks

In some applications, the applicant seeks to register a “phantom” element (*i.e.*, a word, alpha-numeric designation, or other component that is subject to change) as part of a mark. The applicant represents the changeable or “phantom” element by inserting a blank, or by using dots, dashes, underlining, or a designation such as “XXXX.”

Examples include marks incorporating a date (usually a year), a geographic location, or a model number that is subject to change. While these are some of the most common examples of the types of elements involved, there are many variations.

#### 1214.01 Single Application May Seek Registration of Only One Mark

Where an applicant seeks registration of a mark with a changeable or “phantom” element, the examining attorney should refuse registration under §§1 and 45 of the Trademark Act, 15 U.S.C. §§1051 and 1127, on the ground that the application seeks registration of more than one mark. See *In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999); *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theatres Inc.*, 56 USPQ2d 1538 (TTAB 2000).

In *International Flavors*, the applicant filed three applications to register the designations “LIVING xxxx,” “LIVING xxxx FLAVOR,” and “LIVING xxxx FLAVORS,” for essential oils, flavor substances, and fragrances. Each application included a statement that “[t]he meaning of ‘xxxx’ is for a specific herb, fruit, plant or vegetable.” In upholding the refusal of registration, the Federal Circuit noted that under §22 of the Trademark Act, 15 U.S.C. §1072, registration serves as constructive notice to the public of the registrant’s ownership of the mark and therefore precludes another user from claiming innocent misappropriation as a trademark infringement defense. To make this constructive notice meaningful, the mark as registered must accurately reflect the mark that is used in commerce, so that someone who searches the register for a similar mark will locate the registration. The court stated that “phantom marks” with missing elements “encompass too many combinations and permutations to make a thorough and effective search possible” and, therefore, the registration of these marks does not provide adequate notice to competitors and the public. *International Flavors*, 51 USPQ2d at 1517-18. *Cf. In re Upper Deck Co.*, 59 USPQ2d 1688 (TTAB 2001) (hologram used on trading cards in varying shapes, sizes, contents and positions constitutes more than one “device” as contemplated by §45 of the Trademark Act).

See *also* TMEP §807.01 regarding the requirement that an application be limited to one mark.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1214.02 Agreement of Mark on Drawing With Mark on Specimens or Foreign Registration**

Where an applicant seeks registration of a “phantom mark,” the examining attorney should also consider whether the mark on the drawing is a substantially exact representation of the mark as used on the specimens in a use-based application, or the mark in the home country registration in an application based on Trademark Act §44, 15 U.S.C. §1126. See TMEP §§807.12 *et seq.*

The applicant may amend the mark to overcome a refusal on the ground that the mark on the drawing does not agree with the mark as used on the specimens, or with the mark in the foreign registration, if the amendment is not a material alteration of the mark. See TMEP §§807.14 *et seq.* regarding material alteration.

### **1214.03 “Phantom Marks” in Intent-to-Use Applications**

In an intent-to-use application for which no allegation of use has been filed, it may be unclear whether the applicant is seeking registration of a mark with a changeable element. If an intent-to-use application indicates that the applicant is seeking registration of a “phantom mark” (e.g., if the application includes a statement that “the blank line represents a date that is subject to change”), the examining attorney should issue a refusal of registration under §§1 and 45 of the Trademark Act, 15 U.S.C. §§1051 and 1127, on the ground that the application seeks registration of more than one mark, as discussed above. If it is unclear whether an applicant is seeking registration of a “phantom” mark, the examining attorney should advise the applicant that if the specimens filed with an amendment to allege use under §1(c) of the Trademark Act, 15 U.S.C. §1051(c), or a statement of use under §1(d) of the Act, 15 U.S.C. §1051(d), show that applicant is seeking registration of a mark with a changeable element, registration will be refused on the ground that the application seeks registration of more than one mark. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided before the applicant files an allegation of use, the Office is not precluded from refusing registration on this basis.

### **1214.04 “Phantom Marks” in §44 and §66(a) Applications**

The refusal should be made in applications under §44 and §66(a) as well as §1 of the Trademark Act.

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### 1215 Marks Composed, in Whole or in Part, of Domain Names

#### 1215.01 Background

A domain name is part of a Uniform Resource Locator (“URL”), which is the address of a site or document on the Internet. In general, a domain name is comprised of a second-level domain, a “dot,” and a top-level domain (“TLD”). The wording to the left of the “dot” is the second-level domain, and the wording to the right of the “dot” is the TLD.

*Example:* If the domain name is “ABC.com,” the term “ABC” is a second-level domain and the term “com” is a TLD.

A domain name is usually preceded in a URL by “http://www.” The “http://” refers to the protocol used to transfer information, and the “www” refers to World Wide Web, a graphical hypermedia interface for viewing and exchanging information.

*Generic TLDs.* The following are examples of generic TLDs that are designated for use by the public:

.com	commercial, for-profit organizations
.edu	4-year, degree-granting colleges/universities
.gov	U.S. federal government agencies
.int	international organizations
.mil	U.S. military organizations, even if located outside the U.S.
.net	network infrastructure machines and organizations
.org	miscellaneous, usually non-profit organizations and individuals

Each of the above TLDs is intended for use by a certain type of organization. For example, the TLD “.com” is for use by commercial, for-profit organizations. However, the administrator of the .com, .net, .org and .edu TLDs does not check the requests of parties seeking domain names to ensure that such parties are a type of organization that should be using those TLDs. On the other hand, .mil, .gov, and .int TLD applications are checked, and only the U.S. military, the U.S. government, or international organizations are allowed in the respective domain space.

*Country Code TLDs.* Country code TLDs are for use by each individual country. For example, the TLD “.ca” is for use by Canada, and the TLD “.jp” is for use by Japan. Each country determines who may use their code. For

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

example, some countries require that users of their code be citizens or have some association with the country, while other countries do not.

### 1215.02 Use as a Mark

When a trademark, service mark, collective mark or certification mark is composed, in whole or in part, of a domain name, neither the beginning of the URL (“http://www.”) nor the TLD have any source-indicating significance. Instead, those designations are merely devices that every Internet site provider must use as part of its address. Advertisements for all types of products and services routinely include a URL for the web site of the advertiser, and the average person familiar with the Internet recognizes the format for a domain name and understands that “http,” “www,” and a TLD are a part of every URL.

#### 1215.02(a) Use Applications

A mark composed of a domain name is registrable as a trademark or service mark only if it functions as a source identifier. The mark as depicted on the specimens must be presented in a manner that will be perceived by potential purchasers to indicate source and not as merely an informational indication of the domain name address used to access a web site. *See In re Eilberg*, 49 USPQ2d 1955 (TTAB 1998).

In *Eilberg*, the Trademark Trial and Appeal Board held that a term that only serves to identify the applicant’s domain name or the location on the Internet where the applicant’s web site appears, and does not separately identify applicant’s services, does not function as a service mark. The applicant’s proposed mark was WWW.EILBERG.COM, and the specimens showed that the mark was used on letterhead and business cards in the following manner:

**WILLIAM H. EILBERG**  
ATTORNEY AT LAW  
820 HOMESTEAD ROAD, P.O. Box 7  
**JENKINTOWN, PENNSYLVANIA 19046**  
215-855-4600  
FAX: 215-855-4603  
EMAIL WHE@EILBERG.COM

PATENTS, TRADEMARKS  
AND COPYRIGHTS WWW.EILBERG.COM

(The specimen submitted was the business card of William H. Eilberg, Attorney at Law, 820 Homestead Road, P.O. Box 7, Jenkintown, Pennsylvania 19046, 215-855-4600, email whe@eilberg.com.)



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

The Board affirmed the examining attorney's refusal of registration on the ground that the matter presented for registration did not function as a mark, stating that:

[T]he asserted mark, as displayed on applicant's letterhead, does not function as a service mark identifying and distinguishing applicant's legal services and, as presented, is not capable of doing so. As shown, the asserted mark identifies applicant's Internet domain name, by use of which one can access applicant's Web site. In other words, the asserted mark WWW.EILBERG.COM merely indicates the location on the Internet where applicant's Web site appears. It does not separately identify applicant's legal services as such. *Cf. In re The Signal Companies, Inc.*, 228 USPQ 956 (TTAB 1986).

This is not to say that, if used appropriately, the asserted mark or portions thereof may not be trademarks or [service marks]. For example, if applicant's law firm name were, say, EILBERG.COM and were presented prominently on applicant's letterheads and business cards as the name under which applicant was rendering its legal services, then that mark may well be registrable.

49 USPQ2d at 1957.

The examining attorney must review the specimens in order to determine how the proposed mark is actually used. It is the perception of the ordinary customer that determines whether the asserted mark functions as a mark, not the applicant's intent, hope or expectation that it does so. *See In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (C.C.P.A. 1960).

If the proposed mark is used in a way that would be perceived as nothing more than an Internet address where the applicant can be contacted, registration must be refused. Examples of a domain name used only as an Internet address include a domain name used in close proximity to language referring to the domain name as an address, or a domain name displayed merely as part of the information on how to contact the applicant.

*Example:* The mark is WWW.ABC.COM for online ordering services in the field of clothing. Specimens of use consisting of an advertisement that states "visit us on the web at www.ABC.com" do not show service mark use of the proposed mark.

*Example:* The mark is ABC.COM for financial consulting services. Specimens of use consisting of a business card that refers to the service and lists a phone number, fax number, and

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

the domain name sought to be registered do not show service mark use of the proposed mark.

If the specimens of use fail to show the domain name used as a mark and the applicant seeks registration on the Principal Register, the examining attorney must refuse registration on the ground that the matter presented for registration does not function as a mark. The statutory bases for the refusals are §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, for trademarks; and §§1, 3 and 45 of the Act, 15 U.S.C. §§1051, 1053 and 1127, for service marks.

If the applicant seeks registration on the Supplemental Register, the examining attorney must refuse registration under Trademark Act §23, 15 U.S.C. §1091.

### **1215.02(b) Advertising One's Own Products or Services on the Internet is not a Service**

Advertising one's own products or services is not a service. *In re Reichhold Chemicals, Inc.*, 167 USPQ 376 (TTAB 1970). See TMEP §§1301.01(a)(ii) and 1301.01(b)(i). Therefore, businesses that create a web site for the sole purpose of advertising their own products or services cannot register a domain name used to identify that activity. In examination, the issue usually arises when the applicant describes the activity as a registrable service, e.g., "providing information about [a particular field]," but the specimens of use make it clear that the web site merely advertises the applicant's own products or services. In this situation, the examining attorney must refuse registration because the mark is used to identify an activity that does not constitute a "service" within the meaning of the Trademark Act. Trademark Act §§1, 3 and 45, 15 U.S.C. §§1051, 1053 and 1127.

### **1215.02(c) Agreement of Mark on Drawing with Mark on Specimens of Use**

In viewing a domain name mark (e.g., ABC.COM or HTTP://WWW.ABC.COM), consumers look to the second level domain name for source identification, not to the top-level domain (TLD) or the terms "http://www." or "www." Therefore, it is usually acceptable to depict only the second level domain name on the drawing page, even if the specimens of use show a mark that includes the TLD or the terms "http://www." or "www." Cf. *Institut National des Appellations D'Origine v. Vintners Int'l Co., Inc.*, 958 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992) (CHABLIS WITH A TWIST held to be registrable separately from CALIFORNIA CHABLIS WITH A TWIST as shown on labels); *In re Raychem Corp.*, 12 USPQ2d 1399 (TTAB 1989) (refusal to register TINEL-LOCK based on specimens showing "TRO6AI-TINEL-LOCK-RING" reversed). See also 37 C.F.R. §§2.51(a) and (b), and TMEP §§807.12 *et. seq.*

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

*Example:* The specimens of use show the mark HTTP://WWW.ABC.COM. The applicant may elect to depict only the term “ABC” on the drawing.

Sometimes the specimens of use fail to show the entire mark sought to be registered (e.g., the drawing of the mark is HTTP://WWW.ABC.COM, but the specimens only show ABC). If the drawing of the mark includes a TLD, or the terms “http://www.,” or “www.,” the specimens of use must also show the mark used with those terms. Trademark Act §1(a)(3)(C), 15 U.S.C. §1051(a)(3)(C).

*Example:* If the drawing of the mark is ABC.COM, specimens of use that only show the term ABC are unacceptable.

See TMEP §§807.14 *et seq.* and 1215.08 *et seq.* regarding material alteration.

### **1215.02(d) Marks Comprised Solely of TLDs for Domain Name Registry Services**

If a mark is composed solely of a TLD for “domain name registry services” (e.g., the services of registering .com domain names), registration should be refused under Trademark Act §§1, 3 and 45, 15 U.S.C. §§1051, 1053 and 1127, on the ground that the TLD would not be perceived as a mark. The examining attorney should include evidence from the LEXIS® database, the Internet, or other sources to show that the proposed mark is currently used as a TLD or is under consideration as a new TLD.

If the TLD merely describes the subject or user of the domain space, registration should be refused under Trademark Act §2(e)(1), 15 U.S.C. §2(e)(1), on the ground that the TLD is merely descriptive of the registry services.

### **1215.02(e) Intent-to-Use Applications**

A refusal of registration on the ground that the matter presented for registration does not function as a mark relates to the manner in which the asserted mark is used. Generally, in an intent-to-use application, a mark that includes a domain name will not be refused on this ground until the applicant has submitted specimens of use with either an amendment to allege use under §1(c) of the Trademark Act, or a statement of use under §1(d) of the Act, 15 U.S.C. §1051(c) or (d). The specimens provide a better record upon which to determine the registrability of the mark. However, the examining attorney should include an advisory note in the first Office action that registration may be refused if the proposed mark, as used on the specimens, identifies only an Internet address. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided to the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

applicant prior to the filing of the allegation of use, the Office is not precluded from refusing registration on this basis.

### **1215.02(f) Section 44 and §66(a) Applications**

If the record indicates that the proposed mark would be perceived as merely an informational indication of the domain name address used to access a web site rather than an indicator of source, the examining attorney should refuse registration in an application under §44 or §66(a) of the Trademark Act, on the ground that the subject matter does not function as a mark.

### **1215.03 Surnames**

If a mark is composed of a surname and a TLD, the examining attorney must refuse registration because the mark is primarily merely a surname under Trademark Act §2(e)(4), 15 U.S.C. §1052(e)(4), absent a showing of acquired distinctiveness under Trademark Act §2(f), 15 U.S.C. §1052(f). A TLD has no trademark significance. If the primary significance of a term is that of a surname, adding a TLD to the surname does not alter the primary significance of the mark as a surname. *Cf. In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204, 98 USPQ 265 (C.C.P.A. 1953) (S. SEIDENBERG & CO'S. held primarily merely a surname); *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939 (TTAB 1993) (HAMILTON PHARMACEUTICALS for pharmaceutical products held primarily merely a surname); *In re Cazes*, 21 USPQ2d 1796 (TTAB 1991) (BRASSERIE LIPP held primarily merely a surname where "brasserie" is a generic term for applicant's restaurant services). See also TMEP §1211.01(b)(vi) regarding surnames combined with additional wording.

### **1215.04 Descriptiveness**

If a proposed mark is composed of a merely descriptive term(s) combined with a TLD, in general the examining attorney should refuse registration under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that the mark is merely descriptive. This applies to trademarks, service marks, collective marks and certification marks.

*Example:* The mark is SOFT.COM for facial tissues. The examining attorney must refuse registration under §2(e)(1).

*Example:* The mark is NATIONAL BOOK OUTLET.COM for retail book store services. The examining attorney must refuse registration under §2(e)(1).

The TLD will be perceived as part of an Internet address, and typically does not add source identifying significance to the composite mark. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1177, 71 USPQ2d1370 (Fed. Cir. 2004)

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

(PATENTS.COM merely descriptive of “computer software for managing a database of records and for tracking the status of the records by means of the Internet”); *In re Microsoft Corp.*, 68 USPQ2d 1195, 1203 (TTAB 2003) (“The combination of the specific term and TLD at issue, i.e., OFFICE and .NET, does not create any double entendre, incongruity, or any other basis upon which we can find the composite any more registrable than its separate elements. The combination immediately informs prospective purchasers that the software includes ‘office suite’ type software and is from a Internet business, i.e., a ‘.net’ type business”); *In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789, 1792 (TTAB 2002) (“The public would not understand BONDS.COM to have any meaning apart from the meaning of the individual terms combined”); *In re Martin Container, Inc.*, 65 USPQ2d 1058, 1060 (TTAB 2002) (“[T]o the average customer seeking to buy or rent containers, ‘CONTAINER.COM’ would immediately indicate a commercial web site on the Internet which provides containers.”). *Cf. In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998) (PATENT & TRADEMARK SERVICES INC. is merely descriptive of legal services in the field of intellectual property; the term “INC.” merely indicates the type of entity that performs the services, and has no significance as a mark); *In re The Paint Products Co.*, 8 USPQ2d 1863 (TTAB 1988) (PAINT PRODUCTS CO. is no more registrable as a trademark for goods emanating from a company that sells paint products than it would be as a service mark for retail paint store services offered by such a company).

When examining domain name marks, it is important to evaluate the commercial impression of the mark as a whole, including the TLD indicator. In *Oppedahl*, the Court of Appeals for the Federal Circuit cautioned that, while “[t]he addition of a TLD such as ‘.com’ or ‘.org’ to an otherwise unregistrable mark will typically not add any source-identifying significance,” this “is not a bright-line, per se rule. In exceptional circumstances, a TLD may render an otherwise descriptive term sufficiently distinctive for trademark registration.” 373 F.3d at 1177, 71 USPQ2d at 1374.

See also *In re Eddie Z’s Blinds and Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005) (BLINDSANDDRAPERY.COM generic for retail store services featuring blinds, draperies and other wall coverings, sold via the Internet).

See also TMEP §1209.03(m).

### 1215.05 Generic Refusals

If a mark is composed of a generic term(s) for the applicant’s goods or services and a TLD, in general the examining attorney should refuse registration on the ground that the mark is generic and the TLD has no trademark significance. Marks comprised of generic terms combined with TLDs are not eligible for registration on the Supplemental Register, or on the Principal Register under Trademark Act §2(f), 15 U.S.C. §1052(f). This

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

applies to trademarks, service marks, collective marks and certification marks. *In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789 (TTAB 2002) (BONDS.COM held generic for providing information regarding financial products and services and electronic commerce services rendered via the Internet, where bonds was the name of one of the financial products offered under the mark); *In re Martin Container, Inc.*, 65 USPQ2d 1058 (TTAB 2002) (CONTAINER.COM held generic for “retail store services and retail services offered via telephone featuring metal shipping containers” and “rental of metal shipping containers”).

*Example:* TURKEY.COM for frozen turkeys is unregistrable on either the Principal or Supplemental Register.

*Example:* BANK.COM for banking services is unregistrable on either the Principal or Supplemental Register.

See TMEP §1209.01(c)(i) regarding the test for establishing that a term is generic.

When examining domain name marks, it is important to evaluate the commercial impression of the mark as a whole, including the TLD indicator. The Court of Appeals for the Federal Circuit has cautioned that, while “[t]he addition of a TLD such as ‘.com’ or ‘.org’ to an otherwise unregistrable mark will typically not add any source-identifying significance,” this “is not a bright-line, per se rule. In exceptional circumstances, a TLD may render an otherwise descriptive term sufficiently distinctive for trademark registration.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1177, 71 USPQ2d1370, 1374 (Fed. Cir. 2004).

See also *In re Eddie Z’s Blinds and Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005) (BLINDSANDDRAPERY.COM generic for retail store services featuring blinds, draperies and other wall coverings, sold via the Internet).

The examining attorney generally should not issue a refusal in an application for registration on the Principal Register on the ground that a mark is a generic name for the goods or services unless the applicant asserts that the mark has acquired distinctiveness under §2(f) of the Trademark Act, 15 U.S.C. §1052(f). Absent a claim of acquired distinctiveness, the examining attorney should issue a refusal on the ground that the mark is merely descriptive of the goods or services under §2(e)(1), 15 U.S.C. §1052(e)(1), and provide an advisory statement that the matter sought to be registered appears to be a generic name for the goods or services. See TMEP §1209.02.

See also TMEP §§1209.03(m).

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

### 1215.06 Marks Containing Geographical Matter

The examining attorney should examine marks containing geographic matter in the same manner that any mark containing geographic matter is examined. See *generally* TMEP §§1210 *et seq.* Depending on the manner in which it is used on or in connection with the goods or services, a proposed domain name mark containing a geographic term may be primarily geographically descriptive under §2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2), primarily geographically deceptively misdescriptive under §2(e)(3) of the Trademark Act, 15 U.S.C. §1052(e)(3), deceptive under 15 U.S.C. §1052(a), and/or merely descriptive or deceptively misdescriptive under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

When a geographic term is used as a mark for services that are provided on the Internet, sometimes the geographic term describes the subject of the service rather than the geographic origin of the service. Usually this occurs when the mark is composed of a geographic term that describes the subject matter of information services (*e.g.*, NEW ORLEANS.COM for “providing vacation planning information about New Orleans, Louisiana by means of the global computer network”). In these cases, the examining attorney should refuse registration under §2(e)(1) because the mark is merely descriptive of the services. See TMEP §1210.02(b)(iii).

### 1215.07 Disclaimers

Trademark Act §6(a), 15 U.S.C. §1056(a), provides for the disclaimer of “an unregistrable component of a mark otherwise registrable.” The guidelines on disclaimer discussed in TMEP §§1213 *et seq.* apply to domain name mark applications.

If a composite mark includes a domain name composed of unregistrable matter (*e.g.*, a merely descriptive or generic term and a TLD), disclaimer is required.

If a disclaimer is required and the domain name includes a misspelled or telescoped word, the correct spelling must be disclaimed. See TMEP §§1213.05(a)(i) and 1213.08(c).

A compound term composed of arbitrary or suggestive matter combined with a “dot” and a TLD is considered unitary, and therefore no disclaimer of the TLD is required. See examples below and TMEP §§1213.05 *et seq.* regarding unitary marks.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

<i>Mark</i>	<i>Disclaimer</i>
ABC BANK.COM	BANK.COM
ABC FEDERALBANK.COM	FEDERAL BANK.COM
ABC GROCERY STORE.COM	GROCERY STORE.COM
ABC.COM	no disclaimer
ABC.BANK.COM	no disclaimer
ABCBANK.COM	no disclaimer

### 1215.08 Material Alteration

Amendments may not be made to the drawing of the mark if the character of the mark is materially altered. 37 C.F.R. §2.72. In determining whether an amendment is a material alteration, the controlling question is always whether the new and old forms of the mark create essentially the same commercial impression. See TMEP §§807.14 *et seq.*

#### 1215.08(a) Adding or Deleting TLDs in Domain Name Marks

Generally, an applicant may add or delete a TLD to/from the drawing of a domain name mark (*e.g.*, COOPER amended to COPPER.COM, or COOPER.COM amended to COOPER) without materially altering the mark. A mark that includes a TLD will be perceived by the public as a domain name, while a mark without a TLD will not. However, the public recognizes that a TLD is a universally used part of an Internet address. As a result, the essence of a domain name mark is created by the second level domain name, not the TLD. The commercial impression created by the second-level domain name usually remains the same whether the TLD is present or not.

*Example:* Amending a mark from PETER to PETER.COM would *not* materially change the mark because the essence of both marks is still PETER, a person's name.

Similarly, substituting one TLD for another in a domain name mark, or adding or deleting a "dot" or "http://www." or "www." to a domain name mark is generally permitted.

*Example:* Amending a mark from ABC.ORG to ABC.COM would *not* materially change the mark because the essence of both marks is still ABC.

#### 1215.08(b) Adding or Deleting TLDs in Other Marks

If a mark that is not used as an Internet domain name includes a TLD, adding or deleting the TLD may be a material alteration.



## SUBSTANTIVE EXAMINATION OF APPLICATIONS

*Example:* Deleting the term .COM from the mark “.COM ☀” used on sports magazines would materially change the mark.

### 1215.09 Likelihood of Confusion

When analyzing whether a domain name mark is likely to cause confusion with another pending or registered mark, the examining attorney must consider the marks as a whole, but generally should accord little weight to the TLD portion of the mark. See TMEP §1207.01(b)(iii).

### 1215.10 Marks Containing the Phonetic Equivalent of a Top-Level Domain

Marks that contain the phonetic equivalent of a TLD (e.g., ABC DOTCOM) are treated in the same manner as marks composed of a TLD. If a disclaimer is necessary, the disclaimer must be in the form of the TLD and not the phonetic equivalent. See TMEP §1213.08(c) regarding disclaimer of misspelled words.

*Example:* The mark is INEXPENSIVE RESTAURANTS DOT COM for providing information about restaurants by means of a global computer network. Registration should be refused because the mark is merely descriptive of the services under 15 U.S.C. §1052(e)(1).

*Example:* The mark is ABC DOTCOM. The applicant must disclaim the TLD “.COM” rather than the phonetic equivalent “DOTCOM.”

### 1216 Effect of Applicant’s Prior Registrations

#### 1216.01 Decisions Involving Prior Registrations Not Controlling

Trademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence of record that exist at the time registration is sought. *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9, 18 (C.C.P.A. 1982); *In re Thunderbird Products Corp.*, 406 F.2d 1389, 160 USPQ 730 (C.C.P.A. 1969); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001); *In re Styleclick.com Inc.*, 58 USPQ2d 1523 (TTAB 2001); *In re Styleclick.com Inc.*, 57 USPQ2d 1445 (TTAB 2000).

Each case must be decided on its own facts. The Office is not bound by the decisions of the examiners who examined the applications for the applicant’s previously registered marks, based on different records. See *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) (incontestable registration of CASH MANAGEMENT ACCOUNT for credit card services did not automatically entitle applicant to registration of the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

same mark for broader financial services); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (examining attorney could properly refuse registration on ground that mark DURANGO for chewing tobacco is primarily geographically deceptively misdescriptive, even though applicant owned incontestable registration of same mark for cigars); *In re Best Software Inc.*, 58 USPQ2d 1314 (TTAB 2001) (applicant's ownership of registration for the mark BEST! did not preclude the examining attorney from requiring a disclaimer of "Best" in applications seeking registration of BEST! SUPPORT PLUS and BEST! SUPPORT PLUS PREMIER for the same services plus additional services); *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994) (examining attorney not precluded from refusing registration of ULTRA for "gasoline, motor oil, automotive grease, general purpose grease, machine grease and gear oil," even though applicant owned registrations of same mark for "motor oil" and "gasoline for use as automotive fuel, sold only in applicant's automotive service stations"); *In re Medical Disposables Co.*, 25 USPQ2d 1801 (TTAB 1992) (disclaimer of the unitary term "MEDICAL DISPOSABLES" required, notwithstanding applicant's ownership of a prior registration in which a piecemeal disclaimer of the words "MEDICAL" and "DISPOSABLES" was permitted); *In re Perez*, 21 USPQ2d 1075 (TTAB 1991) (likelihood of confusion between applicant's EL GALLO for fresh tomatoes and peppers and the previously registered mark ROOSTER for fresh citrus fruit, notwithstanding applicant's ownership of an expired registration of the same mark for the same goods); *In re Lean Line, Inc.*, 229 USPQ 781 (TTAB 1986) (LEAN found merely descriptive of low-calorie foods, even though applicant had registered the term for other goods and services and a third party had registered the term "LEAN CUISINE" with no disclaimer); *In re McDonald's Corp.*, 229 USPQ 555 (TTAB 1985) (Board not bound to allow registration of APPLE PIE TREE for restaurant services merely because applicant had succeeded in registering the character and name as trademarks and the character as a service mark); *In re Harcourt Brace Jovanovich, Inc.*, 222 USPQ 820 (TTAB 1984) (LAW & BUSINESS incapable of distinguishing the services of arranging and conducting seminars in the field of business law, notwithstanding applicant's ownership of a registration on the Supplemental Register for the same mark for books, pamphlets and monographs); *In re Local Trademarks, Inc.*, 220 USPQ 728 (TTAB 1983) (refusal of registration on the ground that WHEN IT'S TIME TO ACT did not identify advertising services upheld; Board not bound to allow registration simply because applicant owned registrations bearing similar recitations of services); *In re Pilon*, 195 USPQ 178 (TTAB 1977) (title of chapter or section of book not registrable, even though applicant owned prior registrations of marks comprising chapter titles). See also *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001) ("Reasoned decisionmaking" doctrine, which prohibits a federal agency from creating conflicting lines of precedent governing identical situations, did not entitle applicant to registration of PINE CONE BRAND for packaged fresh citrus fruit, even though Office issued registration for similar

## SUBSTANTIVE EXAMINATION OF APPLICATIONS

PINE CONE mark in 1933 despite then-existing registration for PINE CONE mark that was cited against applicant).

### 1216.02 Effect of “Incontestability” in *Ex Parte* Examination

Section 15 of the Trademark Act, 15 U.S.C. §1065, provides a procedure by which a registrant’s exclusive right to use a mark in commerce on or in connection with the goods or services covered by the registration can become incontestable. See TMEP §§1605 *et seq.* for information about the requirements for filing an affidavit of incontestability under §15.

In *Park ‘N Fly v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327 (1985), the Supreme Court held that the owner of a registered mark may rely on incontestability to enjoin infringement, and that an incontestable registration therefore cannot be challenged on the ground that the mark is merely descriptive.

In *In re American Sail Training Association*, 230 USPQ 879 (TTAB 1986), the Trademark Trial and Appeal Board held that an examining attorney could not require a disclaimer of “TALL SHIPS” in an application for registration of the mark RETURN OF THE TALL SHIPS, where the applicant owned an incontestable registration for the mark TALL SHIPS for the identical services. This would be a collateral attack on an incontestable registration. However, this applies only where both the marks and the goods or services are identical. In *American Sail Training*, the Board noted that the matter required to be disclaimed was “identical to the subject matter of applicant’s incontestable registration,” and that “the services described in applicant’s application are identical to those recited in the prior incontestable registration.” 230 USPQ at 880.

Ownership of an incontestable registration does *not* give the applicant a right to register the same mark for different goods or services, even if they are closely related to the goods or services in the incontestable registration. See *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001) (applicant’s ownership of incontestable registration of the word mark SAVE VENICE for newsletters, brochures and fundraising services did not preclude examining attorney from refusing registration of a composite mark consisting of the phrases THE VENICE COLLECTION and SAVE VENICE INC. with an image of the winged Lion of St. Mark for different goods; “[a] registered mark is incontestable only in the form registered and for the goods or services claimed.”); *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) (incontestable registration of CASH MANAGEMENT ACCOUNT for credit card services did not automatically entitle applicant to registration of the same mark for broader financial services); *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1, 7 n. 5 (Fed. Cir. 1985) (incontestable status of registration for one speaker design did not establish non-functionality of another speaker design with shared feature); *In*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (examining attorney could properly refuse registration on ground that mark DURANGO for chewing tobacco is primarily geographically deceptively misdescriptive, even though applicant owned incontestable registration of same mark for cigars); *In re Best Software Inc.*, 63 USPQ2d 1109, 1113 (TTAB 2002) (applicant's ownership of incontestable registration for the mark BEST! did not preclude the examining attorney from requiring a disclaimer of "BEST" in applications seeking registration of BEST! IMPERATIV HRMS "for goods which, although similar, are nevertheless somewhat different"); *In re Best Software Inc.*, 58 USPQ2d 1314 (TTAB 2001) (applicant's ownership of incontestable registration for the mark BEST! did not preclude the examining attorney from requiring a disclaimer of "BEST" in applications seeking registration of BEST! SUPPORT PLUS and BEST! SUPPORT PLUS PREMIER for the same services plus additional services); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988), *aff'd*, 883 F.2d 1026 (Fed. Cir. 1989) (examining attorney could properly refuse registration on the ground that a mark is primarily merely a surname even if applicant owned incontestable registration of same mark for unrelated goods); *In re BankAmerica Corp.*, 231 USPQ 873 (TTAB 1986) (examining attorney could refuse registration of the mark BANK OF AMERICA for computerized financial data processing services under §§2(e)(1) and 2(e)(2), despite applicant's ownership of incontestable registrations of the same mark for related services).

### 1217 Res Judicata

A prior adjudication against an applicant, in connection with the same mark, on the basis of the same facts and issues, constitutes a proper ground of refusal as *res judicata*. Prior adjudications include decisions of the Trademark Trial and Appeal Board or any of the reviewing courts. The refusal is appropriate only after the time for further court review has expired and no such review has been sought or, if sought, the review action has been terminated. However, the applicant may not be precluded under the doctrine of *res judicata* from again seeking registration if the facts and circumstances have changed since the adverse decision. See *In re Honeywell Inc.*, 8 USPQ2d 1600 (TTAB 1988); *In re Johanna Farms Inc.*, 8 USPQ2d 1408 (TTAB 1988); *In re Minnetonka, Inc.*, 3 USPQ2d 1711 (TTAB 1987).

When refusing registration on the basis of *res judicata*, the examining attorney also must raise all other issues that are pertinent to the application.

When all matters other than the question of *res judicata* have been attended to, but review action on the prior adjudication is not yet terminated, the examining attorney may suspend action on the application pending termination. See TMEP §716.02(d).

# Chapter 1300

## Examination of Different Types of Marks

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### 1301 Service Marks

#### 1301.01 What Is a Service

##### 1301.01(a) Criteria for Determining What Constitutes a Service

1301.01(a)(i) Performance of a Real Activity

1301.01(a)(ii) For the Benefit of Others

1301.01(a)(iii) Sufficiently Distinct from Activities Involved in Sale of Goods or Performance of Other Services

##### 1301.01(b) Whether Particular Activities Constitute “Services”

1301.01(b)(i) Contests and Promotional Activities

1301.01(b)(ii) Warranty or Guarantee of Repair

1301.01(b)(iii) Publishing One’s Own Periodical

1301.01(b)(iv) Soliciting Investors

1301.01(b)(v) Informational Services Ancillary to the Sale of Goods

#### 1301.02 What Is a Service Mark

1301.02(a) Matter That Does Not Function as a Service Mark

1301.02(b) Names of Characters or Personal Names as Service Marks

1301.02(c) Three-Dimensional Service Marks

1301.02(d) Titles of Radio and Television Programs

1301.02(e) Process, System or Method

#### 1301.03 Use of Service Mark in Commerce

1301.03(a) Use of Service Mark in Advertising to Identify Services

1301.03(b) Rendering of Service in Commerce Regulable by Congress

#### 1301.04 Specimens of Use for Service Marks

1301.04(a) Specimens Must Show Use as a Service Mark

## **TRADEMARK MANUAL OF EXAMINING PROCEDURE**

1301.04(b) Association Between Mark and Services

1301.04(c) Letterhead

1301.04(d) Specimens for Entertainment Services

1301.05 Identification and Classification of Services

### **1302 Collective Marks Generally**

1302.01 History of Collective Marks

### **1303 Collective Trademarks and Collective Service Marks**

1303.01 Use of Collective Trademark and Collective Service Mark Is By Members

1303.02 Examination of Collective Trademark and Collective Service Mark Applications

1303.02(a) Classification of Goods and Services in Collective Trademark and Collective Service Mark Applications

1303.02(b) Specimens of Use for Collective Trademark and Collective Service Mark Applications

1303.02(c) Special Elements of Collective Trademark and Collective Service Mark Applications

1303.02(c)(i) Manner of Control

1303.02(c)(ii) Use by Members Indicated in Dates-of-Use Clause

### **1304 Collective Membership Marks**

1304.01 History of Membership Marks

1304.02 Purpose of Membership Mark

1304.03 Use of Membership Mark Is by Members

1304.04 Who May Apply to Register Membership Mark

1304.05 Who May Own Membership Mark

1304.06 Nature of the Collective Group

1304.07 Character of the Mark

1304.08 Refusal to Register Membership Mark

1304.08(a) Matter That Does Not Function as a Membership Mark

1304.08(b) Likelihood of Confusion

1304.08(c) Degree or Title Designations Contrasted to Membership Marks

## EXAMINATION OF DIFFERENT TYPES OF MARKS

### 1304.09 Examination of Collective Membership Mark Applications

1304.09(a) Classification in Membership Mark Applications

1304.09(b) Identifications in Membership Mark Applications

1304.09(c) Specimens of Use for Membership Marks

1304.09(d) Special Elements of Applications for Collective Membership Marks

1304.09(d)(i) Exercise of Control

1304.09(d)(ii) Manner of Control

1304.09(d)(iii) Use by Members Indicated in Dates-of-Use Clause

### **1305 Trademarks and Service Marks Used by Collective Organizations**

### **1306 Certification Marks**

#### 1306.01 Definition of Certification Mark

1306.01(a) Use Is by Person Other than Owner

1306.01(b) Purpose Is to Certify, Not to Indicate Source

#### 1306.02 Certification Marks That Are Indications of Regional Origin

1306.02(a) Indicating the Region

1306.02(b) Authority to Control a Geographical Term

1306.02(c) The Government as Applicant for a Geographical Certification Mark

#### 1306.03 Certification Marks Certifying that Labor Was Performed by Specific Group or Individual

#### 1306.04 Ownership of Certification Marks

#### 1306.05 Characteristics of Certification Marks

1306.05(a) Same Mark Not Registrable as Certification Mark and as Any Other Type of Mark

1306.05(b) Cancellation of Applicant's Prior Registration Required by Change from Certification Mark Use to Trademark or Service Mark Use, or Vice Versa

#### 1306.06 Examination of Certification Mark Applications

1306.06(a) Refusal to Register Certification Mark

1306.06(b) The Mark on the Drawing

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- 1306.06(c) Specimens of Use for Certification Marks
- 1306.06(d) Relation Between Certification Mark and Trademark or Service Mark on Specimens
- 1306.06(e) Classification of Goods and Services in Certification Mark Applications
- 1306.06(f) Identification of Goods and Services in Certification Mark Applications
- 1306.06(g) Special Elements of Certification Mark Applications
  - 1306.06(g)(i) Statement of What the Mark Certifies
  - 1306.06(g)(ii) Standards
  - 1306.06(g)(iii) Exercise of Control
  - 1306.06(g)(iv) Use by Others Indicated in Dates-of-Use Clause
  - 1306.06(g)(v) Statement That Mark is Not Used by Applicant
  - 1306.06(g)(vi) Amendment to Different Type of Mark
- 1306.07 Relationship of §14 (Cancellation) to Examination of Certification Mark Applications
- 1306.08 Registration of Certification Mark on Basis of Foreign Registration
- 1306.09 Uncertainty Regarding Type of Mark
  - 1306.09(a) Distinction Between Certification Mark and Collective Mark
  - 1306.09(b) Distinguishing Certification Mark Use from Related-Company Use of Trademark or Service Mark
  - 1306.09(c) Patent Licenses

### **1307 Registration as Correct Type of Mark**

The Trademark Act of 1946 provides for registration of trademarks, service marks, collective trademarks and service marks, collective membership marks and certification marks. 15 U.S.C. §§1051, 1053, and 1054. The language of this Manual is generally directed to trademarks. Procedures for trademarks usually apply to other types of marks, unless otherwise stated. This chapter is devoted to special circumstances relating to service marks, collective marks, collective membership marks, and certification marks.



## EXAMINATION OF DIFFERENT TYPES OF MARKS

### 1301 Service Marks

Section 45 of the Trademark Act, 15 U.S.C. §1127, defines “service mark” as follows:

The term “service mark” means any word, name, symbol, or device, or any combination thereof--

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,

to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

Therefore, to be registrable as a service mark, the asserted mark must function both to *identify* the services recited in the application *and distinguish* them from the services of others, and to *indicate the source* of the recited services, even if that source is unknown. The activities recited in the identification must constitute services as contemplated by the Trademark Act. See TMEP §§1301.01 *et seq.*

If a proposed mark does not function as a service mark for the services recited or if the applicant is not rendering a registrable service, the statutory basis for refusal of registration on the Principal Register is §§1, 3 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1053 and 1127.

See TMEP §1303 concerning collective service marks.

#### 1301.01 What Is a Service

A service mark can only be registered for activities that constitute services as contemplated by the Trademark Act. 15 U.S.C. §§1051, 1053 and 1127. The Trademark Act defines the term “service mark,” but it does not define what constitutes a service. Many activities are obviously services (*e.g.*, dry cleaning, banking, shoe repairing, transportation, and house painting).

#### 1301.01(a) Criteria for Determining What Constitutes a Service

The following criteria have evolved for determining what constitutes a service: (1) a service must be a real activity; (2) a service must be performed to the order of, or for the benefit of, someone other than the applicant; and (3) the activity performed must be qualitatively different from anything necessarily done in connection with the sale

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

of the applicant's goods or the performance of another service. *In re Canadian Pacific Limited*, 754 F.2d 992, 224 USPQ 971 (Fed. Cir. 1985); *In re Betz Paperchem, Inc.*, 222 USPQ 89 (TTAB 1984); *In re Integrated Resources, Inc.*, 218 USPQ 829 (TTAB 1983); *In re Landmark Communications, Inc.*, 204 USPQ 692 (TTAB 1979).

### **1301.01(a)(i) Performance of a Real Activity**

A service must be a real activity. A mere idea or concept, e.g., an idea for an accounting organizational format or a recipe for a baked item, is not a service. Similarly, a system, process or method is not a service. *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (C.C.P.A. 1973); *In re Citibank, N.A.*, 225 USPQ 612 (TTAB 1985); *In re Scientific Methods, Inc.*, 201 USPQ 917 (TTAB 1979); *In re McCormick & Company, Inc.*, 179 USPQ 317 (TTAB 1973). See TMEP §1301.02(e) regarding marks that identify a system or process.

The commercial context must be considered in determining whether a real service is being performed. For example, at one time the activities of grocery stores, department stores, and similar retail stores were not considered to be services. However, it is now recognized that gathering various products together, making a place available for purchasers to select goods, and providing any other necessary means for consummating purchases constitutes the performance of a service.

### **1301.01(a)(ii) For the Benefit of Others**

To be a service, an activity must be primarily for the benefit of someone other than the applicant. While an advertising agency provides a service when it promotes the goods or services of its clients, a company that promotes the sale of its own goods or services is doing so for its own benefit rather than rendering a service for others. *In re Reichhold Chemicals, Inc.*, 167 USPQ 376 (TTAB 1970). See TMEP §1301.01(b)(i). Similarly, a company that sets up a personnel department to employ workers for itself is merely facilitating the conduct of its own business, while a company whose business is to recruit and place workers for other companies is performing employment agency services.

The controlling question is who *primarily* benefits from the activity for which registration is sought. If the activity is done primarily for the benefit of others, the fact that applicant derives an incidental benefit is not fatal. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). On the other hand, if the activity primarily benefits applicant, it is not a registrable service even if others derive an incidental benefit. *In re Dr. Pepper Co.*, 836 F.2d 508, 5 USPQ2d 1207 (Fed. Cir. 1987) (contest promoting applicant's goods not a service, even though benefits accrue to winners of contest); *In re Alaska Northwest Publishing Co.*, 212 USPQ 316 (TTAB 1981).

## EXAMINATION OF DIFFERENT TYPES OF MARKS

Collecting information for the purpose of publishing one's own periodical is not a service, because it is done primarily for applicant's benefit rather than for the benefit of others. See TMEP §1301.01(b)(iii).

Offering shares of one's own stock for investment is not a service, because these are routine corporate activities that primarily benefit the applicant. See TMEP §1301.01(b)(iv). On the other hand, offering a retirement income plan to applicant's employees was found to be a service, because it primarily benefits the employees. *American International Reinsurance Co., Inc. v. Airco, Inc.*, 570 F.2d 941, 197 USPQ 69 (C.C.P.A. 1978), cert. denied 439 U.S. 866, 200 USPQ 64 (1978).

Licensing intangible property has been recognized as a separate service, analogous to leasing or renting tangible property, that primarily benefits the licensee. *In re Universal Press Syndicate*, 229 USPQ 638 (TTAB 1986).

### **1301.01(a)(iii) Sufficiently Distinct from Activities Involved in Sale of Goods or Performance of Other Services**

In determining whether an activity is sufficiently separate from an applicant's principal activity to constitute a service, the examining attorney should first ascertain what is the applicant's principal activity under the mark in question (*i.e.*, the sale of a service or the sale of a tangible product). The examining attorney must then determine whether the activity identified in the application is in any material way a different kind of economic activity than what any provider of that particular product or service normally provides. *In re Landmark Communications, Inc.*, 204 USPQ 692, 695 (TTAB 1979).

For example, operating a grocery store is clearly a service. Bagging groceries for customers is not considered a separately registrable service, because this activity is normally provided to and expected by grocery store customers, and is therefore merely ancillary to the primary service.

Providing general information or instructions as to the purpose and uses of applicant's goods is merely incidental to the sale of goods, not a separate consulting service. See TMEP §1301.01(b)(v).

Conducting a contest to promote the sale of one's own goods or services is usually not considered a service, because it is an ordinary and routine promotional activity. See TMEP §1301.01(b)(i).

While the repair of the goods of others is a recognized service, an applicant's guarantee of repair of its own goods does not normally constitute a separate service because that activity is ancillary to and normally expected in the trade. See TMEP §1301.01(b)(ii).

However, the fact that an activity is ancillary to a principal service or to the sale of goods does not in itself mean that it is not a separately registrable service. The

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

statute makes no distinction between primary, incidental or ancillary services. *In re Universal Press Syndicate*, 229 USPQ 638 (TTAB 1986) (licensing cartoon character found to be a separate service that was not merely incidental or necessary to larger business of magazine and newspaper cartoon strip); *In re Betz Paperchem, Inc.*, 222 USPQ 89 (TTAB 1984) (chemical manufacturer's feed, delivery and storage of liquid chemical products held to constitute separate service, because applicant's activities extend beyond routine sale of chemicals); *In re Congoleum Corp.*, 222 USPQ 452 (TTAB 1984) (awarding prizes to retailers for purchasing applicant's goods from distributors held to be sufficiently separate from the sale of goods to constitute a service rendered to distributors, because it confers a benefit on distributors that is not normally expected by distributors in the relevant industry); *In re C.I.T. Financial Corp.*, 201 USPQ 124 (TTAB 1978) (computerized financial data processing services rendered to applicant's loan customers held to be a registrable service, since it provides benefits that were not previously available, and is separate and distinct from the primary service of making consumer loans); *In re U.S. Home Corp. of Texas*, 199 USPQ 698 (TTAB 1978) (planning and laying out residential communities for others was found to be a service, because it goes above and beyond what the average individual would do in constructing and selling a home on a piece of land that he or she has purchased); *In re John Breuner Co.*, 136 USPQ 94 (TTAB 1963) (credit services provided by a retail store constitute a separate service, since extension of credit is neither mandatory nor required in the operation of a retail establishment).

The fact that the activities are offered only to purchasers of the applicant's primary product or service does not necessarily mean that the activity is not a service. *In re Otis Engineering Corp.*, 217 USPQ 278 (TTAB 1982) (quality control and quality assurance services held to constitute a registrable service even though the services were limited to applicant's own equipment); *In re John Breuner Co.*, *supra* (credit services offered only to customers of applicant's retail store found to be a service).

The fact that the services for which registration is sought are offered to a different class of purchasers than the purchasers of applicant's primary product or service is also a factor to be considered. *In re Forbes Inc.*, 31 USPQ2d 1315 (TTAB 1994); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990).

Another factor to be considered in determining whether an activity is a registrable service is the use of a mark different from the mark used on or in connection with the applicant's principal product or service. See *In re Mitsubishi Motor Sales of America Inc.*, 11 USPQ2d 1312 (TTAB 1989); *In re Universal Press Syndicate*, *supra*; *In re Congoleum Corp.*, *supra*; *In re C.I.T. Financial Corp.*, *supra*. However, an activity that is normally expected or routinely done in connection with sale of a product or another service is not a registrable service even if it is identified by a different mark. *In re Dr. Pepper Co.*, 836 F.2d 508, 5 USPQ2d 1207 (Fed. Cir. 1987); *In re Television Digest, Inc.*, 169 USPQ 505 (TTAB 1971). Moreover, the mark identifying the ancillary service does not have to be different from the mark identifying the

## EXAMINATION OF DIFFERENT TYPES OF MARKS

applicant's goods or primary service. *Ex parte Handmacher-Vogel, Inc.*, 98 USPQ 413 (Comm'r Pats. 1953).

### **1301.01(b) Whether Particular Activities Constitute "Services"**

#### **1301.01(b)(i) Contests and Promotional Activities**

It is well settled that the promotion of one's own goods is not a service. *In re Radio Corp. of America*, 205 F.2d 180, 98 USPQ 157 (C.C.P.A. 1953) (record manufacturer who prepares radio programs primarily designed to advertise and sell records is not rendering service); *In re SCM Corp.*, 209 USPQ 278 (TTAB 1980) (supplying merchandising aids and store displays to retailers does not constitute separate service); *Ex parte Wembley, Inc.*, 111 USPQ 386 (Comm'r Pats. 1956) (national advertising program designed to sell manufacturer's goods to ultimate purchasers is not service to wholesalers and retailers, because national product advertising is normally expected of manufacturers of nationally distributed products, and is done in furtherance of the sale of the advertised products).

However, an activity that goes above and beyond what is normally expected of a manufacturer in the relevant industry may be a registrable service, even if it also serves to promote the applicant's primary product or service. *In re U.S. Tobacco Co.*, 1 USPQ2d 1502 (TTAB 1986) (tobacco company's participating in auto race held to constitute an entertainment service, because participating in an auto race is not an activity that a seller of tobacco normally does); *In re Heavenly Creations, Inc.*, 168 USPQ 317 (TTAB 1971) (applicant's free hairstyling instructional parties found to be a service separate from the applicant's sale of wigs, because it goes beyond what a seller of wigs would normally do in promoting its goods); *Ex parte Handmacher-Vogel, Inc.*, 98 USPQ 413 (Comm'r Pats. 1953) (clothing manufacturer's conducting women's golf tournaments held to be a service, because it is not an activity normally expected in promoting the sale of women's clothing).

Conducting a contest to promote the sale of one's own goods is usually not considered a service, even though benefits may accrue to the winners of the contest. Such a contest is usually ancillary to the sale of goods or services, and is nothing more than a device to advertise the applicant's products. *In re Dr. Pepper Co.*, 836 F.2d 508, 5 USPQ2d 1207 (Fed. Cir. 1987); *In re Loew's Theatres, Inc.*, 179 USPQ 126 (TTAB 1973); *In re Johnson Publishing Co., Inc.*, 130 USPQ 185 (TTAB 1961). However, a contest that serves to promote the sale of the applicant's goods may be registrable if it operates in a way that confers a benefit unrelated to the sale of the goods, and the benefit is not one that is normally expected of a manufacturer in that field. *In re Congoleum Corp.*, 222 USPQ 452 (TTAB 1984).

A mark identifying a beauty contest is registrable either as a promotional service, rendered by the organizer of the contest to the businesses or groups that sponsor the contest, or as an entertainment service. *In re Miss American Teen-Ager, Inc.*, 137 USPQ 82 (TTAB 1963). See TMEP §1402.11.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

See TMEP §1301.01(b)(iii) regarding the providing of advertising space in a periodical.

### **1301.01(b)(ii) Warranty or Guarantee of Repair**

While the repair of the goods of others is a recognized service, an applicant's guarantee of repair of its own goods does not normally constitute a separate service because that activity is ancillary to and normally expected in the trade. *In re Orion Research Inc.*, 669 F.2d 689, 205 USPQ 688 (C.C.P.A. 1980) (guarantee of repair or replacement of applicant's goods that is not separately offered, promoted or charged for is not a service); *In re Lenox, Inc.*, 228 USPQ 966 (TTAB 1986) (lifetime warranty that is not separately offered, promoted or charged for is not a service). However, a warranty that is offered or charged for separately from the goods, or is sufficiently above and beyond what is normally expected in the industry may constitute a service. *In re Mitsubishi Motor Sales of America, Inc.*, 11 USPQ2d 1312 (TTAB 1989) (comprehensive automobile vehicle preparation, sales and service program held to be a service, where applicant's package included features that were unique and would not normally be expected in the industry); *In re Sun Valley Waterbeds Inc.*, 7 USPQ2d 1825 (TTAB 1988) (retailer's extended warranty for goods manufactured by others held to be a service, where the warranty is considerably more extensive than that offered by others); *In re Otis Engineering Corp.*, 217 USPQ 278 (TTAB 1982) (non-mandatory quality control and quality assurance services held to constitute a registrable service even though the services were limited to applicant's own equipment, where the services were separately charged for, the goods were offered for sale without services, and the services were not merely a time limited manufacturer's guarantee).

### **1301.01(b)(iii) Publishing One's Own Periodical**

The publication of one's own periodical is not a service, because it is done primarily for applicant's own benefit and not for the benefit of others. *In re Billfish International Corp.*, 229 USPQ 152 (TTAB 1986) (activities of collecting, distributing and soliciting information relating to billfishing tournaments for a periodical publication not a separate service, because these are necessary preliminary activities that a publisher must perform prior to publication and sale of goods); *In re Alaska Northwest Publishing Co.*, 212 USPQ 316 (TTAB 1981) (title of magazine section not registrable for magazine publishing services, because the activities and operations associated with designing, producing and promoting applicant's own product are ancillary activities that would be expected by purchasers and readers of any magazine); *In re Landmark Communications, Inc.*, 204 USPQ 692 (TTAB 1979) (title of newspaper section not registrable as service mark for educational or entertainment service, because collected articles, stories, reports, comics, advertising and illustrations are indispensable components of newspapers without which newspapers would not be sold); *In re Television Digest, Inc.*, 169 USPQ 505 (TTAB 1971) (calculating advertising rates for a trade publication not a registrable

## EXAMINATION OF DIFFERENT TYPES OF MARKS

service, because this is an integral part of the production or operation of any publication).

However, providing advertising space in one's own periodical may be a registrable service, if the advertising activities are sufficiently separate from the applicant's publishing activities. *In re Forbes Inc.*, 31 USPQ2d 1315 (TTAB 1994) ("providing advertising space in a periodical" held to be a registrable service, where the advertising services were rendered to a different segment of the public under a different mark than the mark used to identify applicant's magazines); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990) (real estate advertising services rendered by soliciting advertisements and publishing a guide comprising the advertisements of others held to be a registrable service, where advertising was found to be the applicant's primary activity, and the customers who received the publication were not same as those to whom the advertising services were rendered).

### **1301.01(b)(iv) Soliciting Investors**

Offering shares of one's own stock for investment and reinvestment, and publication of reports to one's own shareholders, are not services, because these are routine corporate activities that primarily benefit the applicant. *In re Canadian Pacific Ltd.*, 754 F.2d 992, 224 USPQ 971 (Fed. Cir. 1985). Similarly, soliciting investors in applicant's own partnership is not a registrable service. *In re Integrated Resources, Inc.*, 218 USPQ 829 (TTAB 1983) (syndicating investment partnerships did not constitute a service within the meaning of the Trademark Act, because there was no evidence that the applicant was in the business of syndicating the investment partnerships of others; rather, the applicant partnership was engaged only in syndication of interests in its own organization). On the other hand, investing the funds of others is a registrable service that primarily benefits others. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985) (investment of funds of institutional investors and providing capital for management found to be a registrable service).

In *Canadian Pacific*, 224 USPQ at 974, the court noted that since shareholders are owners of the corporation, an applicant who offers a reinvestment plan to its stockholders is essentially offering the plan to itself and not to a segment of the buying public. The court distinguished *American International Reinsurance Co., Inc. v. Airco, Inc.*, 570 F.2d 941, 197 USPQ 69 (C.C.P.A. 1978), *cert. denied* 439 U.S. 866, 200 USPQ 64 (1978), in which offering an optional retirement plan to applicant's employees was found to be a registrable service that primarily benefits the employees.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1301.01(b)(v) Informational Services Ancillary to the Sale of Goods

Providing general information or instructions as to the purpose and uses of applicant's goods is merely incidental to the sale of goods, not a separate consulting service. *In re Moore Business Forms Inc.*, 24 USPQ2d 1638 (TTAB 1992) (paper manufacturer who rates the recycled content and recyclability of its own products is merely providing information about its goods, not rendering a service to others); *In re Reichhold Chemicals, Inc.*, 167 USPQ 376 (TTAB 1970) ("promoting the sale and use of chemicals" is not a registrable service, where applicant is merely providing "technical bulletins" that contain information about its own products); *Ex parte Armco Steel Corp.*, 102 USPQ 124 (Comm'r Pats. 1954) (analyzing the needs of customers is not registrable as a consulting service, because it is an ordinary activity that is normally expected of a manufacturer selling goods); *Ex parte Elwell-Parker Electric Co.*, 93 USPQ 229 (Comm'r Pats. 1952) (providing incidental instructions on the efficient use of applicant's goods not a service). However, an applicant's free hairstyling instructional "parties" were found to be a service, because conducting parties goes beyond what a seller of wigs would normally do in promoting its goods. *In re Heavenly Creations, Inc.*, 168 USPQ 317 (TTAB 1971).

### 1301.02 What Is a Service Mark

Not every word, combination of words, or other designation used in the sale or advertising of services is registrable as a service mark. To function as a service mark, the asserted mark must be used in a way that identifies and distinguishes the source of the services recited in the application. Even if it is clear that the applicant is rendering a service (see TMEP §§1301.01 *et seq.*), the record must show that the asserted mark actually identifies and distinguishes the source of the service recited in the application. *In re Advertising and Marketing Development Inc.*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987) (stationery specimens showed use of THE NOW GENERATION as a mark for applicant's advertising or promotional services as well as to identify a licensed advertising campaign, where the recited services were specified in a byline appearing immediately beneath the mark).

The fact that the proposed mark appears in an advertisement or brochure in which the services are advertised does not in itself show use as a mark. The record must show that there is a direct association between the mark and the service. See *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (C.C.P.A. 1973) (term that identifies only a process does not function as a service mark, even where services are advertised in the same specimen brochure in which the name of the process is used); *In re Duratech Industries Inc.*, 13 USPQ2d 2052 (TTAB 1989) (term used on bumper sticker with no reference to the services does not function as a mark); *Peopleware Systems, Inc. v. Peopleware, Inc.*, 226 USPQ 320 (TTAB 1985) (term PEOPLEWARE used within a byline on calling card specimen does not constitute service mark usage of term, even if specimen elsewhere shows that applicant provides the recited services); *In re J.F. Pritchard & Co. and Kobe Steel, Ltd.*, 201



## EXAMINATION OF DIFFERENT TYPES OF MARKS

USPQ 951 (TTAB 1979) (proposed mark used only to identify a liquefaction process in brochure advertising the services does not function as a mark, because there is no direct association between mark and offering of services). See TMEP §1301.04(b).

The question of whether a designation functions as a mark that identifies and distinguishes the recited services is determined by examining the specimen(s) and any other evidence in the record that shows how the designation is used. *In re Morganroth*, 208 USPQ 284 (TTAB 1980); *In re Republic of Austria Spanische Reitschule*, 197 USPQ 494 (TTAB 1977). It is the perception of the ordinary customer that determines whether the asserted mark functions as a service mark, not the applicant's intent, hope or expectation that it do so. *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (C.C.P.A. 1960). Factors that the examining attorney should consider in determining whether the asserted mark is used as a service mark include whether wording is physically separate from textual matter, whether a term is displayed in capital letters or enclosed in quotation marks, and the manner in which a term is used in relation to other material on the specimen.

While a service mark does not have to be displayed in any particular size or degree of prominence, it must be used in a way that makes a commercial impression separate and apart from the other elements of the advertising matter or other material upon which it is used, such that the designation will be recognized by prospective purchasers as a source identifier. *In re C.R. Anthony Co.*, 3 USPQ2d 1894 (TTAB 1987); *In re Post Properties, Inc.*, 227 USPQ 334 (TTAB 1985). The proposed mark must not blend so well with other matter on specimens that it is difficult or impossible to discern what the mark is. *In re McDonald's Corp.*, 229 USPQ 555 (TTAB 1985); *In re Royal Viking Line A/S*, 216 USPQ 795 (TTAB 1982); *In re Republic of Austria Spanische Reitschule, supra*; *Ex parte National Geographic Society*, 83 USPQ 260 (Comm'r Pats. 1949). On the other hand, the fact that the proposed mark is prominently displayed does not in and of itself make it registrable, if it is not used in a manner that would be perceived by consumers as an indicator of source. *In re Wakefern Food Corp.*, 222 USPQ 76 (TTAB 1984). The important question is not how readily a mark will be noticed but whether, when noticed, it will be understood as identifying and indicating the origin of the services. *In re Singer Mfg. Co.*, 255 F.2d 939, 118 USPQ 310 (C.C.P.A. 1958).

The presence of the "SM" symbol is not dispositive of the issue of whether matter sought to be registered is used as a service mark. *In re British Caledonian Airways Ltd.*, 218 USPQ 737 (TTAB 1983).

See TMEP §1301.02(a) for further information about matter that does not function as a service mark.

See TMEP §§1301.01 *et seq.* regarding what constitutes a service.

See TMEP §§1301.04 *et seq.* regarding service mark specimens.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1301.02(a) Matter That Does Not Function as a Service Mark

To function as a service mark, a designation must be used in a manner that would be perceived by purchasers as identifying and distinguishing the source of the services recited in the application.

Use of a designation or slogan to convey advertising or promotional information, rather than to identify and indicate the source of the services, is not service mark use. See *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (C.C.P.A. 1960) (GUARANTEED STARTING found to be ordinary words that convey information about the services, not a service mark for the services of “winterizing” motor vehicles); *In re Melville Corp.*, 228 USPQ 970 (TTAB 1986) (BRAND NAMES FOR LESS found to be informational phrase that does not function as a mark for retail store services); *In re Brock Residence Inns, Inc.*, 222 USPQ 920 (TTAB 1984) (FOR A DAY, A WEEK, A MONTH OR MORE so highly descriptive and informational in nature that purchasers would be unlikely to perceive it as an indicator of the source of hotel services); *In re Wakefern Food Corp.*, 222 USPQ 76 (TTAB 1984) (WHY PAY MORE found to be a common commercial phrase that does not serve to identify grocery store services); *In re Gilbert Eiseman, P.C.*, 220 USPQ 89 (TTAB 1983) (IN ONE DAY not used as source identifier but merely as a component of advertising matter that conveyed a characteristic of applicant’s plastic surgery services); *In re European-American Bank & Trust Co.*, 201 USPQ 788 (TTAB 1979) (slogan THINK ABOUT IT found to be an informational or instructional phrase that would not be perceived as a mark for banking services); *In re Restonic Corp.*, 189 USPQ 248 (TTAB 1975) (phrase used merely to advertise goods manufactured and sold by applicant’s franchisees does not serve to identify franchising services). Cf. *In re Post Properties, Inc.*, 227 USPQ 334 (TTAB 1985) (the designation QUALITY SHOWS, set off from text of advertising copy in extremely large typeface and reiterated at the conclusion of the narrative portion of the ad, held to be a registrable service mark for applicant’s real estate management and leasing services, because it was used in a way that made a commercial impression separate from that of the other elements of advertising material upon which it was used, such that the designation would be recognized by prospective customers as a source identifier). See also TMEP §1202.04 regarding informational matter that does not function as a trademark.

A term that is used only to identify a product, device or instrument sold or used in the performance of a service rather than to identify the service itself does not function as a service mark. See *In re Moody’s Investors Service Inc.*, 13 USPQ2d 2043 (TTAB 1989) (“Aaa,” as used on the specimens, found to identify the applicant’s ratings instead of its rating services); *In re Niagara Frontier Services, Inc.*, 221 USPQ 284 (TTAB 1983) (WE MAKE IT, YOU BAKE IT only identifies pizza, and does not function as a service mark to identify grocery store services); *In re British Caledonian Airways Ltd.*, 218 USPQ 737 (TTAB 1983) (term that identifies a seat in the first class section of an airplane does not function as mark for air transportation services); *In re Editel Productions, Inc.*, 189 USPQ 111 (TTAB 1975) (MINI-MOBILE

## EXAMINATION OF DIFFERENT TYPES OF MARKS

identifies only a vehicle used in rendering services and does not serve to identify the production of television videotapes for others); *In re Oscar Mayer & Co. Inc.*, 171 USPQ 571 (TTAB 1971) (WIENERMOBILE does not function as mark for advertising and promoting the sale of wieners, where it is used only to identify a vehicle used in rendering claimed services).

Similarly, a term that only identifies a process, style, method, or system used in rendering the services is not registrable as a service mark unless it is also used to identify and distinguish the service. See TMEP §1301.02(e) and cases cited therein.

A term that only identifies a menu item does not function as a mark for restaurant services. *In re El Torito Restaurant Inc.*, 9 USPQ2d 2002 (TTAB 1988).

The name or design of a character or person does not function as a service mark unless it identifies and distinguishes the services in addition to identifying the character or person. See TMEP §1301.02(b) and cases cited therein.

A term used only as a trade name is not registrable as a service mark. See *In re Signal Companies, Inc.*, 228 USPQ 956 (TTAB 1986) (journal advertisement submitted as specimen showed use of ONE OF THE SIGNAL COMPANIES merely as an informational slogan, where words appeared only in small, subdued typeface underneath the address and telephone number of applicant's subsidiary). See TMEP §1202.01 for additional information about matter used solely as a trade name.

Matter that is merely ornamental in nature does not function as a service mark. See *In re Tad's Wholesale, Inc.*, 132 USPQ 648 (TTAB 1962) (wallpaper design not registrable as a service mark for restaurant services). See TMEP §1202.03 *et seq.* for additional information about ornamentation.

See TMEP §1202.02(b)(ii) regarding trade dress.

### **1301.02(b) Names of Characters or Personal Names as Service Marks**

Under 15 U.S.C. §1127, a name or design of a character does not function as a service mark unless it identifies and distinguishes services in addition to identifying the character. If the name or design is used only to identify the character, it is not registrable as a service mark. *In re Hechinger Investment Co. of Delaware Inc.*, 24 USPQ2d 1053 (TTAB 1991) (design of dog appearing in advertisement does not function as mark for retail hardware and housewares services); *In re McDonald's Corp.*, 229 USPQ 555 (TTAB 1985) (APPLE PIE TREE does not function as mark for restaurant services, where the specimens show use of mark only to identify one character in a procession of characters); *In re Whataburger Systems, Inc.*, 209 USPQ 429 (TTAB 1980) (design of zoo animal character distributed to restaurant customers in the form of an iron-on patch not used in a manner that would be perceived as an indicator of source); *In re Burger King Corp.*, 183 USPQ

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

698 (TTAB 1974) (fanciful design of king does not serve to identify and distinguish restaurant services).

Similarly, personal names (actual names and pseudonyms) of individuals or groups function as marks only if they identify and distinguish the services recited and not merely the individual or group. *In re Mancino*, 219 USPQ 1047 (TTAB 1983) (holding that BOOM BOOM would be viewed by the public solely as applicant's professional boxing nickname and not as an identifier of the service of conducting professional boxing exhibitions); *In re Lee Trevino Enterprises, Inc.*, 182 USPQ 253 (TTAB 1974) (LEE TREVINO used merely to identify a famous professional golfer rather than as a mark to identify and distinguish any services rendered by him); *In re Generation Gap Products, Inc.*, 170 USPQ 423 (TTAB 1971) (GORDON ROSE used only to identify a particular individual and not as a service mark to identify the services of a singing group).

The name of a character or person *is* registrable as a service mark if the record shows that it is used in a manner that would be perceived by purchasers as identifying the services in addition to the character or person. *In re Florida Cypress Gardens Inc.*, 208 USPQ 288 (TTAB 1980) (name CORKY THE CLOWN used on handbills found to function as a mark to identify live performances by a clown, where the mark was used to identify not just the character but also the act or entertainment service performed by the character); *In re Carson*, 197 USPQ 554 (TTAB 1977) (individual's name held to function as mark, where specimens showed use of the name in conjunction with a reference to services and information as to the location and times of performances, costs of tickets, and places where tickets could be purchased); *In re Ames*, 160 USPQ 214 (TTAB 1968) (name of musical group functions as mark, where name was used on advertisements that prominently featured a photograph of the group and gave the name, address and telephone number of the group's booking agent); *In re Folk*, 160 USPQ 213 (TTAB 1968) (THE LOLLIPOP PRINCESS functions as a service mark for entertainment services, namely, telling children's stories by radio broadcasting and personal appearances).

See TMEP §§1202.09 *et seq.* regarding the registrability of the name of an artist or author as a trademark for goods.

### **1301.02(c) Three-Dimensional Service Marks**

The three-dimensional configuration of a building is registrable as a service mark only if it is used in such a way that it is or could be perceived as a mark. Evidence of use might include menus or letterhead that shows promotion of the building's design, or configuration, as a mark. See *In re Lean-To Barbecue, Inc.*, 172 USPQ 151 (TTAB 1971); *In re Master Kleens of America, Inc.*, 171 USPQ 438 (TTAB 1971); *In re Griffs of America, Inc.*, 157 USPQ 592 (TTAB 1968). Cf. *Fotomat Corp. v. Cochran*, 437 F. Supp. 1231, 194 USPQ 128 (D. Kan. 1977); *Fotomat Corp. v. Photo Drive-Thru, Inc.*, 425 F. Supp. 693, 193 USPQ 342 (D.N.J. 1977).

## EXAMINATION OF DIFFERENT TYPES OF MARKS

A three-dimensional costume design may function as a mark for entertainment services. See *In re Red Robin Enterprises, Inc.*, 222 USPQ 911 (TTAB 1984).

Generally, a photograph is a proper specimen of use for a three-dimensional mark. However, photographs of a building are not sufficient to show use of the building design as a mark for services performed in the building if they only show the building in which the services are performed. The specimen must show that the proposed mark is used in a way that would be perceived as a mark.

See 37 C.F.R. §2.52(b)(2) and TMEP §807.10 regarding drawings of three-dimensional marks.

When examining a three-dimensional mark, the examining attorney must determine whether the proposed mark is inherently distinctive. See TMEP §1202.02(b)(ii).

### **1301.02(d) Titles of Radio and Television Programs**

The title of a continuing series of presentations (e.g., a television or movie “series,” a series of live performances, or a continuing radio program), may constitute a mark for either entertainment services or educational services. However, the title of a single creative work, that is, the title of one episode or event presented as one program, does not function as a service mark. *In re Posthuma*, 45 USPQ2d 2011 (TTAB 1998) (term that identifies title of a play not registrable as service mark for entertainment services). See also *In re Cooper*, 254 F.2d 611, 117 USPQ 396 (C.C.P.A. 1958), cert. denied, 358 U.S. 840, 119 USPQ 501 (1958); *In re Scholastic Inc.*, 223 USPQ 431 (TTAB 1984), and TMEP §1202.08, in which analogous situations involving book titles are discussed. The record must show that the matter sought to be registered is more than the title of one presentation, performance or recording.

Specimens that show use of a service mark in relation to television programs or a movie series may be in the nature of a photograph of the video or film frame when the mark is used in the program.

Service marks in the nature of titles of entertainment programs may be owned by the producer of the show, by the broadcasting system or station, or by the author or creator of the show, depending upon the circumstances. Normally, an applicant’s statement that the applicant owns the mark is sufficient; the examining attorney should not inquire about ownership unless information in the record clearly contradicts the applicant’s verified statement that it is the owner of the mark.

### **1301.02(e) Process, System or Method**

A term that only identifies a process, style, method, system, or the like is not registrable as a service mark. A system or process is only a way of doing something, not a service. The name of a system or process does not become a

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

service mark unless it is also used to identify and distinguish the service. *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (C.C.P.A. 1973) (term not registrable as service mark where the specimens show use of the term only as the name of a process, even though applicant is in the business of rendering services generally and the services are advertised in the same specimen brochure in which the name of the process is used); *In re Walker Research, Inc.*, 228 USPQ 691 (TTAB 1986) (term that merely identifies computer program used in rendering services does not function as mark to identify market analysis services); *In re Hughes Aircraft Co.*, 222 USPQ 263 (TTAB 1984) (term does not function as service mark where it only identifies a photochemical process used in rendering service); *In re Turbine Metal Technology, Inc.*, 219 USPQ 1132 (TTAB 1983) (term that merely identifies coating material does not function as mark for repair and reconstruction services); *In re Vsesoyuzny Ordena Trudovogo Krasnogo Znameni Nauchnoissledovatel'skiy Gorno-Metallurgicheskiy Institut Tsvetnykh Metallov "Vnitsvetmet"*, 219 USPQ 69 (TTAB 1983) (KIVCET identifies only a process and plant configuration, not engineering services); *In re Information Builders Inc.*, 213 USPQ 593 (TTAB 1982) (term identifies only a computer program, not the service of installing and providing access to a computer program); *In re Scientific Methods, Inc.*, 201 USPQ 917 (TTAB 1979) (term that merely identifies educational technique does not function as mark to identify educational services); *In re J.F. Pritchard & Co. and Kobe Steel, Ltd.*, 201 USPQ 951 (TTAB 1979) (term used only to identify liquefaction process does not function as mark to identify design and engineering services); *In re Produits Chimiques Ugine Kuhlmann Societe Anonyme*, 190 USPQ 305 (TTAB 1976) (term that merely identifies a process used in rendering the service does not function as service mark); *In re Lurgi Gesellschaft Fur Mineraloltechnik m.b.H.*, 175 USPQ 736 (TTAB 1972) (term that merely identifies process for recovery of high purity aromatics from hydrocarbon mixtures does not function as service mark for consulting, designing and construction services); *Ex parte Phillips Petroleum Co.*, 100 USPQ 25 (Comm'r Pats. 1953) (although used in advertising of applicant's engineering services, CYCLOVERSION was only used in the advertisements to identify a catalytic treating and conversion process).

If the term is used to identify *both* the process *and* the services rendered by means of the process, the designation may be registrable as a service mark. See *Liqwaccon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305 (TTAB 1979), in which the Board found that the mark LIQWACON identified both a waste treatment and disposal service and a chemical solidification process.

The name of a system or process is registrable only if (1) the applicant is performing a service (see TMEP §§1301.01 *et seq.*), and (2) the designation identifies and indicates the source of the service. In determining eligibility for registration, the examining attorney must carefully review the specimens, together with any other information in the record, to see how the applicant uses the proposed mark. The mere advertising of the recited services in a brochure that refers to the process does not establish that a designation functions as a service mark; there must be some

## EXAMINATION OF DIFFERENT TYPES OF MARKS

association between the offer of services and the matter sought to be registered. *In re Universal Oil Products Co.*, *supra*; *In re J.F. Pritchard & Co.*, *supra*.

### **1301.03 Use of Service Mark in Commerce**

#### **1301.03(a) Use of Service Mark in Advertising to Identify Services**

In examining an application under 15 U.S.C. §1051(a), an amendment to allege use under 15 U.S.C. §1051(c), or a statement of use under 15 U.S.C. §1051(d), the examining attorney ordinarily should refuse registration if the record shows that the services advertised have not been rendered. For example, the use of a mark in the announcement of a future service does not constitute use as a service mark. *In re Port Authority of New York*, 3 USPQ2d 1453 (TTAB 1987) (advertising and promoting telecommunications services before the services were available insufficient to support registration); *In re Cedar Point, Inc.*, 220 USPQ 533 (TTAB 1983) (advertising of OCEANA marine entertainment park, that was not yet open, held not a valid basis for registration); *In re Nationwide Mutual Ins. Co.*, 124 USPQ 465 (TTAB 1960) (stickers placed on policies, bills and letters announcing prospective name change is mere adoption, not service mark use).

See TMEP 806.03(c) regarding amendment of the basis to intent-to-use under 15 U.S.C. §1051(b) when a §1(a) basis fails; TMEP §1104.10 regarding withdrawal of an amendment to allege use, and TMEP §§1109.16 *et seq.* regarding the time limits for correcting deficiencies in a statement of use.

#### **1301.03(b) Rendering of Service in Commerce Regulable by Congress**

In an application under §1(a) or 1(b) of the Trademark Act, 15 U.S.C. §1051(a) or 1051(b), the applicant must use the mark in commerce before a registration may be granted. Section 45 of the Act, 15 U.S.C. §1127, defines “commerce” as “all commerce which may lawfully be regulated by Congress.” See TMEP §§901.01 and 901.03.

The following are three examples of how a service may be rendered in commerce: (1) the applicant’s services are rendered across state lines; (2) customers come across state lines in response to advertising for the services; and (3) the applicant’s licensees or franchisees are located in more than one state, and they use the mark. See TMEP §901.03 and cases cited therein.

### **1301.04 Specimens of Use for Service Marks**

A service mark specimen must show the mark as actually used in the sale or advertising of the services recited in the application. 37 C.F.R. §2.56(b)(2). Acceptable specimens may include newspaper and magazine advertisements, brochures, billboards, handbills, direct-mail leaflets, menus (for restaurants), and the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

like. However, printer's proofs for advertisements, publicity releases to news media, or printed articles resulting from such releases, are not accepted because they do not show use of the mark by the applicant in the sale or advertising of the services. Business documents such as letterhead and invoices may be acceptable service mark specimens if they show the mark and refer to the relevant services. See TMEP §1301.04(b).

See 37 C.F.R. §2.59 and TMEP §904.09 regarding substitute specimens.

### **1301.04(a) Specimens Must Show Use as a Service Mark**

To show service mark usage, the specimens must show use of the mark in a manner that would be perceived by potential purchasers as identifying the applicant's services and indicating their source. *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (C.C.P.A. 1973) (term that identified only a process held not registrable as service mark, even though applicant was rendering services and the services were advertised in the same brochure in which the name of the process was used); *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART perceived as informational matter rather than as service mark for art dealership services, where the term is displayed inconspicuously in specimen brochure amid other informational matter, in the same size and font as the rest of the brochure text); *In re Moody's Investors Service Inc.*, 13 USPQ2d 2043 (TTAB 1989) ("Aaa," as used on the specimens, found to identify the applicant's ratings instead of its rating services); *In re McDonald's Corp.*, 229 USPQ 555 (TTAB 1985) (APPLE PIE TREE did not function as mark for restaurant services, where the specimens showed use of mark only to identify one character in a procession of characters, and the proposed mark was no more prominent than anything else on specimens); *In re Signal Companies, Inc.*, 228 USPQ 956 (TTAB 1986) (journal advertisement submitted as specimen showed use of ONE OF THE SIGNAL COMPANIES merely as an informational slogan, where the words appeared only in small, subdued typeface underneath the address and telephone number of applicant's subsidiary); *In re Republic of Austria Spanische Reitschule*, 197 USPQ 494 (TTAB 1977) (use of mark as one of many pictures in applicant's brochure would not be perceived as an indication of the source of the services); *Intermed Communications, Inc. v. Chaney*, 197 USPQ 501 (TTAB 1977) (business progress reports directed to potential investors do not show service mark use for medical services); *In re Restonic Corp.*, 189 USPQ 248 (TTAB 1975) (phrase used merely to advertise goods manufactured and sold by applicant's franchisees does not identify franchising services); *In re Reichhold Chemicals, Inc.*, 167 USPQ 376 (TTAB 1970) (technical bulletins and data sheets on which mark was used merely to advertise chemicals do not show use as a service mark for consulting services).

See TMEP §1301.02(a) regarding matter that does not function as a service mark.



## EXAMINATION OF DIFFERENT TYPES OF MARKS

### 1301.04(b) Association Between Mark and Services

Where the mark is used in advertising the services, the specimen must show an association between the mark and the services for which registration is sought. A specimen that shows only the mark, with no reference to the services, does not show service mark usage. *In re Adair*, 45 USPQ2d 1211 (TTAB 1997) (tags affixed to decorated Christmas tree that bear the mark “TREE ARTS CO. and design” and the applicant’s location, but make no reference to services, fail to show use for “design services in the nature of designing handcrafted, permanently decorated Christmas and designer trees”); *In re Johnson Controls, Inc.*, 33 USPQ2d 1318 (TTAB 1994) (labels affixed to packaging of valves do not show use of mark for custom manufacture of valves); *In re Duratech Industries Inc.*, 13 USPQ2d 2052 (TTAB 1989) (bumper stickers showing only the mark do not show use to identify “association services, namely promoting the interests of individuals who censor the practice of drinking and driving”); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (cutouts showing mark with no reference to the services held unacceptable for automotive service center); *In re Whataburger Systems, Inc.*, 209 USPQ 429 (TTAB 1980) (iron-on transfer clothing patches in the form and shape of a cartoon animal mark, distributed as free promotional items to restaurant customers at counters, held insufficient to identify restaurant services). See also TMEP §1301.04(c) and cases cited therein.

A specimen that shows the mark as used in the course of performing the services is generally acceptable. Where the record shows that the mark is used in performing (as opposed to advertising) the services, a reference to the services on the specimen itself may not be necessary. *In re Metriplex Inc.*, 23 USPQ2d 1315 (TTAB 1992) (computer printouts showing mark GLOBAL GATEWAY found acceptable to show use of mark to identify data transmission services accessed via computer, because they show use of mark as it appears on computer terminal in the course of rendering the services); *In re Eagle Fence Rentals, Inc.*, 231 USPQ 228 (TTAB 1986) (photograph of rented fence held acceptable for rental of chain link fences, since it shows use of distinctive color scheme in the rendering services); *In re Red Robin Enterprises, Inc.*, 222 USPQ 911 (TTAB 1984) (photograph of costume worn by performer during performance of entertainment services held to be an acceptable specimen). In *Johnson Controls, Inc.*, *supra*, 33 USPQ2d at 1320 (holding that labels attached to the packaging of valves did not show use of the mark for custom manufacturing of valves), the Board distinguished *Metriplex* and *Eagle Fence*, noting that the labels were not used in the rendering of the services, as the custom manufacturing services were complete before purchasers ever see the mark.

In determining whether a specimen is acceptable evidence of service mark use, the examining attorney may consider applicant’s explanations as to how the specimen is used, along with any other available evidence in the record that shows how the mark is actually used. See *In re International Environmental Corp.*, 230 USPQ 688 (TTAB 1986), in which a survey distributed to potential customers of applicant’s heating and air conditioning distributorship services was held to be an acceptable specimen even

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

though it did not specifically refer to the services, where the applicant stated that the sale of its services involved ascertaining the needs of customers serviced, and the record showed that the surveys were directed to potential customers and were the means by which applicant offered its distributorship services to the public.

### **1301.04(c) Letterhead**

Letterhead stationery, business cards or invoices bearing the mark may be accepted if they create an association between the mark and the services. To create an association between the mark and the services, the specimen does not have to spell out the specific nature or type of services. A general reference to the industry may be acceptable. *In re Ralph Mantia Inc.*, 54 USPQ2d 1284 (TTAB 2000) (letterhead and business cards showing the word “Design” are acceptable evidence of use of mark for commercial art design services); *In re Southwest Petro-Chem, Inc.*, 183 USPQ 371 (TTAB 1974) (use of mark on letterhead next to the name SOUTHWEST PETRO-CHEM, INC. found to be sufficient to show use of the mark for “consulting and advisory services relating to the making and using of lubricating oils and greases,” when used for letters in correspondence with customers).

Letterhead or business cards that bear only the mark and a company name and address are not adequate specimens (unless the mark itself has a descriptive portion that refers to the service), because they do not show that the mark is used in the sale or advertising of the particular services recited in the application. *In re Monograms America, Inc.*, 51 USPQ2d 1317 (TTAB 1999) (letterhead specimens showing the mark MONOGRAMS AMERICA and the wording “A Nationwide Network of Embroidery Stores” held insufficient to support registration for consulting services for embroidery stores).

If the letterhead itself does not include a reference to the services, a copy of an actual letter on letterhead stationery bearing the mark is an acceptable specimen of use if the content of the letter indicates the field or service area in which the mark is used. In *Monograms America, supra*, the Board indicated that the letterhead specimen might have been accepted if the applicant had submitted a copy of a letter to a store owner describing the services. 51 USPQ2d 1319.

### **1301.04(d) Specimens for Entertainment Services**

For live entertainment services, acceptable specimens include a photograph of the group or individual in performance with the name displayed, *e.g.*, the name printed on the drum of a band. For any entertainment service, advertisements or radio or television listings showing the mark may be submitted, but the specimens must show that the mark is used to identify and distinguish the services recited in the application, not just the performer. See *In re Ames*, 160 USPQ 214 (TTAB 1968) (advertisements for records show use of the mark for entertainment services rendered by a musical group, where the advertisements prominently featured a

## EXAMINATION OF DIFFERENT TYPES OF MARKS

photograph of musical group and gave the name, address and telephone number of a booking agent).

A designation that identifies only the performer is not registrable as a service mark. See TMEP §1301.02(b) regarding the registrability of names of characters or personal names as service marks.

### **1301.05 Identification and Classification of Services**

See TMEP §§1402.11 *et seq.* regarding identification of services, and TMEP §§1401 *et seq.* regarding classification.

### **1302 Collective Marks Generally**

Section 45 of the Trademark Act, 15 U.S.C. §1127, defines “collective mark” as follows:

The term “collective mark” means a trademark or service mark--

- (1) used by the members of a cooperative, an association, or other collective group or organization, or
- (2) which such cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, and includes marks indicating membership in a union, an association or other organization.

Under the Trademark Act, a collective mark must be *owned by* a collective entity even though the mark is *used by* the members of the collective. There are basically two types of collective marks: (1) collective trademarks or collective service marks; and (2) collective membership marks. The distinction between these types of collective marks is explained in *Aloe Creme Laboratories, Inc. v. American Society for Aesthetic Plastic Surgery, Inc.*, 192 USPQ 170, 173 (TTAB 1976), as follows:

*A collective trademark or collective service mark* is a mark adopted by a “collective” (*i.e.*, an association, union, cooperative, fraternal organization, or other organized collective group) for use only by its members, who in turn use the mark to identify their goods or services and distinguish them from those of nonmembers. The “collective” itself neither sells goods nor performs services under a collective trademark or collective service mark, but the collective may advertise or otherwise promote the goods or services sold or rendered by its members under the mark. *A collective membership mark* is a mark adopted for the purpose of indicating membership in an organized collective group, such as a union, an association, or other organization. Neither the collective

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

nor its members uses the collective membership mark to identify and distinguish goods or services; rather, the sole function of such a mark is to indicate that the person displaying the mark is a member of the organized collective group.

See also *In re International Institute of Valuers*, 223 USPQ 350 (TTAB 1984). See TMEP §1303 concerning collective trademarks and service marks; TMEP §1304 concerning collective membership marks; and TMEP §1305, which distinguishes collective trademarks or service marks from trademarks and service marks used by collective organizations.

### **1302.01 History of Collective Marks**

Section 4 of the Trademark Act of 1946, 15 U.S.C. §1054, provides for registration of both collective marks and certification marks, without distinguishing between them, but §45 of the Act, 15 U.S.C. §1127, defines collective marks and certification marks separately, as distinctly different types of marks. (See TMEP §§1306 *et seq.* regarding certification marks.)

A brief history will serve to put these sections in perspective. The earlier statutory provision, out of which §4 and the accompanying definitions in §45 grew, was the June 10, 1938, amendment of the Trademark Act of 1905. Under the Act of 1905, registration could be based only on a person's own use of a mark. The purpose of the 1938 amendment was to provide for registration of a mark by an owner who "exercises legitimate control over the use of a collective mark." "Collective marks," however, were not defined under the Act of 1905, as amended. Section 45 of the Act of 1946 defined the separate types of marks.

See TMEP §1304.01 for additional history relating to collective membership marks.

### **1303 Collective Trademarks and Collective Service Marks**

Collective trademarks and collective service marks indicate commercial origin of goods or services, but as *collective* marks they indicate that the party providing the goods or services is a member of a certain group and meets its standards for admission. The mark is used by all members of the group; therefore, no one member can own the mark, and the collective organization holds the title to the collectively used mark for the benefit of all members of the group. An agricultural cooperative of produce sellers is an example of a collective organization that does not sell its own goods or render services, but promotes the goods and services of its members.

The collective organization itself neither sells goods nor performs services under the mark, but may advertise to publicize the mark and promote the goods or services sold by its members under the mark.

## EXAMINATION OF DIFFERENT TYPES OF MARKS

A specimen of use of a collective trademark or service mark must show use of the mark by a member on the member's goods or in the sale or advertising of the member's services. 37 C.F.R. §2.56(b)(3); TMEP 1303.02(b).

### **1303.01 Use of Collective Trademark and Collective Service Mark Is By Members**

Applications for registration of collective trademarks and collective service marks are different in form from applications for registration of other trademarks and service marks because of the difference in ownership and use of collective marks.

Under the definition of "collective mark" in §45 of the Trademark Act, 15 U.S.C. §1127, a collective mark must be owned by a collective entity. The use of a collective trademark or collective service mark is by members of the collective. Therefore, in an application based on use in commerce under §1(a) of the Trademark Act, 15 U.S.C. §1051(a), the applicant must assert that the applicant is exercising legitimate control over the use of the mark in commerce by its members.

In an application based on §1(b), §44 or §66(a) of the Act, 15 U.S.C. §1051(b), 15 U.S.C. §1126 or 15 U.S.C. §1141f(a), the applicant must assert that the applicant has a bona fide intention to exercise legitimate control over the use of the mark in commerce by its members. In a §1(b) application, before the mark can register, the applicant must file an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d) alleging that the applicant is exercising legitimate control over the use of the mark in commerce by its members.

In certain situations, notwithstanding the use of a collective trademark or collective service mark by the members of the collective, the collective itself may also use the same mark as a trademark for the goods covered by the collective trademark or service mark registration. See TMEP §1305. The "anti-use-by-owner rule" of §4 of the Trademark Act, 15 U.S.C. §1054 does not apply to collective marks. See *Roush Bakery Products Co. v. F.R. Lepage Bakery Inc.*, 4 USPQ2d 1401 (TTAB 1987), *aff'd*, 851 F.2d 351, 7 USPQ2d 1395 (Fed. Cir. 1988), *withdrawn, vacated and remanded*, 863 F.2d 43, 9 USPQ2d 1335 (Fed. Cir. 1988), *vacated and modified*, 13 USPQ2d 1045 (TTAB 1989). The Trademark Law Revision Act of 1988, which became effective on November 16, 1989, amended §4 to indicate that the "anti-use-by-owner rule" in that section applies specifically to certification marks.

### **1303.02 Examination of Collective Trademark and Collective Service Mark Applications**

The examination of applications to register collective trademarks and collective service marks is conducted in a manner similar to the examination of applications to register regular trademarks and service marks, using most of the same criteria of registrability. Thus, the same standards generally applicable to trademarks and

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

service marks are used in considering issues such as descriptiveness or disclaimers. However, use and ownership requirements are slightly different due to the nature of collective marks. See TMEP §§1303.02(c) *et seq.* See TMEP §§1304 *et seq.* regarding examination of applications to register collective membership marks.

### **1303.02(a) Classification of Goods and Services in Collective Trademark and Collective Service Mark Applications**

The goods and services recited in collective trademark and collective service mark applications are assigned to the same classes that are appropriate for those goods and services in general, according to the classification schedules set forth in 37 C.F.R. §§6.1 and 6.2. See TMEP §§1401 *et seq.* regarding classification.

### **1303.02(b) Specimens of Use for Collective Trademark and Collective Service Mark Applications**

A specimen of use of a collective trademark or service mark should show use of the mark by a member on the member's goods or in the sale or advertising of the member's services. 37 C.F.R. §2.56(b)(3). The specimen should show use of the mark to indicate that the party providing the goods or services is a member of a certain group and meets its standards for admission.

### **1303.02(c) Special Elements of Collective Trademark and Collective Service Mark Applications**

#### **1303.02(c)(i) Manner of Control**

In addition to specifying and containing all elements that are applicable for trademarks, an application for registration of a collective mark under §1(a) of the Act must specify the class of persons entitled to use the mark, indicating their relationship to the applicant and the nature of the applicant's control over the use of the mark. 37 C.F.R. §2.44(a).

In addition to specifying and containing all elements that are applicable for trademarks, an application for registration of a collective mark under §1(b), §44, or §66(a) of the Act must specify the class of persons intended to be entitled to use the mark, indicating what their relationship to the applicant will be, and the nature of the control the applicant intends to exercise over the use of the mark. See 37 C.F.R. §2.44(b).

The following language may be used for the above purpose:

Applicant controls (or, if the application is being filed under §1(b), §44, or §66(a), applicant intends to control) the use of the mark by the members in the following manner: [specify].

## EXAMINATION OF DIFFERENT TYPES OF MARKS

If the applicant's bylaws or other written provisions specify the manner of control, or intended manner of control, it will be sufficient to so state.

### **1303.02(c)(ii) Use by Members Indicated in Dates-of-Use Clause**

When setting out dates of use of a collective mark on goods or in connection with services, in either a §1(a) application or an allegation of use filed in connection with a §1(b) application, the applicant must state that the mark was first used by members (or a member) of the applicant.

### **1304 Collective Membership Marks**

#### **1304.01 History of Membership Marks**

Section 4 of the Trademark Act of 1946, 15 U.S.C. §1054, provides that collective marks shall be registrable by persons exercising legitimate control over their use, even though not possessing an industrial or commercial establishment, and the definition of a collective mark in §45, 15 U.S.C. §1127, encompasses marks that indicate membership in a union, association or other organization.

The Trademark Act of 1905 prohibited registration by anyone of symbols of collective groups. The Act of 1946, however, contains no prohibition and thus permits registration by the owners of collective marks, including those used to indicate membership.

Membership marks are not trademarks or service marks in the ordinary sense; they are not used in business or trade, and they do not indicate commercial origin of goods or services. Registration of these marks fills the need of collective organizations who do not use the symbols of their organizations on goods or services but who wish to protect their marks to prevent their use by others. See *Ex parte Supreme Shrine of the Order of the White Shrine of Jerusalem*, 109 USPQ 248 (Comm'r Pats. 1956), regarding the rationale for registration of collective membership marks.

#### **1304.02 Purpose of Membership Mark**

The sole purpose of a collective membership mark is to indicate that the user of the mark is a member of a particular organization.

#### **1304.03 Use of Membership Mark Is by Members**

Registration of a membership mark is based on actual use of the mark by the members of a collective organization. The owner of the mark exercises control over the use of the mark; however, because the sole purpose of a membership mark is to indicate membership, use of the mark is by members. See *In re Triangle Club of*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*Princeton University*, 138 USPQ 332 (TTAB 1963) (collective membership mark registration denied because specimens did not show use of mark by members). See also TMEP §1304.09(c).

Nothing in the Trademark Act prohibits the use of the same mark as a membership mark by members and, also, as a trademark or a service mark by the parent organization (see TMEP §1303.01), but the same mark may not be used both as a membership mark and as a certification mark. TMEP §1306.05(a).

### **1304.04 Who May Apply to Register Membership Mark**

Application to register a membership mark must be made by the organization that controls or intends to control the use of the mark and, therefore, owns or is entitled to use the mark. Application may not be made by a member. Before a registration may be issued, however, the mark must have been used by appropriate members. See *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798 (TTAB 1984); *Constitution Party of Texas v. Constitution Association USA*, 152 USPQ 443 (TTAB 1966).

### **1304.05 Who May Own Membership Mark**

The owner of a collective membership mark is normally the collective organization whose members use the mark. The organization is usually an association, either incorporated or unincorporated, but is not limited to being an association and may have some other form.

A collective membership mark may be owned by someone other than the collective organization whose members use the mark, and the owner might not itself be a collective organization. An example is a business corporation that forms a club for persons meeting certain qualifications and arranges to retain control of the group and of the mark used by the members of the group. The corporation that has retained control over the use of the mark is the owner of the mark, and is entitled to apply to register the mark. *In re Stencel Aero Engineering Corp.*, 170 USPQ 292 (TTAB 1971).

### **1304.06 Nature of the Collective Group**

Under the definition of “collective mark” in §45 of the Trademark Act, 15 U.S.C. §1127, only a “cooperative, an association or other collective group or organization” can become the owner of a collective mark. However, there is great variety in the organizational form of collective groups whose members use membership marks. The terms “group” and “organization” are broad enough to cover all groups of persons who are brought together in an organized manner such as to justify their being called “collective.”



## EXAMINATION OF DIFFERENT TYPES OF MARKS

In order to apply to register a collective membership mark, the collective organization who owns the mark must be a person capable of suing and being sued in a court of law. See 15 U.S.C. §1127. See TMEP §§803.01 *et seq.*

The persons that compose a collective group may be either natural or juristic persons.

### **1304.07 Character of the Mark**

A collective membership mark may be a letter or letters, a word or words, a design alone, a name or nickname, or other matter that identifies the collective organization or indicates its purpose. A membership mark may, but need not, include the term “member” or the equivalent.

In addition to being printed (the most common form), a membership mark may consist of an object, such as a flag, or may be a part of articles of jewelry, such as pins or rings. See TMEP §§1304.03 and 1304.09(c) regarding use of membership marks and acceptable specimens.

### **1304.08 Refusal to Register Membership Mark**

An application to register a collective membership mark on the Principal Register must meet all the criteria for registration of other marks on the Principal Register. 15 U.S.C. §1054. See 37 C.F.R. §2.46. Likewise, when determining the registrability of a collective membership mark on the Supplemental Register, the same standards are used as are applied to other types of marks. See 37 C.F.R. §2.47. Thus, the same standards generally applicable to trademarks and service marks are used in considering issues such as descriptiveness or disclaimers. *Racine Industries Inc. v. Bane-Clene Corp.*, 35 USPQ2d 1832, 1837 (TTAB 1994); *In re Association of Energy Engineers, Inc.*, 227 USPQ 76, 77 (TTAB 1985).

#### **1304.08(a) Matter That Does Not Function as a Membership Mark**

Whether or not matter functions as a collective membership mark is determined by the specimens and evidence of record. It is the use of the mark to indicate membership rather than the character of the matter composing the mark that determines whether a term or other designation is a collective membership mark. See *Ex parte Grand Chapter of Phi Sigma Kappa*, 118 USPQ 467 (Comm’r Pats. 1958), which held that Greek letter abbreviations are not collective membership marks indicating membership in Greek letter societies simply because some people apply them to athletic jerseys, and *In re Mountain Fuel Supply Co.*, 154 USPQ 384 (TTAB 1967), which held that the design on a jewelry pin indicated longevity rather than membership in an organization. If a proposed mark does not function as a mark indicating membership, the examining attorney should refuse registration

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

under §§1, 2, 4, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1054, and 1127. See TMEP §1304.08(c) as to degrees or titles.

### **1304.08(b) Likelihood of Confusion**

Likelihood of confusion may arise from the contemporaneous use of a collective membership mark on the one hand and a trademark or service mark on the other. The same standards used to determine likelihood of confusion between trademarks and service marks also apply to collective membership marks. See 15 U.S.C. §1052(d); *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *Allstate Life Ins. Co. v. Cuna International, Inc.*, 169 USPQ 313 (TTAB 1971), *aff'd*, 487 F.2d 1407, 180 USPQ 48 (C.C.P.A. 1973); *Boise Cascade Corp. v. Mississippi Pine Manufacturers Assn.*, 164 USPQ 364 (TTAB 1969).

The finding of likelihood of confusion between a collective membership mark and a trademark or service mark is not based on confusion as to the source of any goods or services which happen to be provided by the members of the collective organization. Rather, the question is whether relevant persons are likely to believe that the trademark owner's goods or services emanate from, are endorsed by, or are in some way associated with the collective organization. *In re Code Consultants Inc.*, 60 USPQ2d 1699, 1701 (TTAB 2001).

### **1304.08(c) Degree or Title Designations Contrasted to Membership Marks**

Professional, technical, educational, and similar organizations often adopt letters or similar designations to be used by persons to indicate that the persons have passed certain tests or completed certain courses of instruction that are specified by the organization, or have demonstrated a degree of proficiency to the satisfaction of the organization. When such a symbol is used solely as a personal title or degree for an individual (*i.e.*, it is used in a manner that identifies only a title or degree conferred on this individual), then it does not serve to indicate membership in an organization and registration as a membership mark must be refused. *In re International Institute of Valuers*, 223 USPQ 350 (TTAB 1984) (refusal affirmed in collective membership application where use of the mark on specimens indicated award of a degree or title, and not membership in collective entity). See also *In re National Society of Cardiopulmonary Technologists, Inc.*, 173 USPQ 511 (TTAB 1972). Cf. *In re Thacker*, 228 USPQ 961 (TTAB 1986); *In re National Association of Purchasing Management*, 228 USPQ 768 (TTAB 1986); *In re Mortgage Bankers Association of America*, 226 USPQ 954 (TTAB 1985).

If the proposed mark functions simply as a degree or title, the examining attorney should refuse registration under §§1, 2, 4, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1054, and 1127, on the ground that the matter does not function as a membership mark. See TMEP §1304.08(a).

## EXAMINATION OF DIFFERENT TYPES OF MARKS

### 1304.09 Examination of Collective Membership Mark Applications

The examination of collective membership mark applications is conducted in the same manner as the examination of applications to register trademarks and service marks, using the same criteria of registrability. Thus, the same standards generally applicable to trademarks and service marks are used in considering issues such as descriptiveness or disclaimers. However, use and ownership requirements are slightly different due to the nature of collective membership marks.

#### 1304.09(a) Classification in Membership Mark Applications

*Section 1 and 44 Applications.* In applications under §§1 and 44 of the Trademark Act, collective membership marks are classified in Class 200. 37 C.F.R. §6.4. Class 200 was established as a result of the decision in *Ex parte Supreme Shrine of the Order of the White Shrine of Jerusalem*, 109 USPQ 248 (Comm'r Pats. 1956). Before this decision, there was no registration of membership insignia as such on the theory that all collective marks were either collective trademarks or collective service marks. Some marks that were actually membership marks were registered under the Act of 1946 as collective service marks, and a few were registered as collective trademarks. That practice was discontinued upon the clarification of the basis for registration of membership marks and the creation of Class 200.

*Section 66(a) Applications.* In a §66(a) application (*i.e.*, a request for extension of protection of an international registration to the United States under the Madrid Protocol), classification is determined by the International Bureau of the World Intellectual Property Organization ("IB"), in accordance with the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks* ("*Nice Agreement*"). Class 200 comes from the old U.S. classification system (see TMEP §1401.02) and is not included in the international classification system. In a §66(a) application, the international classification of goods/services cannot be changed from the classification given to the goods/services by the IB. See TMEP §1401.03(d). Accordingly, if the mark in a §66(a) application appears to be a collective membership mark, the United States Patent and Trademark Office ("USPTO") **will not** reclassify it into Class 200. However, the applicant must comply with all other U.S. requirements for collective membership marks, regardless of the classification chosen by the IB.

#### 1304.09(b) Identifications in Membership Mark Applications

An identification of goods or services is not appropriate in connection with a collective membership mark. The purpose of a collective membership mark is to indicate membership in an organization. Appropriate identification language would be, "to indicate membership in an organization (association, club or the like)..." followed by a phrase indicating the nature of the organization or association, *e.g.*, "to indicate membership in an organization of computer professionals."

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The nature of an organization can be indicated by specifying the area of activity of its members (e.g., they may sell lumber, or cosmetics, or food, or may deal in chemical products or household goods, or they may provide services as fashion designers or engineers or accountants). If goods or services are not directly involved, the nature of an organization can be indicated by specifying the organization's type or purpose (such as a service or social club, a political society, a trade association, a beneficial fraternal organization, or the like). Detailed descriptions of an organization's objectives or activities are not necessary. It is sufficient if the identification indicates broadly either the field of activity as related to the goods or services, or the general type or purpose of the organization.

### **1304.09(c) Specimens of Use for Membership Marks**

The owner of a collective membership mark exercises control over the use of the mark but does not itself use the mark to indicate membership. A specimen of use of a collective membership mark must show use by members to indicate membership in the collective organization. 37 C.F.R. §2.56(b)(4). *In re International Association for Enterostomal Therapy, Inc.*, 218 USPQ 343 (TTAB 1983); *In re Triangle Club of Princeton University*, 138 USPQ 332 (TTAB 1963). See also TMEP §1304.03.

The most common type of specimen is a membership card. Membership certificates are also acceptable. The applicant may submit a blank or voided membership card or certificate.

For trade or professional associations, decals bearing the mark for use by members on doors or windows in their establishments, wall plaques bearing the mark, or decals or plates for use, e.g., on members' vehicles are satisfactory specimens. If the members are in business and place the mark on their business stationery to show their membership, pieces of such stationery are acceptable. Flags, pennants, and banners of various types used in connection with political parties, club groups, or the like could be satisfactory specimens.

Many associations, particularly fraternal societies, use jewelry such as pins, rings or charms to indicate membership. See *In re Triangle Club of Princeton University, supra*. However, not every ornamental design on jewelry is necessarily an indication of membership. The record must show that the design on a piece of jewelry is actually an indication of membership before the jewelry can be accepted as a specimen of use. See *In re Institute for Certification of Computer Professionals*, 219 USPQ 372 (TTAB 1983) (in view of contradictory evidence in record, lapel pin with nothing more than CCP thereon was not considered evidence of membership); *In re Mountain Fuel Supply Co.*, 154 USPQ 384 (TTAB 1967) (design on pin did not indicate membership in organization, but merely showed length of service).

Shoulder, sleeve, pocket, or similar patches, whose design constitutes a membership mark and that are authorized by the parent organization for use by

## EXAMINATION OF DIFFERENT TYPES OF MARKS

members on garments to indicate membership, are normally acceptable as specimens.

A specimen that shows use of the mark by the collective organization itself, rather than by a member, is not acceptable. Collective organizations often publish various kinds of printed material, such as catalogs, directories, bulletins, newsletters, magazines, programs, and the like. Placing the mark on these items by the collective organization represents use of the mark as a trademark or service mark to indicate that the collective organization is the source of the material. The mark is not placed on these items by the parent organization to indicate membership of a person in the organization.

### **1304.09(d) Special Elements of Applications for Collective Membership Marks**

#### **1304.09(d)(i) Exercise of Control**

An application to register a collective membership mark must accurately convey the use or intended use of the mark with appropriate language, as follows.

In an application based on use in commerce under §1(a) of the Trademark Act, the applicant must assert that the applicant is exercising legitimate control over the use of the mark in commerce by its members.

In an application based on §1(b), §44 or §66(a) of the Act, the applicant must assert that the applicant has a bona fide intention to exercise legitimate control over the use of the mark in commerce by its members. In a §1(b) application, before the mark can register, the applicant must file an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d) alleging that the applicant is exercising legitimate control over the use of the mark in commerce by its members.

#### **1304.09(d)(ii) Manner of Control**

In addition to specifying and containing all elements that are applicable for trademarks, an application for registration of a collective mark under §1(a) of the Act must specify the class of persons entitled to use the mark, indicating their relationship to the applicant and the nature of the applicant's control over the use of the mark. 37 C.F.R. §2.44(a).

In addition to specifying and containing all elements that are applicable for trademarks, an application for registration of a collective mark under §1(b), §44, or §66(a) of the Act must specify the class of persons intended to be entitled to use the mark, indicating what their relationship to the applicant will be, and the nature of the control the applicant intends to exercise over the use of the mark. *Cf.* 37 C.F.R. §2.44(b).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The following language may be used for the above purpose:

Applicant controls (or, if the application is being filed under §1(b), §44, or §66(a), applicant intends to control) the use of the mark by the members in the following manner: [specify].

If the applicant's bylaws or other written provisions specify the manner of control, or intended manner of control, it will be sufficient to so state.

### **1304.09(d)(iii) Use by Members Indicated in Dates-of-Use Clause**

When setting out dates of use of a collective membership mark, the application or allegation of use must state that the mark was first used by members of the applicant rather than by the applicant, and that the mark was first used on a specified date to indicate membership rather than first used on goods or in connection with services.

### **1305 Trademarks and Service Marks Used by Collective Organizations**

A collective organization may itself use trademarks and service marks to identify its goods and services, as opposed to collective trademarks and service marks or collective membership marks used by the collective's members. See *B.F. Goodrich Company v. National Cooperatives, Inc.*, 114 USPQ 406 (Comm'r Pats. 1957) (mark used to identify tires made for applicant cooperative and sold by its distributors is trademark, not collective mark that identifies goods of applicant's associated organizations; applicant alone provides specifications and other instructions and applicant alone is responsible for faulty tires).

The examination of applications to register trademarks and service marks used or intended to be used by collective organizations is conducted in the same manner as for other trademarks and service marks, using the same criteria of registrability.

The form of the application used by collective organizations is the same as for those used or intended to be used by other applicants. The collective organization should be listed as the applicant, because it uses or intends to use the mark itself. The specimen submitted must be material applied by the collective organization to its goods or used in connection with its services.

### **1306 Certification Marks**

#### **1306.01 Definition of Certification Mark**

Section 4 of the Trademark Act, 15 U.S.C. §1054, provides for the registration of "certification marks, including indications of regional origin." Section 45 of the Trademark Act, 15 U.S.C. §1127, defines "certification mark" as follows:

## EXAMINATION OF DIFFERENT TYPES OF MARKS

The term “certification mark” means any word, name, symbol, or device, or any combination thereof--

- (1) used by a person other than its owner, or
- (2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this Act,

to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person’s goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

A certification mark “is a special creature created for a purpose uniquely different from that of an ordinary service mark or trademark...” *In re Florida Citrus Commission*, 160 USPQ 495, 499 (TTAB 1968).

There are generally three types of certification marks. First, there are certification marks that certify that goods or services originate in a specific geographic region (e.g., ROQUEFORT for cheese). See *Community of Roquefort v. William Faehndrich, Inc.*, 303 F.2d 494, 133 USPQ 633 (2d Cir. 1962); *State of Florida, Department of Citrus v. Real Juices, Inc.*, 330 F. Supp. 428, 171 USPQ 66 (M.D. Fla. 1971) (SUNSHINE TREE for citrus from Florida); *Bureau National Interprofessionnel Du Cognac v. International Better Drinks Corp.*, 6 USPQ2d 1610 (TTAB 1988) (COGNAC for distilled brandy from a region in France). See TMEP §§1306.02 *et seq.*

Second, there are certification marks that certify that the goods or services meet certain standards in relation to quality, materials, or mode of manufacture (e.g., approval by Underwriters Laboratories). See *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990) (UL certifies, among other things, representative samplings of electrical equipment meeting certain safety standards); *In re Celanese Corporation of America*, 136 USPQ 86 (TTAB 1962) (CELANESE certifies plastic toys meeting certifier’s safety standards).

Third, certification marks may certify that the work or labor on the products or services was performed by a member of a union or other organization, or that the performer meets certain standards. See TMEP §1306.03 and cases cited therein for further information.

The statutory definition differentiates certification marks from trademarks or service marks by two characteristics. First, a certification mark is not used by its owner and, second, a certification mark does not indicate commercial source nor distinguish the goods or services of one person from those of another person. See TMEP

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

§1306.09(a) for a discussion of the distinction between a certification mark and a collective trademark, collective service mark or collective membership mark.

See Holtzman, *Certification Marks: An Overview*, 81 Trademark Rep. 180 (1991).

### **1306.01(a) Use Is by Person Other than Owner**

A certification mark may not be used, in the trademark sense of “used,” by the owner of the mark; it may be used only by a person or persons other than the owner of the mark. That is, the owner of a certification mark does not apply the mark to his or her goods or services and, in fact, usually does not attach or apply the mark at all. The mark is generally applied by other persons to their goods or services, with authorization from the owner of the mark.

The owner of a certification mark does not produce the goods or perform the services in connection with which the mark is used, and thus does not control their nature and quality. Therefore, it is not appropriate to inquire about control over the nature and quality of the goods or services. What the owner of the certification mark does control is use of the mark by others on their goods or services. This control consists of taking steps to ensure that the mark is applied only to goods or services that contain the characteristics or meet the requirements that the certifier/owner has established or adopted for the certification. See TMEP §1306.06(g)(ii) regarding submission of the standards established by the certifier to determine whether the certification mark may be used in relation to the goods and/or services of others.

### **1306.01(b) Purpose Is to Certify, Not to Indicate Source**

The purpose of a certification mark is to inform purchasers that the goods or services of a person possess certain characteristics or meet certain qualifications or standards established by another person. A certification mark does not indicate origin in a single commercial or proprietary source. In certifying, the same mark is used on the goods or services of many different producers.

The message conveyed by a certification mark is that the goods or services have been examined, tested, inspected, or in some way checked by a person who is not their producer, by methods determined by the certifier/owner. The placing of the mark on goods or its use in connection with services thus constitutes a certification by someone other than the producer that the prescribed characteristics or qualifications of the certifier for those goods or services have been met.

### **1306.02 Certification Marks That Are Indications of Regional Origin**

A geographical term may be used, either alone or as a portion of a composite mark, to certify that the goods originate in the particular geographical region identified by



## EXAMINATION OF DIFFERENT TYPES OF MARKS

the term. As noted in *Community of Roquefort v. William Faehndrich, Inc.*, 303 F.2d 494, 497, 133 USPQ 633, 635 (2d Cir. 1962):

A geographical name does not require a secondary meaning in order to qualify for registration as a certification mark. It is true that section 1054 provides that certification marks are “subject to the provisions relating to the registration of trademarks, so far as they are applicable....” But section 1052(e)(2), which prohibits registration of names primarily geographically descriptive, specifically excepts “indications of regional origin” registrable under section 1054.

Therefore, a geographical name may be registered as a certification mark even though it is primarily geographically descriptive.

When a geographical term is used in a composite certification mark to certify regional origin, the examining attorney should not require a disclaimer or refuse registration of the composite mark on the ground that the mark is primarily geographically descriptive. However, when a geographical term used in a composite certification mark is not used to certify regional origin (e.g., “California” used to certify that fruit is organically grown), the examining attorney should refuse registration or require a disclaimer, as appropriate.

Marks that may be used to certify regional origin are not necessarily limited to terms that comprise precise geographical terminology. A distortion of a geographical term, an abbreviation of a geographical term, or a combination of geographical terms can be used as, or in, a certification mark indicating regional origin. It is also possible for a term that is not technically geographical to have significance as an indication of origin solely in a particular region.

The issue in determining whether a designation is registrable as a regional certification mark is whether the public understands that goods bearing the mark come only from the region named in the mark, not whether the public is expressly aware of the certification function of the mark per se. If use of the designation in fact is controlled by the certifier and limited to products meeting the certifier’s standards of regional origin, and if purchasers understand the designation to refer only to products produced in the particular region and not to products produced elsewhere, then the designation functions as a regional certification mark. *Institut National Des Appellations D’Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875 (TTAB 1998).

A mark that is geographically deceptive may not be registered as a certification mark of regional origin. See TMEP §§1210.05 *et seq.* regarding geographically deceptive marks.

### **1306.02(a)      Indicating the Region**

The examining attorney should examine the specimens of use and evidence in the record to determine whether the geographical term is being used as a certification mark to indicate the regional origin of the goods upon which it is used. If the record

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

or other evidence available to the examining attorney indicates that a specific term in question has a principal significance as a generic term denoting a type of goods, registration should be refused. *In re Cooperativa Produttori Latte E Fontina Valle D'Acosta*, 230 USPQ 131 (TTAB 1986) (FONTINA held a generic name of a type of cheese rather than a certification mark indicating regional origin, in view of the fact that non-certified producers outside that region use the term to identify non-certified cheeses). The basis for refusal of registration on the Principal Register is 15 U.S.C. §§1052(e)(1), 1054, and 1127, and the basis for refusal of registration on the Supplemental Register is 15 U.S.C. §§1054, 1091 and 1127 (see TMEP §1209.02).

When a geographic term is being used as a certification mark to indicate regional origin, the application should define the regional origin that the mark certifies.

### **1306.02(b) Authority to Control a Geographical Term**

When a certification mark consists solely, or essentially, of a geographical term, the examining attorney should inquire as to the authority of the applicant to control the use of the term, if the authority is not obvious. Normally the entity that has authority to exercise control over the use of a geographical term as a certification mark is a governmental body or a body operating with governmental authorization. The right that a private person can acquire in a geographical term is usually a trademark right, on the basis of exclusive use resulting in the term becoming distinctive of that person's goods. When, however, circumstances make it desirable or necessary for many or all persons in a region to use the name of the region to indicate the origin of their goods, there would be no opportunity for the name to become distinctive for only one person. The term would be used by all persons in the region, not as a trademark indicating commercial origin, but as a certification mark indicating regional origin.

When a geographical term is used as a certification mark, two elements are of basic concern: first, preserving the freedom of all persons in the region to use the term and; second, preventing abuses or illegal uses of the mark that would be detrimental to all those entitled to use the mark. Normally a private individual is not in the best position to fulfill these objectives. The government of a region would be the logical authority to control the use of the name of the region. The government, either directly or through a body to which it has given authority, would have power to preserve the right of all persons and to prevent abuse or illegal use of the mark.

### **1306.02(c) The Government as Applicant for a Geographical Certification Mark**

The applicant may be the government itself (such as the government of the United States, a state or a city), one of the departments of a government, or a body operating with governmental authorization that is not formally a part of the government. There may be an interrelationship between bodies in more than one of

## EXAMINATION OF DIFFERENT TYPES OF MARKS

these categories and the decision as to which is the appropriate body to apply depends on which body actually conducts the certification program or is most directly associated with it. The determination may be made by the applicant, provided the examining attorney does not find any inconsistency between the selection and the facts indicated in the record.

### **1306.03 Certification Marks Certifying that Labor Was Performed by Specific Group or Individual**

A certification mark may be used to certify that the work or labor on the goods or services was performed by a member of a union or other organization, or by a person who meets certain standards and tests of competency set by the certifier. 15 U.S.C. §1127. The certifier does not certify the quality of the work being performed, but only that the work was performed by a member of the union or group, or by someone who meets certain standards. *In re National Institute for Automotive Service Excellence*, 218 USPQ 744, 747 (TTAB 1983). See also *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798 (TTAB 1984). Used in this manner, the mark certifies a characteristic of the goods or services. Whether or not specific matter functions as a certification mark depends on whether the matter is used in connection with the goods or services in such a manner that the purchasing public will recognize it, either consciously or otherwise, as a certification mark.

Occasionally it is not clear whether a term is being used to certify that work or labor relating to the goods or services was performed by someone meeting certain standards or by members of a union or other organization to indicate membership or whether the term is merely being used as a title or a degree of the performer to indicate professional qualifications. Matter that might appear to be simply a title or a degree may function as a certification mark if used in the proper manner. See *In re Software Publishers Association*, 69 USPQ2d 2009 (TTAB 2003) (CERTIFIED SOFTWARE MANAGER used on certificate merely indicates that holder of the certificate has been awarded a title or degree, and is not likely to be perceived as certification mark); *In re National Association of Purchasing Management*, 228 USPQ 768 (TTAB 1986) (C.P.M. used merely as title or degree, not as certification mark); *In re National Association of Legal Secretaries (International)*, 221 USPQ 50 (TTAB 1983) (PROFESSIONAL LEGAL SECRETARY not used on the specimens in such a way as to indicate certification significance); *In re National Institute for Automotive Service Excellence, supra* (design mark not used simply as a degree or title, but to certify that the performer of the services had met certain standards); *In re Institute of Certified Professional Business Consultants*, 216 USPQ 338 (TTAB 1982) (CPBC not used as a certification mark for business consulting services, but only as a title or degree); *In re Professional Photographers of Ohio, Inc.*, 149 USPQ 857 (TTAB 1966) (CERTIFIED PROFESSIONAL PHOTOGRAPHER used only as the title of a person, not as a certification mark). Cf. *In re University of Mississippi*, 1

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

USPQ2d 1909 (TTAB 1987) (use of university seal on diplomas did not represent use as a certification mark).

See TMEP §1306.09(a) regarding the difference between a certification mark and a collective mark.

### **1306.04            Ownership of Certification Marks**

The owner of a certification mark is the party responsible for the certification that is conveyed by the mark. The party who affixes the mark, with authorization of the certifier, does not own the mark; nor is the mark owned by someone who merely acts as an agent for the certifier, for example, an inspector hired by the certifier. The certifier, as owner, is the only person who may file an application for registration of a certification mark. See *In re Safe Electrical Cord Committee*, 125 USPQ 310 (TTAB 1960).

Certification is often the sole activity for the owner of a certification mark. However, a person is not necessarily precluded from owning a certification mark because he or she also engages in other activities, including the sale of goods or the performance of services. However, the certification mark may not be the same mark that the person uses as a trademark or service mark on goods or services. See TMEP §1306.05(a).

Examples of organizations which conduct both types of activities are trade associations and other membership or “club” types of businesses, such as automobile associations. These organizations may perform services for their members, and sell various goods to their members and others, as well as conduct programs in which they certify characteristics or other aspects of goods or services, especially of kinds which relate to the main purpose of the association.

Manufacturing or service companies that do not certify the goods or services of members may nonetheless engage in certification programs under proper circumstances. For example, a manufacturer of chemical wood preservatives might conduct a program certifying certain characteristics of wood or wood products that are treated and sold by others. Among the characteristics or circumstances certified could be the fact that a preservative produced by this manufacturer under a specified trademark was used in the treatment.

As another example, a magazine publisher may conduct a certification program relating to goods or services that are advertised in or have some relevance to the interest area of the magazine.

The certifier/owner determines the requirements for the certification. The standards do not have to be original with the certifier/owner, but may be standards established by another person, such as specifications promulgated by a government agency or

## EXAMINATION OF DIFFERENT TYPES OF MARKS

standards developed through research of a private research organization. See TMEP §1306.06(g)(ii) regarding the standards for certification.

If the name of the organization that developed the standards is part of the mark, an issue could arise as to whether the mark is deceptively misdescriptive under 15 U.S.C. §1052(e)(1) (see TMEP §1209.04) or falsely suggests a connection with persons, institutions, beliefs or national symbols under 15 U.S.C. §1052(a) (see TMEP §1203.03(e)).

### **1306.05            Characteristics of Certification Marks**

The Trademark Act does not require that a certification mark be in any specific form or include any specific wording. A certification mark can be wording only, design only, or a combination of wording and design. In other words, there is no particular way that a mark must look in order to be a certification mark.

A certification mark often includes wording such as “approved by,” “inspected,” “conforming to” or “certified,” or similar wording, which is natural since certification (or approval) is practically the only significance the mark is to have when it is used on goods or in connection with services. However, this wording is not required, and a mark that entirely lacks this wording can perform the function of certification.

The examining attorney must look to the facts disclosed in the record to determine whether the mark is used in certification activity and is in fact a certification mark.

It is not necessary to show that the mark is instantly recognizable as a certification mark, or that the mark has already become well known to the public as a certification mark. However, it should be clear from the record that the circumstances surrounding the use or promotion of the mark will give certification significance to the mark in the marketplace. See *Ex parte Van Winkle*, 117 USPQ 450 (Comm’r Pats. 1958).

### **1306.05(a)        Same Mark Not Registrable as Certification Mark and as Any Other Type of Mark**

Trade or service marks and certification marks are different and distinct types of marks designed to serve different purposes. A trademark or service mark is used by the owner of the mark on his or her goods or services, whereas a certification mark is used by persons other than the owner of the mark. A certification mark does not distinguish between producers, but represents a certification regarding some characteristic that is common to the goods or services of many persons. Using the same mark for two contradictory purposes would result in confusion and uncertainty about the meaning of the mark and would invalidate the mark for either purpose.

Section 4 of the Trademark Act, 15 U.S.C. §1054, prohibits the registration of a certification mark “when used so as to represent falsely that the owner or a user

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

thereof makes or sells the goods or performs the services on or in connection with which such mark is used,” and §14(5)(B) of the Act, 15 U.S.C. §1064(5)(B), provides for the cancellation of a registered certification mark where the registrant engages in the production or marketing of any goods or services to which the certification mark is applied. See TMEP §1306.07 regarding §14(5) of the Act. Thus, if a party has a registration as a trademark or service mark for any goods or services, he or she may not register the same mark as a certification mark for those goods or services. Conversely, a registration as a certification mark precludes registration of the same mark by its owner as a trademark or service mark for any goods or services to which the certification mark applies. See *In re Florida Citrus Commission*, 160 USPQ 495 (TTAB 1968).

The prohibition against registration both as a trademark or service mark and as a certification mark applies to marks that are identical or so similar as to constitute essentially the same mark. Variations in wording or design, even though small, can, if meaningful, create different marks. On the other hand, inconsequential differences, such as the style of lettering or the addition of wording of little importance, normally would not prevent marks from being regarded as the same. See *In re 88Open Consortium Ltd.*, 28 USPQ2d 1314 (TTAB 1993), in which the mark 88OPEN COMPATIBILITY CERTIFIED and design was found registrable as a certification mark even though applicant owned six registrations for the marks 88OPEN in typed and stylized form as trademarks, service marks and collective membership marks. The Board noted that the words COMPATIBILITY CERTIFIED served to inform those seeing the mark that it is functioning as a certification mark, and that the certification mark included a design feature not found in the previously registered marks). See also TMEP §§1306.04, 1306.06(d) and 1306.09.

### **1306.05(b) Cancellation of Applicant’s Prior Registration Required by Change from Certification Mark Use to Trademark or Service Mark Use, or Vice Versa**

The nature of the activity in which the mark is used or intended to be used may change from use to certify characteristics of goods or services to use on the party’s own goods or services, or on goods or services produced for the party by related companies. The change might also be the other way around, from trade or service mark use to certification mark use.

If there is already a registration as one type of mark and the registrant files an application for registration of the mark as the other type, the applicant must surrender the previous registration under §7(e) of the Trademark Act, 15 U.S.C. §1057(e), before the examining attorney approves the new application for publication for opposition or issuance of a registration on the Supplemental Register. See 37 C.F.R. §2.172 and TMEP §1608 regarding surrender. The registration certificate for the new application should not issue until the prior registration actually has been cancelled.

## EXAMINATION OF DIFFERENT TYPES OF MARKS

In examining the new application, the examining attorney must carefully review the application to ensure that the facts of record support the new application.

### **1306.06 Examination of Certification Mark Applications**

#### **1306.06(a) Refusal to Register Certification Mark**

The same standards are used to determine the registrability of certification marks that are used for other types of marks. Thus, the standards generally applicable to trademarks and service marks are used in considering issues such as descriptiveness, disclaimers, and likelihood of confusion. (*But see* TMEP §§1306.02 *et seq.* regarding certification marks indicating regional origin only.)

Regarding the application of §2(e) of the Trademark Act, 15 U.S.C. §1052(e), to certification marks, *see Community of Roquefort v. Santo*, 443 F.2d 1196, 170 USPQ 205 (C.C.P.A. 1971); *In re National Association of Legal Secretaries (International)*, 221 USPQ 50 (TTAB 1983). Regarding the application of §2(d), 15 U.S.C. §1052(d), to certification marks, *see Procter & Gamble Co. v. Cohen*, 375 F.2d 494, 153 USPQ 188 (C.C.P.A. 1967); *Stabilisierungsfonds fur Wein v. Peter Meyer Winery GmbH*, 9 USPQ2d 1073 (TTAB 1988). *See also E.I. duPont de Nemours & Co. v. Yoshida International, Inc.*, 393 F. Supp. 502, 185 USPQ 597 (E.D.N.Y. 1975).

A refusal to register because the subject matter does not function as a certification mark is predicated on §§1, 2, 4, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1054, and 1127. Educational or other degrees or titles awarded to individuals, and used only as personal titles or degrees, are not certification marks. So used, titles and degrees indicate qualifications or attainments of the person; they do not pertain to or certify services that have been performed by the person. *See* TMEP §1306.03.

#### **1306.06(b) The Mark on the Drawing**

The drawing in the application must include the entire certification mark, but it should not include anything that is not part of the mark. The examining attorney must refer to the specimens to determine what constitutes the mark. *See In re National Institute for Automotive Service Excellence*, 218 USPQ 744 (TTAB 1983). In evaluating the drawing, the same standards used in relation to trademark and service mark drawings apply to certification marks (*see* TMEP §§807 *et seq.*).

#### **1306.06(c) Specimens of Use for Certification Marks**

Certification mark specimens must show use to certify. Although a certification mark performs a different function from a trademark or a service mark, it is used in a manner analogous to that of a trademark or a service mark (*i.e.*, on a label, tag, or

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

container for the goods, a display associated with the goods, or in the sale or advertising of services rendered).

A certification mark specimen must show how a person other than the owner uses the mark to certify regional or other origin, quality, or other characteristics of that person's goods or services; or that members of a union or other organization performed the work or labor on the goods or services. 37 C.F.R. §2.56(b)(5).

Materials that bear the mark and are actually attached or applied to the goods or used in relation to the services by the persons authorized to use the mark constitute proper specimens.

The same standards used to evaluate trademark and service mark specimens also apply to certification marks. See TMEP §§904 *et seq.*

Sometimes the owner/certifier prepares tags or labels that bear the certification mark that are supplied to the authorized users to attach to their goods or for use in relation to their services. See *Ex parte Porcelain Enamel Institute, Inc.*, 110 USPQ 258 (Comm'r Pats. 1956). These tags or labels are acceptable specimens.

### **1306.06(d)      Relation Between Certification Mark and Trademark or Service Mark on Specimens**

It is customary for trademarks or service marks to be placed on goods or used with services in conjunction with certification marks. However, it is also possible for a certification mark to be the only mark used on goods or with services. Some producers market their goods or services without using a trademark or service mark, yet these producers may be authorized to use a certification mark and, as a result, the certification mark would be the only mark on the goods or services. In these situations, the significance of the mark might not be readily apparent and the examining attorney should request an explanation of the circumstances to ascertain whether the mark is a certification mark rather than a trademark or service mark. See *also* TMEP §1306.09.

When a trademark or a service mark appears on the specimens in addition to a certification mark, the certification mark can be on a separate label, or can be included on a single label along with the user's own trademark or service mark.

A composite certification mark may include a trademark or service mark, provided the composite mark functions to certify, with the trade or service mark serving only to inform, or to suggest the certification program, rather than to indicate origin of the goods or services with which the mark is used. These situations usually are created when a company that produces goods or performs services wants to develop a program and a mark to certify characteristics of the goods or services of others that are related to the producer's own goods or services. See the examples in TMEP §1306.04.



## EXAMINATION OF DIFFERENT TYPES OF MARKS

The trademark or service mark must be owned by the same person who owns the certification mark. A party may not include the trademark or service mark of another in a certification mark, even with a disclaimer. If the examining attorney believes that a trademark or service mark included in a certification mark is owned by another, the examining attorney should refuse registration of the certification mark.

### **1306.06(e) Classification of Goods and Services in Certification Mark Applications**

#### *Section 1 and 44 Applications*

In applications to register certification marks, all goods are classified in Class A and all services are classified in Class B. 37 C.F.R. §6.3. Both Classes A and B (but not any other classes) may be included in one application. See TMEP §§1403 *et seq.* regarding multiple class applications.

*NOTE: When the Trademark Act of 1946 went into effect, the goods and services for which certification marks were registered were classified in the regular classes for goods and services. It was later concluded that this was not reasonable, because a certification mark is commonly used on a great variety of goods and services, and the specialized purpose of these marks makes it unrealistic to divide the goods and services into the competitive groups that the regular classes represent. The change to classification in Classes A and B for certification marks was made by amendment of the Trademark Rules on August 15, 1955.*

#### *Section 66(a) Applications*

In a §66(a) application, classification is determined by the IB, in accordance with the *Nice Agreement*. Classes A and B come from the old U.S. classification system (see TMEP §1401.02) and are not included in the international classification system. In a §66(a) application, the international classification of goods/services cannot be changed from the classification given to the goods/services by the IB. See TMEP §1401.03(d). Accordingly, if the mark in a §66(a) application appears to be a certification mark, the USPTO will not reclassify it into Classes A and B. However, the applicant must comply with all other U.S. requirements for certification marks, regardless of the classification chosen by the IB.

### **1306.06(f) Identification of Goods and Services in Certification Mark Applications**

In a certification mark application, the goods or services that are certified may be identified less specifically than in an application for a trademark or service mark.

Ordinarily it is only necessary to indicate general kinds of goods and services, such as food, agricultural commodities, electrical products, textile materials, printed material, or insurance agency services, machinery repair, restaurant services.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

However, if the certification program itself is limited to specific goods or services, for example, wine, wood doors, bakery machinery, then the identification in the application should be more specific.

### **1306.06(g) Special Elements of Certification Mark Applications**

#### **1306.06(g)(i) Statement of What the Mark Certifies**

The application must contain a statement of the characteristic, standard, or other feature that is certified or intended to be certified by the mark. The statement may begin with the wording, “The certification mark, as used (or intended to be used) by authorized persons, certifies (or is intended to certify) . . . .” See 37 C.F.R. §2.45.

All of the characteristics or features that the mark certifies should be included. A mark does not have to be limited to certifying a single characteristic or feature.

The characteristics or features that the mark certifies should be explained in reasonable detail, so that they are clear. The broad suggestive terms of the statute, such as quality, material, mode of manufacture, are generally not satisfactory by themselves because they do not accurately reveal the nature of the certification. How specific the statement should be depends in part on the narrowness or breadth of the certification. For example, “quality” would not inform the public of the meaning of the certification where the characteristic being certified is limited, for example, to the strength of material, or the purity of a strain of seed.

The statement of certification in the application is printed on the registration certificate. For that reason it should be reasonably specific but does not have to include the details of the specifications of the characteristic being certified. If practicable, however, more detailed specifications should be made of record in the application file.

Although the information as to what the mark certifies may appear in the same statement as the identification of goods and/or services, it is preferable that these elements be recited separately in the application.

#### **1306.06(g)(ii) Standards**

The applicant (certifier) must submit a copy of the standards established to determine whether others may use the certification mark on their goods and/or in connection with their services. 37 C.F.R. §2.45. For an intent-to-use application, under §1(b) of the Act, 15 U.S.C. §1051(b), the standards are submitted with the amendment to allege use or the statement of use. 37 C.F.R. §2.45(b).

The standards do not have to be original with the applicant. They may be standards established by another party, such as specifications promulgated by a government agency or standards developed through research of a private research organization.

## EXAMINATION OF DIFFERENT TYPES OF MARKS

### **1306.06(g)(iii) Exercise of Control**

In an application based on use in commerce under §1(a) of the Trademark Act, the applicant must assert that the applicant is exercising legitimate control over the use of the certification mark in commerce. 37 C.F.R. §2.45(a).

In an application based on §1(b), §44, or §66(a) of the Act, the applicant must assert that the applicant has a bona fide intention to exercise legitimate control over the use of the certification mark in commerce. See 37 C.F.R. §2.45(b). In a §1(b) application, before the mark can register, the applicant must file an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d) alleging that the applicant is exercising legitimate control over the use of the certification mark in commerce.

If there is doubt as to the existence or nature of such control by the applicant, the examining attorney should require an explanation and sufficient disclosure of facts or the filing of appropriate documents to support the applicant's statement regarding the exercise of control over the use of the mark, pursuant to 37 C.F.R. §2.61(b).

### **1306.06(g)(iv) Use by Others Indicated in Dates-of-Use Clause**

When specifying the dates of first use, the applicant must indicate that the certification mark was first used under the authority of the applicant, or by persons authorized by the applicant, because a certification mark is not used by the applicant itself.

### **1306.06(g)(v) Statement That Mark is Not Used by Applicant**

The application must contain a statement that the applicant is not engaged in (or, if the application is filed under §1(b), §44 or §66(a) of the Act, will not engage in) the production or marketing of the goods or services to which the mark is applied. See 37 C.F.R. §2.45. This statement does not have to be verified, and can therefore be entered by examiner's amendment.

### **1306.06(g)(vi) Amendment to Different Type of Mark**

If an application is filed to register a mark as a certification mark and the mark is actually another type of mark, or if an application is filed to register a mark as another type when it is actually a certification mark, the application may be amended (without additional fee) to request registration as the proper type of mark. It is preferred that the applicant completely rewrite the application to provide a clean copy, rather than amend the original papers. Also, the application should be re-executed because some essential allegations differ for the different types of marks.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1306.07 Relationship of §14 (Cancellation) to Examination of Certification Mark Applications

*Extract from 15 U.S.C. §1064. Cancellation. A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of dilution under section 43(c), by the registration of a mark on the principal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905...*

...

*(5) At any time in the case of a certification mark on the ground that the registrant (A) does not control, or is not able legitimately to exercise control over, the use of such mark, or (B) engages in the production or marketing of any goods or services to which the certification mark is applied, or (C) permits the use of the certification mark for purposes other than to certify, or (D) discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies....*

...

*Nothing in paragraph (5) shall be deemed to prohibit the registrant from using its certification mark in advertising or promoting recognition of the certification program or of the goods or services meeting the certification standards of the registrant. Such uses of the certification mark shall not be grounds for cancellation under paragraph (5), so long as the registrant does not itself produce, manufacture, or sell any of the certified goods or services to which its identical certification mark is applied.*

Section 14 of the Trademark Act, 15 U.S.C. §1064, provides for petitions to cancel registrations. Subsection (5) lists specific circumstances when petitions to cancel certification marks may be filed. The provisions of §14(5) are applicable in *ex parte* examination as follows:

Subsection A: In an application, the applicant states under oath or declaration that the applicant is exercising, or has a bona fide intention to exercise, legitimate control over the use of the certification mark. TMEP §1306.06(g)(iii). Such statement is accepted unless the examining attorney has knowledge of facts indicating that it should not be accepted.

Subsection B: The applicant is required to state, as appropriate, that he or she is not engaged in, or will not engage in, the production or marketing of any goods or services to which the certification mark is applied. TMEP §1306.06(g)(v). Such statement is accepted unless the examining attorney has knowledge of facts indicating the contrary.

Subsection C: This subsection concerns whether a party permits use of the certification mark for purposes other than to certify. No statements are required

## EXAMINATION OF DIFFERENT TYPES OF MARKS

in the application specifically on this point. The existence of unauthorized or illegal uses by others without the applicant's authorization is not within the examining attorney's province and cannot be used as a basis for refusal to register, provided that use authorized by the applicant, as supported by the record, is proper certification use.

Subsection D: This subsection relates to the obligation of the owner not to discriminately refuse to certify. This subject is not mentioned in §§4 or 45, 15 U.S.C. §1054 or §1127. The Office has never undertaken to evaluate, in *ex parte* examination, whether the standards or characteristics which the mark certifies, as set out by the applicant, are discriminatory per se; nor is it in the province of *ex parte* procedure to investigate or police how the certification is practiced.

### **1306.08 Registration of Certification Mark on Basis of Foreign Registration**

A certification mark may be registered in the United States under §44 of the Trademark Act, on the basis of a foreign registration. However, whether a particular foreign registration is acceptable as the basis for a United States registration depends on the scope of the foreign registration.

A person may not obtain a registration in the United States that is broader in scope than the foreign registration on which the United States application is based. See *In re Löwenbräu München*, 175 USPQ 178 (TTAB 1972); TMEP §1402.01(b). Therefore, a registration as a certification mark in the United States may not be based on a foreign registration that is actually a trademark registration, *i.e.*, a registration that is based on the registrant's placement of the mark on his or her own goods as a trademark. The scope of the registration, *i.e.*, the nature of the registration right, would not be the same.

The scope and nature of the registration right is not always immediately apparent from a foreign registration certificate. Foreign registration certificates are not always labeled as pertaining to a trademark, service mark, collective mark or certification mark and, when they are labeled, the significance of the term is not always clear. For example, the designation "collective" represents a different concept in some foreign countries than it does in the United States. Moreover, while a certificate printed on a standardized form may be headed with the designation "trademark," the body of the certificate might contain language to the contrary.

Since certification is an exception in the larger world of trademarks, an indication of certification in the registration certificate would normally represent a conscious decision that a certification situation exists. Therefore, if a foreign registration certificate has a heading that designates the mark as a certification mark or if the body of the foreign certificate contains language indicating that the registration is for

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

certification, the foreign registration normally may be accepted to support registration in the United States as a certification mark.

Whenever there is ambiguity about the scope or nature of the foreign registration or whenever the examining attorney believes that the foreign certificate may not reflect the actual registration right, the examining attorney should inquire regarding the basis of the foreign registration.

### **1306.09            Uncertainty Regarding Type of Mark**

When the facts in the application are insufficient to provide an adequate basis for determining whether the mark is functioning as a trademark or service mark or as a certification mark, the examining attorney should ask for further explanation as to the activities in which the mark is used and should require a sufficient disclosure of the facts to enable a proper examination to be made. The manner in which the activities associated with a mark are conducted is the main factor that determines the type of mark. The conduct of parties involved with the mark evidences the relationship between the parties, and the responsibilities of each to the goods or services and to the mark.

#### **1306.09(a)            Distinction Between Certification Mark and Collective Mark**

A collective trademark or collective service mark indicates origin of goods or services in the members of a group. A collective membership mark indicates membership in an organization. A certification mark certifies characteristics or features of goods or services. See *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798, 806-808 (TTAB 1984), for a discussion of the distinction between collective marks and certification marks.

Both collective marks and certification marks are used by more than one person, but only the users of collective marks are related to each other through membership in a collective group. The collective mark is used by all members and the collective organization holds the title to the collective mark for the benefit of all members.

A certification mark may be used to certify that the work or labor on the goods or services was performed by a member of a union or other organization. See TMEP §1306.03. Used in this manner, the certification mark certifies not that the user is a member of an organization but that the labor on the user's goods or services was performed by a member of an organization.

An application to register a mark that is used or intended to be used by members of a collective group must be scrutinized carefully to determine the function of the mark. If the mark is used or intended to be used by the members as a trademark on goods they produce or as a service mark for services they perform, then the mark is a collective trademark or collective service mark. If the mark is used or intended to be used by members to indicate membership in an organization, then the mark is a

## EXAMINATION OF DIFFERENT TYPES OF MARKS

collective membership mark. However, if use of the mark is or will be authorized only under circumstances designated by the organization to certify characteristics or features of the goods or services, the mark is a certification mark.

### **1306.09(b) Distinguishing Certification Mark Use from Related-Company Use of Trademark or Service Mark**

Sometimes an application requests registration of a certification mark, but there is a contractual relationship in the nature of a franchise or license between the applicant and the user of the mark, whereby the applicant, as the franchisor or licensor, specifies the nature or quality of the goods produced (or of the services performed) under the contract. These situations require care in examination because they usually indicate trademark or service mark use (through related companies) rather than certification mark use, because the applicant, as franchisor or licensor, controls the nature of the goods or services and has the responsibility for their quality.

The key distinction between use of subject matter as a certification mark and use as a trademark or service mark through a related company is the purpose and function of the mark in the market place, and the significance that it would have to the relevant purchasing public. A trademark or service mark serves to indicate the origin of goods or services, whereas a certification mark serves to guarantee certain qualities or characteristics. See *In re Monsanto Co.*, 201 USPQ 864, 870 (TTAB 1978); *In re Celanese Corp. of America*, 136 USPQ 86 (TTAB 1962).

Furthermore, the owner of a certification mark must permit use of the mark if the goods or services meet the certifier's standard, whereas a trademark owner may, but is not obligated to, license use of its mark to third parties. *Monsanto*, 201 USPQ at 870.

### **1306.09(c) Patent Licenses**

Sometimes the owner of a patent asserts ownership of the mark that is applied to goods that are manufactured under license from the patent owner, in accordance with the terms and specifications of the patent. In most cases, these marks have been registered as trademarks, on the basis of related-company use. Generally, the patent owner's purpose, in arranging for the application of a mark to the goods manufactured under his or her license, would be to identify and distinguish those goods whose nature and quality the patent owner controls through the terms and specifications of the patent. Therefore, registration as a trademark (on the basis of related-company use) rather than registration as a certification mark would be appropriate.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1307 Registration as Correct Type of Mark

The examining attorney should take care to ascertain the correct type of mark during examination, and to require amendment if necessary. If a registration is issued for the wrong type of mark, it may be subject to cancellation. See *National Trailways Bus System v. Trailway Van Lines, Inc.*, 269 F. Supp. 352, 155 USPQ 507 (E.D.N.Y. 1965); *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798 (TTAB 1984).



# Chapter 1400 — Classification and Identification of Goods and Services

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## 1401 Classification

1401.01 Statutory Authority

1401.02 International Trademark Classification Adopted

1401.02(a) Headings of International Trademark Classes

1401.02(b) Short Titles for International Trademark Classes

1401.02(c) International Alphabetical List

1401.03 Designation of Class

1401.03(a) Designation of Class by Applicant Normally Accepted in Applications Under §§1 and 44

1401.03(b) Designation of Class by Office When Class Number Is Not Designated or Is Inaccurate in Application Under §1 or §44

1401.03(c) Failure to Classify May Delay Action in Applications Under §§1 and 44

1401.03(d) Classification Determined by World Intellectual Property Organization in §66(a) Applications

1401.04 Classification Determines Number of Fees

1401.04(a) Prior U.S. Classification System

1401.04(b) Limiting Goods and Services to the Number of Classes for Which Filing Fees Are Paid

1401.05 Criteria on Which International Classification Is Based

1401.06 Specimens as Related to Classification

1401.06(a) Specimen Discloses Special Characteristics

1401.07 Classification and Plurality of Uses

1401.08 Classification and the Identification of Goods and Services, In General

1401.09 Changes in Practice Based on the Restructuring of International Class 42 in the 8<sup>th</sup> Edition of the Nice Agreement

1401.09(a) Elimination of “Miscellaneous Class Designation”

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

1401.09(b) Implementation of the Changes

### **1402 Identification of Goods and Services**

1402.01 Specifying the Goods and/or Services - in General

1402.01(a) General Guidelines for Acceptable Identifications of Goods or Services

1402.01(b) Identification of Goods and Services in a §44 Application

1402.01(c) Identification of Goods and Services in a §66(a) Application

1402.01(d) Location of "Identification of Goods and Services"

1402.01(e) Responsibilities of Examining Attorney as to Identification

1402.02 Entitlement to Filing Date With Respect to Specification of Goods and Services

1402.03 Specificity of Terms Used in Identifying Goods and Services

1402.03(a) Inclusive Terminology

1402.03(b) House Marks

1402.03(c) Marks for a "Full Line of ..."

1402.03(d) Identifying Computer Programs with Specificity

1402.03(e) Identifying Publications with Specificity

1402.04 Acceptable Identification of Goods and Services Manual

1402.05 Accuracy of Identification

1402.05(a) Goods That Are Components or Ingredients

1402.05(b) Material Composition

1402.06 Amendments Permitted to Clarify or Limit Identification

1402.06(a) Limiting the Identification of Goods and Services

1402.06(b) Clarifying the Identification of Goods and Services

1402.07 Scope of Identification of Goods and Services for Purposes of Amendment

1402.07(a) The "Ordinary-Meaning" Test

1402.07(b) Ambiguous Identifications

1402.07(c) Unambiguous Identifications

1402.07(d) Permissible Scope of Identification Not Affected by Proposed Amendment That Is Unacceptable

## **CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES**

- 1402.07(e) Permissible Scope of Identification Affected by Proposed Amendment That Is Accepted
- 1402.08 Moving Goods and Services Between Companion Applications
- 1402.09 Use of Marks Inappropriate in Identifications
- 1402.10 Identification of Goods and Services in Documents Filed in Connection with §1(b) Applications
- 1402.11 Identification of Services
  - 1402.11(a) Computer Services
  - 1402.11(b) Information Services
  - 1402.11(c) Association Services and “Promoting the Interest of” Services
  - 1402.11(d) Charitable Services, Other than Monetary
  - 1402.11(e) Consulting Services
- 1402.12 Parentheses and Brackets Should Not be Used in Identifications of Goods and Services
- 1402.13 Requirement For Amendment of Portion of Identification of Goods/Services
- 1402.14 Identification of Goods/Services Must Conform to Rules and Policies in Effect at the Time of Examination

### **1403 Combined or Multiple-Class Application**

- 1403.01 Requirements for Combined or Multiple-Class Application
- 1403.02 Amendment of Combined or Multiple-Class Application
  - 1403.02(a) Deletion of Classes
  - 1403.02(b) Correction of Classification
  - 1403.02(c) Addition of Classes
- 1403.03 Dividing of Combined or Multiple-Class Application
- 1403.04 Combined or Multiple-Class Marks in *Official Gazette*
- 1403.05 Action After Filing, Multiple Classes
  - 1403.05(a) Fees for Action After Filing, Multiple Classes
  - 1403.05(b) Surrender or Amendment in Multiple-Class Registrations

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1401 Classification**

#### **1401.01 Statutory Authority**

Section 30 of the Trademark Act, 15 U.S.C. §1112, provides authority for establishing a classification system. That section states, in part, as follows:

The Director may establish a classification of goods and services, for convenience of Patent and Trademark Office administration, but not to limit or extend the applicant's or registrant's rights.

#### **1401.02 International Trademark Classification Adopted**

As of September 1, 1973, the international classification of goods and services is the primary classification used by the United States, and it applies to all applications filed on or after September 1, 1973, and their resulting registrations, for all statutory purposes. See 37 C.F.R. §2.85. Unless otherwise indicated, references in this manual to class refer to the international class.

Prior to September 1, 1973, the United States used its own classification of goods and services, which is different from the international classification. The prior United States classification continues to govern for all statutory purposes for trademark applications filed on or before August 31, 1973, and all registrations issued on the basis of an application filed on or before August 31, 1973.

If a registration issued under the U.S. classification system, the registrant may voluntarily amend to reclassify under the international classification system, if registrant pays the \$100.00 filing fee required by 37 C.F.R. §2.6 for Section 7 amendments. See TMEP §1609.04.

Classification schedules are set forth in Part 6 of the Trademark Rules of Practice. The international classification schedule for goods and services is found in 37 C.F.R. §6.1, and the prior United States classification schedule for goods and services is found in 37 C.F.R. §6.2. The United States schedule for certification marks is found in 37 C.F.R. §6.3 and the United States schedule for collective membership marks is found in 37 C.F.R. §6.4.

#### **1401.02(a) Headings of International Trademark Classes**

International trademark classification, and the headings of the international trademark classes, are established by the Committee of Experts of the Nice Union and are promulgated in the volume entitled *International Classification of Goods and Services for the Purposes of the Registration of Marks* (8<sup>th</sup> ed. 2002), published by the World Intellectual Property Organization ("WIPO"). For additional information relating to this publication, see TMEP §1401.02(c).

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

The general remarks, class numbers, class headings, and explanatory notes for each international trademark class are as follows. (The word or words in parentheses following the class numbers are short titles for the classes that are used exclusively in the United States Patent and Trademark Office (“USPTO”) and are not part of the official text of the Nice Union classes. See TMEP 1401.02(b).)

### **GENERAL REMARKS**

The indications of goods or services appearing in the List of Classes are general indications relating to the field to which, in principle, the goods or services belong. The Alphabetical List should therefore be consulted in order to make sure of the classification of each specific product or service.

#### *Goods*

- (1) If a product cannot be classified in accordance with the List of Classes or with the Alphabetical List, the following remarks indicate the criteria to be applied:
  - (a) Finished products are classified, in principle, according to their function or purpose; if that criterion is not provided for in the List of Classes, finished products are classified by analogy with other comparable finished products contained in the Alphabetical List. If none is found, other subsidiary criteria such as that of the material of which the goods are made or the mode of operation are applied.
  - (b) Finished products which are multipurpose composite objects (e.g., clocks incorporating radios) may be classified in all the classes that correspond to each of their functions or intended purposes. If those criteria are not provided in the List of Classes, then other criteria indicated under (a) are to be applied.
  - (c) Raw materials, unworked or semi-worked, are classified, in principle, according to the material of which they consist.
  - (d) Goods intended to form part of another product are, in principle, classified in the same class as that product only in cases where the same type of goods cannot normally be used for another purpose. In all other cases, criterion (a) applies.
  - (e) Where goods, whether finished or not, are classified according to the material of which they are made and where they are made of different materials, such goods are in principle classified according to the material which predominates.
  - (f) Cases adapted to the product they are intended to contain are classified, in principle, in the same class as the product.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### *Services*

- (1) If a service cannot be classified in accordance with the Alphabetical List, the following remarks indicate the criteria to be applied:
  - (a) Services are classified, in principle, according to the branches of activity specified in the headings of the service classes and their Explanatory Notes or, subsidiarily, by analogy with other comparable services contained in the Alphabetical List.
  - (b) Rental services are classified, in principle, in the same classes as the services provided by means of the rented objects (e.g., Rental of telephones, Cl. 38).
  - (c) Services that provide advice, information or consultation are in principle classified in the same classes as the services that correspond to the subject matter of the advice, information or consultation, e.g., transportation consultancy (Cl. 39), business management consultancy (Cl. 35), financial consultancy (Cl. 36), beauty consultancy (Cl. 44). The rendering of the advice, information or consultancy by electronic means (e.g., telephone, computer) does not affect the classification of these services.

## **GOODS**

### **CLASS 1**

#### **(Chemicals)**

Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.

#### *Explanatory Note*

This class includes mainly chemical products used in industry, science and agriculture, including those which go to the making of products belonging to other classes.

*Includes, in particular:*

- compost;
- salt for preserving other than for foodstuffs.

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

*Does not include, in particular:*

- raw natural resins (Cl. 02);
- chemical products for use in medical science (Cl. 05);
- fungicides, herbicides and preparations for destroying vermin (Cl. 05);
- adhesives for stationery or household purposes (Cl. 16);
- salt for preserving foodstuffs (Cl. 30);
- straw mulch (Cl. 31).

### CLASS 2

#### (Paints)

Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colourants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.

#### *Explanatory Note*

This class includes mainly paints, colourants and preparations used for the protection against corrosion.

*Includes, in particular:*

- paints, varnishes and lacquers for industry, handicrafts and arts;
- dyestuffs for clothing;
- colourants for foodstuffs and beverages.

*Does not include, in particular:*

- unprocessed artificial resins (Cl. 01);
- laundry blueing (Cl. 03);
- cosmetic dyes (Cl. 03);
- paint boxes (articles for use in school) (Cl. 16);
- insulating paints and varnishes (Cl. 17).

### CLASS 3

#### (Cosmetics and cleaning preparations)

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### *Explanatory Note*

This class includes mainly cleaning preparations and toilet preparations.

*Includes, in particular:*

- deodorants for personal use;
- sanitary preparations being toiletries.

*Does not include, in particular:*

- chemical chimney cleaners (Cl. 01);
- degreasing preparations for use in manufacturing processes (Cl. 01);
- deodorants other than for personal use (Cl. 05);
- sharpening stones and grindstones (handtools) (Cl. 08).

### **CLASS 4**

#### **(Lubricants and fuels)**

Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.

### *Explanatory Note*

This class includes mainly industrial oils and greases, fuels and illuminants.

*Does not include, in particular:*

- certain special industrial oils and greases (consult the Alphabetical List of Goods).

### **CLASS 5**

#### **(Pharmaceuticals)**

Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

### *Explanatory Note*

This class includes mainly pharmaceuticals and other preparations for medical purposes.



## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

*Includes, in particular:*

- sanitary preparations for personal hygiene, other than toiletries;
- deodorants other than for personal use;
- cigarettes without tobacco, for medical purposes.

*Does not include, in particular:*

- sanitary preparations being toiletries (Cl. 03);
- deodorants for personal use (Cl. 03);
- supportive bandages (Cl. 10).

### CLASS 6

#### (Metal goods)

Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; nonelectric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.

#### *Explanatory Note*

This class includes mainly unwrought and partly wrought common metals as well as simple products made of them.

*Does not include, in particular:*

- bauxite (Cl. 01);
- mercury, antimony, alkaline and alkaline-earth metals (Cl. 01);
- metals in foil and powder form for painters, decorators, printers and artists (Cl. 02).

### CLASS 7

#### (Machinery)

Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.

#### *Explanatory Note*

This class includes mainly machines, machine tools, motors and engines.

*Includes, in particular:*

- parts of motors and engines (of all kinds);

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- electric cleaning machines and apparatus.

*Does not include, in particular:*

- certain special machines and machine tools (consult the Alphabetical List of Goods);
- hand tools and implements, hand operated (Cl. 08);
- motors and engines for land vehicles (Cl. 12).

### **CLASS 8**

#### **(Hand tools)**

Hand tools and implements (hand operated); cutlery; side arms; razors.

#### *Explanatory Note*

This class includes mainly hand operated implements used as tools in the respective professions.

*Includes, in particular:*

- cutlery of precious metals;
- electric razors and clippers (hand instruments).

*Does not include, in particular:*

- certain special instruments (consult the Alphabetical List of Goods);
- machine tools and implements driven by a motor (Cl. 07);
- surgical cutlery (Cl. 10);
- paperknives (Cl. 16);
- fencing weapons (Cl. 28).

### **CLASS 9**

#### **(Electrical and scientific apparatus)**

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), lifesaving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

### *Explanatory Note*

#### *Includes, in particular:*

- apparatus and instruments for scientific research in laboratories;
- apparatus and instruments for controlling ships, such as apparatus and instruments, for measuring and for transmitting orders;
- the following electrical apparatus and instruments:
  - (a) certain electrothermic tools and apparatus, such as electric soldering irons, electric flat irons which, if they were not electric, would belong to Class 8;
  - (b) apparatus and devices which, if not electrical, would be listed in various classes, *i.e.*, electrically heated clothing, cigar-lighters for automobiles;
- protractors;
- punched card office machines;
- amusement apparatus adapted for use with television receivers only;
- all computer programs and software regardless of recording media or means of dissemination, that is, software recorded on magnetic media or downloaded from a remote computer network.

#### *Does not include, in particular:*

- the following electrical apparatus and instruments:
  - (a) electromechanical apparatus for the kitchen (grinders and mixers for foodstuffs, fruit-presses, electrical coffee mills, etc.), and certain other apparatus and instruments driven by an electrical motor, all coming under Class 7;
  - (b) electric razors and clippers (hand instruments) (Cl. 08);
  - (c) electric toothbrushes and combs (Cl. 21);
  - (d) electrical apparatus for space heating or for the heating of liquids, for cooking, ventilating, etc. (Cl. 11);
- clocks and watches and other chronometric instruments (Cl. 14);
- control clocks (Cl. 14).

## **CLASS 10**

### **(Medical apparatus)**

Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### *Explanatory Note*

This class includes mainly medical apparatus, instruments and articles.

*Includes, in particular:*

- special furniture for medical use;
- hygienic rubber articles (consult the Alphabetical List of Goods);
- supportive bandages.

### **CLASS 11**

#### **(Environmental control apparatus)**

Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

### *Explanatory Note*

*Includes, in particular:*

- air conditioning apparatus;
- bedwarmers, hot water bottles, warming pans, electric or nonelectric;
- electrically heated cushions (pads) and blankets, not for medical purposes;
- electric kettles;
- electric cooking utensils.

*Does not include, in particular:*

- steam producing apparatus (parts of machines) (Cl. 07);
- electrically heated clothing (Cl. 09).

### **CLASS 12**

#### **(Vehicles)**

Vehicles; apparatus for locomotion by land, air or water.

### *Explanatory Note*

*Includes, in particular:*

- motors and engines for land vehicles;
- couplings and transmission components for land vehicles;
- air cushion vehicles.

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

*Does not include, in particular:*

- certain parts of vehicles (consult the Alphabetical List of Goods);
- railway material of metal (Cl. 06);
- motors, engines, couplings and transmission components other than for land vehicles (Cl. 07);
- parts of motors and engines (of all kinds) (Cl. 07).

### **CLASS 13**

#### **(Firearms)**

Firearms; ammunition and projectiles; explosives; fireworks.

#### *Explanatory Note*

This class includes mainly firearms and pyrotechnical products.

*Does not include, in particular:*

- matches (Cl. 34).

### **CLASS 14**

#### **(Jewelry)**

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewelry, precious stones; horological and chronometric instruments.

#### *Explanatory Note*

This class includes mainly precious metals, goods in precious metals and, in general, jewelry, clocks and watches.

*Includes, in particular:*

- jewelry (*i.e.* imitation jewelry and jewelry of precious metal and stones);
- cuff links, tie pins.

*Does not include, in particular:*

- certain goods in precious metals (classified according to their function or purpose), for example:
  - metals in foil and powder form for painters, decorators, printers and artists (Cl. 02);
  - amalgam of gold for dentists (Cl. 05);

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- cutlery (Cl. 08);
- electric contacts (Cl. 09);
- pen nibs of gold (Cl. 16);
- objects of art not in precious metals (classified according to the material of which they consist).

### CLASS 15

#### (Musical Instruments)

Musical instruments.

#### *Explanatory Note*

*Includes, in particular:*

- mechanical pianos and their accessories;
- musical boxes;
- electrical and electronical musical instruments.

*Does not include, in particular:*

- apparatus for the recording, transmission, amplification and reproduction of sound (Cl. 09).

### CLASS 16

#### (Paper goods and printed matter)

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.

#### *Explanatory Note*

This class includes mainly paper, goods made from that material and office requisites.

*Includes, in particular:*

- paper knives;
- duplicators;
- plastic sheets, sacks and bags for wrapping and packaging.

## **CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES**

*Does not include, in particular:*

- certain goods made of paper and cardboard (consult the Alphabetical List of Goods);
- colours (Cl. 02);
- hand tools for artists (for example: spatulas, sculptors' chisels) (Cl. 08).

### **CLASS 17**

#### **(Rubber goods)**

Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.

#### *Explanatory Note*

This class includes mainly electrical, thermal and acoustic insulating materials and plastics, being for use in manufacture in the form of sheets, blocks and rods.

*Includes, in particular:*

- rubber material for recapping tyres;
- padding and stuffing materials of rubber or plastics;
- floating anti-pollution barriers.

### **CLASS 18**

#### **(Leather goods)**

Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

#### *Explanatory Note*

This class includes mainly leather, leather imitations, travel goods not included in other classes and saddlery.

*Does not include, in particular:*

- clothing, footwear, headgear (consult the Alphabetical List of Goods).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### CLASS 19

#### **(Nonmetallic building materials)**

Building materials (nonmetallic); nonmetallic rigid pipes for building; asphalt, pitch and bitumen; nonmetallic transportable buildings; monuments, not of metal.

#### *Explanatory Note*

This class includes mainly nonmetallic building materials.

*Includes, in particular:*

- semi-worked woods (for example: beams, planks, panels);
- veneers;
- building glass (for example: floor slabs, glass tiles);
- glass granules for marking out roads;
- letter boxes of masonry.

*Does not include, in particular:*

- cement preservatives and cement-waterproofing preparations (Cl. 01);
- fireproofing preparations (Cl. 01).

### CLASS 20

#### **(Furniture and articles not otherwise classified)**

Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

#### *Explanatory Note*

This class includes mainly furniture and its parts and plastic goods, not included in other classes.

*Includes, in particular:*

- metal furniture and furniture for camping;
- bedding (for example: mattresses, spring mattresses, pillows);
- looking glasses and furnishing or toilet mirrors;
- registration number plates not of metal;
- letter boxes not of metal or masonry.



## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

*Does not include, in particular:*

- certain special types of mirrors, classified according to their function or purpose (consult the Alphabetical List of Goods);
- special furniture for laboratories (Cl. 09);
- special furniture for medical use (Cl. 10);
- bedding linen (Cl. 24);
- eiderdowns (Cl. 24).

### CLASS 21

#### (Housewares and glass)

Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

#### *Explanatory Note*

This class includes mainly small, hand-operated, utensils and apparatus for household and kitchen use as well as toilet utensils, glassware and articles in porcelain.

*Includes, in particular:*

- utensils and containers for household and kitchen use, for example: kitchen utensils, pails, and pans of iron, aluminum, plastics and other materials, small hand-operated apparatus for mincing, grinding, pressing, etc.;
- candle extinguishers, not of precious metal;
- electric combs;
- electric toothbrushes;
- dish stands and decanter stands.

*Does not include, in particular:*

- certain goods made of glass, porcelain and earthenware (consult the Alphabetical List of Goods);
- cleaning preparations, soaps, etc. (Cl. 03);
- small apparatus for mincing, grinding, pressing, etc., driven by electricity (Cl. 07);
- razors and shaving apparatus, clippers (hand instruments), metal implements and utensils for manicure and pedicure (Cl. 08);
- cooking utensils, electric (Cl. 11);
- toilet mirrors (Cl. 20).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### CLASS 22

#### (Cordage and fibers)

Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.

#### *Explanatory Note*

This class includes mainly rope and sail manufacture products, padding and stuffing materials and raw fibrous textile materials.

*Includes, in particular:*

- cords and twines in natural or artificial textile fibres, paper or plastics.

*Does not include, in particular:*

- certain nets, sacs and bags (consult the Alphabetical List of Goods);
- strings for musical instruments (Cl. 15).

### CLASS 23

#### (Yarns and threads)

Yarns and threads, for textile use.

### CLASS 24

#### (Fabrics)

Textiles and textile goods, not included in other classes; bed and table covers.

#### *Explanatory Note*

This class includes mainly textiles (piece goods) and textile covers for household use.

*Includes, in particular:*

- bedding linen of paper.

*Does not include, in particular:*

- certain special textiles (consult the Alphabetical List of Goods);
- electrically heated blankets (Cl. 10);
- table linen of paper (Cl. 16);

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

- horse blankets (Cl. 18).

### **CLASS 25**

#### **(Clothing)**

Clothing, footwear, headgear.

#### *Explanatory Note*

*Does not include, in particular:*

- certain clothing and footwear for special use (consult the Alphabetical List of Goods).

### **CLASS 26**

#### **(Fancy goods)**

Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.

#### *Explanatory Note*

This class includes mainly dressmakers' articles.

*Includes, in particular:*

- slide fasteners.

*Does not include, in particular:*

- certain special types of hooks (consult the Alphabetical List of Goods);
- certain special types of needles (consult the Alphabetical List of Goods);
- yarns and threads for textile use (Cl. 23).

### **CLASS 27**

#### **(Floor coverings)**

Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (nontextile).

#### *Explanatory Note*

This class includes mainly products intended to be added as furnishings to previously constructed floors and walls.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### CLASS 28

#### (Toys and sporting goods)

Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

#### *Explanatory Note*

#### *Includes, in particular:*

- fishing tackle;
- equipment for various sports and games.

#### *Does not include, in particular:*

- Christmas tree candles (Cl. 04);
- diving equipment (Cl. 09);
- amusement apparatus adapted for use with television receivers only (Cl. 09);
- electrical lamps (garlands) for Christmas trees (Cl. 11);
- fishing nets (Cl. 22);
- clothing for gymnastics and sports (Cl. 25);
- confectionery and chocolate decorations for Christmas trees (Cl. 30).

### CLASS 29

#### (Meats and processed foods)

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.

#### *Explanatory Note*

This class includes mainly foodstuffs of animal origin as well as vegetables and other horticultural comestible products which are prepared for consumption or conservation.

#### *Includes, in particular:*

- milk beverages (milk predominating).

#### *Does not include, in particular:*

- certain foodstuffs of plant origin (consult the Alphabetical List of Goods);
- baby food (Cl. 05);
- dietetic substances adapted for medical use (Cl. 05);

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

- salad dressings (Cl. 30);
- fertilised eggs for hatching (Cl. 31);
- foodstuffs for animals (Cl. 31);
- living animals (Cl. 31).

### CLASS 30

#### (Staple foods)

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

#### *Explanatory Note*

This class includes mainly foodstuffs of plant origin prepared for consumption or conservation as well as auxiliaries intended for the improvement of the flavour of food.

#### *Includes, in particular:*

- beverages with coffee, cocoa or chocolate base;
- cereals prepared for human consumption (for example: oat flakes and those made of other cereals).

#### *Does not include, in particular:*

- certain foodstuffs of plant origin (consult the Alphabetical List of Goods);
- salt for preserving other than for foodstuffs (Cl. 01);
- medicinal teas and dietetic substances adapted for medical use (Cl. 05);
- baby food (Cl. 05);
- raw cereals (Cl. 31);
- foodstuffs for animals (Cl. 31).

### CLASS 31

#### (Natural agricultural products)

Agricultural, horticultural and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### *Explanatory Note*

This class includes mainly land products not having been subjected to any form of preparation for consumption, living animals and plants as well as foodstuffs for animals.

*Includes, in particular:*

- raw woods;
- raw cereals;
- fertilized eggs for hatching;
- mollusca and crustacea (live).

*Does not include, in particular:*

- cultures of micro-organisms and leeches for medical purposes (Cl. 05);
- semi-worked woods (Cl. 19);
- artificial fishing bait (Cl. 28);
- rice (Cl. 30);
- tobacco (Cl. 34).

### **CLASS 32**

#### **(Light beverages)**

Beers; mineral and aerated waters and other nonalcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

### *Explanatory Note*

This class includes mainly nonalcoholic beverages, as well as beer.

*Includes, in particular:*

- de-alcoholised drinks.

*Does not include, in particular:*

- beverages for medical purposes (Cl. 05);
- milk beverages (milk predominating) (Cl. 29);
- beverages with coffee, cocoa or chocolate base (Cl. 30).

### **CLASS 33**

#### **(Wine and spirits)**

Alcoholic beverages (except beers).

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

### *Explanatory Note*

*Does not include, in particular:*

- medicinal drinks (Cl. 05);
- de-alcoholised drinks (Cl. 32).

### **CLASS 34**

#### **(Smokers' articles)**

Tobacco; smokers' articles; matches.

### *Explanatory Note*

*Includes, in particular:*

- tobacco substitutes (not for medical purposes).

*Does not include, in particular:*

- cigarettes without tobacco, for medical purposes (Cl. 05);
- certain smokers' articles in precious metal (Cl. 14) (consult the Alphabetical List of Goods).

## **SERVICES**

### **CLASS 35**

#### **(Advertising and business)**

Advertising; business management; business administration; office functions.

### *Explanatory Note*

This class includes mainly services rendered by persons or organizations principally with the object of:

- (1) help in the working or management of a commercial undertaking, or
- (2) help in the management of the business affairs or commercial functions of an industrial or commercial enterprise, as well as services rendered by advertising establishments primarily undertaking communications to the public, declarations or announcements by all means of diffusion and concerning all kinds of goods or services.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*Includes, in particular:*

- services consisting of the registration, transcription, composition, compilation, or systematization of written communications and registrations, and also the exploitation or compilation of mathematical or statistical data;
- services of advertising agencies and services such as the distribution of prospectuses, directly or through the post, or the distribution of samples. This class may refer to advertising in connection with other services, such as those concerning bank loans or advertising by radio;
- the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods.

*Does not include, in particular:*

- activity of an enterprise the primary function of which is the sale of goods, *i.e.*, of a so-called commercial enterprise;
- services such as evaluations and reports of engineers which do not directly refer to the working or management of affairs in a commercial or industrial enterprise (consult the Alphabetical List of Services).

### **CLASS 36**

#### **(Insurance and financial)**

Insurance; financial affairs; monetary affairs; real estate affairs.

#### *Explanatory Note*

This class includes mainly services rendered in financial and monetary affairs and services rendered in relation to insurance contracts of all kinds.

*Includes, in particular:*

- services relating to financial or monetary affairs comprise the following:
  - (a) services of all the banking establishments, or institutions connected with them such as exchange brokers or clearing services;
  - (b) services of credit institutions other than banks such as cooperative credit associations, individual financial companies, lenders, etc.;
  - (c) services of “investment trusts,” of holding companies;
  - (d) services of brokers dealing in shares and property;
  - (e) services connected with monetary affairs vouched for by trustees;



## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

- (f) services rendered in connection with the issue of travellers' cheques and letters of credit;
- services of realty administrators of buildings, *i.e.*, services of letting or valuation, or financing;
- services dealing with insurance such as services rendered by agents or brokers engaged in insurance, services rendered to insured, and insurance underwriting services.

### CLASS 37

#### (Building construction and repair)

Building construction; repair; installation services.

#### *Explanatory Note*

This class includes mainly services rendered by contractors or subcontractors in the construction or making of permanent buildings, as well as services rendered by persons or organizations engaged in the restoration of objects to their original condition or in their preservation without altering their physical or chemical properties.

*Includes, in particular:*

- services relating to the construction of buildings, roads, bridges, dams or transmission lines and services of undertakings specializing in the field of construction such as those of painters, plumbers, heating installers or roofers;
- services auxiliary to construction services like inspections of construction plans;
- services of shipbuilding;
- services consisting of hiring of tools or building materials;
- repair services, *i.e.*, services which undertake to put any object into good condition after wear, damage, deterioration or partial destruction (restoration of an existing building or another object that has become imperfect and is to be restored to its original condition);
- various repair services such as those in the fields of electricity, furniture, instruments, tools, etc.;
- services of maintenance for preserving an object in its original condition without changing any of its properties (for the difference between this class and Class 40 see the explanatory note of Class 40).

*Does not include, in particular:*

- services consisting of storage of goods such as clothes or vehicles (Cl. 39);
- services connected with dyeing of cloth or clothes (Cl. 40).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### CLASS 38

#### (Telecommunications)

Telecommunications.

##### *Explanatory Note*

This class includes mainly services allowing at least one person to communicate with another by a sensory means. Such services include those which:

- (1) allow a person to talk to another,
- (2) transmit messages from one person to another, and
- (3) place a person in oral or visual communication with another (radio and television).

*Includes, in particular:*

- services which consist essentially of the diffusion of radio or television programmes.

*Does not include, in particular:*

- radio advertising services (Cl. 35).

### CLASS 39

#### (Transportation and storage)

Transport; packaging and storage of goods; travel arrangement.

##### *Explanatory Note*

This class includes mainly services rendered in transporting people or goods from one place to another (by rail, road, water, air or pipeline) and services necessarily connected with such transport, as well as services relating to the storing of goods in a warehouse or other building for their preservation or guarding.

*Includes, in particular:*

- services rendered by companies exploiting stations, bridges, rail-road ferries, etc., used by the transporter;
- services connected with the hiring of transport vehicles;
- services connected with maritime tugs, unloading, the functioning of ports and docks and the salvaging of wrecked ships and their cargoes;
- services connected with the functioning of airports;

## **CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES**

- services connected with the packaging and parcelling of goods before dispatch;
- services consisting of information about journeys or the transport of goods by brokers and tourist agencies, information relating to tariffs, timetables and methods of transport;
- services relating to the inspection of vehicles or goods before transport.

*Does not include, in particular:*

- services relating to advertising transport undertakings such as the distribution of prospectuses or advertising on the radio (Cl. 35);
- services relating to the issuing of travellers' cheques or letters of credit by brokers or travel agents (Cl. 36);
- services relating to insurances (commercial, fire or life) during the transport of persons or goods (Cl. 36);
- services rendered by the maintenance and repair of vehicles, nor the maintenance or repair of objects connected with the transport of persons or goods (Cl. 37);
- services relating to reservation of rooms in a hotel by travel agents or brokers (Cl. 43).

### **CLASS 40**

#### **(Treatment of materials)**

Treatment of materials.

#### *Explanatory Note*

This class includes mainly services not included in other classes, rendered by the mechanical or chemical processing or transformation of objects or inorganic or organic substances.

For the purposes of classification, the mark is considered a service mark only in cases where processing or transformation is effected for the account of another person. A mark is considered a trade mark in all cases where the substance or object is marketed by the person who processed or transformed it.

*Includes, in particular:*

- services relating to transformation of an object or substance and any process involving a change in its essential properties (for example, dyeing a garment); consequently, a maintenance service, although usually in Class 37, is included in Class 40 if it entails such a change (for example, the chroming of motor vehicle bumpers);

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- services of material treatment which may be present during the production of any substance or object other than a building; for example, services which involve cutting, shaping, polishing by abrasion or metal coating.

*Does not include, in particular:*

- repair services (Cl. 37).

### CLASS 41

#### (Education and entertainment)

Education; providing of training; entertainment; sporting and cultural activities.

#### *Explanatory Note*

This class contains mainly services rendered by persons or institutions in the development of the mental faculties of persons or animals, as well as services intended to entertain or to engage the attention.

*Includes, in particular:*

- services consisting of all forms of education of persons or training of animals;
- services having the basic aim of the entertainment, amusement or recreation of people;
- Presentation of works of visual art or literature to the public for cultural or educational purposes.

### CLASS 42

#### (Computer, scientific & legal)

Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services.

#### *Explanatory Note*

Class 42 includes mainly services provided by persons, individually or collectively, in relation to the theoretical and practical aspects of complex fields of activities; such services are provided by members of professions such as chemists, physicists, engineers, computer specialists, lawyers, etc.

*Includes, in particular:*

- the services of engineers who undertake evaluations, estimates, research and reports in the scientific and technological fields;

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

- scientific research services for medical purposes.

*Does not include, in particular:*

- business research and evaluations (Cl. 35);
- word processing and computer file management services (Cl. 35);
- financial and fiscal evaluations (Cl. 36);
- mining and oil extraction (Cl. 37);
- computer (hardware) installation and repair services (Cl. 37);
- services provided by the members of professions such as medical doctors, veterinary surgeons, psychoanalysts (Cl. 44);
- medical treatment services (Cl. 44);
- garden design (Cl. 44).

### CLASS 43

#### (Hotels and restaurants)

Services for providing food and drink; temporary accommodations.

#### *Explanatory Note*

Class 43 includes mainly services provided by persons or establishments whose aim is to prepare food and drink for consumption and services provided to obtain bed and board in hotels, boarding houses or other establishments providing temporary accommodations.

*Includes, in particular:*

- reservation services for travellers' accommodations, particularly through travel agencies or brokers;
- boarding for animals.

*Does not include, in particular:*

- rental services for real estate such as houses, flats, etc., for permanent use (Cl. 36);
- arranging travel by tourist agencies (Cl. 39);
- preservation services for food and drink (Cl. 40);
- discotheque services (Cl. 41);
- boarding schools (Cl. 41);
- rest and convalescent homes (Cl. 44).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### CLASS 44

#### (Medical, beauty & agricultural)

Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

#### *Explanatory Note*

Class 44 includes mainly medical care, hygienic and beauty care given by persons or establishments to human beings and animals; it also includes services relating to the fields of agriculture, horticulture and forestry.

#### *Includes, in particular:*

- medical analysis services relating to the treatment of persons (such as x-ray examinations and taking of blood samples);
- artificial insemination services;
- pharmacy advice;
- animal breeding;
- services relating to the growing of plants such as gardening;
- services relating to floral art such as floral compositions as well as garden design.

#### *Does not include, in particular:*

- vermin extermination (other than for agriculture, horticulture and forestry) (Cl. 37);
- installation and repair services for irrigation systems (Cl. 37);
- ambulance transport (Cl. 39);
- animal slaughtering services and taxidermy (Cl. 40);
- timber felling and processing (Cl. 40);
- animal training services (Cl. 41);
- health clubs for physical exercise (Cl. 41);
- scientific research services for medical purposes (Cl. 42);
- boarding for animals (Cl. 43);
- retirement homes (Cl. 43).

### CLASS 45

#### (Personal)

Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals.

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

### *Explanatory Note*

#### *Includes, in particular:*

- investigation and surveillance services relating to the safety of persons and entities;
- services provided to individuals in relation with social events, such as social escort services, matrimonial agencies, funeral services.

#### *Does not include, in particular:*

- professional services giving direct aid in the operations or functions of a commercial undertaking (Cl. 35);
- services relating to financial or monetary affairs and services dealing with insurance (Cl. 36);
- escorting of travellers (Cl. 39);
- security transport (Cl. 39);
- services consisting of all forms of education of persons (Cl. 41);
- performances of singers and dancers (Cl. 41);
- legal services (Cl. 42);
- services provided by others to give medical, hygienic or beauty care for human beings or animals (Cl. 44);
- certain rental services (consult the Alphabetical List of Services and General Remarks relating to the classification of services).

### **1401.02(b) Short Titles for International Trademark Classes**

The United States Patent and Trademark Office associates the following word titles with the respective international trademark class numbers:

#### *GOODS*

1. Chemicals
2. Paints
3. Cosmetics and cleaning preparations
4. Lubricants and fuels
5. Pharmaceuticals
6. Metal goods
7. Machinery
8. Hand tools
9. Electrical and scientific apparatus
10. Medical apparatus
11. Environmental control apparatus
12. Vehicles
13. Firearms

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

14. Jewelry
15. Musical instruments
16. Paper goods and printed matter
17. Rubber goods
18. Leather goods
19. Non-metallic building materials
20. Furniture and articles not otherwise classified
21. Housewares and glass
22. Cordage and fibers
23. Yarns and threads
24. Fabrics
25. Clothing
26. Fancy goods
27. Floor coverings
28. Toys and sporting goods
29. Meats and processed foods
30. Staple foods
31. Natural agricultural products
32. Light beverages
33. Wines and spirits
34. Smokers' articles

### SERVICES

35. Advertising and business
36. Insurance and financial
37. Building construction and repair
38. Telecommunications
39. Transportation and storage
40. Treatment of materials
41. Education and entertainment
42. Computer, scientific and legal
43. Hotels and restaurants
44. Medical, beauty and agricultural
45. Personal

These short titles are not an official part of the international classification. Their purpose is to provide a means to quickly identify the general content of numbered international classes. By their nature, these titles will not necessarily disclose the classification of specific items. The titles are not designed to be used for classification but only as information to assist in the identification of numbered classes. To determine the classification of particular goods and services, it is necessary to refer to the Alphabetical List of Goods and Services, the class headings of international classes and Explanatory Notes in the *International Classification of Goods and Services for the Purposes of the Registration of Marks*



## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

(8<sup>th</sup> ed. 2002), published by WIPO. The full names of international classes are set forth in 37 C.F.R. §6.1.

The short titles are printed in the *Official Gazette* in association with the international class numbers under MARKS PUBLISHED FOR OPPOSITION, Sections 1 and 2; TRADEMARK REGISTRATIONS ISSUED, PRINCIPAL REGISTER, Section 1; TRADEMARK REGISTRATIONS ISSUED UNDER SECTION 1(d), Sections 1 and 2; and SUPPLEMENTAL REGISTER, Sections 1 and 2.

The international trademark classification was adopted by the United States as its system of classification as of September 1, 1973. See 911 TMOG 210 (June 26, 1973). The use of short titles was announced in a notice at 924 TMOG 155 (July 16, 1974).

### **1401.02(c) International Alphabetical List**

Additional general guidance concerning identifications may be found in the “Alphabetical List” of goods and services appearing in the *International Classification of Goods and Services for the Purposes of the Registration of Marks Under the Nice Agreement-Part I* (8<sup>th</sup> ed. 2002), published by the World Intellectual Property Organization, 34, chemin des Colombettes, 1211 Geneva 20 Switzerland. (Specify the English edition when ordering.) The *International Classification* is available at <http://www.wipo.int/classifications/en/index.html>. However, because the international list was developed to *classify* goods and services and not to identify specific goods and services, most entries will not be sufficiently definite to use in an identification of goods or services.

The *Acceptable Identification of Goods and Services Manual* should be used to determine whether an identification is sufficiently definite. See TMEP §1402.04.

### **1401.03 Designation of Class**

In an application for registration of a mark, the applicant or the applicant’s attorney should designate the international class number(s) that are appropriate for the identified goods or services whenever the information is known. 37 C.F.R. §2.32(a)(7). See TMEP §1401.02(a) for the international classification schedule with explanatory notes.

In an application under §1 or §44, incorrect classification will be corrected by amendment. See TMEP §1401.03(b).

### **1401.03(a) Designation of Class by Applicant Normally Accepted in Applications Under §§1 and 44**

Sometimes a product could be classified in more than one class. Some products are classified differently depending on the type of material of which the product is

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

composed. For example, plastic statuettes are in Class 20 while glass statuettes are in Class 21. Generally, in applications under §1 or §44 of the Trademark Act, the Office will presume that the class number designated by the applicant or the applicant's attorney is correct in the absence of any contradictory information. The applicant may be asked for further clarification for classification of goods of this type during the examination of the application.

### **1401.03(b) Designation of Class by Office When Class Number Is Not Designated or Is Inaccurate in Application Under §1 or §44**

In an application under §1 or §44 of the Trademark Act, if the applicant does not designate a class number(s), the Office will do so. If the class number(s) indicated by the applicant is clearly wrong (e.g., goods are classified in a service class), the Pre-Examination Section of the Office will change the classification. The filing receipt for the application will indicate the class number(s) that have been designated.

Upon examination, the classification must be amended if the class numbers are incorrect. When the examining attorney requires or recommends an amendment of the identification of goods or services that would necessitate an amendment of the classification, the examining attorney should also require that the classification be amended.

If an incorrect class number was designated by the Pre-Examination Section, the examining attorney must inform the applicant of the correct class number for the identified goods or services and require amendment of the classification.

Amendment or correction of classification may be done through an examiner's amendment, without prior authorization by the applicant or the applicant's attorney. *Groening v. Missouri Botanical Garden*, 59 USPQ2d 1601 (Comm'r Pats. 1999). See TMEP §707.02.

Before approving an application for publication, the examining attorney should check to make sure that the properly assigned class is reflected in the electronic records of the Office.

### **1401.03(c) Failure to Classify May Delay Action in Applications Under §§1 and 44**

The applicant should make an initial effort at classification, using the Alphabetical List of Goods and Services. In an application under §1 or §44 of the Trademark Act, when an application and fee is filed for a single class, but the identification lists a large number of items that obviously involve many classes, the examining attorney will require the applicant to properly classify the items. Class designations must be determined and fees for multiple classes must be paid before an examining attorney does an extensive search in a large number of classes. TMEP §810.01.

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

### 1401.03(d) Classification Determined by World Intellectual Property Organization in §66(a) Applications

In an application under §66(a) of the Trademark Act, *i.e.*, a request for protection of an international registration to the United States pursuant to the Madrid Protocol, the International Bureau of the World Intellectual Property Organization (“IB”) controls classification. Article 3(2) of the Protocol. The §66(a) application (and any resulting registration) remains part of the international registration, and a change of classification in the United States would have no effect on the international registration. Therefore, the international classification of goods/services in a §66(a) application **cannot be changed** from the classification given to the goods/services by the IB, even if the IB’s classification of goods/services in the §66(a) application is different from the classification set forth in the USPTO’s *Acceptable Identification of Goods and Services Manual*.

Accordingly, if the mark in a §66(a) application appears to be a certification or collective membership mark, the USPTO **will not** reclassify it into U.S. Class A, B or 200. However, the applicant must comply with all other U.S. requirements for certification and collective membership marks, regardless of the classification chosen by the IB. See TMEP §§1304 *et seq.* and 1306 *et seq.*

For purposes of *identification* of goods/services, the examining attorney will examine a §66(a) application according to the same standards of specificity used in examining applications under §1 and §44 of the Trademark Act. That is, the examining attorney must follow the procedures set forth in the TMEP and identify the goods/services in accordance with the USPTO’s *Manual of Acceptable Identification of Goods and Services* (see TMEP §1402.04) whenever possible.

See also TMEP §§1402.01(c) and 1902.07(c)(i).

### 1401.04 Classification Determines Number of Fees

*Extract from 15 U.S.C. §1112. The applicant may apply to register a mark for any or all of the goods or services on or in connection with which he or she is using or has a bona fide intention to use the mark in commerce: Provided, That if the Director by regulation permits the filing of an application for the registration of a mark for goods or services which fall within a plurality of classes, a fee equaling the sum of the fees for filing an application in each class shall be paid, and the Director may issue a single certificate of registration for such mark.*

Classification is the basis for determining the number of fees that must be paid. In an application under §1 or §44 of the Trademark Act, fee is required for each class.

In an application under §1 or §44, if the application sets forth goods or services in more than one class and only one fee has been paid, the applicant must either amend the application to restrict the goods or services to a single class or submit a fee for each additional class to prosecute the application as a multiple-class

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

application. The fees for multiple classes must be paid before an examining attorney does an extensive search in a large number of classes. TMEP §810.01.

If, with the original application, the applicant submits fees for more classes than are validly represented in the application, the fees that have been overpaid in error will be refunded.

In a §66(a) application, the amount of the filing fee will be determined by the IB, who will collect the fee and send it to the USPTO pursuant to the provisions of the Madrid Protocol and the *Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to That Agreement* (April 1, 2004) ("Common Regs."). The examining attorney will not question the sufficiency of the filing fee in a §66(a) application. The classification in a §66(a) application cannot be changed, and classes cannot be added. See TMEP §1401.03(d) for further information.

### **1401.04(a) Prior U.S. Classification System**

Prior to the adoption of the International Classification in 1973, the U.S. Classification was the primary classification used in the Office. After adoption of the International Classification, the U.S. Classification became a secondary classification system. United States classes are still assigned to all applications by a computerized system. Each international class is coordinated with the U.S. classes that are most frequently associated with it. Neither examining attorneys nor any other Office personnel have the authority or capability of altering these automatically assigned secondary U.S. Classification designations.

### **1401.04(b) Limiting Goods and Services to the Number of Classes for Which Filing Fees Are Paid**

An application may list, in connection with each international class number designated, only goods or services that fall within that class. An applicant may apply to register a mark for any or all of the goods/services on or in connection with which the applicant is using or has a bona fide intent to use the mark in commerce, if the applicant submits a filing fee for each class. See 15 U.S.C. §1112; 37 C.F.R. §2.86(a). An application that includes more than one class of goods or services is called a combined or multiple class application. See TMEP §§1403 *et seq.*

The applicant should designate only the number of classes for which a filing fee is submitted and should limit the specified goods and services to those within the particular class(es) designated. Thus, if a single filing fee is submitted, the applicant should designate only one class and should limit the goods or services specified in the identification to items in that class.

The examining attorney must require any necessary amendments to ensure that the classification is correct for the specified goods or services. In an application under

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

§1 or §44 of the Trademark Act, if the applicant identifies goods or services that are classified in a greater number of classes than the classes for which filing fees have been paid, the examining attorney must require that the applicant either: (1) pay the additional fees; or (2) amend the identification to restrict the application to the number of classes for which fees have already been paid. See TMEP §§810.01 and 1403.02(c).

In a §66(a) application, the amount of the filing fee will be determined by the IB, who will collect the fee and send it to the USPTO, pursuant to the provisions of the Madrid Protocol and the Common Regs. The examining attorney will not question the sufficiency of the filing fee in a §66(a) application. The classification in a §66(a) application cannot be changed, and classes cannot be added. See TMEP §1401.03(d).

### **1401.05 Criteria on Which International Classification Is Based**

The Alphabetical List of Goods and Services according to the International Classes contains information about the appropriate class for particular products and services. See TMEP §1401.02(c). See *also* the Explanatory Notes at the end of each class heading of goods or services. TMEP §1401.02(a). These notes explain the principles and differentiating lines on which the international classes are based.

Some general criteria have been formulated for placing goods or services in the international classes:

- Finished products are classified, in principle, according to their function or purpose or the industry that produces them or, secondarily, according to the material of which they are made or the trade in which they are sold.
- Finished products that are multipurpose composite objects (*e.g.*, clocks incorporating radios) may be classified in all the classes that correspond to each of their functions or intended purposes.
- Raw materials, unworked or semi-worked, are classified, in principle, according to the material of which they consist.
- Goods intended to form part of another product are, in principle, only classified in the same class as the end product if they cannot also be used for other purposes. When the goods can be used for other purposes in general manufacture, the same criterion as for finished products (above) applies.
- Goods, whether finished or not, are classified according to the material of which they are made and where they are made of different materials, such goods are classified, in principle, according to the material that predominates.
- Cases adapted to the product they are intended to contain are classified, in principle, in the same class as the product.
- Services are classified, in principle, according to the branches of activity specified in the headings of the service classes and their Explanatory Notes

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

or, subsidiarily, by analogy with other comparable services contained in the Alphabetical List.

- Rental services are classified, in principle, in the same classes as the services provided by means of the rented objects (e.g., rental of telephones, in Class 38).
- Services that provide advice, information or consultation are in principle classified in the same classes as the services that correspond to the subject matter of the advice, information or consultation, e.g., transportation consultancy in Class 39, business management consultancy in Class 35, financial consultancy in Class 36, beauty consultancy in Class 44. The rendering of the advice, information or consultancy by electronic means (such as telephone or computer) does not affect the classification of these services. See TMEP §1402.11(b) and (e).

See TMEP §1401.02(a).

As indicated above, in the international classification, considerable weight is given to the material of which goods are made.

A product may comprise items that are sold as a unit and that, if sold separately, would be classified in different classes. The identification in such cases should include wording to indicate that the goods are “sold as a unit.” The predominant elements should be listed first and the item will be classified accordingly.

*Example* - Computer software is classified in Class 9. Instructional manuals are classified in Class 16. The item “Computer software in the field of investment management and instructional manuals related thereto, sold as a unit” would be classified in Class 9. “Instructional manuals in the field of investment management and computer software relating thereto, sold as a unit” would be classified in Class 16.

### **1401.06 Specimens as Related to Classification**

As a general rule, the specimen(s) in an application under §1 of the Trademark Act helps to determine the correct classification. The examining attorney should carefully review the specimen to ensure that the identification and classification are accurate. If the information in the record and the wording of the identification differ, or if some significant characteristic shown in the record is omitted from the identification, the assigned class number may be incorrect. See TMEP §1402.05. However, the examining attorney must remember that, generally, the specimen need only support use of the mark on one item in each class of goods or services set forth in an application. See TMEP 904.01(a).

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

### **1401.06(a) Specimen Discloses Special Characteristics**

The classification of goods could be affected if the specimen shows that the mark identifies a composition, an ingredient or a part that exists in the market only as a component of another product, and the identification does not reveal that the item exists only as a component of a specified product.

If the specimen indicates that the goods are promoted for industrial use only, this should be reflected in the identification when it affects the designation of the correct class. For example, detergents for use in industrial and manufacturing processes are classified in Class 1, not in Class 3 where other detergents are classified.

If the specimen shows that the mark identifies a structural part of a machine, this should be reflected in the identification, because parts for machines are generally classified with the machine if the part has no applicability elsewhere.

If the mark is used or intended to be used on raw materials such as plastics or resins which may be marketed in a variety of forms (such as sheets, powders or solutions, or as materials that may be either natural or synthetic), these facts should be indicated in the identification of the goods. This is important because some raw materials are classified in several international classes; for example, plastic in sheet form is in a different class from plastic in powder or pellet form, and synthetic materials are in a different class from those that are natural. Usually, a specimen will disclose these characteristics of raw materials.

If the specimen indicates that a product is made of a particular material, the identification should specify the material, because many finished products are classified on the basis of the material composition of the article. Generally, if there is a classification dedicated to a particular type of goods, the material composition for those goods does not have to be indicated in the identification. For example, Class 20 is the proper class for furniture. This is true regardless of whether the furniture is made of metal. Metal furniture is not classified in Class 6 with other metal products because there is an acceptable class (Class 20) for all furniture regardless of material composition. On the other hand, there is no class specifically designated for ladders. Therefore, ladders are classified by material composition: metal ladders are in Class 6; wood or plastic ladders are in Class 20; and rope ladders are in Class 22.

The only exception to this general guideline is in the area of precious metal. Most items that are made of precious metal are classified in Class 14, even when there is another class in which those goods would be classified if they were made of any other material. For example, nut crackers are classified in Class 8 whether they are made of plastic, wood, nonprecious metal or any other material except precious metal. Nut crackers made of precious metal are in Class 14.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1401.07 Classification and Plurality of Uses

One product or service that has a plurality of uses or aspects is ordinarily classified in a single class. *Ex parte Schatz*, 87 USPQ 374 (Comm'r Pats. 1950). However, if it can be shown that a product or service has a plurality of uses or aspects so that two or more classes are indicated, multiple classification may be permissible. However, identical language cannot be used as the identification of goods in more than one class in these situations. The identification must clearly indicate the basis for multiple classification with language that is appropriate for the respective classes. In an application under §1 of the Trademark Act, the specimen(s) should reflect acceptable use of the mark for each of the specified classes or should be of a general utility nature. In the case of general utility specimens, there must be nothing in the record indicating only one use or aspect. See *Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505 (TTAB 1972), *modified without opinion*, 498 F.2d 1406, 181 USPQ 722 (C.C.P.A. 1974); *In re International Salt Co.*, 166 USPQ 215 (TTAB 1970); *Mead Johnson Co. v. Watson*, 112 USPQ 284 (D.D.C. 1957), *aff'd* 253 F.2d 862, 117 USPQ 13 (D.C. Cir. 1958).

Where a single product or service is classified in more than one class, the applicant must file an acceptable specimen (or copy thereof) for each class with an application under §1(a) of the Act, or an amendment to allege use or statement of use in an application under §1(b). The applicant must also comply with all other requirements for multiple-class applications. See TMEP §1403.01.

If an item is consistently classified in a particular class, the applicant cannot obtain registration in another class by adding language that indicates that other class.

*Example* - Essential oils are classified in Class 3. This item cannot be classified in Class 1 with an indication that it is used in the manufacture of other finished products. Raw or unfinished materials that are used in the manufacture of other finished products may be classified in Class 1. However, an item like essential oils, that is always classified in Class 3 regardless of its ultimate use, cannot be transferred to Class 1 by adding Class 1 qualifying language.

### 1401.08 Classification and the Identification of Goods and Services, In General

The items listed in the identification of goods and services must be limited to those on or in connection with which the applicant uses or has a bona fide intention to use the mark in commerce. The entire contents of a class, as represented by the short title of the class, should not be recited as the identification of goods or services. The short titles of the classes indicate the general scope of the classes and are generally too broad and inclusive to be used to identify particular goods or services.



## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

### **1401.09 Changes in Practice Based on the Restructuring of International Class 42 in the 8<sup>th</sup> Edition of the Nice Agreement**

Effective January 1, 2002, the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (“Nice Agreement”) was amended to add three new service classes (43 through 45). These new classes arose from the extensive restructuring of Class 42. In the course of that restructuring, many activities were removed from Class 42 and placed in one of the three new classes.

The purpose of the Nice Classification is to group, as much as possible, like goods or services in a single class. Generally, the system is successful in achieving that purpose. However, over the years, it became apparent that Class 42 included many disparate services. This was due in large part to the inclusion of the language “services that cannot be classified in other classes” in the class heading for Class 42. This language allowed services as different as “chemical research” and “horoscope casting” to be included in the class. Therefore, after much study and discussion, the Committee of Experts for the Nice Agreement approved the restructuring of Class 42. The restructuring amended Class 42 by limiting the scope of the services included in that class to computer, scientific and legal services, and created three additional classes that grouped services previously classified in Class 42 into new classes that kept like services grouped together. See TMEP §1401.02(a).

Effective January 1, 2002, the language “services that cannot be classified in other classes,” which previously appeared in the class heading of Class 42, has been eliminated. See TMEP §1401.09(a).

#### **1401.09(a) Elimination of “Miscellaneous Class Designation”**

As previously noted, prior to January 1, 2002, the language “services that cannot be classified in other classes” appeared in the class heading of Class 42. Effective January 1, 2002, this language “services that cannot be classified in other classes” no longer appears in any of the class headings or explanatory notes of the Nice Agreement. The Committee of Experts found that the revision of the Nice Agreement created an adequate number of well-defined classes so that this language was no longer necessary. Services must now be identified with sufficient clarity and precision to allow for appropriate classification in one of the eleven service classes.

See TMEP §§1402.11(a) *et seq.* for further information about the changes in identification and classification of services.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1401.09(b) Implementation of the Changes

The new requirements of the 8<sup>th</sup> edition of the Nice Agreement apply only to applications filed on or after January 1, 2002. In an application filed before January 1, 2002, the examining attorney may give the applicant the option of remaining in compliance with the 7<sup>th</sup> edition of the Nice Agreement or amending the application to comply with the classification requirements of the 8<sup>th</sup> edition. The applicant may, of its own accord, submit an amendment to its application that brings it into compliance with the 8<sup>th</sup> edition of the Nice Agreement.

### 1402 Identification of Goods and Services

#### 1402.01 Specifying the Goods and/or Services - in General

A written application must specify the particular goods or services on or in connection with which the applicant uses, or has a bona fide intention to use, the mark in commerce. 15 U.S.C. §§1051(a)(2) and 1051(b)(2); 37 C.F.R. §2.32(a)(6). To “specify” means to name in an explicit manner. The identification of goods or services should set forth common names, using terminology that is generally understood. For products or services that do not have common names, the applicant should use clear and succinct language to describe or explain the item. Technical or esoteric language and lengthy descriptions of characteristics or uses are not appropriate.

The language used to describe goods or services should be understandable to the average person and should not require an in-depth knowledge of the relevant field. An identification may include terms of art in a particular field or industry, but, if these terms are not widely understood by the general population, the identification should include an explanation of the specialized terminology.

The identification of goods or services must be specific, definite, clear, accurate and concise. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296 (TTAB 1986), *rev'd on other grounds*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505 (TTAB 1972), *modified without opinion*, 498 F.2d 1406, 181 USPQ 722 (C.C.P.A. 1974); *In re Cardinal Laboratories, Inc.*, 149 USPQ 709 (TTAB 1966); *California Spray-Chemical Corp. v. Osmose Wood Preserving Co. of America, Inc.*, 102 USPQ 321 (Comm'r Pats. 1954); *Ex parte A.C. Gilbert Co.*, 99 USPQ 344 (Comm'r Pats. 1953).

The accuracy of identification language in the original application is important because the identification cannot later be expanded. See 37 C.F.R. §2.71(a); TMEP §§1402.06 and 1402.07 *et seq.*; *In re M.V Et Associes*, 21 USPQ2d 1628 (Comm'r Pats. 1991).

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

### **1402.01(a) General Guidelines for Acceptable Identifications of Goods or Services**

With few exceptions, an identification of goods and services will be considered acceptable if it:

- Is written in English;
- Describes the goods and/or services so that an English speaker could understand what the goods and/or services are, even if the grammar or phrasing is not optimal;
- Meets the *standards* (not necessarily the language) set forth in the *Acceptable Identification of Goods and Services Manual*;
- Is not a class heading; and
- Is in the correct class.

Deference should be given to the language and the classification set forth by the applicant in the original application. Obvious spelling errors in an identification of goods/services may be corrected by examiner's amendment without contacting the applicant. See TMEP §707.02.

### **1402.01(b) Identification of Goods and Services in a §44 Application**

The identification of goods and services in an application based on §44 of the Trademark Act, 15 U.S.C. §1126, must comply with the same standards that govern other applications. The applicant must identify the goods and services specifically, to enable the Office to classify the goods and services properly and to reach informed judgments concerning likelihood of confusion under 15 U.S.C. §1052(d).

Foreign registrations will often include broad statements of the identification of goods and services. In many cases the identification is merely a repetition of the entire general class heading for a given class. These broad identifications are generally unacceptable in United States applications. The identification of goods or services in the United States application must be definite and specific even if the foreign registration includes an overly broad identification. *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296, 1298 (TTAB 1986), *rev'd on other grounds*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987).

Furthermore, in an application based on §44 of the Trademark Act, the identification of goods and services covered by the §44 basis in the United States application may not exceed the scope of the goods and services identified in the foreign registration. *Marmark Ltd. v. Nutrexp S.A.*, 12 USPQ2d 1843 (TTAB 1989); *In re Löwenbräu München*, 175 USPQ 178 (TTAB 1972). However, if the applicant also relies on use in commerce or intent-to-use in commerce, the identification of goods or services may include items or services not listed in the foreign registration if the applicant specifically limits the §44 basis to the goods and services covered by the foreign

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

registration. 37 C.F.R. §2.32(a)(6). See TMEP §§806.02 *et seq.* regarding multi-basis applications.

If a foreign registration in a single class includes a broad statement of the identification of goods or services and the Office determines that the goods or services identified are in more than one class, the applicant may rely on the same foreign registration to cover the additional classes in the United States application, provided the identification in the foreign registration encompasses all goods or services identified in the United States application. See TMEP §§1403 *et seq.* regarding multiple class applications.

### **1402.01(c) Identification of Goods and Services in a §66(a) Application**

The examining attorney will examine the identification of goods/services in a §66(a) application according to the same standards of specificity used in examining applications under §1 and §44 of the Trademark Act, 15 U.S.C. §§1051 and 1126. That is, the examining attorney must follow the procedures set forth in the TMEP and identify the goods/services in accordance with the *Manual of Acceptable Identification of Goods and Services* whenever possible.

However, the international classification of goods/services in a §66(a) application **cannot be changed** from the classification given to the goods/services by the IB. See TMEP §1401.03(d). If the IB's classification of goods/services in the §66(a) application is different from the classification set forth in the *Manual of Acceptable Identification of Goods and Services*, the examining attorney will not request an amendment of the classification. The goods/services cannot be moved to another class identified in the application. See TMEP §1904.02(b).

### **1402.01(d) Location of “Identification of Goods and Services”**

If the applicant submits a separate drawing page, this page is considered part of the written application and not a separate element. Any goods or services listed on the drawing will be considered part of the “identification of goods and services,” even if these goods or services do not appear within the body of the application.

### **1402.01(e) Responsibilities of Examining Attorney as to Identification**

It is the applicant's duty and prerogative to identify the goods and services. However, the examining attorney may require amendment of the identification of goods or services to ensure that it is clear and accurate and conforms to the requirements of the statute and rules. The examining attorney should explain clearly but concisely the reason for requiring an amendment.

Under 37 C.F.R. §2.61(b), the examining attorney may require information and exhibits if necessary to ascertain the nature of the goods or services or otherwise permit proper examination. See TMEP §814.

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

When requiring amendment to the identification of goods and services, the examining attorney should advise the applicant that goods or services deleted by amendment may not be reinserted at a later point in prosecution. See TMEP §§1402.06(a) and 1402.07(e). Examining attorneys should take particular care to ensure that *pro se* applicants are aware of the restrictions on amendments to the identification of goods and services.

If an examining attorney is uncertain as to the acceptability of the language in an identification, he or she should consult with a senior or managing attorney. If still unresolved, questions about an identification of goods or services should be referred to the Administrator for Trademark Identifications, Classification and Practice.

The examining attorney has the discretion to issue a final refusal based on a requirement to amend the identification of goods or services. Examining attorneys should make every effort to resolve these issues, and should suggest an acceptable identification if possible. The appropriate senior or managing attorney must approve final action if the examining attorney does not have full signatory authority. The Administrator for Trademark Identifications, Classification and Practice should be consulted whenever necessary and copies of appeal briefs that involve an issue of identification of goods or services should be sent to the Administrator for monitoring purposes.

### **1402.02 Entitlement to Filing Date With Respect to Specification of Goods and Services**

An application under §1 or §44 must include an identification of goods/services to receive a filing date. 37 C.F.R. §2.21(a)(4). If an application does not include an identification of recognizable goods or services, it will be denied a filing date.

Effective October 30, 1999, any goods or services listed on a drawing page are considered part of the “identification of goods and services.”

If the application does not identify any recognizable goods or services, the Office will deny a filing date. For example, a filing date will be denied if the identification of goods or services is blank or recites only the following:

- (1) the mark itself;
- (2) a class number;
- (3) wording such as “company name,” “corporate name” or “company logo;”
- (4) “Internet services” or “e-commerce services;”
- (5) “advertising and business” (the short title of Class 35);
- (6) “miscellaneous” or “miscellaneous services;” or

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

(7) “personal services” (the short title of Class 45).

These examples fail to meet even the minimum requirements necessary to receive a filing date under 37 C.F.R. §2.21(a)(4).

In an application under §1 or §44, if an examining attorney finds that the application materials fail to specify recognizable goods or services, the examining attorney should return the materials to the supervisory legal instruments examiner with instructions to cancel the filing date for failure to specify goods or services, under 37 C.F.R. §2.21(a)(4).

If the identification language includes wording that would not be sufficient and other wording that, by itself, would be specific enough to entitle the application to a filing date, the Office will grant the application a filing date. The Office will disregard wording that fails to include any scope limitations for the purpose of determining the scope of permissible amendments. For example, if the applicant uses “e-commerce services” along with definite language, the identification of services may only be amended to correct the identification within the scope of services indicated by the presence of the definite language. See TMEP §§1402.07 *et seq.* regarding the scope of an identification for purposes of amendment.

Reference to the goods or services only on the specimen(s) does not satisfy the requirement for an “identification of goods or services.”

The Office will not deny a filing date if the applicant uses the language of an international class heading or indicates that the mark is used on all goods or services in a certain class. However, the Office strongly discourages the use of the language of the international class headings or statements that the mark is used on all goods or services in a class to identify the goods or services for which registration of the mark is sought, and will require amendment of any such identification. Note also that an applicant is required to submit a verified statement specifying either that the applicant is using the mark in commerce or has a bona fide intention to use the mark in commerce on or in connection with the specified goods or services. It is unlikely that any applicant is using or intends to use a mark on all goods or services within a certain class.

### **1402.03            Specificity of Terms Used in Identifying Goods and Services**

Applicants frequently use broad terms to identify the goods or services in an application. In applications based solely on §1(a), 15 U.S.C. §1051(a), the applicant must have used the mark in commerce on all of the goods or services as of the application filing date. See *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988). In applications filed under §1(b), 15 U.S.C. §1051(b), and §44, 15 U.S.C. §1126, the applicant must assert a bona fide intent to use the mark in commerce on the goods or services as of the application filing date. The requirement for use or a bona fide intent to use is not necessarily violated by broad

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

identifying terms. When a mark is used on a number of items that make up a homogeneous group, a term that identifies the group as a whole would be understood as encompassing products of the same general type that are commercially related.

As long as a broad term identifies the goods or services that are intended to be covered with reasonable certainty, it will be reasonable, from a commercial viewpoint, to consider that the mark has been used for all the related goods or services that fall in the designated group. See *In re Dynamit Nobel AG*, 169 USPQ 499 (TTAB 1971) (“ammunition” permitted because its scope was assumed to be understood); *In re Port Huron Sulphite & Paper Co.*, 120 USPQ 343 (TTAB 1959) (“paper other than board papers” approved because of evidence of actual use on various types of paper).

Where an applicant has identified its goods very broadly but does not use the mark on a substantial number of related goods encompassed by the identification language, the Office may require further specificity. For example, the Office generally requires that “paper” be identified with greater specificity, as many marks for paper are actually used on specific types of paper that may be classified in different classes and that have distinct channels of trade.

The examining attorney must consider the following guidelines:

- (1) A term that clearly includes particular items that are classified in more than one class (e.g., “artists’ materials”) is not acceptable. Another example is “tables,” which would include such diverse and differently classified types as operating tables, draftsmen’s tables and dining tables. However, the conclusion that a term would clearly include items classified in more than one class should not be drawn unless reasonable, in light of the commercial relationships between all the goods or services identified in the application. See TMEP §1402.05(b) regarding goods that may be classified in more than one class depending on their material composition.
- (2) Some terminology is sufficient for purposes of according a filing date but too indefinite to enable proper examination to be made (e.g., “metallic parts”). For example, in *In re Societe Des Parfums Schiaparelli, S.A.*, 122 USPQ 349, 350 n. 4 (TTAB 1959), clarification of the term “beauty products” was held to be necessary because the term does not have a particular commercial meaning. In such a situation the examining attorney may seek further information under 37 C.F.R. §2.61(b). See TMEP §814.
- (3) An identification that can be understood when read in association with the title of the class in which it is placed, and that is otherwise satisfactory, should not be required to be further qualified by amendment. For example, “mufflers” in the clothing class would not require further modification to indicate that articles of clothing are intended; similarly, the term “house organ” in the class for printed publications would not need further

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

qualification. The limited number of items to which this applies, however, represents a narrow exception to the general rule that an identification must itself provide a clear indication of the nature of the goods or services. See TMEP §§1402.01 and 1402.05(b). However, the title of a class cannot be used to define the nature of the goods when the same item could be classified in more than one class depending on material composition or field of use. For example, tools are classified in Class 7 if they are power-driven or Class 8 if they are not power-driven. The identification must indicate whether the tools should be classified in Class 7 or 8 (powered or non-powered). In this situation, the class title cannot be used to justify the appropriate classification.

- (4) The common understanding of words or phrases used in an identification determine the scope and nature of the goods or services. A basic and widely-available dictionary should be consulted to determine the definition or understanding of a commonly used word.
- (5) Many goods are commonly understood to move in a particular channel of trade or have particular attributes. When those goods are classified in the class that is appropriate for that common understanding, very often no further specification as to the nature of those goods is necessary. However, when the goods have a special use or attributes that are not typically associated with those particular goods that would cause it to be classified in a different class, that use or attribute should be indicated in the identification in order to justify the classification. For example, "skin lotion" usually refers to a cosmetic product - one that is not medicated. For that reason, it can be classified in Class 3 without further specification. However, a skin lotion that is medicated should be classified in



## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

fact that the applicant has stated that the facts set forth in the application are true. For a closely related group, a specimen showing use of the mark on one item of the group is sufficient. As the closeness of the relationship becomes less certain, specimens of use on more than one item might be necessary to show generalized use. The nature of the mark may also be considered. "House" marks are placed on all the goods that a company produces, whereas a "product" mark that is appropriate only for a specific commodity is used only on that commodity. See TMEP §1402.03(b) regarding house marks, and TMEP §1402.03(c) regarding identifications that refer to "a full line of" a genre of products.

The appropriateness of any broad identification depends on the facts in the particular case. The examining attorney should permit applicants to adopt terms that are as broad as the circumstances justify.

### **1402.03(a) Inclusive Terminology**

The identification should state common names for goods or services, be as complete and specific as possible and avoid indefinite words and phrases. The terms "including," "comprising," "such as," "and the like," "and similar goods," "products," "concepts," "like services" and other indefinite terms and phrases are almost always unacceptable.

The terms "namely" and "consisting of" are definite and are preferred whenever setting forth an identification that requires greater particularity. Vague terminology should be replaced by "namely" and "consisting of" whenever possible.

In limited situations for closely related goods, certain indefinite terms may be used in explanatory phrases that follow a definite term -- for example, "fabric suitable for making coats, suits, and the like." See *Ex parte A.C. Gilbert Co.*, 99 USPQ 344 (Comm'r Pats. 1953).

"Parts therefor," as related to machinery, is acceptable when it follows a definite identification. "Accessories therefor" is usually considered indefinite but it has been allowed in some cases, particularly in the toy field. Identifications such as "dolls and accessories therefor" and "toy vehicles and accessories therefor" are acceptable because all goods that fall within that broad designation would be classified in Class 28 with the dolls or toy vehicles and could be the basis for a refusal of registration under 15 U.S.C. §1052(d). However, this phrase should only be used in a situation where it is clear that the goods encompassed by the phrase relate closely to the primary goods and would all be classified in the same class as the primary goods.

### **1402.03(b) House Marks**

House marks refer to marks that are used by an entity on a wide range of goods. Marks of this type are often used in the chemical, pharmaceutical and food fields. A

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

house mark is different from a product mark that is used on a specific item or closely related items. A product may bear both a product mark and a house mark.

Under certain limited circumstances, an applicant may apply to register a mark as a house mark. In an application for registration of a house mark, the identification of goods may include wording such as “a house mark for...” As with other applications, these applications must define the type of goods with sufficient particularity to permit proper classification and to enable the Office to make necessary determinations under §2(d) of the Trademark Act, 15 U.S.C. §1052(d).

In an application to register a mark as a house mark based on use in commerce, the applicant must demonstrate that the mark is, in fact, used as a house mark. The examining attorney should require that the applicant provide catalogues showing broad use of the mark or similar evidence to substantiate this claim.

An intent-to-use applicant who wishes to register a mark as a house mark must clearly indicate its intention to register the mark as a house mark during initial examination, and the circumstances must establish that the applicant’s proposed use of the mark as a house mark is credible. The nature of the mark and the capacity of the applicant to use the mark as asserted should be considered in determining whether the claim that the mark is to be used as a house mark is credible. If the applicant indicates such an intention, the examining attorney should advise the applicant that, upon filing of the amendment to allege use or statement of use, the applicant will be required to provide evidence to substantiate use as a house mark. If the applicant cannot do so, the applicant will be required to amend the identification of goods to conform to the usual standards for specificity.

The USPTO will register a mark as a house mark only in the limited circumstances where the mark is actually used as a house mark. Therefore, if an applicant seeks to register a house mark in an application under §44 or §66(a) of the Trademark Act, the examining attorney must require evidence that the mark is in fact used as a house mark. This is not a requirement for specimens, but rather a requirement that applicant provide evidence to substantiate the claim of use as a house mark. 37 C.F.R. §2.61(b). If the applicant cannot do so, the identification of goods must be amended to conform to the usual standards for specificity.

### **1402.03(c) Marks for a “Full Line of ...”**

In rare circumstances, the Office may accept an identification of goods that refers to “a full line of” a genre of products. In order to qualify for the use of such terminology, the line of products must be virtually all classifiable in one class. The most commonly accepted situation is “a full line of clothing” or “a full line of pharmaceuticals.” While there may be some rare exceptions, all clothing is classified in Class 25 and all pharmaceuticals are classified in Class 5. Therefore, so long as the specimens and/or other evidence show use of the mark on virtually all of these goods, the “full line of” language may be used. It may not be used in a

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

situation such as “a full line of hand tools.” Even though Class 8 is the general class for hand tools and many hand tools are classified in Class 8, there are a number of items that would easily be considered hand tools that are not classified in that class (e.g., a non-electric egg beater is in Class 21 but could be considered to fall within the broad category of “hand tools.”)

The “full line of” language may be used only in appropriate situations and the circumstances and specimens or other evidence of record should be analyzed carefully, to ensure that an applicant who does not in fact use a particular mark on a sufficient number or variety of products in its line does not receive a trademark registration that could potentially bar the registration of another applicant who uses a similar mark on different products. See *In re Astra Merck Inc.*, 50 USPQ2d 1216 (TTAB 1999) (evidence of use on only three products does not justify registration of the mark for a full line of those products).

In some cases it may be more appropriate to indicate that the applicant is providing a full line of a subset of a genre of products (e.g., “a full line of sports clothing” or “a full line of anti-viral and cardiovascular pharmaceuticals.”) As with an identification that refers to a full line of a genre of products, virtually all of the products must be classifiable in one class and the specimens and/or other evidence must show use of the mark on virtually all of the relevant goods.

An intent-to-use applicant who wishes to register a mark for a full line of a genre of products must clearly indicate an intention to register the mark for a full line during initial examination, and the circumstances must establish that the applicant’s proposed use of the mark for a full line of products is credible. The nature of the mark and the capacity of the applicant to use the mark as asserted should be considered in determining whether the claim that the mark is to be used for a full line of products is credible. If the applicant indicates such an intention, the examining attorney should advise the applicant that, upon filing of the amendment to allege use or statement of use, the applicant will be required to provide evidence to substantiate use for a full line of products. If the applicant cannot do so, the applicant will be required to amend the identification of goods to conform to the usual standards for specificity.

The USPTO will register a mark for a “full line of” a genre of products only in the limited circumstances where the mark is actually used as such. If an applicant seeks to register a mark for a “full line of” a genre of products in an application under §44 or §66(a) of the Trademark Act, the examining attorney must require evidence to substantiate use for a full line of products. This is not a requirement for specimens, but rather a requirement that applicant provide evidence to substantiate the claim of use as a mark for a “full line of” a genre of products. 37 C.F.R. §2.61(b). If the applicant cannot do so, the identification of goods must be amended to conform to the usual standards for specificity.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1402.03(d) Identifying Computer Programs with Specificity

Any identification of goods for computer programs must be sufficiently specific to permit determinations with respect to likelihood of confusion. The purpose of requiring specificity in identifying computer programs is to avoid the issuance of unnecessary refusals of registration under 15 U.S.C. §1052(d) where the actual goods of the parties are not related and there is no conflict in the marketplace. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). Due to the proliferation of computer programs over recent years and the degree of specialization that these programs have, broad specifications such as “computer programs in the field of medicine” or “computer programs in the field of education” should not be accepted unless the particular function of the program in that field is indicated. For example, “computer programs for use in cancer diagnosis” or “computer programs for use in teaching children to read” would be acceptable.

Typically, indicating only the intended users, field, or industry will not be deemed sufficiently definite to identify the nature of a computer program. However, this does not mean that user, field or industry indications can never be sufficient to specify the nature of the computer program adequately. For example, “computer programs in the field of geographical information systems” would be acceptable. Geographical information systems, also known in the industry as GIS, are well-defined computer applications that do not need further definition. If the identification in the application does not adequately specify the nature of a computer program, further information may be requested. Any questions concerning the recognition of a term of art for a computer program should be discussed with the senior attorneys or other examining attorneys who are knowledgeable in the computer field.

If an applicant asserts that the computer programs at issue serve a wide range of diverse purposes, the applicant must submit appropriate evidence to substantiate such a broad identification of goods. See 37 C.F.R. §2.61(b); TMEP §§1402.03(b) and (c).

Generally, an identification of “computer software” will be acceptable as long as *both* the function/purpose *and* the field are set forth. Some general wording is allowed. The following wording is acceptable:

- (1) *Computer game software.*
- (2) *Computer operating programs or computer operating systems:* Software under this category comprises master control programs that run the computer itself. They are the first programs loaded when the computer is turned on and set the standards for the application programs that run in the operating system or operating program.
- (3) *Computer utility programs:* These programs must be designed to perform maintenance work on a computer system or components thereof, such as file management (sorting, copying, comparing, listing, and searching files),

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

as well as diagnostic and measurement routines that check the health and performance of the computer system. Beware of identifications that read "Computer utility programs, namely, business software." - This is NOT a utility program!

- (4) *Software development tools*: These programs are designed to create other computer programs. This is one of the few exceptions in which use of the term "tools" is acceptable.
- (5) *Database management software [indicate for general use or specific field]*: Software that controls the organization, storage, retrieval, security, and integrity of data in a database (an electronically stored collection of data). For example:

General purpose database management software.

- Database management software for use by financial advisors.
  - Database management software in the field of baseball cards.
- (6) *Spreadsheet software [indicate for general use or specific field]*: Software that simulates a paper spreadsheet, or worksheet, in which columns or individual cells of numbers are summed, subtracted, multiplied or divided with the contents of other columns or cells for budgets and plans. For example:
    - General purpose spreadsheet software.
    - Spreadsheet software for use by budget analysts.
  - (7) *Word processing programs [indicate for general use or specific field]*: Software used to create text documents.
  - (8) *Computer aided design (CAD) software [indicate for general use or specific field]*: Computer Aided Design software is generally used to design products. CAD software is available for generic design or specialized uses, such as architectural, electrical and mechanical design. For example:
    - Computer aided design (CAD) software for general use.
    - Computer aided design (CAD) software used for designing integrated circuits.
    - Computer aided design (CAD) software for architectural use.
  - (9) *Computer aided manufacturing (CAM) software [indicate for general use or specific field]*: Computer Aided Manufacturing software automates manufacturing systems and techniques, including numerical control,

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

process control, robotics and materials requirements planning. For example:

- Computer aided manufacturing (CAM) software for general use.
- Computer aided manufacturing (CAM) software used in the manufacture of airplane components.
- Computer aided manufacturing (CAM) software for integrated circuits.

(10) *CAD/CAM software [indicate for general use or specific field]:* Computer Aided Design/Computer Aided Manufacturing software integrates functions of CAD and CAM software in that products designed by the CAD systems are directly inputted into the CAM systems for manufacture.

Indefinite and unacceptable wording include the following:

- (1) Computer programs featuring multimedia (unless the applicant specifies the content, *e.g.*, motion pictures in the field of [specify], recorded on computer media).
- (2) Computer firmware (unless the applicant specifies the function/purpose of the program, and, if the program is content or field specific, the field of use).
- (3) Computer devices (must specify the common commercial name therefor).
- (4) Computer accessories (must specify the common commercial name therefor).

See TMEP §1402.11(a) regarding identification and classification of computer services.

### **1402.03(e) Identifying Publications with Specificity**

When the goods are publications, the identification must indicate both the specific physical nature and the literary subject matter of the publication.

*Example* - “Magazine devoted to medicine” is acceptable.

*Example* - “Television programming newsletter” is acceptable.

In the case of printed matter of a specialized nature, the identification should describe the goods by specific names or wording that explains their specialized nature.

*Example* - “Children’s storybooks” is acceptable.

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

Even if the mark itself indicates the subject of a publication, the identification must specify the subject matter.

As a general rule, “books” should be described by subject matter or class of purchasers. In the case of a mark used by a publishing house on books, a general identification, such as “a house mark for books” or “a full line of books” is sufficient if supported by the record. However, if the goods are restricted to certain types of literature, such as science fiction, engineering, romance or poetry, the identification should so indicate. The applicant may also indicate the channels of trade or groups of purchasers for the goods.

When the subject matter is not a significant aspect of a publication, such as with in-house newsletters, the identification may merely give an indication of the general character or type of the publication.

*Example* - “Employee newspaper” may be accepted.

See TMEP §1402.11(a) regarding online publications.

### **1402.04 Acceptable Identification of Goods and Services Manual**

The USPTO maintains a listing of acceptable identifications of goods and services compiled by the Administrator for Trademark Identifications, Classification and Practice in the Office of the Commissioner for Trademarks. The *Acceptable Identification of Goods and Services Manual* contains identifications of goods and services and their classifications that are acceptable in the Office without further inquiry by an examining attorney (provided such identification and classification is supported by the specimens of record). The Manual is updated periodically, and the entries in it are more extensive and specific than the Alphabetical List of Goods and Services that is published by WIPO. The listing is not exhaustive but is intended to serve as a guide to examining attorneys in acting on applications and to the public in preparing applications.

Using identification language from the Manual enables trademark owners to avoid objections by examining attorneys concerning indefinite identifications of goods or services; however, applicants should note that they must assert actual use in commerce or a bona fide intent to use the mark in commerce for the goods or services specified. Therefore, even if the identification is definite, examining attorneys may inquire as to whether the identification chosen accurately describes the applicant’s goods or services (see TMEP §1402.05 regarding accuracy of identifications).

No listing could include all possible identifications for the multitude of products and services for which marks may be registered. Therefore a primary use of the Manual’s listings, in addition to indicating precise identifications that will be accepted, is to indicate by analogy and example the kinds of identifications that will be acceptable for products and services not covered by the existing listings.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The *Acceptable Identification of Goods and Services Manual* can be downloaded free of charge from the USPTO website at <http://www.uspto.gov>.

### **1402.05 Accuracy of Identification**

An identification is unacceptable if it is inconsistent with the goods or services indicated by the specimens, or if the ordinary meaning of the identification language is at variance with the goods or services evidenced by the specimens or any other part of the record. For example, the term “posters” would be an unacceptable identification when specimens show use of the mark for “decalcomanias.”

The examining attorney may require an amendment of the identification language to accurately describe the goods or services. *In re Water Gremlin Co.*, 635 F.2d 841, 208 USPQ 89 (C.C.P.A. 1980), *aff'g* 204 USPQ 261 (TTAB 1979) (examining attorney has discretion to require applicant to state whether goods are packaged in container to which mark refers); *Kiekhaefer Corp. v. Willys-Overland Motors, Inc.*, 236 F.2d 423, 111 USPQ 105 (C.C.P.A. 1956) (requirement to amend “internal combustion engines for industrial use” to “outboard motors” considered proper); *In re Opryland USA Inc.*, 1 USPQ2d 1409, 1410 (TTAB 1986) (noting that specimens showed use of the mark for “television broadcasting services” and/or “cable television transmission services” rather than “television production services”); *In re Air Products & Chemicals, Inc.*, 192 USPQ 84, *recon. denied* 192 USPQ 157 (TTAB 1976) (acceptance of identification of goods as “catalysts,” which could include large number of catalysts that applicant does not manufacture, would give applicant a scope of protection to which it was not entitled); *Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505, 509 (TTAB 1972), *modified without opinion*, 498 F.2d 1406, 181 USPQ 722 (C.C.P.A. 1974) (noting that, in view of specimens, greater specificity should have been required in identifying registrant’s detergent product); *In re Toro Mfg. Corp.*, 174 USPQ 241 (TTAB 1972) (noting that use on “grass-catcher bags for lawn-mowers” did not justify the broad identification “bags,” which would encompass goods diverse from and commercially unrelated to applicant’s specialized article); *Ex parte Consulting Engineer Publishing Co.*, 115 USPQ 240 (Comm’r Pats. 1957) (amendment of “periodical” to “monthly news bulletin” required); *Merchandising Promotions v. Hastings & Co., Inc.*, 110 USPQ 256 (Comm’r Pats. 1956) (amendment of “gold stamping foil” to “cellophane folders with pressure-sensitive gold foil strip attached for personalizing articles” required).

An identification cannot be amended to accurately describe the goods if the amendment would add to or expand the scope of the identification. See 37 C.F.R. §2.71(a); TMEP §§1402.06 and 1402.07 *et seq.*

### **1402.05(a) Goods That Are Components or Ingredients**

When a mark is used to identify only a component or ingredient of a product, and not the entire product, the identification should precisely set forth the component or ingredient. In other words, when the specimen or other material in the record clearly



## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

indicates that the mark relates only to a distinguishable part, component or ingredient of a composite or finished product, then the application should identify that component or ingredient as the goods. The identification should leave no doubt that the mark refers only to one part and not to the entire product. Also, the identification should indicate the types of finished products of which the identified components or ingredients form a part, *e.g.*, “liposomes for use as an ingredient in face creams.” See *Ex parte Joseph & Feiss Co.*, 114 USPQ 463 (Comm’r Pats. 1957); *Ex parte Palm Beach Co.*, 114 USPQ 463 (Comm’r Pats. 1957); *Mercantile Stores Co. v. Joseph & Feiss Co.*, 112 USPQ 298 (Comm’r Pats. 1957); *In re Libbey-Owens-Ford Glass Co.*, 75 USPQ 202 (Comm’r Pats. 1947).

If the mark does not pertain solely to a component or ingredient rather than the finished or composite product, the identification should not specify the component or ingredient as the goods.

The same rules of language construction for purposes of amendment, as set forth in TMEP §§1402.01, 1402.06 and 1402.07 *et seq.*, apply to amendments of identifications to indicate components or ingredients. Thus, whether an identification may be amended in order to identify a component or ingredient will depend on the particular circumstances of each application.

*Example* - The indefinite term “fabric” may be amended to the definite identification “fabric for use in the manufacture of slacks” but may not be amended to “slacks,” which is beyond the scope of the identification.

When classifying component or ingredient marks, a distinction should be made between marks that identify these products sold as separate ingredients or components and used to make the finished product, and marks that identify components or ingredients sold as part of the finished product. In the first situation, the goods are classified in the class of the component or ingredient since it has not yet been transformed into the finished product. In the second, the goods are classified in the class of the finished product since the component or ingredient has now been incorporated into other goods. In this situation, the examining attorney should make sure that the specimen shows use of the mark to identify the component or ingredient and not to identify the finished product in its entirety.

### **1402.05(b) Material Composition**

If an identification of goods is specific, but the goods could be classified in more than one class depending on the material composition, then the material composition must be indicated in the identification of the goods.

*Example* - “Statues” refers to specific items; however, the classification depends on the material composition. “Statues of non-precious metal” are classified in Class 6; “statues of precious metal” are classified in

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Class 14; “statues of wax, wood, plaster or plastic” are classified in Class 20; and “statues of glass or porcelain” are classified in Class 21.

However, in certain situations, because of the nature of the particular industry and the knowledge that the items are made out of different materials and are classified accordingly, an indication of the material composition in the identification may be unnecessary. See TMEP §1401.06(a) and 1402.03 for further explanation.

### **1402.06 Amendments Permitted to Clarify or Limit Identification**

Trademark Rule 2.71(a), 37 C.F.R. §2.71(a), restricts amendments to the identification of goods or services as follows, “The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services.” This rule applies to all applications.

Section 7(c) of the Trademark Act, 15 U.S.C. §1057(c), provides that filing an application for registration on the Principal Register establishes constructive use and nationwide priority contingent on issuance of the registration (see TMEP §201.02). Therefore, the identification of goods and services in an application defines the scope of those rights established by the filing of an application for the Principal Register.

#### **1402.06(a) Limiting the Identification of Goods and Services**

As noted above, the rules permit amendments to limit the identification of goods and services.

Deletions from the identification of goods and services are also permitted. “Deletion” means the elimination of an existing item in an identification of goods and services in its entirety. If the applicant wishes to amend the identification of goods and services to delete one or more items, the examining attorney should accept the amendment, if it is timely and otherwise proper. However, once the applicant has expressly amended the identification of goods and services to delete an item, it may not be reinserted in a later amendment.

If the applicant wishes to amend the identification of goods and services to restrict one or more of the items by inserting qualifying language or substituting more specific language, the examining attorney should accept the amendment, if it is timely and otherwise proper. Qualifying language, however, may not be deleted from an identification.

*Example* - If the applicant initially identifies the goods as “publications,” the applicant may amend to substitute one or more terms that fall under the definition of publications. Likewise, if an applicant identifies its goods as “pamphlets,” the applicant may amend to include “brochures,” because these terms are generally equivalent and

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

interchangeable. In either case, the applicant must specify the subject matter.

*Example* - If the applicant initially identifies the goods as “football uniforms,” the applicant may amend to indicate football uniforms in Class 25 and football helmets and shoulder pads in Class 28. These goods are logically included within the initial identification. Footballs, however, could not be added, because this would add an item not logically included within the original identification.

*Example* - If the applicant initially identifies the services as “prepaid medical services” and wishes to amend to “underwriting prepaid medical plans and health care services in the nature of a health maintenance organization,” the amendment should be permitted. Both specific services are logically included under prepaid medical services.

*Example* - If the applicant initially identifies the goods as “cooking utensils sold to restaurants,” the applicant cannot delete the language “sold to restaurants,” because this would broaden the identification.

If an applicant wishes to amend the identification of goods and services to insert an item that is equivalent to or logically encompassed by an item already included in the identification of goods and services, the examining attorney should permit the amendment, if it is timely and otherwise proper.

On the other hand, an applicant may not amend an identification of goods or services to add or substitute a term that is not logically included within the scope of the terms originally identified or that is otherwise qualitatively different from the goods and services as originally identified.

*Example* - If the applicant identifies the goods as “computer programs,” the applicant may not add or substitute computers or other items of computer hardware to the listing.

*Example* - If the applicant initially identifies the goods as “hats,” the applicant may not add or substitute “scarves” in the identification of goods. Likewise, the applicant may not add or substitute “shirts” for “slacks.”

*Example* - If the applicant identifies its services as “ophthalmologist’s services” and proposes to amend the identification to “medical services,” the amendment should not be permitted, because the amendment would expand the identification to include services beyond the scope of those identified initially.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The scope of the goods and services, as originally identified or as amended by an express amendment, establishes the outer limit for any later amendments. See TMEP §1402.07.

Under 37 C.F.R. §2.71(a), there is no general prohibition against specific types of limitations in identifications of goods and services, such as the use of negatives, exceptions or similar language. Limitations on identifications phrased in the negative or as exceptions are acceptable, if they are otherwise proper.

Because 37 C.F.R. §2.71(a) precludes additions to the identification of goods/services, examining attorneys should not require or suggest unduly restrictive identifications. See *In re Sentry Chemical Co.*, 230 USPQ 556 (TTAB 1986). Once the identification has been limited, it cannot be expanded later. See *In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991); *In re M.V Et Associes*, 21 USPQ2d 1628 (Comm'r Pats. 1991). Also, when requiring amendments to the identification of goods/services, examining attorneys should advise applicants that additions to the identification are not permitted.

### **1402.06(b) Clarifying the Identification of Goods and Services**

Under 37 C.F.R. §2.71(a), an applicant may amend “to clarify” the identification of goods and services. The applicant may clarify an identification of goods and services that is indefinite or overly broad, to identify goods or services that are within the scope of the goods and services in the identification. As noted in TMEP §1402.06, filing an application for registration on the Principal Register establishes a constructive date of first use in commerce, contingent on issuance of the registration. 15 U.S.C. §1057(c). Accordingly, the applicant may not expand those rights through amendment of the identification of goods and services.

Thus the applicant may amend from the more general to the specific, but the applicant may not amend from the specific to the more general. The scope of the goods and services identified initially, or as limited by an express amendment, establishes the outer limit for permissible amendments.

In an application under §1 or §44 of the Trademark Act, classification may provide some guidance in determining whether an amendment exceeds the scope of the goods/services identified initially, but it is not controlling. In an application under §1 or §44, the examining attorney may suggest and accept amendments to the identification of goods/services that result in a change of class, if the amended identification does not exceed the scope of the original identification.

*Example* - If an applicant has erroneously identified its goods and services as “menus” but, in fact, the applicant intends to register the mark for restaurant services, the applicant may not amend the identification of goods to “restaurant services.” In such a case, the

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

original identification, which is specific and narrow in scope, may not be expanded to services beyond the scope of that identification.

*Example* - If an applicant has erroneously identified its goods and services as “bottles *for* salad dressing” but, in fact, the applicant intends to register the mark for salad dressing, the applicant may not amend the identification to “salad dressing.” However, if an applicant identifies its goods and services as “bottles *of* salad dressing,” the applicant may amend the identification to “salad dressing.” As above, where the original language is specific and narrow in scope, the identification may not be expanded to goods beyond that scope.

*Example* - If an applicant has erroneously identified its goods and services either as “packaging and labels” or as “packaging and labels for toys” but, in fact, the applicant intends to register the mark for toys, the applicant may not amend to correct the identification. The initial identification failed to indicate the true nature of the applicant’s goods and services in any form. Therefore, the examining attorney must reject the amendment, because it is not within the scope of the initial identification.

In a §66(a) application, classification is assigned by the IB and cannot be changed. See TMEP §§1401.03(d), 1402.01(c) and 1902.07(c)(i) regarding §66(a) applications.

### **1402.07            Scope of Identification of Goods and Services for Purposes of Amendment**

#### **1402.07(a)        The “Ordinary-Meaning” Test**

For the purpose of determining the scope of an identification, the examining attorney should consider the ordinary meaning of the wording apart from the class designation. The class designation (see TMEP §1401.03), whether inserted by the applicant or the Office, does not limit the scope of permissible amendments. If the applicant designates the class, this information may be weighed with other factors for the benefit of the applicant in determining the scope of permissible amendments.

However, if the applicant does not merely designate the class but expressly limits the goods or services recited to those that are within one or more classes, the applicant may not amend to specify items not in those classes.

#### **1402.07(b)        Ambiguous Identifications**

An applicant may amend an ambiguous identification of goods or services (*i.e.*, an identification that fails to indicate a type of goods or services) in order to specify definite goods *or* services within the scope of the indefinite terminology.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*Example* - If the applicant specifies “computer systems,” the applicant may amend to specify either goods or services within the scope of that term, such as “custom design of computer programs,” “computers” or “computer programs for . . . [indicating specific purpose or function].”

*Example* - “Food” is indefinite, but may be amended to “fresh fruit” (Class 31), or “processed fruit” (Class 29), or “dog food” (Class 31). However, “food” may not be amended to “whiskey” (Class 33).

*Example* - “Metallic parts” is indefinite, but may be amended to “metal thread fasteners” (Class 6), or “metal drive gears for machines” (Class 7). However, “metallic parts” may not be amended to “automobile chassis” (Class 12).

Likewise, if the applicant includes wording in an indefinite identification of goods or services that, in context, is obviously surplus, the applicant may amend the identification to specify goods *or* services within the scope of the indefinite terminology. In many cases, the surplus wording will not restrict the range of permissible amendments.

*Example* - If the applicant begins an indefinite identification of goods with surplus wording such as “sale of . . .,” “publishing of . . .,” “advertising of . . .,” “manufacture of . . .,” or similar wording, the applicant may amend to specify either goods or services within the scope of the existing identification. However, the specific terms used to preface the goods do establish some limitation as to scope. “Sale of” may justify an amendment to retail or mail order services for specific goods, but not to custom manufacturing or advertising agency services related to those goods.

The policy permitting applicants to amend to specify *either* goods *or* services should be construed narrowly. The applicant should only be permitted to amend from goods to services, or vice versa, when the existing identification of goods and services fails to specify a definite type of goods or services *and* when the existing identification provides reasonable notice to third parties that the applicant may be providing *either* goods *or* services within the scope of the existing identification.

### **1402.07(c) Unambiguous Identifications**

An applicant may amend an unambiguous identification of *goods* that indicates a specific type of goods to specify definite and acceptable identifications of *goods* within the scope of the existing terminology.

An applicant may amend an unambiguous identification of *services* that indicates a specific type of service to specify definite and acceptable identifications of *services* within the scope of the existing terminology.

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

*An applicant may not amend a definite identification of goods to specify services, or vice versa.*

*Example* - If the applicant specifies “computer programs in the field of accounting,” the applicant may only amend to specify computer programs within the scope specified, those concerning accounting. The applicant may not amend to any service, or to any goods outside the scope of those already identified.

*Example* - Likewise, if the applicant identifies the goods as “computer programs” without specifying the field, the applicant is limited to specific types of computer programs for the purposes of amendment. The applicant has identified a definite type of goods, but Office policy requires further specificity as to purpose or function. An applicant who had identified its goods as “clothing” would likewise be limited to goods within the scope of the term “clothing.”

*Example* - If the applicant specified “retail store services,” the applicant would be limited to amendments within the scope of this service. Although Office policy requires further specificity as to field, the applicant has identified a definite type of service.

*Example* - If the applicant identifies its goods as “stationery” or “wine labels” or “menus,” the applicant is restricted, in any amendments, to goods within the scope of the type indicated. The applicant could not amend to specify other types of goods or services, such as “wine” or “restaurant services.”

### **1402.07(d) Permissible Scope of Identification Not Affected by Proposed Amendment That Is Unacceptable**

If the applicant proposes an amendment to the identification of goods and services, and the examining attorney determines that the amendment is unacceptable, the examining attorney should refer to the identification of goods before the proposed amendment to determine whether any later amendment is within the scope of the identification. In such a case, the applicant is not bound by the scope of the language in the proposed amendment but, rather, by the language of the identification before the proposed amendment.

If the applicant submits an amendment to the identification of goods and services and the examining attorney determines that it is unacceptable, in whole or in part, the examining attorney should advise the applicant of the item or items that are unacceptable. The examining attorney should also advise the applicant that the previous items listed in the existing identification (not the unacceptable substitute) remain operative for purposes of future amendment.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If the applicant submitted the amendment in response to a requirement, the examining attorney should issue a final requirement for amendment of the identification if the proposed amendment raises no new issues and the application is otherwise in condition for a final action. See TMEP §714.05(a)(ii).

### **1402.07(e) Permissible Scope of Identification Affected by Proposed Amendment That Is Accepted**

Once an applicant amends the identification of goods or services in a manner that is acceptable to the examining attorney, the amendment replaces all previous identifications, and thus restricts the scope of goods/services to that of the amended language. Further amendments that would add to or expand the scope of the recited goods or services, as amended, will not be permitted. *In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991); *In re M.V Et Associes*, 21 USPQ2d 1628 (Comm'r Pats. 1991). The applicant may not amend the identification to reinsert goods or services that were omitted or deleted from the identification of goods or services, except in the following limited circumstances:

- (1) Where, before publication or within six months of the mailing of an examiner's amendment (see TMEP §§707 *et seq.*), whichever is earlier, the applicant objects to an amendment of the identification of goods or services in the examiner's amendment *on the ground that the examiner's amendment does not reflect the agreement between the applicant and the examining attorney*;
- (2) Where the applicant inadvertently omits goods or services from an amendment to allege use and has not specifically indicated an intention to delete those goods or services (see TMEP §1104.09(c)); or
- (3) Where the applicant inadvertently omits goods or services from a statement of use and has not specifically indicated an intention to delete those goods or services (see TMEP §1109.13).

In contrast to situations (2) and (3), set out above, if, in a request for an extension of time to file a statement of use, the applicant inadvertently omits particular goods or services when specifying the goods and services on or in connection with which it has a continued bona fide intention to use the mark in commerce, those items may not later be reinserted. 37 C.F.R. §2.89(f); TMEP §1108.02(d).

### **1402.08 Moving Goods and Services Between Companion Applications**

If an applicant has filed separate applications to register the same mark, the applicant may amend to move items of goods or services from one application to another, if the application from which the item is to be moved was filed at least as early as the application to which it is to be moved. Moving goods between files in this way may only be done when the applications involved have not yet been



## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

published in the *Official Gazette*. Items of goods/services can be moved between files only in applications filed under §1 or §44 of the Trademark Act. The applicant cannot amend to move items of goods/services to or from a §66(a) application.

### **1402.09 Use of Marks Inappropriate in Identifications**

If a trademark or a service mark that is registered to an entity other than the applicant is used in the identification of goods or services, the examining attorney should require that it be deleted and that generic wording be substituted. It is inappropriate to use a registered mark to identify a kind of product or a service, because such a mark indicates origin in only one party and cannot be used to define goods that originate in a party other than the registrant. *Camloc Fastener Corp. v. Grant*, 119 USPQ 264 (TTAB 1958). In place of the mark, a generic term must be used.

However, an applicant may use its own registered mark in an identification of goods or services in its own application. The applicant should be careful to use the registered mark as an adjective and to follow it with the generic name of the goods or services offered under its mark. The words “applicant” or “registrant” should not appear in the identification of goods. Before registration, use of the term “registrant” is inaccurate, and, after registration, use of the term “applicant” is inaccurate.

### **1402.10 Identification of Goods and Services in Documents Filed in Connection with §1(b) Applications**

See TMEP §1104.09(c) regarding examination of the identification of goods or services in an amendment to allege use; TMEP §1108.02(d) regarding the identification of goods or services in a request for an extension of time to file a statement of use; and TMEP §1109.13 regarding examination of the identification of goods or services in a statement of use.

### **1402.11 Identification of Services**

This section addresses identifications of particular types of services.

The major requirements for an acceptable identification of services are: (1) the identification must be definite; (2) it must use the common name or terminology for the services, so as to be readily understandable; (3) it must accurately describe the services; and (4) it must specify the services, and not merely collateral or related activities associated with rendering the services.

*Examples* - Where a mark identifies checking account services, the identification “banking services in the nature of a checking account” is more accurate than the general identification “banking services,” which is inclusive of services that may not be associated with the mark. The former identification is more definite, and clearly stated. On the other

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

hand, if a service mark identifies a bank's many services, then the more general identification "banking services" would be appropriate. Thus, either of these identifications could be accepted depending on the particular circumstances, including the nature of the mark and its use or intended use. In both cases, the services would be classified in Class 36.

*Examples* - "Radio broadcasting services" (Class 38) would be an appropriate identification when a radio station uses a mark, such as call letters, to indicate the source of its broadcasting services generally. On the other hand, if an applicant is using the name of a weekly comedy television show as a mark, "television broadcasting services" would not be appropriate because the mark does not serve to identify and distinguish the electrical transmission of the program. Instead, the applicant should identify the services as "television entertainment services in the nature of a series of comedy programs" (Class 41).

Generally, the identification of a service should not emphasize the method or manner by which the service is provided. However, in some circumstances, it may be helpful to include such information in a trailing phrase.

*Example* - "Accounting services" (Class 35) is an acceptable identification of services; thus, whether this type of service is rendered by use of computers or other means need not be mentioned.

*Example* - "Dinner theater services" (Class 41) emphasizes the entertainment aspect associated with theater generally. The fact that dinner is also served at the theater performance is ancillary to the primary service of presenting the theatrical production.

For franchise services (rendered by a franchisor as distinguished from a franchisee), the identification should include an indication of the type of franchise.

*Example* - "franchising services, namely, offering technical assistance in the establishment and/or operation of restaurants" (Class 35).

A mark identifying a beauty contest is classified either as a promotional service rendered by the organizer of the contest to the businesses or groups that sponsor the contest, or as an entertainment service. When the record shows that the primary purpose of conducting such a pageant is to promote the sale of goods or services of the sponsors, the service should be recited as "promoting the goods or services of others by means of a beauty contest," in Class 35. Where the beauty contest is presented primarily as entertainment for the general public (such as beauty contests offered in theaters or amusement parks), the service should be identified as, "entertainment services in the nature of beauty contests," in Class 41.

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

See TMEP §§1401.09 *et seq.* regarding the changes in the international classification of services effective January 1, 2002.

### 1402.11(a) Computer Services

#### ***Services Classified in Classes 35, 36, 37, 39, 40, 41, 44 and 45***

Any activity consisting of a service that ordinarily falls in these classes (*e.g.*, real estate agency services, banking services, dating services), and that happens to be provided over the Internet, is classified in the class where the underlying service is classified. For example, banking services are in Class 36 whether provided in a bank or online.

Some acceptable identifications:

- “Providing banking services via the Internet, in Class 36.”
- “Arranging travel tours via the Internet, in Class 39.”
- “Promoting the goods and services of others by preparing and placing advertisements on websites accessed through the Internet, in Class 35.”
- “Electronic payment, namely, electronic processing and transmission of bill payment data, in Class 36.”
- “Providing social introduction services by means of an Internet website, in Class 45.”

#### ***Content Providers***

The service of providing information via the Internet is classified in the class of the information subject. Entities that provide these services by computer are considered to be “content providers,” that is, they provide the informational or substantive content of a website and/or home page. If an entity provides information in a wide variety of fields, the applicant must select the subject matter to be protected and classify the services accordingly (*e.g.*, banking information in Class 36, business information in Class 35, home repair information in Class 37). See TMEP §1402.11(b) regarding information services.

Some acceptable identifications:

- “Providing information in the field of banking via websites on the Internet, in Class 36.”
- “Providing a website *featuring information* in the field of banking, in Class 36.” This is purely an information provision service and should be treated accordingly. *Note:* The identification “providing a website in the field of \_\_\_\_\_” is *not* acceptable because there is no indication of what the services are, *e.g.*, providing information, online retail store services.
- “Providing information in the field of travel destinations, in Class 39.”

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### ***Class 38: Provision of Telecommunications Connections to the Internet***

These services primarily involve providing telecommunication connections such as those provided by AT&T® and MCI®. Telecommunication connections are the technical means by which one computer can communicate with another. A telecommunications provider is NOT providing the computer technology that transfers the data; rather, it provides the means by which that data or information is transferred. This service connects the user to the “link provider” (see discussion below) or the website itself.

Remember: Just because the applicant is conducting an activity that may *involve* transmission of data on the Internet does not mean the applicant’s service is a Class 38 service. For example, an applicant who merely has a website is not conducting “electronic transmission of messages and data,” in Class 38. The companies providing the Internet connections are conducting the actual transmissions; the applicant is merely making the information available.

“Online bulletin boards” and “chat rooms” are classified in Class 38 *regardless of the content or subject matter*. The rationale for this stems from the fact that these services allow individuals to communicate with each other, like other Class 38 services.

“Providing multiple-user access to the Internet,” is classified in Class 38. *Note:* This identification covers those services provided by Internet Service Providers (“ISPs”), such as Erol’s®, Mindspring®, MCI®, and AT&T®. They provide the computer connection (often using the Class 38 telecommunications services of other entities) that enables a computer user to access the databases and home pages of others via the Internet. These entities are considered “link providers” in that they provide the computer connection needed for a computer user to access a content provider. The word “access” should be limited to these services and should not be used in describing the services of a content provider.

*Some acceptable identifications:*

- “Provision of telecommunications connections to the Internet, in Class 38.”
- “Electronic mail services, in International Class 38.”
- “Broadcasting television or radio programs via the Internet, in Class 38.”
- “Webcasting audio/visual programming via the Internet, in Class 38.”
- “Video and audio teleconferencing via the Internet, in Class 38.”
- “Providing an online bulletin board in the field of medicine, in Class 38.”
- “Providing online chat rooms for transmission of messages among computer users concerning teen topics, in Class 38.”
- “Providing multiple-user access to the Internet, in Class 38.” Many ISPs, such as AOL®, Prodigy® and CompuServe®, have also expanded their services to encompass content-based services for their subscribers. The “providing multiple-user access” identification only covers the ISP services. If

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

the applicant wishes to protect its “content-based” services, it must identify those services with specificity and pay the appropriate fees therefor, if applicable.

### ***Office Function-Type Computer Services***

These services are essentially office function services (e.g., filing and record keeping) that happen to be conducted with the use of a computer:

- “Data processing services, in Class 35.”
- “Computer data entry and data retrieval services, in Class 35.”

### ***Computer Installation and Repair Services***

The applicant must distinguish between computer *hardware* and computer *software*. For example:

- “Installation, maintenance and repair of computer *hardware* systems, in Class 37.”
- “Installation, maintenance and updating of computer *software* systems, in Class 42.”

If the installation and maintenance services refer to networks or systems, the service should be classified in Class 37. For example:

“Installation, maintenance and repair of computer systems, in Class 37.”

If the applicant applies for “*technical support services*,” the examining attorney should suggest both of the following two identifications:

- “Installation and maintenance services in either Class 37 or 42 (depending on whether the subject matter is hardware or software);” and
- “Technical support services, namely, troubleshooting of computer hardware and software problems in Class 42.”

### ***Computer Retail Services***

Retail (and distributorship) services are classified in Class 35 no matter how the services are conducted. Either of the following identifications is acceptable:

- “Computerized online retail store services in the field of [specify], in Class 35.”
- “Providing a website used to place online orders in the field of [specify], in Class 35.”

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### ***Computer Entertainment Services***

Generally, the entertainment services are classified in Class 41. The difficulty is trying to figure out what entertainment activity the applicant is conducting. Therefore, the identification “providing a website featuring entertainment” is not acceptable. Instead, one of the following may be more appropriate:

If the services comprise an “*online game*:”

- “Entertainment services, namely, providing a multi-user online computer game, in Class 41.”
- “Providing a computer game that may be accessed network-wide by network users, in Class 41.”

If the services involve “*chat rooms*:” “Providing online chat rooms for transmission of messages among computer users concerning [indicate field or subject of chat room], in Class 38.”

If the services involve providing *content*: “Providing a website featuring information in the field of computer gaming entertainment, in Class 41.” See TMEP §1402.11(b).

If the services involve providing a website from which a user can receive “*webcasted*” transmissions over the Internet: “Broadcasting (radio programs, television programs, multimedia programming, etc.) via the Internet, in Class 38.”

If the services consist of providing a particular *online show* “*webcasted*” over the Internet: “Entertainment, namely a continuing [indicate type, e.g. variety, news, comedy] show broadcasted over the Internet, in Class 41.”

### ***Computer Design and Development Services***

Generally, these services are in Class 42. It is important to remember that these services must be performed for the benefit of *others*. If an applicant is developing its own software, it is not engaging in a recognized service. (See TMEP §§1301.01 *et seq.* regarding activities that do not constitute services.) If the services are identified as “computer design and development services,” the specimens must show that the applicant provides these services for other parties. Some acceptable identifications are:

- “Computer software design and development services for others, in Class 42.”
- “Computer services, namely, creating and maintaining websites for others, in Class 42.”
- “Duplication of computer programs, in Class 42.”

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

### ***Database Services***

Prior to January 1, 2002, the service of providing an online database via the Internet was classified in Class 42 if the database included a wide variety of subject matter. However, effective January 1, 2002, the *subject matter or content of the online database now governs the classification of the services*. Applicants must now separate the subject matter or content of the databases into their appropriate individual international classes. Acceptable identifications include:

- “Providing an online electronic database on the Internet in the field of banking, in Class 36.”
- “Providing an online electronic database on the Internet in the field of business evaluations of automobile companies, in Class 35.”
- “Providing an online electronic database on the Internet in the field of computer programming, in Class 42.”
- “Providing an online electronic database on the Internet in the field of cosmetology, in Class 44.”

In determining whether the specimens support “database provision services,” look for the following clues:

- See if the specimens use words like “to access our database,” “our database includes...”, etc.
- Confirm that the information provided online is capable of being searched, sorted, re-arranged and indexed like a traditional database.
- If the specimens consist of merely a series of web pages, this is NOT a database. A more appropriate identification would be “providing a website on the Internet featuring information in the fields of \_\_\_\_\_, in Class \_\_\_\_ (class dependent on the content).”

Other common database services include the following:

- “Database development services, in Class 42.”
- “Computerized database management services, in Class 35.”

See TMEP §1402.11(b) regarding information services.

### ***Miscellaneous Computer Services***

Occasionally, an applicant applies for an identification such as “electronic storage and retrieval of information, in Class 35.” This identification is no longer acceptable. The examining attorney should suggest wording such as: “electronic storage (or archiving) for others of [indicate subject matter, e.g. messages, data], in Class 39.”

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Do not use the term “data warehouse” to describe these services. A “data warehouse” is a very large database designed for fast processing of queries, projections, and data summaries, normally used by a large organization.

### **Online Publications**

All online publications are classified in Class 41 *no matter what the subject matter*. An acceptable identification would be:

“Computer services, namely providing online [indicate specific nature of publications, e.g., magazines] in the field of [indicate subject matter of publication], in Class 41.”

A column or section of an online publication would be identified as “computer services, namely, providing a [column or section] in an online [indicate type of publication] in the field of [indicate subject matter of publication],” in Class 41.

The examining attorney should verify from the specimens that the information is presented in a “publication” format. An online magazine in Class 41 must really look and act like a magazine, *i.e.*, contain monthly or periodic articles, sections, features, advertisements, credits, etc. If it does not, a more appropriate identification would be “providing a website on the Internet featuring information in the field of \_\_\_\_\_, in Class \_\_\_\_” (classification dependent on the content).

If an applicant identifies its goods as “publications, namely ...,” and it becomes apparent during examination that the goods are in fact online publications, the applicant may amend the identification to indicate that the goods are online publications in Class 41, since the term “publications” is broad enough to encompass both printed and online publications. On the other hand, if the applicant identifies its goods as “printed publications...,” the identification cannot be amended to indicate that the goods are “online publications,” because this would exceed the scope of the original identification. 37 C.F.R. §2.71(a).

### **1402.11(b) Information Services**

Prior to January 1, 2002, the identification “providing information in a wide variety of fields” was an acceptable identification of services, particularly in the context of Internet websites. The only caveat was to make sure that the website or information services *did* provide information in a wide variety of fields.

Effective January 1, 2002, the “miscellaneous” phrase has been eliminated from the heading of Class 42 (see TMEP §1401.09(a)). Therefore, the examining attorney must require that the applicant indicate the fields in which it is providing information so that the service can be accurately classified. The fields may be listed somewhat broadly, but with enough specificity to allow classification. “Bundling” of the fields of



## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

information (that is, listing all fields of information but allowing the dominant or most significant field to control the classification with the other fields simply “along for the ride”) is no longer acceptable.

Since information services must now be classified according to the subject matter of the information, the nature or subject matter of the information provided must be specified to allow for proper classification. For example, “information in the field of automobiles” is not sufficiently definite to allow for proper classification. If the information pertains to purchasing an automobile, then the service is classified in Class 35. If the information pertains to the care and maintenance of automobiles, the service is classified in Class 37. If the service involves insurance or financing of automobiles, then Class 36 is the proper class. Perhaps the best way to ensure that the information is classified correctly is to identify the subject matter of the service. For example, “information in the field of automobile financing” is adequate to classify the service in Class 36. Another way to clarify the classification of information services is to characterize the information itself. Thus, “providing financing information in the field of automobiles” clearly puts the service in Class 36. As with many other service identifications that require an indication of the subject matter or field, the subject matter or field does not have to be as specific as would be required if that were the service itself. However, an indication of the nature of the information must be included, either by reference to the type of information or the subject matter of the information provided, to allow for proper classification of the activity.

An applicant is not required to register in all classes in which it provides information, but may instead choose to register only the classes of the fields that are most important to it. The examining attorney will ask the applicant to indicate the fields of information to assist in classification. The applicant must decide if it wishes to (1) go forward and register the information services in all of the appropriate classes, or (2) choose the class(es) that are most important to its business, and amend the identification to delete reference to fields of information that fall into other classes. See TMEP §1401.04(b).

### **1402.11(c) Association Services and “Promoting the Interest of” Services**

The classification of services rendered by associations was affected by the reorganization of Class 42 (see TMEP §§1401.09 *et seq.*). Prior to January 1, 2002, the Explanatory Notes regarding this topic for the old Class 42 included the language “services (not included in other classes) rendered by associations to their own members.” This language in the old Class 42 allowed identifications of services such as “association services, namely, promoting the interest of lawyers” to be accepted in Class 42. Effective January 1, 2002, there is no reference to “services rendered by an association” in the Class Heading or Explanatory Notes for any of the service classes.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Most activities rendered by associations are easily classified in other classes, *e.g.*, insurance services (Class 36), business services (Class 35), travel arrangements (Class 39), training and entertainment (Class 41).

Effective January 1, 2002, lobbying services and activities related or similar to lobbying activities provided by an association are classified in Class 35, because they further the business interests of the group represented by the association. Even non-business interests such as those that promote reading skills or environmental protection have a “business interest” in promoting their concerns.

### **1402.11(d) Charitable Services, Other than Monetary**

Prior to January 1, 2002, non-monetary charitable services were classified in Class 42, regardless of the type of service being provided by the charity. Effective January 1, 2002, services are classified by the nature of the service provided, *e.g.*, “charitable services, namely, providing shelter for the homeless” are in Class 43, like other temporary accommodation services; “charitable services, namely, providing tutoring for underprivileged students” are classified in Class 41 like other educational services. See TMEP §§1401.09 *et seq.* regarding the changes in the international classification of services effective January 1, 2002.

### **1402.11(e) Consulting Services**

Prior to January 1, 2002, all consulting services were classified in Class 42 except those relating to business (Class 35) and financial or insurance (Class 36). Effective January 1, 2002, consulting services are classified in the class of the subject matter of the service. The type of consultation or subject matter of the consultation must be set forth with adequate specificity to allow for accurate classification.

See TMEP §§1401.09 *et seq.* regarding the changes in the international classification of services effective January 1, 2002.

### **1402.12 Parentheses and Brackets Should Not be Used in Identifications of Goods and Services**

Generally, parentheses and brackets should not be used in identifications of goods and services. The Post Registration Section of the Office uses single brackets to indicate that goods/services have been deleted from a registration either by amendment under 15 U.S.C. §1057, filing of a partial affidavit of continued use under 15 U.S.C. §1058 or 15 U.S.C. §1141k, or filing of a partial renewal application under 15 U.S.C. §1059. The Post Registration Section also uses double parentheses to indicate that certain goods or services are not claimed in an affidavit of incontestability under 15 U.S.C. §1065. See TMEP Chapter 1600 regarding affidavits of continued use or excusable nonuse, renewal applications, affidavits of incontestability, and amendment of registrations.

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

Therefore, to avoid confusion, applicants should not use parentheses and brackets in the identification of goods or services in an application. The only time parentheses may be used in an identification is when the parentheses merely explain or translate the matter preceding the parenthetical phrase in such a way that it does not affect the clarity of the identification.

For example, “bags (tote)” in Class 18 would not be an acceptable use of parentheses. If the identification were misinterpreted to mean that “tote” was no longer part of the identification of goods (due to an amendment of the goods, or filing of a partial affidavit of continued use or renewal application, the item would merely read “bags.” That would create an ambiguity within Class 18, since it could refer to any type of bag – from an all-purpose sports bag to an evening bag – and it would make a determination of likelihood of confusion difficult. Also, there are bags that are in classes other than Class 18. Without an indication of the type of bag, classification of the goods is problematic.

However, an identification of goods such as “obi (Japanese sash)” in Class 25 would be acceptable because the parenthetical phrase merely provides further information about the goods.

### **1402.13 Requirement For Amendment of Portion of Identification of Goods/Services**

If a requirement for an amendment of the identification of goods/services is expressly limited to only certain goods/services, and the applicant fails to file a response to the refusal or requirement, the application shall be abandoned only as to those particular goods/services. 37 C.F.R. §2.65(a); TMEP §718.02(a).

Accordingly, when the identification of goods/services includes some terminology that is indefinite and some terminology that is acceptable, the examining attorney should specify which terminology is indefinite, suggest amended language if possible, and indicate that the rest of the identification is acceptable.

When an applicant fails to respond to a requirement to amend some terminology in an otherwise acceptable identification of goods/services, the examining attorney should issue an examiner’s amendment that clearly sets forth the changes that will be made to the identification of goods/services. No prior authorization from the applicant or the applicant’s attorney is needed to issue an examiner’s amendment in this situation.

### **1402.14 Identification of Goods/Services Must Conform to Rules and Policies in Effect at the Time of Examination**

The question of whether an identification of goods/services is acceptable must be determined on the basis of the facts and evidence that exist at the time registration is sought. *Cf.* TMEP §1216.01. The international classification system and Office

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

policy on acceptable identifications change periodically (see, e.g., TMEP §§1401.09 *et seq.* regarding the restructuring of international class 42). Accordingly, identifications of goods/services found in earlier-filed applications and registrations are not always controlling on the acceptability of such identifications in a later-filed application.

### **1403 Combined or Multiple-Class Application**

*Extract from 37 C.F.R. §2.86.*

*(a) In a single application, an applicant may apply to register the same mark for goods and/or services in multiple classes. The applicant must:*

*(1) Specifically identify the goods or services in each class;*

*(2) Submit an application filing fee for each class, as set forth in §2.6(a)(1).*

*(3) Include either dates of use (see §§2.34(a)(1)(ii) and (iii)) and one specimen for each class, or a statement of a bona fide intention to use the mark in commerce on or in connection with all the goods or services specified in each class. The applicant may not claim both use in commerce and a bona fide intention to use the mark in commerce for the identical goods or services in one application.*

*(b) An amendment to allege use under §2.76 or a statement of use under §2.88 must include, for each class, the required fee, dates of use, and one specimen. The applicant may not file the amendment to allege use or statement of use until the applicant has used the mark on all the goods or services, unless the applicant files a request to divide. See §2.87 for information regarding requests to divide.*

*(c) The Office will issue a single certificate of registration for the mark, unless the applicant files a request to divide. See §2.87 for information regarding requests to divide.*

#### **1403.01 Requirements for Combined or Multiple-Class Application**

Goods and/or services that fall in more than one class may be included in one application, called a “combined” or “multiple-class” application.

A multiple-class application may pertain to only one mark, and to only one register. A single certificate of registration will be issued, unless the application is divided. See TMEP §§1110 *et seq.* regarding division of an application.

A multiple-class application must contain the following:

- (1) The class numbers for which registration is sought, and the goods or services appropriately classified in each class. The classes must be set forth in consecutive numerical order beginning with the lowest number, and the goods or services must be listed in association with their class numbers. Setting the classes and the goods or services out in tabulated form rather than narrative form is desirable because it usually adds clarity.

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

- (2) A filing fee for each class. See TMEP §§810.01 and 1403.05(a).
- (3) The dates of first use and first use in commerce for each class, in an application under §1(a) of the Act. If the dates are the same for all classes, the dates may be stated once, with the statement that the mark was first used on said dates on the goods or services in all the classes. If the dates of use differ for different classes, the appropriate dates for each class must be specified separately. The dates may be set forth in separate clauses, sentences or paragraphs, or in tabular form, whichever will give complete information in the clearest way under the circumstances.
- (4) One specimen supporting use of the mark on goods or services in each class, in an application under §1(a) of the Act.
- (5) Only one drawing may be included, because there may be only one mark per application.

Prior to registration, an intent-to-use applicant must file an allegation of use (*i.e.*, either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d)), that states that the applicant is using the mark in commerce on or in connection with the goods or services; includes dates of use and a filing fee for each class; and includes one specimen evidencing use for each class. See 37 C.F.R. §2.76 and TMEP §§1104 *et seq.* regarding amendments to allege use, and 37 C.F.R. §2.88 and TMEP §§1109 *et seq.* regarding statements of use.

### **1403.02 Amendment of Combined or Multiple-Class Application**

An application under §1 or §44 of the Trademark Act may be amended during prosecution to delete, correct, or add classes, when appropriate.

In a §66(a) application, classes may be deleted, but classes cannot be added, and goods/services cannot be moved to another class. See TMEP §§1401.03(d), 1402.01(c) and 1904.02(b).

#### **1403.02(a) Deletion of Classes**

An applicant may delete a class or classes and prosecute the application only in the remaining class or classes. Normally, the filing fee is not refunded when a class is deleted. 37 C.F.R. §2.209; TMEP §§405.04 and 810.02.

If the applicant designates the classes incorrectly and there are actually no goods in one of the classes designated in a multiple class application, the fee for that class may be refunded.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1403.02(b) Correction of Classification**

In an application under §1 or §44 of the Trademark Act, improper classification can be corrected by switching goods/services by amendment from one to another of the classes originally set forth, or by changing the class designations as long as the number of classes is not increased.

When more than one item of goods or services are listed in a class, the specimen and dates of use given do not necessarily apply to all the items listed. If the item to which the specimen and/or dates pertain is removed from the identification by amendment, the applicant must submit a new specimen and/or dates of use for that class. If the new dates differ from the dates originally set forth, the additional dates must be supported by an affidavit or declaration by the applicant. 37 C.F.R. §2.71(c). See TMEP §903.05 regarding permissible amendment of dates of use.

In a §66(a) application, classes cannot be added, and goods/services cannot be moved to another class. See TMEP §§1401.03(d), 1402.01(c) and 1904.02(b).

### **1403.02(c) Addition of Classes**

In an application under §1 or §44 of the Trademark Act, class(es) may be added if any of the items originally recited are properly classified in class(es) not originally designated. The applicant must pay an additional fee for each new class.

The amount of the fee varies depending whether the amendment adding additional classes is filed through TEAS or on paper. Under 37 C.F.R. §2.6(a)(1)(i), the fee is lower for an amendment to add classes filed through TEAS, either as a preliminary amendment or a response to an examining attorney's Office action. A higher fee is required under 37 C.F.R. §2.6(a)(1)(i) if the applicant files an amendment adding class(es) on paper or authorizes an examining attorney to add class(es) by examiner's amendment.

If dates of use for a class that is added are different from dates previously set forth, the applicant must submit an affidavit or declaration under 37 C.F.R. §2.20 to support the dates. 37 C.F.R. §2.71(c). See TMEP §903.05 regarding permissible amendment of dates of use.

An additional specimen that is not identical to a specimen originally filed must be supported by an affidavit or a declaration attesting to use as of an appropriate date. 37 C.F.R. §2.59; TMEP §904.09.

If an intent-to-use application is amended to add class(es), the applicant must submit, for each added class, the basic application fee *and* fees for either the amendment to allege use or the statement of use, and any extension requests granted in the interim. This applies even if the classes are added after the amendment to allege use or statement of use is filed, or the extension requests are granted.

## CLASSIFICATION AND IDENTIFICATION OF GOODS AND SERVICES

In a §66(a) application, classes cannot be added, and goods/services cannot be moved to another class. See TMEP §§1401.03(d), 1402.01(c) and 1904.02(b).

### **1403.03 Dividing of Combined or Multiple-Class Application**

A delay in registration of one class in a multiple-class application will mean delay for the entire application. In such a situation, upon payment of the applicable fee, the applicant may request the Office to physically divide the application into separate applications. These new applications are assigned new serial numbers and cross-referenced with the original application. The additional separate applications are given the same filing date as the original application.

The following are examples of situations when an applicant may want to have a class or classes divided out into one or more separate applications:

- (1) Registration is refused in less than all the classes;
- (2) A notice of opposition is filed against goods in one class but not against the goods in the other class(es); and
- (3) The applicant in a §1(b) application begins using the mark in commerce on goods or services in less than all the classes.

When a multiple-class application is divided, the application is separated or divided into individual files. See TMEP §§1110 *et seq.* for information about dividing an application.

### **1403.04 Combined or Multiple-Class Marks in *Official Gazette***

The marks in multiple-class applications appear in the *Official Gazette* in a separate section from the marks in single-class applications. Therefore, it is necessary to look in more than one place in the *Official Gazette* to make a complete review of published marks.

### **1403.05 Action After Filing, Multiple Classes**

A refusal to register or a requirement may be made for less than all the classes in an application. Whether it is appropriate to make a refusal or requirement with regard to less than all classes must be considered on a case by case basis. If appropriate, the examining attorney should indicate the class(es) to which the refusal or requirement pertains and that the refusal or requirement does not pertain to the remaining class(es).

If an applicant fails to file a complete response to a refusal or requirement that was expressly limited to certain class(es), the application shall be abandoned only as to those class(es). 37 C.F.R. §2.65(a). See TMEP §718.02(a).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

When an opposition is sustained only as to some of the class(es) in a multiple-class application, the file is returned to the examining attorney. The examining attorney should perform the proper TRAM transaction to ensure issuance of registration for only the proper class(es).

### **1403.05(a) Fees for Action After Filing, Multiple Classes**

In a multiple-class application or registration, a fee for each class must be paid when filing an amendment to allege use, statement of use, or request for extension of time to file a statement of use for applications under §1(b) of the Act; *ex parte* appeal to the Trademark Trial and Appeal Board; affidavit or declaration under §8 or §71 of the Act; affidavit of incontestability under §15 of the Act; application for renewal of a registration, opposition and petition for cancellation of a registration. 15 U.S.C. §§1051, 1058, 1059, 1063, 1064, 1065 and 1141k.

In these situations, when a party submits a fee that does not cover all the classes in the application or registration, the party should state that action is sought only for the number of classes equal to the number of fees submitted, and should specify the classes for which action is being sought. This may avoid an unnecessary inquiry by the Office.

### **1403.05(b) Surrender or Amendment in Multiple-Class Registrations**

In a multiple-class registration, deletion of less than all the goods or services in a single class constitutes an amendment, whereas deletion of an entire class constitutes a surrender of the registration for cancellation as to the class deleted. 37 C.F.R. §2.172; TMEP §1609.03.



# Chapter 1500

## Post-Examination Procedures

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### **1501 Appeal to Trademark Trial and Appeal Board**

- 1501.01 Appealable Matter
- 1501.02 Examining Attorney's Appeal Brief
  - 1501.02(a) Reply Briefs in *Ex Parte* Appeals
- 1501.03 Withdrawal of Refusal or Requirement After Appeal
- 1501.04 Fee for Appeal
- 1501.05 Amendment During Appeal
- 1501.06 Amendment After Decision on Appeal
- 1501.07 Examining Attorney's Request for Reconsideration

### **1502 Publication in Trademark Official Gazette**

- 1502.01 Notification of Errors in *Trademark Official Gazette*

### **1503 Opposition**

- 1503.01 Filing a Notice of Opposition
- 1503.02 Joining Persons in an Opposition
- 1503.03 Time for Opposing
- 1503.04 Extension of Time to Oppose
- 1503.05 Opposition Fee
- 1503.06 Opposition to §66(a) Applications

### **1504 Jurisdiction over Application**

- 1504.01 Jurisdiction of Examining Attorney
- 1504.02 Jurisdiction of Trademark Trial and Appeal Board
- 1504.03 Action By Examining Attorney After Publication
- 1504.04 Restoration of Jurisdiction to Examining Attorney by Director
  - 1504.04(a) Request for Jurisdiction

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

1504.05 Remand to Examining Attorney by Trademark Trial and Appeal Board

1504.05(a) Request for Remand

### **1505 Amendments Filed by Applicants After Publication**

1505.01 Approval of Amendments After Publication

1505.01(a) Amendments to the Identification of Goods or Services

1505.01(b) Amendments to Classification

1505.01(c) Amendments to Drawings

1505.01(d) Amendments to the Dates of Use

1505.01(e) Amendments Adding or Deleting Disclaimers

1505.01(f) Amendment of the Basis

1505.02 Procedures for Processing Amendments Filed by the Applicant After Publication

1505.02(a) Form and Timing of Amendments

1505.02(b) Processing Amendments in Cases Where No Opposition Has Been Filed

1505.02(c) Processing Amendments in Cases Where a Request for Extension of Time to Oppose Has Been Filed or Granted

1505.02(d) Processing Amendments in Cases Where an Opposition Has Been Filed

### **1506 Concurrent Use Registration Proceeding**

### **1507 Interference**

#### **1501 Appeal to Trademark Trial and Appeal Board**

*15 U.S.C. §1070. An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner in charge of the registration of marks upon the payment of the prescribed fee.*

*37 C.F.R. §2.141. Ex parte appeals from the Examiner of Trademarks. Every applicant for the registration of a mark may, upon final refusal by the Examiner of Trademarks, appeal to the Trademark Trial and Appeal Board upon payment of the prescribed fee for each class in the application for which an appeal is taken. An appeal which includes insufficient fees to cover all classes in the application should specify the particular class or classes in which appeal is taken. A second refusal on*

## POST-EXAMINATION PROCEDURES

*the same grounds may be considered as final by the applicant for purpose of appeal.*

An appeal from an examining attorney's action is taken to the Trademark Trial and Appeal Board, not to a court. An appeal is taken by filing a Notice of Appeal and paying the appeal fee within six months of the mailing date of the action from which the appeal is taken. 15 U.S.C. §1070; 37 C.F.R. §2.142(a). See *Trademark Trial and Appeal Board Manual of Procedure* ("TBMP") §1202.03.

The Trademark Act gives applicants a right to appeal to the Trademark Trial and Appeal Board after a *final* action by an examining attorney. 15 U.S.C. §1070. Under 37 C.F.R. §2.141, an applicant may consider a second refusal on the same grounds or a repeated requirement to be final for the purpose of appeal. Appeal from a first refusal or requirement, however, is premature.

The applicant must file the notice of appeal and appeal fee within six months from the mailing date of final refusal. 37 C.F.R. §2.142(a); TBMP §1202.02. If the applicant does not timely file a notice of appeal and appeal fee, the application is abandoned. 15 U.S.C. §1062(b). See 37 C.F.R. §§2.197 and 2.198, and TMEP §§305.02, 305.03 and 306.05 *et seq.* regarding certificate of mailing, certificate of transmission and "Express Mail" procedures to avoid lateness. If the applicant's failure to file a proper notice of appeal was unintentional, the applicant may file a petition to revive under 37 C.F.R. §2.66 (see TMEP §§1714 *et seq.*)

When an applicant files a notice of appeal, Office personnel must refer the notice and application record to the Trademark Trial and Appeal Board. In appropriate circumstances, the Board will remand the application to the examining attorney. See TBMP §§1204 and 1209. Where the Board initiated the remand, the examining attorney must take action upon the remanded issue within 30 days. See 37 C.F.R. §2.142(f)(1).

The applicant must file an appeal brief within 60 days of the date of the appeal, or the Board may dismiss the appeal. 37 C.F.R. §2.142(b)(1). See *In re Live Earth Products Inc.*, 49 USPQ2d 1063 (TTAB 1998). If the appeal is dismissed, the applicant may file a motion with the Board to set aside the dismissal and accept a late-filed brief. If the Board denies the motion, the applicant may file a petition to the Director under 37 C.F.R. §2.146, asking the Director to review the Board's action. The Director will reverse the Board's action only if the Board clearly erred or abused its discretion. An applicant should not file a petition to the Director until it has *first* filed a request/motion to accept the late-filed brief with the Board, and that request/motion has been denied. TBMP §1203.02(a). The applicant cannot file a petition to revive under 37 C.F.R. §2.66 when an appeal is dismissed for failure to file a brief. TMEP §1714.01(f)(ii).

The date of appeal for purposes of calculating the due date of the appeal brief is the date the notice of appeal and filing fee is received by the Office. If the applicant has also filed a request for reconsideration under 37 C.F.R. §2.142, the appeal is

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

considered suspended until the examining attorney acts upon the request for reconsideration, returns the file to the Board, and the Board resets the time for applicant to file its appeal brief. See TBMP §1204.

See 37 C.F.R. §§2.142 and 2.144 and TBMP Chapter 1200 for further information about *ex parte* appeals to the Trademark Trial and Appeal Board.

See 37 C.F.R. §2.145 and TBMP Chapter 900 regarding appeal to a court from the decision of the Trademark Trial and Appeal Board.

### **1501.01           Appealable Matter**

An applicant who wishes to contest a refusal based on a matter of substance (*e.g.*, a matter arising under §§2, 3, 4, 5, 6 and 23 of the Act of 1946, 15 U.S.C. §§1052, 1053, 1054, 1055, 1056 or 1091), should file an appeal to the Trademark Trial and Appeal Board, not a petition to the Director.

If the only issue in dispute is a question regarding the applicant's compliance with a technical provision of the Trademark Act or Trademark Rules of Practice, the applicant may file a petition to the Director rather than an appeal. See 37 C.F.R. §§2.63 and 2.146. See TMEP §1704 and TBMP §1201.05 regarding petitionable matter versus appealable matter.

An examining attorney's requirement that is the subject of a petition decided on the merits by the Director may not subsequently be the subject of an appeal to the Board. 37 C.F.R. §2.63(b).

### **1501.02           Examining Attorney's Appeal Brief**

After the appellant's brief has been filed, the Board will send a notice to the examining attorney. The examining attorney has sixty days from the date of the Board's notice to file a responsive brief with the Board and send a copy to the appellant. 37 C.F.R. §2.142(b). See TBMP §1203.02(b).

The examining attorney's appeal brief should be concise and contain a complete statement of reasons for the refusal or requirement and supporting facts.

Examining attorneys should use the format shown in Appendix A as a model when preparing an appeal brief. The purpose of this format is to promote consistency and to provide content guidelines. The substance of the appeal brief is a matter of individual discretion.

If the applicant submits new evidence with its brief, the examining attorney should object, because the record must be complete prior to appeal. 37 C.F.R. §2.142(d); TMEP §710.01(c). The examining attorney should raise objections to evidence as soon as possible, and continue the objection in his or her brief, or the Board may

## POST-EXAMINATION PROCEDURES

consider the objection to be waived. TBMP §1207.03. See *In re Broyhill Furniture Industries, Inc.*, 60 USPQ2d 1511, 1513 n. 3 (TTAB 2001).

If, during the preparation of the appeal brief, the examining attorney determines that jurisdiction should be restored for further examination (e.g., to make a new refusal, to correct informalities, or to suspend), the examining attorney should submit a request for remand instead of an appeal brief. See TMEP §1504.05(a). If the Board grants the examining attorney's request, the Board will stay further proceedings in connection with the appeal. If the Board denies the request, it will reset the time for submission of the examining attorney's appeal brief.

Either the applicant or the examining attorney can request a remand. A request for remand to introduce additional evidence must include a showing of good cause (which may take the form of a satisfactory explanation as to why the evidence was not filed prior to appeal), and be accompanied by the additional evidence sought to be introduced. See TBMP §1207.02. Absent a request for remand to introduce additional evidence with a showing of good cause, no evidence should be submitted to the Board following a notice of appeal. See TBMP §1207.01.

### **1501.02(a) Reply Briefs in *Ex Parte* Appeals**

The applicant may file a brief in reply to the examining attorney's appeal brief. Reply briefs must be filed within twenty days from the date of mailing of the examining attorney's brief. 37 C.F.R. §2.142(b)(1). It is not appropriate for the examining attorney to file a written response to the reply brief. However, in the oral argument (if the applicant requests an oral argument), the examining attorney should respond to any significant issues raised in the applicant's reply brief.

### **1501.03 Withdrawal of Refusal or Requirement After Appeal**

If, after considering the appellant's brief or reply brief, the examining attorney believes that the requirement or refusal is not tenable, the examining attorney should withdraw the requirement or refusal and approve the application for publication or issue, if it is otherwise in condition for such action. The examining attorney should notify the applicant by telephone that the requirement or refusal is withdrawn, and should make an appropriate note to the file. This may be done at any time before the Board's decision on appeal. It is not necessary to notify the Board that the refusal or requirement has been withdrawn.

If there is more than one ground of refusal and one ground is no longer tenable, that refusal should be withdrawn and the appeal should go forward on the remaining ground(s). The following language is appropriate for informing the appellant of the withdrawal of the refusal or requirement in such a case:

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The examining attorney acknowledges receipt of the applicant's appeal brief. The examining attorney has withdrawn [specify the refusal or requirement].

### **1501.04 Fee for Appeal**

When filing an *ex parte* appeal to the Trademark Trial and Appeal Board from the refusal of the examining attorney to register a mark, the applicant must pay a fee for each class in the application for which the appeal is taken. 37 C.F.R. §2.141.

The fee for at least one class of goods/services must be paid before expiration of the six month statutory filing period, or the application is abandoned. If the fee filed with the appeal is sufficient for at least one class of goods/services but insufficient for all the classes in a multiple class application, the Board will notify the applicant of the defect, and will set a time limit in which the applicant may either pay the additional fee(s), or limit the appeal to the number of classes for which the fee(s) have been paid. See 37 C.F.R. §2.85(e); TBMP §1202.04.

### **1501.05 Amendment During Appeal**

If the applicant files an amendment after filing a timely notice of appeal, the Board must act on the amendment, because jurisdiction over the application is with the Board after a notice of appeal is filed. In appropriate cases, the Board may remand the case to the examining attorney to consider the matter presented in the paper, with appropriate instructions to the examining attorney regarding consideration of the paper and disposition of the case after such consideration. TBMP §1205.

If an application is remanded to the examining attorney to consider an amendment, and the examining attorney determines that the amendment places the application in condition for publication or issue, the examining attorney should notify the applicant by telephone that the amendment has been entered, and that the amendment renders the appeal moot.

### **1501.06 Amendment After Decision on Appeal**

An examining attorney may not take action in an application after the Trademark Trial and Appeal Board has rendered a decision on appeal, because the examining attorney does not have jurisdiction of the application. See *In re U.S. Catheter & Instrument Corp.*, 158 USPQ 54 (TTAB 1968). After a decision on appeal, the applicant may petition the Director under 37 C.F.R. §2.142(g) to reopen prosecution of the application. If the petition is granted, jurisdiction is restored to the examining attorney to take the specified action.

A petition to reopen prosecution of the application could be granted if the appeal involved the applicant's compliance with a requirement rather than a refusal based on the nature of the mark. For example, the Director may reopen prosecution to

## POST-EXAMINATION PROCEDURES

permit the applicant to comply with a requirement for a new drawing, if this would place the application in condition for publication of the mark without further examination. See *In re Hickory Mfg. Co.*, 183 USPQ 789 (Comm'r Pats. 1974). However, the Director will deny a petition to reopen prosecution if granting the petition would require further examination (e.g., to consider a claim of acquired distinctiveness under 15 U.S.C. §1052(f) or an amendment to the Supplemental Register). See *In re Petite Suites, Inc.*, 21 USPQ2d 1708 (Comm'r Pats. 1991); *In re Vycom Electronics Ltd.*, 21 USPQ2d 1799 (Comm'r Pats. 1986); *In re Mack Trucks, Inc.*, 189 USPQ 642 (Comm'r Pats. 1976).

### **1501.07 Examining Attorney's Request for Reconsideration**

In *In re Ferrero S.p.A.*, 22 USPQ2d 1800 (TTAB 1992), *recon. denied*, 24 USPQ2d 1061 (TTAB 1992), an augmented panel of the Trademark Trial and Appeal Board expressly overruled prior precedent and held that an examining attorney may request reconsideration of a Board decision reversing the examining attorney in an *ex parte* appeal.

To request reconsideration, the examining attorney must prepare a request and a supporting brief and submit the request to the managing attorney for concurrence in the decision to seek reconsideration. If the managing attorney concurs, the managing attorney will submit the request for reconsideration and brief to the Administrator for Trademark Policy and Procedure for approval.

If the Administrator approves the request, the examining attorney will file the request with the Board and send a copy to the applicant. The Board will set an appropriate time for the applicant to respond to the request. The examining attorney may not file a reply brief in response to the applicant's brief.

### **1502 Publication in Trademark Official Gazette**

After examination of an application is completed and the examining attorney determines that the mark is entitled to registration on the Principal Register, the mark is published in the *Official Gazette* of the United States Patent and Trademark Office for opposition. 15 U.S.C. §1062; 37 C.F.R. §2.80. Any notice of opposition must be filed within thirty days after the date of publication or within an extension of time granted by the Trademark Trial and Appeal Board for filing an opposition. 15 U.S.C. §1063; 37 C.F.R. §2.101(c); TMEP §1503.03. See 37 C.F.R. §§2.197 and 2.198 and TMEP §§305.02, 305.03 and 306.05 *et seq.* regarding certificate of mailing, certificate of transmission and "Express Mail" procedures to avoid lateness.

Marks that are found to be registrable on the Supplemental Register are registered when printed in the *Official Gazette*. Marks registered on the Supplemental Register cannot be opposed, but are subject to cancellation under 15 U.S.C. §1064. 15 U.S.C. §1094.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

In addition, marks registered on the Principal Register under the intent-to-use provisions of §1(d) of the Act are printed in the *Official Gazette* on the date of issuance of the registration. These marks were previously published for opposition, and are not subject to opposition again. See TMEP §1105 regarding the publication of intent-to-use applications for opposition.

### **1502.01 Notification of Errors in Trademark Official Gazette**

To correct a clerical error in the publication of a mark in the *Trademark Official Gazette*, the applicant or applicant's attorney must file a written request. This request should include the applicant's or attorney's telephone number and e-mail address, and should be directed to the Photocomposition Coordinators in the Publication and Issue Section of the Office. The request should be filed within one week after the date of publication in the *Official Gazette*.

The Photocomposition Coordinators can only correct errors that are purely clerical (e.g., a typographical error or omission, drawing printed upside down, or incorrectly stated data). The Photocomposition Coordinator will review the applicant's request and verify the existence of the clerical error, determine whether the error can be corrected without jurisdiction being restored to the examining attorney or republication being required, and coordinate the appropriate correction procedure.

### **1503 Opposition**

#### **1503.01 Filing a Notice of Opposition**

Any person who believes that he or she would be damaged by the registration of a mark on the Principal Register may oppose registration by filing a notice of opposition with the Trademark Trial and Appeal Board, and paying the required fee within thirty days after the date of publication or within an extension period granted by the Board for filing an opposition. See 15 U.S.C. §1063; 37 C.F.R. §§2.101 through 2.107; TBMP §§303 *et seq.*

The notice of opposition must include a concise statement of the reasons for the opposer's belief that the opposer would be damaged by the registration of the opposed mark, and must state the grounds for opposition. 37 C.F.R. §2.104(a); TBMP §§309.01 *et seq.*

A notice of opposition to an application based on §1 of §44 of the Trademark Act may be filed either on paper or through the Electronic System for Trademark Trials and Appeals ("ESTTA") at <http://estta.uspto.gov/>. 37 C.F.R. §2.101(b)(1). A notice of opposition to an application based on §66(a) of the Act *must* be filed through ESTTA. 37 C.F.R. §2.101(b)(2). See *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019 (TTAB 2005).

A notice of opposition does not have to be verified, and it may be signed by either the opposer or the opposer's attorney. 37 C.F.R. §2.101(b); TBMP §309.02(b).



## POST-EXAMINATION PROCEDURES

### 1503.02 Joining Persons in an Opposition

Two or more persons may join in an opposition. TBMP §303.06. Related companies are separate persons for the purpose of filing an opposition.

### 1503.03 Time for Opposing

An opposition must be filed within thirty days after the date of publication in the *Official Gazette*, or within an extension period granted by the Board. 15 U.S.C. §1063; 37 C.F.R. §2.101(c); TBMP §§306 *et seq.* The time within which to file an opposition is set by statute and may not be extended or waived. *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477 (Comm'r Pats. 1994); *In re Cooper*, 209 USPQ 670 (Comm'r Pats. 1980).

See TBMP §216 regarding the handling of a registration that is issued, inadvertently, after the timely filing of a notice of opposition.

### 1503.04 Extension of Time to Oppose

Requests for extensions of time to oppose are handled by the Trademark Trial and Appeal Board. See TBMP Chapter 200.

A written request for an extension of time must be filed within thirty days after the date of publication in the *Official Gazette*, or within an extension period granted by the Board. 15 U.S.C. §1063; 37 C.F.R. §2.102(c); TBMP §§202 *et seq.* The time within which to file a request for extension of time to oppose is set by statute and may not be extended or waived. *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477 (Comm'r Pats. 1994); *In re Cooper*, 209 USPQ 670 (Comm'r Pats. 1980).

The request for extension of time to oppose should specify the period of extension desired, and be addressed to the Trademark Trial and Appeal Board. 37 C.F.R. §2.102(c); TBMP §203.01.

No more than three requests to extend the time for filing an opposition may be filed, as follows:

- (1) A first request of thirty days will be granted on request, without a showing of cause. Alternatively, a first request of ninety days will be granted upon a showing of good cause. 37 C.F.R. §2.102(c)(1).
- (2) If the first request was for thirty days, a second request for sixty days will be granted upon a showing of good cause. 37 C.F.R. §2.102(c)(2).
- (3) After receiving extensions totaling ninety days, a final request for sixty days will be granted with the consent of the applicant or upon a showing of extraordinary circumstances. 37 C.F.R. §2.102(c)(3).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The Board will not grant an extension of time to oppose aggregating more than 180 days from the date of publication. 37 C.F.R. §2.102(c).

The request for extension of time to oppose must be signed by either the potential opposer or the potential opposer's attorney. TBMP §203.03.

A request for extension of time to oppose an application based on §1 or §44 of the Trademark Act may be filed either on paper or through ESTTA, at <http://estta.uspto.gov/>. 37 C.F.R. §2.102(a)(1). A request for extension of time to oppose a §66(a) application *must* be filed through ESTTA. 37 C.F.R. §2.102(a)(2). See *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019 (TTAB 2005).

An extension of time to oppose is a personal privilege, and the right to oppose will be granted only to the person who requested the extension of time. TBMP §303.05(a). Therefore, great care should be taken to ensure that an extension request clearly and accurately identifies the potential opposer. See 37 C.F.R. §2.102(b) and TBMP §206.03 regarding the misidentification of the name of a party filing an opposition or extension request, and TBMP §§206.02 and 303.05(b) regarding notices of opposition and extension requests filed by persons who are in privity by reason of having the same right or interest, such as related companies under 15 U.S.C. §1055.

See TBMP §216 regarding the handling of a registration that is issued, inadvertently, from an application that was the subject of an unexpired extension of time to oppose on the date of registration.

### **1503.05            Opposition Fee**

The opposer must pay a fee for each international class in the application that is being opposed. 37 C.F.R. §2.6; TBMP §308.

When two or more persons are joined in an opposition, a fee must be paid by each person for each class. See TBMP §303.06 regarding joining persons in an opposition.

The opposition must be accompanied by the required fee for each party joined as opposer for each class in the application for which registration is opposed. 37 C.F.R. §§2.101(d)(1) and (2).

### **1503.06            Opposition to §66(a) Applications**

Section 68(a)(2) of the Trademark Act, 15 U.S.C. §1141h(a)(2), provides that a request for extension of protection is subject to opposition under §13 of the Trademark Act. The United States Patent and Trademark Office ("USPTO") must notify the International Bureau of the World Intellectual Property Organization ("IB") within 18 months of the date the IB sends the request for extension of protection to

## POST-EXAMINATION PROCEDURES

the USPTO of: (1) a notification of refusal based on the filing of an opposition; or (2) a notification of the possibility that an opposition may be filed after expiration of the 18-month period. See TMEP §§1904.03 *et seq.* and 1904.04.

An opposition to a §66(a) application, or a request for extension of time to oppose a §66(a) application, must be filed through ESTTA. 37 C.F.R. §§2.101(b)(2) and §2.102(a)(2). See *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019 (TTAB 2005).

Once filed, an opposition to a §66(a) application may not be amended to add to the grounds for opposition or to add to the goods or services opposed. 37 C.F.R. §2.107(b).

### **1504 Jurisdiction over Application**

#### **1504.01 Jurisdiction of Examining Attorney**

As a general rule, until publication of the mark in the *Official Gazette*, the examining attorney has jurisdiction over the application and can issue a refusal or a requirement without the approval of the Director. In addition, for applications under §1(b) of the Act, the examining attorney has jurisdiction after issuance of the notice of allowance under §13(b) of the Trademark Act, 15 U.S.C. §1063(b). 37 C.F.R. §2.84(a).

See TMEP §1504.03 regarding action by the examining attorney after publication, and TMEP §1107 regarding amendment of a §1(b) application during the period between issuance of a notice of allowance and filing of a statement of use.

#### **1504.02 Jurisdiction of Trademark Trial and Appeal Board**

The Trademark Trial and Appeal Board has jurisdiction over an application upon the filing of the notice of appeal. The Board may, in response to an examining attorney's request or on its own initiative, suspend the appeal and remand the case to the examining attorney. If an examining attorney wants to issue a new refusal or requirement during an appeal, the examining attorney must file a "Request for Remand" with the Board. 37 C.F.R. §2.142(f)(6). See TBMP §§1209.01 and 1209.02; TMEP §1504.05(a).

The Board also has jurisdiction over any application in which a notice of opposition has been filed. The Board will approve or disapprove any amendments proposed during an opposition proceeding. See 37 C.F.R. §2.133; TMEP §1505.02(d); TBMP §§514 *et seq.*

In an application under §1 or §44 of the Act, if an examining attorney wants to issue a new refusal or requirement during an opposition, the examining attorney must file a "Request for Remand" with the Board. In a §66(a) application, the examining

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

attorney may not request a remand during an opposition. 37 C.F.R. §2.130; TMEP §1504.05(a).

A request for an extension of time to file an opposition does *not* vest jurisdiction in the Board. In this situation, any request by the examining attorney for jurisdiction should be addressed to the Director. See TMEP §§1504.03 and 1504.04(a).

### **1504.03 Action By Examining Attorney After Publication**

If it is found necessary, *e.g.*, through internal quality review by the Office, for an examining attorney to refuse registration or to make a requirement after a mark has been published for opposition, jurisdiction over the application must be restored to the examining attorney.

With the exception of applications that are the subject of *inter partes* proceedings before the Board (see TMEP §1504.05(a)), the examining attorney can telephone an applicant and issue an examiner's amendment without restoration of jurisdiction. However, if the examining attorney issues an Office action, even if merely asking for additional information, the examining attorney must request jurisdiction, because the request for additional information is a "requirement."

If it is necessary to issue an Office action after publication, the examining attorney must check the status of the application to determine whether the Board has received a notice of opposition. If the Board has not received a notice of opposition, the examining attorney should prepare a request to restore jurisdiction, directed to the Director. See TMEP §1504.04(a). If a notice of opposition has been filed, jurisdiction is with the Board, and the examining attorney should file a request for remand, directed to the Board. See TMEP §1504.05(a).

If a request for an extension of time to file an opposition has been filed, the Board does not have jurisdiction, so the examining attorney must file a request for jurisdiction addressed to the Director. It is not necessary for the examining attorney to notify the Board that he or she proposes to take action on the application.

See TMEP §§1505 *et seq.* regarding amendments proposed by applicants after publication.

### **1504.04 Restoration of Jurisdiction to Examining Attorney by Director**

If it is necessary to refuse registration or to make a requirement after publication of the mark for opposition and prior to the filing of a notice of opposition (see TMEP §1504.02), the examining attorney must request that the Director restore jurisdiction so that the examining attorney may take the specified action on the application. As noted in TMEP §1504.01, however, the examining attorney does not have to request jurisdiction to act in a §1(b) application after issuance of the notice of allowance.

## POST-EXAMINATION PROCEDURES

Normally, the Director will restore jurisdiction to the examining attorney only if there has been a clear error.

After actual publication of a mark, a restoration of jurisdiction to the examining attorney is possible only in the case of an application for registration on the Principal Register. A mark found registrable on the Supplemental Register is not published for opposition but is published only when it has registered.

The provisions with respect to requesting jurisdiction over published §66(a) applications are similar to those for applications under §§1(a) and 44 of the Trademark Act. 37 C.F.R. §2.84. However, when deciding whether to grant requests for jurisdiction of §66(a) applications, the Director must consider the time limits for notifying the IB of a refusal of a §66(a) application, set forth in Article 5(2) of the Madrid Protocol and §68(c) of the Trademark Act. See TMEP §1904.03(a).

### **1504.04(a) Request for Jurisdiction**

The examining attorney's request for jurisdiction should be in the form of a memorandum to the Director, accompanied by the Office action that the examining attorney proposes to send to the applicant. The request should be signed by the examining attorney, the managing attorney, and the Administrator for Trademark Policy and Procedure.

In the Office action, the examining attorney should apologize for the untimeliness of the action because, at this point, except for possible opposition issues, the applicant is expecting issuance of a registration or notice of allowance. The action should provide a detailed explanation of the basis for the refusal or requirement, citing appropriate case law, even when addressing basic and well-established propositions.

### **1504.05 Remand to Examining Attorney by Trademark Trial and Appeal Board**

The Trademark Trial and Appeal Board, on its own initiative or in response to a request, may remand an application to the examining attorney for consideration of specific facts. See TBMP §1209 regarding remand during an appeal, and TBMP §515 regarding remand during an *inter partes* proceeding. A request for remand by the examining attorney to submit additional evidence must include a showing of good cause (which may take the form of a satisfactory explanation as to why the evidence was not filed prior to appeal), and be accompanied by the additional evidence sought to be introduced. See TBMP §1207.02. Absent a request for remand for additional evidence with a showing of good cause, no evidence should be submitted to the Board following a notice of appeal. See TBMP §1207.01.

On remand, the examining attorney may address only those issues for which the application was remanded. Issues other than those for which the application was

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

remanded may be considered only if the examining attorney requests and is granted an expanded remand. TBMP §1209.02.

The following are examples of circumstances when the Board may remand an application to the examining attorney during an *ex parte* appeal:

- (1) When evidence that the applicant's attorney or the examining attorney wants to include in the record was not previously available (e.g., a recent article, newly issued registration, or recent decision);
- (2) When a new attorney for the applicant, or a new examining attorney, wants to supplement the record made by his or her predecessor; or
- (3) When the applicant and the examining attorney agree to a remand.

See TBMP §1207.02.

The examining attorney should take action on the application within thirty days of the Board's remand order.

### **1504.05(a) Request for Remand**

If it is found necessary to issue a new requirement or new ground for refusal of registration during an *ex parte* appeal, the examining attorney must request the Board to remand the application so that the examining attorney may take the specified action. 37 C.F.R. §2.142(f)(6); TBMP §1209.02.

In an application under §1 or §44 of the Trademark Act, if it is found necessary to refuse registration or to make a requirement during an *inter partes* proceeding before the Trademark Trial and Appeal Board, the examining attorney must request the Board to remand the application so that the examining attorney may take the specified action. In a §66(a) application, the examining attorney may not request a remand during an *inter partes* proceeding. 37 C.F.R. §2.130.

A request for remand should succinctly explain the specific reasons why remand is requested. That is, the request should be a brief statement of the reason for the request and an explanation of the action the examining attorney intends to take.

### **1505 Amendments Filed by Applicants After Publication**

Applicants will sometimes submit amendments after publication. The Office has established the following procedures and policies for the disposition of such amendments. An "amendment after publication" includes any amendment filed after the Office is unable to delete the mark from its scheduled publication in the *Official Gazette*. The Office is generally unable to delete a mark unless the amendment is filed at least twenty days before the scheduled publication date.

## POST-EXAMINATION PROCEDURES

### **1505.01 Approval of Amendments After Publication**

#### **1505.01(a) Amendments to the Identification of Goods or Services**

If an applicant proposes to amend the identification of goods or services after publication by *restricting* or *deleting* items in the existing identification, and the amendment is otherwise proper, the Office will approve the amendment, and the mark will not be republished. See TMEP §1107 regarding amendment of a §1(b) application during the period between issuance of a notice of allowance and filing of a statement of use.

Amendments to an identification to add goods or services or to broaden its scope are not permitted at any time. See 37 C.F.R. §2.71(a); TMEP §§1402.06 and 1402.07 *et seq.*

#### **1505.01(b) Amendments to Classification**

In an application under §1 or §44, if the applicant proposes to amend the classification after publication, and the amendment is consistent with the current version of the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks*, the Office will approve the amendment. Republication is not required.

The international classification of goods/services in a §66(a) application cannot be changed from the classification given to the goods/services by the IB. See TMEP §1401.03(d).

#### **1505.01(c) Amendments to Drawings**

In an application under §1 or §44, if the applicant proposes to amend the mark after publication, the amendment is not a material alteration of the mark, and the specimen of record or foreign registration (if applicable) supports use of the mark as amended, the Office will approve the amendment and will not republish the mark. If the applicant proposes to amend the mark and the amendment represents a material alteration to the mark, the Office will not approve the amendment. See 37 C.F.R. §2.72; TMEP §§807.13 and 807.14 *et seq.*

The mark in a §66(a) application cannot be amended. TMEP §807.13(b).

#### **1505.01(d) Amendments to the Dates of Use**

If, in an application under §1(a), the applicant proposes to amend the dates of use to adopt a date of use that is after the filing date of the application, the Office will not approve the amendment. See 37 C.F.R. §2.71(c)(1). If, in an application under §1(a), the applicant proposes to amend the dates of use to adopt a date of use that is later than the date originally stated, but before the filing date, the Office will approve the amendment and will republish the mark to provide notice to parties who

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

may have commenced use of a similar mark during the intervening period. If the applicant proposes to amend the dates of use to adopt a date that is before the date originally stated, the Office will approve the amendment and will not republish the mark.

See TMEP §903.05 for more information about amending the dates of use in a pending application, and TMEP §1609.07 regarding amendment of the dates of use after registration.

### **1505.01(e) Amendments Adding or Deleting Disclaimers**

If the applicant proposes to amend the application after publication to insert a disclaimer, and the amendment is otherwise proper, the Office will approve the amendment and will not republish the mark. Likewise, if the Office requests the insertion of a disclaimer after publication and the applicant agrees to the disclaimer, the Office will enter the disclaimer and will not republish the mark.

If the applicant proposes to amend the application to delete a disclaimer after publication and before issuance of the notice of allowance, the applicant must petition the Director to restore jurisdiction of the application to the examining attorney to consider the amendment. If a notice of allowance has issued, however, the examining attorney has jurisdiction to consider the amendment, and a petition to the Director to restore jurisdiction is unnecessary. See 37 C.F.R. §2.84(a). If the examining attorney eventually approves the amendment, the Office will republish the mark. Republication is always required when a disclaimer is deleted after publication (e.g., if printed through a clerical error or originally required by the examining attorney and later determined to be unnecessary). See TMEP §1107 regarding processing an amendment to a §1(b) application filed between the issuance of a notice of allowance and the submission of a statement of use.

### **1505.01(f) Amendment of the Basis**

In an application that is not the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board, if an applicant wants to add or substitute a basis after publication, the applicant must first petition the Director to allow the examining attorney to consider the amendment. If the Director grants the petition, and the examining attorney accepts the added or substituted basis, the mark must be republished. 37 C.F.R. §2.35(b)(2); TMEP §806.03(j). See TMEP §§806.03 *et seq.* regarding amendment of the basis.

In a §66(a) application, the applicant cannot change the basis, unless the applicant meets the requirements for transformation under §70(c) of the Act, 15 U.S.C. §1141j(c), and 37 C.F.R. §7.31. 37 C.F.R. §2.35(a). See TMEP §1904.09 regarding transformation.



## POST-EXAMINATION PROCEDURES

See 37 C.F.R. §2.133(a), TMEP §1505.02(d), and TBMP §514 regarding the amendment of the basis of an application that is the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board. No petition is necessary in this situation.

In a multi-basis application, the applicant may delete a basis at any time prior to registration. 37 C.F.R. §2.35(b)(1). See TMEP §806.04(a) regarding the deletion of a §1(b) basis after publication or issuance of the notice of allowance.

### **1505.02 Procedures for Processing Amendments Filed by the Applicant After Publication**

#### **1505.02(a) Form and Timing of Amendments**

All amendments after publication must be submitted in writing. Unless a notice of opposition has been filed, correspondence that is filed after publication but before issuance of a registration or notice of allowance should be directed to the examining attorney. If republication or issuance of an Office action is not necessary, an application under §1(a), §44, or §66(a) that is not the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board may be amended before the certificate of registration is printed.

If the amendment would require republication or issuance of an Office action, an applicant who wants to amend an application must file a petition to the Director to restore jurisdiction of the application to the examining attorney for consideration of the amendment and further examination. 37 C.F.R. §2.84(b). The petition should be directed to the Office of the Commissioner for Trademarks. See TMEP §1504.04 regarding requests for jurisdiction in §66(a) applications.

See TMEP §§1107 and 1107.01 regarding amendments to a §1(b) application filed between the issuance of a notice of allowance and the submission of a statement of use, and TMEP §1609 regarding amendment of a registration under §7(e) of the Trademark Act, 15 U.S.C. §1057(e).

Any amendment filed during the pendency of a Board *inter partes* proceeding should be filed with the Board. See 37 C.F.R. 2.133.

#### **1505.02(b) Processing Amendments in Cases Where No Opposition Has Been Filed**

Except for amendments to allege use filed in connection with §1(b) applications (see TMEP §1104.04 regarding timely amendments to allege use located after publication, and TMEP §1104.03(c) regarding amendments to allege use filed during the blackout period), Office personnel will route amendments filed after publication to the examining attorney.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If the examining attorney approves the amendment and republication is required, the examining attorney should send the applicant a letter advising the applicant that the amendment will be entered, that the mark will be republished, and that the applicant will receive a notice of the new publication date.

If the examining attorney determines that the amendment cannot be approved, the examining attorney should send the applicant a letter notifying the applicant that the amendment cannot be approved. The examining attorney will explain the reason(s) why the amendment cannot be approved and advise the applicant that the applicant's recourse is to file a petition to the Director requesting that jurisdiction be restored to the examining attorney to consider the merits of the amendment. The examining attorney will then return the application to processing for issue without entry of the amendment.

### **1505.02(c) Processing Amendments in Cases Where a Request for Extension of Time to Oppose Has Been Filed or Granted**

An amendment of an application that is under an extension of time to file an opposition should be processed in accordance with the procedures set forth in TMEP §1505.02(b). The Director retains jurisdiction of such an application until an opposition is actually filed.

It is not necessary for the examining attorney to notify the Trademark Trial and Appeal Board of the action taken on the amendment.

The Board will not suspend the potential opposer's time to file a notice of opposition in this situation. See notice at 68 Fed. Reg. 55748, 55760 (Sept. 26, 2003).

### **1505.02(d) Processing Amendments in Cases Where an Opposition Has Been Filed**

If the applicant files an amendment after a notice of opposition has been filed, the Trademark Trial and Appeal Board will act on the amendment under 37 C.F.R. §2.133. The Board has jurisdiction in any application once an opposition has been filed. See TBMP §§514 *et seq.* for further information about amendment of an application during an opposition.

### **1506 Concurrent Use Registration Proceeding**

A concurrent use registration proceeding is an *inter partes* proceeding in which the Trademark Trial and Appeal Board determines whether one or more applications is entitled to a concurrent registration, that is, a registration with conditions and limitations, fixed by the Board, as to the mode or place of use of the applicant's mark or the goods/services on or in connection with which the mark is used. The Board conducts these proceedings after the mark has been published, and the Board

## POST-EXAMINATION PROCEDURES

determines whether or not concurrent use registrations should issue. See TBMP Chapter 1100.

See TMEP §§1207.04 *et seq.* regarding the procedure to be followed by examining attorneys in relation to concurrent use.

### **1507 Interference**

An interference is a proceeding in which the Trademark Trial and Appeal Board determines which, if any, of the owners of conflicting applications (or of one or more applications and one or more registrations that are in conflict) is entitled to registration. See 15 U.S.C. §§1066 and 1068.

An interference can be declared only upon petition to the Director. However, the Director will grant such a petition only if the petitioner can show extraordinary circumstances that would result in a party being unduly prejudiced in the absence of an interference. 37 C.F.R. §2.91(a). Interferences are generally limited to situations where a party would otherwise be required to engage in successive or a series of opposition or cancellation proceedings, and where the issues are substantially the same. See *In re Family Inns of America, Inc.*, 180 USPQ 332 (Comm'r Pats. 1974). Interference normally is considered to be a duplication of remedies for situations that can ordinarily be handled expeditiously by opposition or cancellation proceedings.

The following matters are not subject to interference: (1) registrations on the Supplemental Register; (2) applications for registration on the Supplemental Register; (3) registrations under the Act of 1920; and (4) registrations of marks that have become incontestable. 37 C.F.R. §2.91(b).

See TMEP §§1208.03 *et seq.* and TBMP Chapter 1000 for more information about interferences.

# Chapter 1600

## Registration and Post Registration Procedures

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### **1601 Types of Registrations**

1601.01 Registrations Now Being Issued

1601.01(a) Certificate of Registration

1601.01(b) Duplicate Certificate of Registration

1601.01(c) Registered Extension of Protection of International Registration to the United States

1601.02 Repeal of Prior Acts

1601.03 Additional Registration under Act of 1946

1601.04 1881 and 1905 Act Registrations

1601.05 1920 Act Registrations

1601.06 Registrations Issued Under Prior Classification Systems

1601.07 Form of Copies of Registrations

### **1602 Duration and Maintenance of Registrations**

1602.01 Act of 1946

1602.02 Acts of 1881 and 1905

1602.03 Act of 1920

1602.04 Trademark Law Treaty Implementation Act Changes

### **1603 Bringing Prior Act Registrations Under 1946 Act, §12(c)**

1603.01 Notification and Printing of Mark in *Official Gazette*

1603.02 Cancellation and Incontestability

1603.03 Affidavits of Use in Commerce Required

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1604 Affidavit of Use or Excusable Nonuse of Mark in Commerce under §8**

- 1604.01 Registrations to Which §8 Affidavit Pertains
- 1604.02 Notice of When Affidavit Is Due
- 1604.03 Form for Filing §8 Affidavit
- 1604.04 Time for Filing §8 Affidavit
  - 1604.04(a) Premature Filing of §8 Affidavit
  - 1604.04(b) Registrations in Twenty-Year Terms
- 1604.05 Requirements for §8 Affidavit or Declaration of Use or Excusable Nonuse
- 1604.06 Fees for §8 Affidavit
  - 1604.06(a) Filing Fee for Affidavit or Declaration
  - 1604.06(b) Grace Period Surcharge and Deficiency Surcharge
  - 1604.06(c) Processing Affidavit or Declaration Filed With Insufficient Fees
- 1604.07 Ownership, and Who May File §8 Affidavit
  - 1604.07(a) Affidavit or Declaration Must be Filed by Owner
  - 1604.07(b) Establishing Ownership
  - 1604.07(c) Acceptance Notice Issued in Name of Owner of Record
  - 1604.07(d) Changes of Legal Entity
  - 1604.07(e) Changes of Name
  - 1604.07(f) Correction of Mistake in Setting Forth the Name of the Owner
- 1604.08 Execution of Affidavit or Declaration
  - 1604.08(a) Persons Who May Sign Affidavit or Declaration
  - 1604.08(b) Date of Execution of Affidavit or Declaration
  - 1604.08(c) Signature of Electronically Transmitted Affidavit or Declaration
  - 1604.08(d) Form and Wording of Verification
- 1604.09 Goods and/or Services Set Forth in §8 Affidavit or Declaration
  - 1604.09(a) Goods and/or Services Must be Specified or Expressly Incorporated by Reference
  - 1604.09(b) Deletion of Goods and/or Services

## REGISTRATION AND POST REGISTRATION PROCEDURES

- 1604.09(c) Failure to List All Goods and/or Services Recited in Registration
- 1604.09(d) New Goods and/or Services Cannot be Added
- 1604.10 Use in Commerce
- 1604.11 "Excusable Nonuse" of Mark
- 1604.12 Specimen Showing Current Use of Mark in Commerce
  - 1604.12(a) Specimen for Each Class Required
  - 1604.12(b) Specimens in Electronically Filed Affidavits
  - 1604.12(c) Substitute Specimens
- 1604.13 Differences in the Mark As Used on the Specimen and the Mark as Registered
  - 1604.13(a) Possible Amendment of Mark in Registration
- 1604.14 Designation of Domestic Representative by Foreign Owner
- 1604.15 Office Actions and Notices Regarding Affidavit
- 1604.16 Response to Office Action
- 1604.17 Correction of Deficiencies in §8 Affidavit
  - 1604.17(a) Correcting Deficiencies in Affidavits or Declarations Timely Filed Within the Periods Set Forth in §§8(a) and 8(b) of the Act
  - 1604.17(b) Correcting Deficiencies in Affidavits or Declarations Filed During the Grace Period
  - 1604.17(c) Defects That Cannot be Cured After Expiration of the Grace Period
- 1604.18 Petition Under 37 C.F.R. §2.146
  - 1604.18(a) Response to Examiner's Refusal Required Before Petition
  - 1604.18(b) Decision on Petition is Final Action of the Office
  - 1604.18(c) Request for Reconsideration of Denial of Petition
  - 1604.18(d) Appeal to Federal Court
- 1604.19 Section 8 Affidavit or Declaration of Use or Excusable Nonuse Combined with Renewal Application

### **1605 Affidavit of Incontestability Under §15**

- 1605.01 Registrations to Which §15 Affidavit Pertains
- 1605.02 Form for Filing Affidavit of Incontestability

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- 1605.03 Time for Filing Affidavit of Incontestability
- 1605.04 Requirements for Affidavit or Declaration of Incontestability
- 1605.05 Combining §15 Affidavit With §8 Affidavit
- 1605.06 Section 14 Limitation is Independent of §15 Affidavit

### **1606 Renewal of Registration Under Trademark Act §9**

- 1606.01 Which Registrations Must be Renewed Under §9
  - 1606.01(a) Registrations Based on Applications Under §1 or §44 Must Be Renewed Under §9
  - 1606.01(b) Section 9 Does Not Apply to Extensions of Protection of International Registrations to the United States
  - 1606.01(c) Renewal of Registrations Issued Under Prior U.S. Trademark Acts Must Be Renewed Under §9
- 1606.02 Requirements for Renewal Under §9
- 1606.03 Time for Filing §9 Renewal Application
  - 1606.03(a) Premature Filing of §9 Renewal Application
- 1606.04 Form for Filing §9 Renewal Application
- 1606.05 Fees for §9 Renewal Applications
  - 1606.05(a) Fee for Filing Application for Renewal Under §9
  - 1606.05(b) Grace Period Surcharge and Deficiency Surcharge
  - 1606.05(c) Processing §9 Renewal Application Filed With Insufficient Fees
- 1606.06 Ownership, and Who May File §9 Renewal Application
- 1606.07 Execution of §9 Renewal Application
- 1606.08 Goods and/or Services Set Forth in §9 Renewal Application
  - 1606.08(a) Listing of Goods and/or Services Required Only for Partial Renewal
  - 1606.08(b) No Goods or Services Listed
  - 1606.08(c) Some Goods and/or Services Listed
  - 1606.08(d) Goods and/or Services Not Listed in Registration May Not Be Listed in Renewal Application
- 1606.09 Affidavit of Use in Commerce or Excusable Nonuse Not Required

## **REGISTRATION AND POST REGISTRATION PROCEDURES**

- 1606.10 Designation of Domestic Representative by Foreign Applicant for Renewal Under §9
- 1606.11 Office Actions and Notices Regarding §9 Renewal Application
- 1606.12 Response to Office Action
- 1606.13 Correction of Deficiencies in §9 Renewal Applications
  - 1606.13(a) Correcting Deficiencies in §9 Renewal Applications Filed Within the Year Before the Expiration Date of the Registration
  - 1606.13(b) Correcting Deficiencies in Renewal Applications Filed During the Grace Period
  - 1606.13(c) Late Filing Cannot be Cured
- 1606.14 Petition Under 37 C.F.R. §2.146
  - 1606.14(a) Response to Examiner's Refusal Required Before Petition
  - 1606.14(b) Decision on Petition is Final Action of the Office
  - 1606.14(c) Request for Reconsideration of Denial of Petition
  - 1606.14(d) Appeal to Federal Court
- 1606.15 Section 9 Renewal Application Combined with Affidavit or Declaration of Use or Excusable Nonuse

### **1607 Cancellation of Registrations Under §§14 and 37 of the Trademark Act**

### **1608 Surrender of Registration for Cancellation**

### **1609 Amendment and Correction of Registrations**

- 1609.01 Amendment of Registration - In General
  - 1609.01(a) Registered Extension of Protection Cannot be Amended Under §7
  - 1609.01(b) Amendment of Registration Resulting From §1 or §44 Application
- 1609.02 Amendment of Mark
  - 1609.02(a) Determining What Constitutes Material Alteration of Mark
  - 1609.02(b) New Drawing Required
  - 1609.02(c) Supporting Specimen and Declaration
  - 1609.02(d) Amendment of Black and White Drawing of Mark for Which Color is Claimed to Substitute Color Drawing



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- 1609.03 Amendment of Identification of Goods or Services
- 1609.04 Amendment of Classification
- 1609.05 Disclaimer of Mark
- 1609.06 Territorial Restrictions
- 1609.07 Dates of Use
- 1609.08 Effect of Amendment of Registration on Limitation of Grounds for Cancellation of a Registration
- 1609.09 Amendment From Supplemental to Principal Register Not Permitted
- 1609.10 Correction of Mistake in Registration
  - 1609.10(a) Correction of Office Error
  - 1609.10(b) Correction of Registrant's Error
- 1609.11 Change of Owner's Address Can Be Filed Through TEAS

### **1610 Court Orders Concerning Registrations**

### **1611 Updating Automated Records to Show the Status of Registrations**

### **1612 Powers of Attorney and Designations of Domestic Representative Filed After Registration**

### **1613 Affidavit of Use in Commerce or Excusable Nonuse Under §71 of the Trademark Act**

### **1614 Renewal of Registered Extension of Protection**

### **1615 Division of Registrations**

- 1615.01 Division of Registration Based on Application Under §1 or §44 of the Trademark Act
- 1615.02 Division of Registered Extension of Protection

### **1616 Replacement**

## REGISTRATION AND POST REGISTRATION PROCEDURES

### **1601**            **Types of Registrations**

#### **1601.01**            **Registrations Now Being Issued**

Currently, the United States Patent and Trademark Office (“USPTO”) issues registrations only under the Trademark Act of 1946, 15 U.S.C. §§1051 *et seq.* These are either Principal Register registrations or Supplemental Register registrations. See TMEP §801.02(a) regarding the Principal Register, and TMEP §801.02(b) regarding the Supplemental Register.

#### **1601.01(a)**            **Certificate of Registration**

The USPTO issues registration certificates for all registrations resulting from applications based on §§1, 44 and 66(a) of the Trademark Act. The registration certificate includes the owner’s name and address, the mark, the goods/services, and the international class(es). The certificate is placed in a registration jacket cover under seal and is signed by the Director of the USPTO.

#### **1601.01(b)**            **Duplicate Certificate of Registration**

If the owner of the registration does not receive the original certificate of registration *and* there is proof in the record that non-receipt was due to a USPTO error (*e.g.*, if the USPTO failed to properly enter a notice of change of address filed before the mailing date of the registration certificate), the USPTO will issue a duplicate certificate of registration if the owner files a written request for a duplicate certificate within one year of the registration date.

The owner of a registration may obtain a certified copy of the registration from the Certification Division of the Office of Public Records for a fee (see TMEP §111).

#### **1601.01(c)**            **Registered Extension of Protection of International Registration to the United States**

Effective November 2, 2003, §66(a) of the Trademark Act, 15 U.S.C. §1141f(a), permits the holder of an international registration to file a request for extension of protection of the international registration to the United States. See TMEP §§1904 *et seq.*

Unless the request for extension of protection is refused under §68 of the Trademark Act, the USPTO will issue a certificate of extension of protection and publish notice of such certificate in the *Official Gazette*. Section 69(a) of the Trademark Act, 15 U.S.C. §1141i(a). The certificate of registration will look the same as the certificates issued for registrations resulting from applications based on §§1 and 44 of the Act. From the date of issuance of

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

the certificate, the extension of protection has the same effect and validity as a registration on the Principal Register, and the holder of the international registration has the same rights and remedies as the owner of a registration on the Principal Register. Section 69(b) of the Trademark Act, 15 U.S.C. §1141i(b).

Under §66(b), unless the extension of protection is refused, the proper filing of the request for extension of protection constitutes constructive use of the mark, conferring the same rights as those specified in §7(c) of the Trademark Act, as of the earliest of the following:

- (1) The international registration date, if the request for extension of protection was made in the international application;
- (2) The date of recordal of the subsequent designation requesting an extension of protection to the United States, if the request for extension of protection to the United States was made in a subsequent designation; or
- (3) The date of priority claimed pursuant to §67 of the Trademark Act.

Upon registration, the USPTO will refer to an extension of protection to the United States as a “registration” or a “registered extension of protection.” 37 C.F.R. §7.25(c).

A registered extension of protection remains part of the international registration after registration in the United States. In this respect, the registered extension of protection differs from a registration issuing from a §44 application, which exists independent of the underlying foreign registration, pursuant to §44(f).

A registered extension of protection cannot be amended under §7 of the Trademark Act. See TMEP §1609.01(a).

### **1601.02 Repeal of Prior Acts**

The Act of 1946 became effective on July 5, 1947. Most Acts relating to trademarks that existed prior to the Act of 1946 were repealed as of the effective date of the Act of 1946. Repealed Acts include the Act of 1881, Act of 1905, Act of 1920, and the amendment entitled “Act of June 10, 1938.” The repeal did not affect the validity of registrations granted under prior Acts. Trademark Act §46(a), 15 U.S.C. §1051 note.

### **1601.03 Additional Registration under Act of 1946**

Marks that were registered under any previous Act may be registered again, under the Act of 1946, if the mark meets the requirements of the Act of 1946. Trademark Act §46(b), 15 U.S.C. §1051 note. However, the USPTO will not

## REGISTRATION AND POST REGISTRATION PROCEDURES

issue duplicate registrations for marks that are registered under the 1946 Act. See TMEP §703.

### **1601.04            1881 and 1905 Act Registrations**

Registrations that were issued under the Acts of 1881 and 1905 may be renewed under §9 of the Act of 1946, 15 U.S.C. §1059. These registrations are subject to, and entitled to the benefits of, the provisions of the Act of 1946 as though registered on the Principal Register of the Act, except with certain limitations that are set out in §46(b). Some of these limitations can be removed if the registrant claims the benefits of the Act of 1946 under §12(c), 15 U.S.C. §1062(c). See TMEP §1603.

Marks registered under the “10-year proviso” of §5 of the Act of 1905 are deemed to have become distinctive of the goods or services under §2(f) of the Act of 1946. Trademark Act §46(b), 15 U.S.C. §1051 note.

See TMEP §1602.02 regarding the duration of and requirements for maintaining registrations issued under the Acts of 1881 and 1905.

### **1601.05            1920 Act Registrations**

Registrations under the Act of 1920 are subject to, and entitled to the benefits of, the provisions of the Act of 1946 relating to marks registered on the Supplemental Register, and may not be renewed unless renewal is required to support a foreign registration. Trademark Act §46(b), 15 U.S.C. §1051 note.

See TMEP §1602.03 regarding the duration of and requirements for maintaining registrations issued under the Act of 1920.

### **1601.06            Registrations Issued Under Prior Classification Systems**

Prior to September 1, 1973, the United States used its own system for classification of goods and services, which is different from the international classification system. For all registrations issued on the basis of an application filed on or before August 31, 1973, the classification under which the registration issued governs for all statutory purposes, including affidavits under §8, 15 U.S.C. §1058, and renewal applications under §9, 15 U.S.C. §1059. See 37 C.F.R. §2.85.

As of September 1, 1973, the international system for classification of goods and services is the primary classification system used by the United States, and it applies to all applications filed on or after September 1, 1973, and their resulting registrations, for all statutory purposes. See TMEP §1401.02.

A registrant whose registration issued under the U.S. classification system may voluntarily amend the registration under §7 of the Trademark Act to

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

adopt the international classification set forth in the current version of the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks* ("Nice Agreement"). The registrant must pay the filing fee required for Section 7 amendments under 37 C.F.R. §2.6. See TMEP §1609.04.

### **1601.07 Form of Copies of Registrations**

Before August 24, 1920, the name of the Act under which a registration was issued was not designated on the copy of the registration on file in the Trademark Search Library. Beginning with registrations issued on August 24, 1920, there is printed in the heading of each registration either the words "Act of Feb. 20, 1905" or the words "Act of Mar. 19, 1920." The first registrations under the Act of 1920 apparently were issued on August 24, 1920.

Registrations under the Act of 1881 range from Number 8,191, issued on May 17, 1881, through Number 44,357, issued on March 28, 1905. No registrations were issued between March 28, 1905, and July 4, 1905. On July 4, 1905, the first registration under the Act of 1905 was issued as Number 44,358.

The Act of 1946 provides that the certificates of registration for marks registered on the Supplemental Register shall be conspicuously different from certificates issued for marks registered on the Principal Register. Trademark Act §25, 15 U.S.C. §1093. Certificates issued under the 1946 Act are clearly marked either "Principal Register" or "Supplemental Register," with the date the application was filed.

### **1602 Duration and Maintenance of Registrations**

The Trademark Act of 1946, 15 U.S.C. §§1051 *et seq.*, became effective on July 5, 1947, and as of that date the Trademark Acts of 1881, 1905 and 1920 were repealed insofar as they were inconsistent with the Act of 1946. Trademark Act §46(a), 15 U.S.C. §1051 note.

The duration of registrations has varied, depending upon the Act under which the registration was issued. See TMEP §§1602.01, 1602.02, 1602.03, and 1614.

#### **1602.01 Act of 1946**

##### ***Registrations Resulting From Applications Under §1 and §44***

The Trademark Law Revision Act of 1988, Pub. L. No. 100-667, 102 Stat. 3935, which took effect on November 16, 1989, amended §9 of the Trademark Act of 1946 to reduce both the duration of registration and the

## REGISTRATION AND POST REGISTRATION PROCEDURES

term of renewal from twenty to ten years. All registrations issued or renewed on or after November 16, 1989 are issued or renewed for a ten-year period.

Thus, registrations issued under the Act of 1946 on or after November 16, 1989, remain in force for ten years, provided that affidavits of use or excusable nonuse are filed under §8 of the Act. 37 C.F.R. §2.181(a)(2). See 37 C.F.R. §2.160(a) and TMEP §1604.04 regarding the due dates for affidavits of use or excusable nonuse. Registrations issued under the Act of 1946 before November 16, 1989, remain in force for twenty years, provided that an affidavit or declaration of use or excusable nonuse was filed during the sixth year after the date of registration. 37 C.F.R. §2.181(a)(1). See TMEP §§1604 *et seq.* regarding affidavits of use under §8 of the 1946 Act.

Effective November 16, 1989, registrations under the Act of 1946 may be renewed for periods of ten years from the end of the expiring period. 37 C.F.R. §2.181(a). Before November 16, 1989, registrations under the Act of 1946 were renewed for 20-year periods. The applicable term for renewals that were processed during the transition depends on whether the USPTO granted renewal before or after November 16, 1989. If the USPTO granted renewal before November 16, 1989, the renewal term is twenty years; if the USPTO granted renewal on or after November 16, 1989, the renewal term is ten years. *In re Maytag Corp.*, 21 USPQ2d 1615 (Comm'r Pats. 1991). See TMEP §§1606 *et seq.* regarding renewal under §9 of the 1946 Act.

### ***Registered Extensions of Protection***

Section 9 of the Trademark Act does not apply to registered extensions of protection of international registrations to the United States. Renewal of an international registration and its corresponding extension of protection to the United States must be made at the International Bureau of the World Intellectual Property Organization (“IB”), in accordance with Article 7 of the Madrid Protocol. 37 C.F.R. §7.41(a). See TMEP §1614 for further information about renewal of international registrations.

Section 71 of the Act requires the periodic filing of affidavits of use in commerce or excusable nonuse for registered extensions of protection. See TMEP §1613 regarding due dates and requirements for §71 affidavits.

### **1602.02 Acts of 1881 and 1905**

Registrations under the Act of 1905 were issued for an original term of twenty years, and were renewable for 20-year periods. Registrations under the Act of 1881 were issued for an original term of thirty years, and were renewable under the Act of 1905 for 20-year periods.

Effective November 16, 1989, registrations issued under the 1905 Act and the 1881 Act are renewable under the 1946 Act for periods of ten years. Before

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

November 16, 1989, registrations issued under the 1905 Act and the 1881 Act were renewable under the 1946 Act for periods of twenty years. Trademark Act §46(b), 15 U.S.C. §1051 note; 37 C.F.R. §2.181(b).

Both a 1905 Act and 1881 Act registrant may file an affidavit or declaration under §12(c) of the Trademark Act, 15 U.S.C. §1062(c), to claim the benefits of the 1946 Act, without affecting the term of the registration. See TMEP §1603. Under §8(a)(2) of the 1946 Act, if the registrant claims the benefits of the 1946 Act, the registrant must file an affidavit or declaration of use or excusable nonuse within the sixth year after publication of the notice of the §12(c) claim in the *Official Gazette*, to avoid cancellation. See TMEP §§1604 *et seq.* regarding affidavits or declarations of use or excusable nonuse.

Under §8(a)(3) of the 1946 Act, 1905 Act and 1881 Act registrants must file affidavits of use or excusable nonuse at the end of each successive ten-year period following the date of registration, even if the registrant does not claim the benefits of the 1946 Act under §12(c) of the Act. However, this requirement does not apply to a registration renewed for a 20-year term (*i.e.*, a registration renewed prior to November 16, 1989) until a renewal application is due. See TMEP §1604.04(b).

### **1602.03 Act of 1920**

The Act of 1920 did not specify any term of registration. However, the Act of 1946 provided that 1920 Act registrations would expire six months after July 5, 1947 (the effective date of the 1946 Act), or twenty years from the date of registration, whichever was later. A 1920 Act registration may not be renewed unless renewal is required to support a foreign registration, in which case the registration may be renewed on the Supplemental Register for a ten-year period, in the same manner as a registration issued under the 1946 Act. Trademark Act §46(b), 15 U.S.C. §1051 note; 37 C.F.R. §2.181(c). See TMEP §§1606 *et seq.* regarding renewal.

The requirement that renewal be necessary to support a foreign registration applies to all renewals of a 1920 Act registration, not just the first renewal. *Ex parte U.S. Steel Corp.*, 157 USPQ 435 (Comm'r Pats. 1968).

The application for renewal of a 1920 Act registration should identify the foreign registration(s) that the renewal is needed to support, the country, the name of the present owner, the registration number and the date of registration, and must show that the foreign registration(s) are currently in force.

Under §8(a)(3) of the 1946 Act, an affidavit or declaration of use or excusable nonuse under §8 is also required at the end of each successive ten-year period following the date of registration. However, this requirement does not apply to a registration renewed for a 20-year term (*i.e.* a registration renewed

## REGISTRATION AND POST REGISTRATION PROCEDURES

prior to November 16, 1989) until a renewal application is due. See TMEP §1604.04(b).

### **1602.04 Trademark Law Treaty Implementation Act Changes**

The Trademark Law Treaty Implementation Act of 1998 (“TLTIA”), Pub. L. No. 105-30, 112 Stat. 3064, changed the requirements for filing affidavits or declarations of use or excusable nonuse under 15 U.S.C. §1058 (“§8 affidavits”), and renewal applications under 15 U.S.C. §1059, effective October 30, 1999. See *Post Registration: Changes to Requirements for Maintaining Trademark Registrations*, at 1228 TMOG 187 (Nov. 30, 1999), available at [www.uspto.gov](http://www.uspto.gov), for a discussion of these changes.

TLTIA did not change the duration of registrations. See TMEP §§1602 *et seq.* regarding the term of registrations.

### **1603 Bringing Prior Act Registrations Under 1946 Act, §12(c)**

Owners of marks registered under the Acts of 1905 or 1881 may claim the benefits of the Act of 1946, but are not required to do so. Trademark Act §12(c), 15 U.S.C. §1062(c). The 1946 Act refers to a “registrant” claiming the benefits of the Act. The term “registrant” includes both the original registrant and a person who has acquired ownership through proper transfer of title. See 15 U.S.C. §1127. The claim must be made by the person who owns the mark at the time the claim is made.

To claim the benefits of the Act of 1946, the owner of the registration must file an affidavit or a declaration under 37 C.F.R. §2.20. The affidavit or declaration must: (1) set forth those items listed in the registration on which the mark is currently in use in commerce, specifying the nature of such commerce; and (2) state that the benefits of the Act of 1946 are claimed for the mark. The affidavit must be accompanied by the fee required by 37 C.F.R. §2.6. 37 C.F.R. §2.153. No specimen is required. Goods or services not listed in the affidavit will be deleted from the registration. The affidavit or declaration under §12(c) of the Act may be filed at any time during the life of the registration.

A claim of the benefits of the 1946 Act does *not* affect or alter the *term* of the 1905 or 1881 Act registration. These registrations still remain in force for the times indicated in TMEP §1602.02, *subject to cancellation if acceptable affidavits of use or excusable nonuse are not filed under 15 U.S.C. §1058*. The deadline for *renewal* (and the affidavit of use or excusable nonuse required during the year before the end of every ten-year period after the date of the registration) is calculated from the date of issue of the registration, *not* from the date of publication of the notice of the registrant’s claim of the benefits of the 1946 Act.



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1603.01 Notification and Printing of Mark in *Official Gazette***

If the affidavit or declaration claiming the benefits of the Act of 1946 is acceptable, the mark and accompanying notice of the claim of benefits of the 1946 Act are printed in the *Official Gazette* under the heading "Registrations Published Under Sec. 12(c)." 37 C.F.R. §2.154. The USPTO notifies the registrant of the printing of the mark in the *Official Gazette*, and also informs the registrant of the requirement for filing affidavits of use or excusable nonuse under 15 U.S.C. §1058. 37 C.F.R. §2.155.

If an affidavit or declaration claiming the benefits of the Act of 1946 is unacceptable, the USPTO notifies the registrant of the defect.

These marks are not subject to opposition on their appearance in the *Official Gazette*. 37 C.F.R. §2.156.

### **1603.02 Cancellation and Incontestability**

If the benefits of the Act of 1946 are claimed, registrants under the Acts of 1905 and 1881 may subsequently file affidavits (or declarations) under §15 of the Act of 1946 whereby marks shall be incontestable. See TMEP §§1605 *et seq.*

Once the registrant claims the benefits of the Act of 1946, registrations under the 1905 and 1881 Acts are subject to cancellation under §14 of the Act of 1946. See TMEP §1607.

### **1603.03 Affidavits of Use in Commerce Required**

After the benefits of the Act of 1946 are claimed for a registration issued under the Act of 1881 or the Act of 1905, the registrant must file an affidavit or declaration of use or excusable nonuse during the sixth year after the date of publication of the notice of the registrant's claim of the benefits of the 1946 Act in the *Official Gazette*, or within the six-month grace period after expiration of the sixth year, to avoid cancellation under §8(a)(2) of the Act. 15 U.S.C. §§1058(a)(2) and 1058(c)(1); 37 C.F.R. §2.160(a)(1)(ii).

An affidavit of use or excusable nonuse must also be filed within one year before the end of every ten-year period after the date of the registration, or within the six-month grace period thereafter. 15 U.S.C. §1058(a)(3); 37 C.F.R. §2.160(a)(2).

See TMEP §§1604 *et seq.* for further information about affidavits or declarations of use or excusable nonuse under 15 U.S.C. §1058.

## REGISTRATION AND POST REGISTRATION PROCEDURES

### 1604 Affidavit of Use or Excusable Nonuse of Mark in Commerce under §8

15 U.S.C. §1058. *Duration.*

(a) *Each registration shall remain in force for 10 years, except that the registration of any mark shall be canceled by the Director for failure to comply with the provisions of subsection (b) of this section, upon the expiration of the following time periods, as applicable:*

(1) *For registrations issued pursuant to the provisions of this Act, at the end of 6 years following the date of registration.*

(2) *For registrations published under the provisions of section 12(c), at the end of 6 years following the date of publication under such section.*

(3) *For all registrations, at the end of each successive 10-year period following the date of registration.*

(b) *During the 1-year period immediately preceding the end of the applicable time period set forth in subsection (a), the owner of the registration shall pay the prescribed fee and file in the Patent and Trademark Office--*

(1) *an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce and such number of specimens or facsimiles showing current use of the mark as may be required by the Director; or*

(2) *an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is not in use in commerce and showing that any such nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark.*

(c)(1) *The owner of the registration may make the submissions required under this section within a grace period of 6 months after the end of the applicable time period set forth in subsection (a). Such submission is required to be accompanied by a surcharge prescribed by the Director.*

(2) *If any submission filed under this section is deficient, the deficiency may be corrected after the statutory time period and within the time prescribed after notification of the deficiency. Such submission is required to be accompanied by a surcharge prescribed by the Director.*

(d) *Special notice of the requirement for affidavits under this section shall be attached to each certificate of registration and notice of publication under section 12(c).*

(e) *The Director shall notify any owner who files 1 of the affidavits required by this section of the Director's acceptance or refusal thereof and, in the case of a refusal, the reasons therefor.*

(f) *If the registrant is not domiciled in the United States, the registrant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Director.*

Under 15 U.S.C. §1058, the owner of a registration must periodically file affidavits or declarations of use or excusable nonuse of the mark. The purpose of the affidavit or declaration of use or excusable nonuse (“§8 affidavit”) is to remove marks that are no longer being used in commerce from the register.

### **1604.01 Registrations to Which §8 Affidavit Pertains**

#### *Registered Extensions of Protection*

Section 8 of the Trademark Act applies only to registrations resulting from applications under §1 or §44 of the Trademark Act. However, §71 of the Act requires periodic affidavits of use or excusable nonuse in registered extensions of protection of international registrations to the United States. See TMEP §1613 for further information about §71 affidavits.

#### *Six-Year Section 8 Affidavits for Registrations Resulting From Applications Under §1 or §44*

Under §8(a)(1) of the Trademark Act, an affidavit or declaration under §8 of the Act is required during the sixth year after the date of registration for registrations issued on either the Principal Register or the Supplemental Register, or within the six-month grace period after expiration of the sixth year. 15 U.S.C. §§1058(a)(1) and 1058(c)(1); 37 C.F.R. §2.160(a)(1)(i).

Under §8(a)(2) of the Act, an affidavit or declaration under §8 is required during the sixth year after the date of publication under §12(c) for registrations issued under the Acts of 1881 and 1905 for which the owner has claimed the benefits of the Act of 1946 under §12(c), or within the six-month grace period after the end of the sixth year. 15 U.S.C. §§1058(a)(2) and 1058(c)(1); 37 C.F.R. §2.160(a)(1)(ii); TMEP §1603.03.

#### *Ten-Year Section 8 Affidavits Required for All Registrations Resulting From Applications Under §1 or §44*

Section 8(a)(3) of the Trademark Act requires an affidavit or declaration of use or excusable nonuse at the end of each successive ten-year period following the date of registration, or within the six-month grace period after the end of the ten-year period. However, the provisions of §8(a)(3) of the Act, requiring the filing of a §8 affidavit at the end of each successive ten-year

## REGISTRATION AND POST REGISTRATION PROCEDURES

period after registration, do not apply to a registration issued or renewed for a twenty-year term until a renewal application is due. See TMEP §1604.04(b).

### **1604.02 Notice of When Affidavit Is Due**

A statement noting the requirement for filing the affidavits or declarations of use or excusable nonuse under §8 of the Act is included on each certificate of registration as originally issued. 15 U.S.C. §1058(d). This is the only notice that the USPTO provides regarding this requirement. However, the owner must file the affidavit or declaration within the time periods required by §8 of the Act regardless of whether the owner receives the notice. 37 C.F.R. §2.162. The USPTO does not provide any reminder of the due date(s) of the affidavits.

### **1604.03 Form for Filing §8 Affidavit**

To expedite processing, it is recommended that the owner file the §8 affidavit through the Trademark Electronic Application System (“TEAS”). See TMEP §301 for more information about electronic filing. Forms for filing affidavits of use or excusable nonuse under §8, combined affidavits of use and incontestability under §§8 and 15 (see TMEP §1605.05), and §8 affidavits combined with renewal applications under §9 of the Act (see TMEP §1604.19) are available through TEAS at <http://www.uspto.gov/teas/index.html>. Alternatively, the owner can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed form that can be mailed, faxed or hand-delivered to the USPTO.

See TMEP §1604.04 regarding the deadline for filing the affidavit, and TMEP §1604.05 regarding the requirements for filing the affidavit.

### **1604.04 Time for Filing §8 Affidavit**

*37 C.F.R. §2.160(a). During the following time periods, the owner of the registration must file an affidavit or declaration of continued use or excusable nonuse, or the registration will be cancelled:*

*(1)(i) For registrations issued under the Trademark Act of 1946, on or after the fifth anniversary and no later than the sixth anniversary after the date of registration; or*

*(ii) For registrations issued under prior Acts, on or after the fifth anniversary and no later than the sixth anniversary after the date of publication under section 12(c) of the Act; and*

*(2) For all registrations, within the year before the end of every ten-year period after the date of registration.*

*(3) The affidavit or declaration may be filed within a grace period of six months after the end of the deadline set forth in paragraphs (a)(1) and (a)(2) of this section, with payment of the grace period surcharge required by section*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*8(c)(1) of the Act and §2.6.*

Under §§8(a) and (b) of the Trademark Act, the owner of the registration must file an affidavit or declaration of use or excusable nonuse:

- (1) on or after the fifth anniversary and no later than the sixth anniversary of the date of registration or date of publication under §12(c) of the Act; *and*
- (2) within the year before the end of every ten-year period after the date of registration. 37 C.F.R. §2.160(a).

See TMEP §1604.04(b) regarding registrations in twenty-year terms.

Under §8(c)(1) of the Act, the owner may file the affidavit or declaration within a grace period of six months after the expiration of the deadline set forth in §8(a) of the Act, accompanied by an additional grace period surcharge.

Affidavits may be filed on the registration anniversary dates at the end of the fifth and sixth years, or at the end of the ninth and tenth years.

*Example:* For a registration issued on Nov. 1, 2001, a six-year affidavit may be filed as early as Nov. 1, 2006, and may be filed as late as November 1, 2007, before entering the six-month grace period.

Under 37 C.F.R. §2.195(a)(2), a §8 affidavit or declaration filed through TEAS is considered to have been filed on the date the USPTO receives the transmission, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia.

Section 8 affidavits or declarations filed on paper are considered timely if they are mailed or transmitted by the due date with a certificate of mailing or facsimile transmission under 37 C.F.R. §2.197. See TMEP §§305.02 and 306.05 for certificate of mailing and certificate of facsimile transmission procedures to avoid lateness.

If the owner of the registration does not file an affidavit or declaration of use or excusable nonuse before the end of the grace period, the registration will be cancelled. 37 C.F.R. §§2.160(a) and 2.164(b). See TMEP §1604.07 regarding who may file a §8 affidavit.

### **1604.04(a) Premature Filing of §8 Affidavit**

The affidavit cannot be filed before the periods specified in §§8(a) and (b) of the Act. The purpose of the affidavit is to show that the mark is still in use in commerce within the relevant period, which cannot be done by an affidavit

## REGISTRATION AND POST REGISTRATION PROCEDURES

filed before that period. *Cf. In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984). If an affidavit is filed before the period specified in §§8(a) and (b) of the Act, the USPTO will issue a notice advising the owner: that the affidavit is premature; of the appropriate time for filing the affidavit; that the fee(s) submitted will be held; and that the owner may file a new affidavit at the appropriate time or may request a refund at any time. There is no deficiency surcharge. The prematurely filed affidavit will remain in the record for informational purposes only. The owner of the registration must file a newly executed affidavit or declaration before the end of the grace period, or the registration will be cancelled and the USPTO will refund the fees.

See TMEP §1604.08(b) regarding the date of execution of a §8 affidavit.

### **1604.04(b) Registrations in Twenty-Year Terms**

As noted in TMEP §1604.04, §8(a)(3) of the Trademark Act requires an affidavit or declaration of use or excusable nonuse at the end of each successive ten-year period following the date of registration for all registrations. However, this requirement does not apply to a registration issued or renewed for a twenty-year term (*i.e.*, a registration issued or renewed before November 16, 1989) until a renewal application is due. See notice at 1228 TMOG 187, 189 (Nov. 30, 1999).

*Example:* If a registration was issued or renewed on November 15, 1989, no §8(a)(3) affidavit is due between November 15, 1998 and November 15, 1999. Section 8(a)(3) of the Act does not apply until the renewal application is due, *i.e.*, between November 15, 2008 and November 15, 2009.

Should the USPTO receive a §8(a)(3) affidavit during the tenth year for a registration in a twenty-year term, the USPTO will refund the filing fee and notify the filer that the document will not be processed.

### **1604.05 Requirements for §8 Affidavit or Declaration of Use or Excusable Nonuse**

*37 C.F.R. §2.161. Requirements for a complete affidavit or declaration of continued use or excusable nonuse*

*A complete affidavit or declaration under section 8 of the Act must:*

- (a) Be filed by the owner within the period set forth in §2.160(a);*
- (b) Include a statement that is signed and verified (sworn to) or supported by a declaration under §2.20 by a person properly authorized to sign on behalf of the owner, attesting to the continued use or excusable nonuse of the mark within the period set forth in section 8 of the Act. The verified statement must be executed on or after the beginning of the filing period specified in §2.160(a).*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*A person who is properly authorized to sign on behalf of the owner is:*

- (1) a person with legal authority to bind the owner; or*
  - (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or*
  - (3) an attorney as defined in §10.1(c) of this chapter who has an actual or implied written or verbal power of attorney from the owner.*
- (c) Include the registration number;*
- (d)(1) Include the fee required by §2.6 for each class of goods or services that the affidavit or declaration covers;*
- (2) If the affidavit or declaration is filed during the grace period under section 8(c)(1) of the Act, include the late fee per class required by §2.6;*
  - (3) If at least one fee is submitted for a multi-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. Additional fee(s) may be submitted if the requirements of §2.164 are met. If the required fee(s) are not submitted and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class;*
- (e)(1) Specify the goods or services for which the mark is in use in commerce, and/or the goods or services for which excusable nonuse is claimed under §2.161(f)(2);*
- (2) If the affidavit or declaration covers less than all the goods or services, or less than all the classes in the registration, specify the goods or services being deleted from the registration;*
- (f)(1) State that the registered mark is in use in commerce on or in connection with the goods or services in the registration; or*
- (2) If the registered mark is not in use in commerce on or in connection with all the goods or services in the registration, set forth the date when use of the mark in commerce stopped and the approximate date when use is expected to resume; and recite facts to show that nonuse as to those goods or services is due to special circumstances that excuse the nonuse and is not due to an intention to abandon the mark;*
- (g) Include a specimen showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed under §2.161(f)(2). The specimen must:*
- (1) Show the mark as actually used on or in connection with the goods or in the sale or advertising of the services. A photocopy or other reproduction of the specimen showing the mark as actually used is acceptable. However, a photocopy that merely reproduces the registration certificate is not a proper specimen;*
  - (2) Be flat and no larger than 8.5 inches (21.6 cm.) wide by 11.69 inches*

## REGISTRATION AND POST REGISTRATION PROCEDURES

(29.7 cm.) long. If a specimen exceeds these size requirements (a “bulky specimen”), the Office will create a facsimile of the specimen that meets the requirements of the rule (i.e., is flat and no larger than 8.5 inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long) and put it in the record. In the absence of non-bulky alternatives, the Office may accept an audio or video cassette tape recording, CD-ROM, or a specimen in another appropriate medium.

(3) Be a digitized image in .jpg format, if transmitted through TEAS.

### **1604.06 Fees for §8 Affidavit**

#### **1604.06(a) Filing Fee for Affidavit or Declaration**

Under 15 U.S.C. §1058(b) and 37 C.F.R. §2.161(d)(1), an affidavit or declaration of use or excusable nonuse must include the fee required by 37 C.F.R. §2.6 for each class of goods or services that the affidavit or declaration covers. See TMEP §§1401.02, 1401.04 and 1601.06 regarding use of international classification or prior United States classification to calculate fees due.

#### **1604.06(b) Grace Period Surcharge and Deficiency Surcharge**

If the affidavit or declaration is filed during the grace period under §8(c)(1) of the Act, it must include the grace period surcharge per class required by 37 C.F.R. §2.6. 37 C.F.R. §2.161(d)(2).

Section 8(c)(2) of the Trademark Act requires a “deficiency surcharge” for correcting deficiencies in the affidavit or declaration after expiration of the deadlines specified in §8. See TMEP §§1604.17 *et seq.* regarding the deadlines and surcharge for correcting deficiencies.

Only a single deficiency surcharge is required for correcting one or more deficiencies in a multi-class registration. Similarly, only a single deficiency surcharge is required to correct several deficiencies within one §8 affidavit or one combined filing under §§8 and 9. See TMEP §1604.19 regarding combined filings under §§8 and 9.

The grace period surcharge applies only where no filing was made during the sixth year after the date of registration (or date of publication under §12(c) of the Act), or within the year before the end of any ten-year period after the date of registration. An owner who files within these periods, but corrects a deficiency after these periods have expired, will be subject to the deficiency surcharge only. On the other hand, someone who files during the grace period and cures deficiencies after expiration of the grace period will be subject to both the grace period surcharge (for the ability to file the affidavit during the grace period) *and* the deficiency surcharge (for the ability to correct a deficiency after the end of the grace period). H.R. Rep. No. 194, 105<sup>th</sup> Congress, 1<sup>st</sup> Sess. 17 (1997).



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1604.06(c) Processing Affidavit or Declaration Filed With Insufficient Fees**

An affidavit or declaration that does not include a fee, or does not include sufficient fees for all the classes to which the affidavit pertains (and the grace period surcharge, where applicable), is deficient. Fee deficiencies may be cured before expiration of the deadlines set forth in §8 of the Act without payment of a deficiency surcharge, or after expiration of the deadlines set forth in §8 of the Act with the deficiency surcharge required by §8(c)(2) of the Act. See TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

If the affidavit or declaration was filed without sufficient fee(s), but the affidavit or declaration included an authorization to charge deficient fees to a USPTO deposit account (37 C.F.R. §2.208), the required fee(s) (and grace period surcharge, where applicable) will be charged to the deposit account. If the deposit account authorization was included with the affidavit or declaration as filed, and the deposit account had sufficient funds to cover the fee(s) in question, there is no fee deficiency and no deficiency surcharge is required.

An authorization to charge fees to a deposit account with insufficient funds to cover the fee is regarded as a deficiency.

If a check submitted as payment of a filing fee for an affidavit of use or excusable nonuse is returned unpaid, or an electronic funds transfer (“EFT”) or credit card payment is refused or charged back by a financial institution, this is regarded as a deficiency. In addition to the deficiency surcharge (where applicable), there is a \$50 fee for processing the payment that was refused. 37 C.F.R. §2.6(b)(12). See TMEP §405.06 for additional information.

If at least one fee is submitted for a multi-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Post Registration examiner will issue an Office action requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. If the owner does not submit the required fee(s) or specify the class(es) to which the original fee(s) should be applied, the USPTO will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class. 37 C.F.R. §2.161(d)(3).

### **1604.07 Ownership, and Who May File §8 Affidavit**

#### **1604.07(a) Affidavit or Declaration Must be Filed by Owner**

The affidavit or declaration of use or excusable nonuse must be filed by the owner of the registration. Filing by the owner is a minimum requirement that must be met before the expiration of the deadlines set forth in §8(a) of the Act (*i.e.*, during the sixth year after the date of registration or publication under

## REGISTRATION AND POST REGISTRATION PROCEDURES

§12(c) of the Trademark Act, within the year before the end of every ten-year period after the date of registration), or within the six-month grace period after expiration of these deadlines. 37 C.F.R. §2.164(b).

If it is unclear whether the party who filed the affidavit is the present owner, the Post Registration examiner will issue an Office action requiring the party to establish its ownership. If the party who filed the affidavit was the owner of the registration at the time of filing, the owner may file evidence to establish ownership even if the filing period set forth in §8 of the Act has expired. There is no deficiency, and no deficiency surcharge is required for providing evidence to establish ownership. See TMEP §1604.07(b).

If the affidavit or declaration was filed in the name of the wrong party, and there is time remaining in the filing period or grace period, the true owner must file a complete new affidavit or declaration, together with the filing fee per class required by 37 C.F.R. §2.6, and, if applicable, a specimen of use for each class. If the new affidavit or declaration is filed during the grace period, the owner must include the grace period surcharge per class with the new affidavit or declaration.

If the affidavit or declaration was filed in the name of the wrong party, and there is no time remaining in the grace period, the registration will be cancelled. 15 U.S.C. §1058; 37 C.F.R. §2.164(b). Filing in the name of another entity is not a deficiency that can be corrected after the expiration of the grace period. See *In re Precious Diamonds, Inc.*, 635 F.2d 845, 208 USPQ 410 (C.C.P.A. 1980); *In re Media Central IP Corp.*, 65 USPQ2d 1637 (Dir USPTO 2002); *In re ACE III Communications, Inc.*, 62 USPQ2d 1049 (Dir USPTO 2001); *In re Caldon Company Limited Partnership*, 37 USPQ2d 1539 (Comm'r Pats. 1995); *In re Weider*, 212 USPQ 947 (Comm'r Pats. 1981). See also TMEP §1604.07(f) regarding mistakes in setting forth the name of the owner.

### **1604.07(b) Establishing Ownership**

When the affidavit is filed by someone other than the original owner of the registration, the examiner cannot accept the affidavit unless there is a clear chain of title from the original owner to the party who filed the affidavit. 37 C.F.R. §3.73(b); TMEP §502.01.

When the affidavit is filed, the examiner will check the records of the Assignment Services Division of the USPTO, available at <http://assignments.uspto.gov/assignments>. If the records of the Assignment Services Division show a clear chain of title in the party who filed the affidavit, no inquiry will be issued. The examiner will enter the change of ownership into the Trademark Reporting and Monitoring ("TRAM") System, if necessary.

If the records of the Assignment Services Division do not show a clear chain of title in the party who filed the affidavit, the examiner will issue an Office

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

action requiring the party to establish its ownership of the registration. To establish ownership, the party must: (1) record papers that show each change of ownership in the Assignment Services Division of the USPTO, and include a statement in the response to the Office action that the papers have been recorded; or (2) submit documentary evidence of a chain of title from the original owner to the party who filed the affidavit. 37 C.F.R. §3.73(b)(1); TMEP §502.01.

“Documentary evidence of a chain of title from the original owner to the assignee” (37 C.F.R. §3.73(b)(1)(i)) normally consists of the same type of documents that would be recorded in the Assignment Services Division, e.g., assignment documents, certificates of merger, or certificates of change of name. In the alternative, an affidavit or declaration containing sufficient facts to support the transfer of title may be accepted.

The owner may submit evidence of ownership even if the filing period set forth in §8 of the Act has expired. Where the party who filed the affidavit was the owner of the registration at the time of filing, there is no deficiency, and no deficiency surcharge is required for providing evidence to establish ownership.

### **1604.07(c) Acceptance Notice Issued in Name of Owner of Record**

The notification of acceptance of a §8 affidavit is issued in the name of the owner of record, as shown in the automated records of the Trademark Operation (*i.e.*, the TRAM System, Trademark Applications and Registrations Retrieval (“TARR”) database, X-Search and Trademark Electronic Search System (“TESS”).

When a party other than the original owner files a §8 affidavit, the USPTO will accept the affidavit if the new owner submits documentary evidence of the chain of title (*see* TMEP §1604.07(b)), even if the new owner does not record the documents of ownership in the Assignment Services Division. 37 C.F.R. §3.73. However, the USPTO will not issue the notice of acceptance of the §8 affidavit in the name of the new owner unless the new owner (1) records the appropriate document in the Assignment Services Division; and (2) notifies the Post Registration examiner that the document has been recorded. 37 C.F.R. §3.85. *See* TMEP §§504 *et seq.* regarding the circumstances in which the ownership field in the trademark database will be automatically updated after recordation of a document with the Assignment Services Division, even if the new owner does not notify the Trademark Operation that the document has been recorded.

*See* TMEP §502.01 regarding establishing ownership of a registration, and TMEP §502.03 regarding issuance of a new certificate in the name of a new owner.

## REGISTRATION AND POST REGISTRATION PROCEDURES

### **1604.07(d) Changes of Legal Entity**

The procedures for establishing ownership, as discussed in TMEP §1604.07(b), also apply to changes of name and changes of legal entity. See TMEP §1604.07(e) regarding changes of name.

A change in the state of incorporation is a change of legal entity, creating a new party.

The death of a partner, or other change in the membership of a partnership, creates a change in legal entity, unless the partnership agreement provides for continuation of the partnership and the relevant state law permits this.

A merger of companies into a new company normally constitutes a change of legal entity.

Affidavits may be accepted from trustees, executors, administrators, and the like, when supported by a court order or other evidence of the person's authority to act on behalf of the present owner. If there is a court order, a copy of the order should be submitted.

### **1604.07(e) Changes of Name**

A mere change of the name of a party is not a change of entity and will not require an inquiry regarding ownership if there is clear title in the party who filed the §8 affidavit. Therefore, if the owner records a change of name with the Assignment Services Division and subsequently files the §8 affidavit in its former name, the examiner will not issue an inquiry regarding ownership.

However, if it is unclear from the records of the Assignment Services Division whether the party who filed the affidavit is the owner of record, the owner must either record evidence of the change of name in the Assignment Services Division or submit proof of the change of name, as discussed in TMEP §1604.07(b). For a corporation, this is done by recording or submitting a certificate of change of name issued by the Secretary of State (or other authorized body) of the state of incorporation.

See TMEP §1604.07(c) regarding issuance of the notice of acceptance of the affidavit in the name of the new owner.

### **1604.07(f) Correction of Mistake in Setting Forth the Name of the Owner**

If the affidavit or declaration was filed by the owner of the registration, but there is a mistake in the manner in which the name of the owner is set out in the affidavit, the mistake can be corrected. *In re Atlanta Blue Print Co.*, 19 USPQ2d 1078 (Comm'r Pats. 1990). No deficiency surcharge is required in this situation.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

However, if the affidavit or declaration was mistakenly filed in the name of a person or legal entity who did not own the mark as of the filing date, a new affidavit or declaration cannot be filed in the name of the true owner unless there is time remaining in the grace period. See TMEP §1604.07(a). *In re Media Central IP Corp.*, 65 USPQ2d 1637 (Dir USPTO 2002); *In re ACE III Communications, Inc.*, 62 USPQ2d 1049 (Dir USPTO 2001).

See TMEP §1201.02(c) for examples of correctable and non-correctable errors.

### **1604.08 Execution of Affidavit or Declaration**

#### **1604.08(a) Persons Who May Sign Affidavit or Declaration**

Under 37 C.F.R. §2.161(b), the §8 affidavit or declaration must include a statement that is signed and verified (sworn to) or supported by a declaration under 37 C.F.R. §2.20 by a person properly authorized to sign on behalf of the owner. A “person who is properly authorized to sign on behalf of the owner” is: (1) a person with legal authority to bind the owner; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or (3) an attorney as defined in 37 C.F.R. §10.1(c) who has an actual written or verbal power of attorney or an implied power of attorney from the owner.

Generally, the USPTO does not question the authority of the person who signs a verification, unless there is an inconsistency in the record as to the signatory’s authority to sign. See TMEP §804.04.

#### **1604.08(b) Date of Execution of Affidavit or Declaration**

Under 37 C.F.R. §2.161(b), the verified statement must be executed on or after the beginning of the relevant filing period specified in §8 of the Act (*i.e.*, on or after the fifth anniversary of the date of registration or publication under §12(c), or on or after the beginning of the one-year period before the end of each ten-year period after the date of registration). Because the purpose of the affidavit is to attest to the use or excusable nonuse of the mark within the time periods specified in §8 of the Act, the affidavit cannot be executed before these time periods begin.

An affidavit filed within the period specified in §8 of the Act, but executed before that period, is deficient. The owner of the registration will be required to submit a substitute or supplemental affidavit or declaration attesting to use in commerce (or excusable nonuse) on or in connection with the goods or services within the relevant period specified in §8 of the Act.

If the prematurely executed §8 affidavit was filed during the relevant period specified in §§8(a) or 8(b) of the Act (*i.e.*, during the sixth year after the date of registration or publication under §12(c) of the Trademark Act, or within one

## REGISTRATION AND POST REGISTRATION PROCEDURES

year before the end of any ten-year period after the date of registration), the substitute affidavit may be filed before expiration of the relevant period for no fee, or after expiration of the relevant period with the deficiency surcharge required under §8(c)(2) of the Act. If the prematurely executed §8 affidavit was filed during the grace period, the substitute affidavit may be filed before expiration of the grace period for no fee, or after expiration of the grace period with the deficiency surcharge. See TMEP §1604.04 regarding the deadlines for filing §8 affidavits, and TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

*Date of Execution Omitted.* If the §8 affidavit is signed, but the date of execution is omitted, the examiner must require that the owner of the registration set forth the date of execution for the record. If the affidavit was executed within the relevant filing period, no deficiency fee is required. If there are no other outstanding issues, the owner may provide the examiner with the date by telephone; and the examiner must make an appropriate note to file. If the affidavit was not executed within the relevant filing period, the affidavit is deficient, and the owner must submit a substitute or supplemental affidavit, as discussed above.

### **1604.08(c)      Signature of Electronically Transmitted Affidavit or Declaration**

See TMEP §804.05 regarding signature of an affidavit or declaration filed through TEAS.

### **1604.08(d)      Form and Wording of Verification**

The format of the verification may be: (1) the classical form for verifying, which includes an oath (jurat) (see TMEP §804.01(a)); or (2) a declaration under 37 C.F.R. §2.20 or 28 U.S.C. §1746 instead of an oath (see TMEP §804.01(b)).

### **1604.09            Goods and/or Services Set Forth in §8 Affidavit or Declaration**

#### **1604.09(a)      Goods and/or Services Must be Specified or Expressly Incorporated by Reference**

Under 15 U.S.C. §1058(b) and 37 C.F.R. §2.161(e)(1), the affidavit or declaration must specify the goods/services recited in the registration on or in connection with which the mark is in use in commerce, and/or the goods/services for which excusable nonuse is claimed. See TMEP §1604.10 regarding use in commerce and TMEP §1604.11 regarding excusable nonuse. The affidavit or declaration may incorporate by reference the identification set forth in the registration certificate (*e.g.*, “all goods/services listed in the registration” or “all goods/services listed in the registration

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

except... [specifying the goods/services not covered by the affidavit or declaration]”). Incorporation by reference is recommended, to avoid inadvertent omissions.

If the owner is alleging use with respect to some of the goods/services and excusable nonuse for other goods/services, the owner must clearly indicate which goods/services are in use and which goods/services are not in use.

### **1604.09(b) Deletion of Goods and/or Services**

If the owner of the registration intends to delete goods/services from the registration, this should be expressly stated in the affidavit or declaration. 37 C.F.R. §2.161(e)(2).

### **1604.09(c) Failure to List All Goods and/or Services Recited in Registration**

An affidavit or declaration that fails to list or incorporate by reference all the goods/services to which the affidavit pertains, and does not include a statement of intent to delete the omitted goods/services, is deficient.

If the owner did not intend to delete the goods/services, the owner may file a substitute or supplemental affidavit or declaration adding the omitted goods/services. The owner must verify that the mark was in use in commerce on or in connection with the goods/services during the relevant filing period specified in §8 of the Act. This substitute affidavit may be filed before expiration of the relevant deadline set forth in §8 of the Act for no fee, or after expiration of the deadline set forth in §8 of the Act with the deficiency surcharge required by §8(c)(2) of the Act. See TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

If the owner does not file a substitute or supplemental affidavit or declaration that the mark was in use in commerce on or in connection with the omitted goods/services within the period for response to the Office action (see TMEP §1604.16), the omitted goods/services will be deleted from the registration.

### **1604.09(d) New Goods and/or Services Cannot be Added**

Goods and/or services that are not listed in the registration may not be set forth in the §8 affidavit.

### **1604.10 Use in Commerce**

The §8 affidavit must state that the mark is in use in commerce on or in connection with the goods and/or services listed in the registration, unless excusable nonuse is claimed. 37 C.F.R. §2.161(f)(1). See TMEP §1604.11

## REGISTRATION AND POST REGISTRATION PROCEDURES

regarding excusable nonuse. The §8 affidavit does not have to specify the type of commerce (*e.g.*, interstate) in which the mark is used. The USPTO presumes that someone who states that the mark is in use in commerce is stating that the mark is in use in a type of commerce that Congress can regulate, unless there is contradictory evidence in the record. See TMEP §§901 *et seq.* regarding use in commerce.

A §8 affidavit that does not state that the mark is in use in commerce is deficient. The owner must submit a substitute affidavit or declaration stating that the mark was in use in commerce on or in connection with the goods and/or services listed in the registration during the relevant period specified in §8 of the Trademark Act, as follows:

- (1) If the §8 affidavit was filed during the sixth year after the date of registration or publication under §12(c) of the Act, the substitute affidavit must state that the mark was in use in commerce on or in connection with the goods/services before the expiration of the sixth year after the date of registration or publication under §12(c), if accurate; or
- (2) If the §8 affidavit was filed within one year before the end of any ten-year period after the date of registration, the substitute affidavit must state that the mark was in use in commerce on or in connection with the goods/services within one year before the end of the ten-year period after the date of registration, if accurate; or
- (3) If the §8 affidavit was filed during the grace period, the substitute affidavit must state that the mark was in use in commerce on or in connection with the goods/services before the expiration of the grace period, if accurate.

If the §8 affidavit was filed during the relevant period specified in §8(a) or §8(b) of the Act (*i.e.*, during the sixth year after the date of registration or publication under §12(c) of the Act, or within one year before the end of any ten-year period after the date of registration), the substitute affidavit may be filed before expiration of the relevant period for no fee, or after expiration of the relevant period with the deficiency surcharge required under §8(c)(2) of the Act. If the §8 affidavit was filed during the grace period, the substitute affidavit may be filed before expiration of the grace period for no fee, or after expiration of the grace period with the deficiency surcharge. See TMEP §1604.04 regarding the deadlines for filing §8 affidavits, and TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

While a substitute affidavit may be filed after the expiration of the period specified in §8 of the Act, the substitute affidavit must attest to use within the time period specified in §8 of the Act. Therefore, if the substitute affidavit does not state that the mark was in use in commerce on or in connection with



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

the goods/services within the relevant period specified in §8 of the Act, the USPTO will not accept the §8 affidavit, and the registration will be cancelled.

### 1604.11 “Excusable Nonuse” of Mark

*Extract from 37 C.F.R. §2.161. A complete affidavit or declaration under section 8 of the Act must:*

...

(f) . . .

*(2) If the registered mark is not in use in commerce on or in connection with all the goods or services in the registration, set forth the date when use of the mark in commerce stopped and the approximate date when use is expected to resume; and recite facts to show that nonuse as to those goods or services is due to special circumstances that excuse the nonuse and is not due to an intention to abandon the mark[.]*

The purpose of Section 8 of the Trademark Act is to remove from the register those registrations which have become deadwood. See *Morehouse Manufacturing Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (C.C.P.A. 1969). It is not intended, however, to cancel registrations due to a temporary interruption in the use of the mark due to circumstances beyond the control of the owner of the registration. *In re Moorman Mfg. Co.*, 203 USPQ 712 (Comm’r Pats. 1979). Thus, if the mark is not in use in commerce but the owner believes the registration should not be cancelled, the owner may file an affidavit or declaration showing that nonuse is due to special circumstances that excuse the nonuse, and is not due to any intention to abandon the mark. 15 U.S.C. §1058(b)(2). *Ex parte Kelley-How-Thomson Co.*, 118 USPQ 40 (Comm’r Pats. 1958).

### **Requirements for Affidavit**

Since "showing" implies proof, merely stating that special circumstances exist and there is no intention to abandon the mark is not sufficient. *In re Conusa Corp.*, 32 USPQ2d 1857 (Comm’r Pats. 1993); *In re Moorman Mfg. Co.*, *supra*; *Ex parte Astra Pharmaceutical Products, Inc.*, 118 USPQ 368 (Comm’r Pats. 1958) ; *Ex parte Denver Chemical Mfg. Co.*, 118 USPQ 106 (Comm’r Pats. 1958). The affidavit must state when use in commerce stopped and give the approximate date when use is expected to resume. 37 C.F.R. §2.161(f)(2). It should also specify the reason for nonuse, the specific steps being taken to put the mark back in use, and any other relevant facts.

Sufficient facts must be set forth to demonstrate clearly that nonuse is due to some special circumstance beyond the owner's control or "forced by outside causes." *In re Conusa Corp.*, *supra*; *In re Moorman Mfg. Co.*, *supra*; *Ex parte Kelley-How-Thomson Co.*, *supra*.

## REGISTRATION AND POST REGISTRATION PROCEDURES

The goods/services for which excusable nonuse is claimed must be specified. See TMEP §1604.09 *et seq.* regarding proper specification of the goods and services.

In a multi-class application, there must be a recitation of facts as to nonuse for each class to which the affidavit pertains, or it must be clear that the facts recited apply to all the classes.

### ***Presumption of Abandonment***

If the mark has not been in use for three consecutive years and the owner has done nothing to try to resume use of the mark, the Office may presume that the owner has abandoned the mark. See 15 U.S.C. §1127; *Stromgren Supports Inc. v. Bike Athletic Co.*, 43 USPQ2d 1100 (TTAB 1997).

### ***Examples of Special Circumstances That Excuse Nonuse***

In addition to a showing that there is no intention to abandon the mark, the owner must show that nonuse is due to special circumstances beyond the owner's control that excuse nonuse. The following examples provide general guidelines as to what is considered to be a special circumstance that excuses nonuse:

- *Decreased Demand.* Decreased demand for the product sold under the mark, resulting in its discontinuance for an indefinite period, does not excuse nonuse. The purpose of the affidavit requirement is to eliminate registrations of marks that are in nonuse due to ordinary changes in social or economic conditions. See *In re Conusa Corp.*, *supra*; *In re Parmalat S.p.A.*, 32 USPQ2d 1860 (Comm'r Pats. 1991); *Ex parte Astra Pharmaceutical Products, Inc.*, *supra*; *Ex parte Denver Chemical Mfg. Co.*, *supra*.
- *Trade Embargo or Other Circumstance Beyond Owner's Control.* Nonuse may be considered excusable where the owner of the registration is willing and able to continue use of the mark in commerce, but is unable to do so due to a trade embargo.
- *Sale of a Business.* Temporary nonuse due to the sale of a business might be considered excusable.
- *Retooling.* The mark might be out of use temporarily because of an interruption of production for retooling of a plant or equipment, with production possible again at a scheduled time. However, nonuse due to retooling is excusable only if the owner shows that the plant or equipment being retooled was essential to the production of the goods and that alternative equipment was unavailable on the market. *In re New England Mutual Life Insurance Co.*, 33 USPQ2d 1532 (Comm'r Pats. 1991).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- *Orders on Hand.* If the product is of a type that cannot be produced quickly or in large numbers (e.g., airplanes), yet there are orders on hand and activity toward filling them, nonuse might be considered excusable.
- *Illness, Fire and Other Catastrophes.* Illness, fire and other catastrophes may create situations of temporary nonuse, with the owner being able to outline arrangements and plans for resumption of use. Such nonuse is often excusable. However, a mere statement that the owner is ill and cannot conduct his or her business will not in itself excuse nonuse; the owner must show that the business is an operation that could not continue without his or her presence. *New England Mutual Life Insurance, supra.*
- *Negotiations With Distributors.* A recitation of efforts to negotiate agreements that would allow for resumption of use of the mark, or a statement that samples of the goods have been shipped to potential distributors, may establish lack of intention to abandon the mark, but does not establish the existence of special circumstances that excuse the nonuse. *In re Parmalat, supra; In re Moorman, supra.*
- *Use in Foreign Country.* Use of the mark in a foreign country has no bearing on excusable nonuse of a mark in commerce that can be regulated by the United States Congress. *In re Conusa, supra.*
- *Use of Mark on Different Goods/Services.* Use of the mark on goods/services other than those recited in the registration does not establish either special circumstances or lack of intention to abandon the mark. *Ex parte Kelley-How-Thomson Co., supra.*
- *Use of Mark in Another Form.* Use of a mark as an essential part of a materially different composite mark does not excuse the failure to use the mark at issue. *In re Continental Distilling Corp., 254 F.2d 139, 117 USPQ 300 (C.C.P.A. 1958).*

### ***Supplementary Evidence or Explanation***

If the Post Registration examiner determines that the facts set forth do not establish excusable nonuse, the owner may file supplementary evidence or explanation, within the response period set forth in the Office action. If the affidavit included a claim of excusable nonuse when filed, no deficiency surcharge will be required for supplementing this claim with additional evidence or an explanation.

## REGISTRATION AND POST REGISTRATION PROCEDURES

### **1604.12 Specimen Showing Current Use of Mark in Commerce**

#### **1604.12(a) Specimen for Each Class Required**

A §8 affidavit must include a specimen or facsimile showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed. 15 U.S.C. §1058(b); 37 C.F.R. §2.161(g).

See TMEP §§904.04 *et seq.* regarding trademark specimens, and TMEP §§1301.04 *et seq.* regarding service mark specimens.

The specimen must show use of essentially the same mark as the mark shown in the registration, and must be used on or in connection with the goods/services listed in the registration. A specimen that shows use of a materially different mark (see TMEP §1604.13), or shows use of the mark on other goods or services, is unacceptable. An affidavit or declaration that does not include an acceptable specimen for each class of goods/services is deficient.

If the specimen is deficient, the owner must file a substitute specimen, together with an affidavit or declaration that the substitute specimen was in use in commerce on or in connection with the goods or services during the relevant period specified in §8 of the Act. See TMEP §1604.12(c) regarding substitute specimens.

Under 37 C.F.R. §2.161(g)(2), the specimen must be flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. If a specimen exceeds these size requirements, the USPTO will create a facsimile of the specimen that meets the requirements of the rule (*i.e.*, is flat and no larger than 8½ inches wide by 11.69 inches long), put it in the record, and destroy the original bulky specimen. If the copy of the specimen created by the USPTO does not adequately depict the mark, the Post Registration examiner will require a substitute specimen that meets the size requirements of the rule, and an affidavit or declaration verifying the use of the substitute specimen.

The USPTO will not return specimens filed with a §8 affidavit or declaration.

#### **1604.12(b) Specimens in Electronically Filed Affidavits**

If the owner files the §8 affidavit through TEAS, the owner must submit a digitized image in .jpg format. 37 C.F.R. §2.161(g)(3).

Sometimes there is no visible specimen in the record due to a technical problem. In this situation, the Post Registration examiner should ask the owner to submit by mail or fax: (1) the specimen (or a facsimile of the specimen) that was attached to the original electronically filed affidavit; and (2) a statement by the person who transmitted the affidavit to the USPTO that

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

the specimen being submitted by mail (or fax) is a true copy of the specimen submitted with the electronically filed affidavit. This statement does not have to be verified. Alternatively, the owner may submit a new specimen, together with an affidavit or declaration that the substitute specimen was in use in commerce on or in connection with the goods/services during the relevant period specified in §8 of the Act. No deficiency surcharge is required. See TMEP §1604.12(c) regarding the requirements for an affidavit supporting use of substitute specimens.

### **1604.12(c) Substitute Specimens**

If a specimen for any class is omitted or is deficient, the owner must file a substitute specimen, together with an affidavit or declaration that the substitute specimen was in use in commerce on or in connection with the goods or services during the relevant period specified in §8 of the Act, as follows:

- (1) If the §8 affidavit was filed during the sixth year after the date of registration or publication under §12(c) of the Act, the affidavit supporting use of the substitute specimen must state that the substitute specimen was in use in commerce before the expiration of the sixth year after the date of registration or publication under §12(c), if accurate; or
- (2) If the §8 affidavit was filed within one year before the end of any ten-year period after the date of registration, the affidavit supporting use of the substitute specimen must state that the substitute specimen was in use in commerce within one year before the end of the ten-year period after the date of registration, if accurate; or
- (3) If the §8 affidavit was filed during the grace period, the affidavit supporting use of the substitute specimen must state that the substitute specimen was in use in commerce before the expiration of the grace period, if accurate.

If the §8 affidavit was filed during the relevant period specified in §§8(a) or 8(b) of the Act (*i.e.*, during the sixth year after the date of registration or publication under §12(c) of the Trademark Act, or within one year before the end of any ten-year period after the date of registration), the substitute specimen may be filed before expiration of the relevant period for no fee, or after expiration of the relevant period with the deficiency surcharge required under §8(c)(2) of the Act. If the §8 affidavit was filed during the grace period, the substitute specimen may be filed before expiration of the grace period for no fee, or after expiration of the grace period with the deficiency surcharge. See TMEP §1604.04 regarding the deadlines for filing §8 affidavits, and TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

## REGISTRATION AND POST REGISTRATION PROCEDURES

While a substitute specimen and supporting affidavit may be filed after the expiration of the period specified in §8 of the Act, the supporting affidavit must attest to use of the specimen within the time period specified in §8 of the Act. Therefore, if the affidavit supporting the substitute specimen does not state that the specimen was in use in commerce prior to the end of the relevant period specified in §8 of the Act, the §8 affidavit will not be accepted, and the registration will be cancelled as to any class for which a proper specimen was not provided.

### **1604.13 Differences in the Mark As Used on the Specimen and the Mark as Registered**

The mark to which the §8 affidavit pertains must be essentially the same as the mark that appears in the registration. Where the specimen reflects a change in the mark since the registration issued, acceptance of the affidavit will depend on the degree of change. A *material* alteration of the mark will result in refusal of the affidavit on the ground that the registered mark is no longer in use. *In re International Nickel Co., Inc.*, 282 F.2d 952, 127 USPQ 331 (C.C.P.A. 1960); *In re Continental Distilling Corp.*, 254 F.2d 139, 117 USPQ 300 (C.C.P.A. 1958); *Ex parte Richards*, 153 USPQ 853 (Comm'r Pats. 1967). See also *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986); *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984).

Mere changes in background or styling, or modernization, are not ordinarily considered to be material changes in the mark. See *Ex parte Petersen & Pegau Baking Co.*, 100 USPQ 20 (Comm'r Pats. 1953) (change in matter determined to be mere background and type face held not a material alteration of "PETER PAN" mark). Whether the change in a mark as used on the specimen is a material change is a question of fact that the Post Registration examiner must determine on a case-by-case basis.

Generally, the standard used to determine whether a change is material under §8 is the same as the standard used to determine whether the mark in a registration may be amended under 15 U.S.C. §1057(e). If the mark could be amended under §7(e) because the character of the mark had not been materially altered, then the specimen filed with the §8 affidavit should be accepted. In determining whether a change constitutes a material alteration, the USPTO will always compare the mark in the specimen to the mark as originally registered. See TMEP §§807.14 *et seq.* and 1609.02(a) for additional information about material alteration.

However, where the registered mark is currently used as one of several elements in a composite mark, the decision as to whether to accept the specimen requires consideration of whether the registered mark makes an impression apart from the other elements of the composite mark. If the display of the composite is such that the essence of the registered mark

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

makes a separate impression, then the specimen may be sufficient for purposes of the §8 requirement. In many cases, word elements are severable from design elements, because words tend to dominate in forming a commercial impression. *In re DeWitt International Corporation*, 21 USPQ2d 1620 (Comm'r Pats. 1991). If the mark, as used on the §8 specimen, creates a separate impression apart from any other material on the specimen, then the specimen may be accepted as evidence of current use of the registered mark.

If the examiner determines that the mark on the specimen is a material alteration of the registered mark, a substitute specimen may be filed. If the substitute specimen is filed after expiration of the relevant filing period specified in §8 of the Act, the owner must pay the deficiency surcharge required by §8(c)(2) of the Act and 37 C.F.R. §2.6. See TMEP §1604.12(c) regarding substitute specimens, and 37 C.F.R. §2.164 and TMEP §§1604.17 *et seq.* regarding the procedures for correcting deficiencies in a §8 affidavit.

### **1604.13(a) Possible Amendment of Mark in Registration**

If the USPTO accepts the §8 affidavit, and there is a difference between the mark on the specimen filed with the affidavit and the mark in the registration, the mark as originally registered remains the mark of record. If the owner wants to change the mark in the registration to agree with the mark currently used, the owner must file a separate request for amendment under §7(e) of the Act, and pay the fee required by 37 C.F.R. §2.6. See *Ex parte Petersen & Pegau Baking Co.*, 100 USPQ 20 (Comm'r Pats. 1953). See TMEP §§1609.02 *et seq.* regarding amendment of a registered mark under §7(e).

Amending the mark in a registration under §7(e) to agree with the mark as shown on a §8 specimen is not mandatory.

### **1604.14 Designation of Domestic Representative by Foreign Owner**

Under 15 U.S.C. §1058(f) and 37 C.F.R. §2.161(h), if the owner of the registration is not domiciled in the United States, the affidavit or declaration may include the name and address of a United States resident upon whom notices or process in proceedings affecting the registration may be served. The USPTO encourages parties who do not reside in the United States to designate domestic representatives. To expedite processing, the Office recommends that designations of domestic representative be filed through TEAS, at <http://www.uspto.gov/teas/index.html>. See TMEP §604.

## REGISTRATION AND POST REGISTRATION PROCEDURES

### 1604.15 Office Actions and Notices Regarding Affidavit

Upon receipt of a §8 affidavit, the prosecution history of the registration in the USPTO's automated database is updated to indicate that the affidavit has been filed. This information is reflected in TRAM and TARR.

When a §8 affidavit is filed through TEAS, the USPTO immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission. This confirmation is evidence of filing should any question arise as to the filing date of the affidavit. If a §8 affidavit is filed on paper, no acknowledgment of receipt of the affidavit is sent before it is examined, unless the applicant includes a stamped, self-addressed postcard with the affidavit (see TMEP §303.02(c)).

If, on examination, the USPTO determines that the affidavit or declaration is acceptable, the USPTO sends a notice of acceptance. If the affidavit or declaration is not acceptable, the USPTO issues an action stating the reasons for refusal. 37 C.F.R. §2.163.

The propriety of the original registration is not re-examined in connection with the affidavit under §8.

### 1604.16 Response to Office Action

Under 37 C.F.R. §2.163(b), a response to a refusal must be filed within six months of the mailing date of the Office action, or before the end of the relevant filing period set forth in §8(a) or §8(b) of the Act, whichever is later. If no response is received within that time, the registration will be cancelled.

The owner may file a petition to the Director under 37 C.F.R. §§2.146(a)(3) and 2.146(a)(5) to waive 37 C.F.R. §2.163(b) so that a late response to an Office action can be accepted. However, the Director will waive a rule only in an extraordinary situation, where justice requires and no other party is injured. See TMEP §1708. The failure to receive an Office action has been found to be an extraordinary circumstance that warrants a waiver of 37 C.F.R. §2.163(b). The "unintentional delay" standard of 37 C.F.R. §2.66 does not apply to the failure to respond to an Office action issued in connection with a §8 affidavit. TMEP §1714.01(f)(ii).

See TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

### 1604.17 Correction of Deficiencies in §8 Affidavit

*37 C.F.R. §2.164. Correcting deficiencies in affidavit or declaration.*

*(a) If the owner of the registration files an affidavit or declaration within the time periods set forth in section 8 of the Act, deficiencies may be corrected, as follows:*



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

(1) *Correcting deficiencies in affidavits or declarations timely filed within the periods set forth in sections 8(a) and 8(b) of the Act. If the owner timely files the affidavit or declaration within the relevant filing period set forth in section 8(a) or section 8(b) of the Act, deficiencies may be corrected before the end of this filing period without paying a deficiency surcharge. Deficiencies may be corrected after the end of this filing period with payment of the deficiency surcharge required by section 8(c)(2) of the Act and §2.6.*

(2) *Correcting deficiencies in affidavits or declarations filed during the grace period. If the affidavit or declaration is filed during the six-month grace period provided by section 8(c)(1) of the Act, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge. Deficiencies may be corrected after the expiration of the grace period with payment of the deficiency surcharge required by section 8(c)(2) of the Act and §2.6.*

(b) *If the affidavit or declaration is not filed within the time periods set forth in section 8 of the Act, or if it is filed within that period by someone other than the owner, the registration will be cancelled. These deficiencies cannot be cured.*

### **1604.17(a) Correcting Deficiencies in Affidavits or Declarations Timely Filed Within the Periods Set Forth in §§8(a) and 8(b) of the Act**

If the owner of the registration timely files the affidavit or declaration during the periods set forth in §§8(a) and 8(b) of the Act (*i.e.*, during the sixth year after the date of registration or publication under §12(c) of the Trademark Act, or within one year before the end of any ten-year period after the date of registration), deficiencies may be corrected within the relevant period without paying a deficiency surcharge. Deficiencies may be corrected after the expiration of the relevant period with payment of the deficiency surcharge required by §8(c)(2) of the Act. 37 C.F.R. §2.164(a)(1).

Any deficiency must be cured within the set period for response to the Post Registration examiner's Office action, *i.e.*, within six months of the mailing date of the action, or before the end of the relevant filing period set forth in §8 of the Act, whichever is later. 37 C.F.R. §2.163(b). See TMEP §1604.16.

### **1604.17(b) Correcting Deficiencies in Affidavits or Declarations Filed During the Grace Period**

If the owner of the registration files the affidavit or declaration during the six-month grace period under §8(c)(1) of the Act, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge, or after the expiration of the grace period with the deficiency surcharge required by §8(c)(2) of the Act. 37 C.F.R. §2.164(a)(2).

## REGISTRATION AND POST REGISTRATION PROCEDURES

Any deficiency must be cured within six months of the mailing date of the Post Registration examiner's Office action. 37 C.F.R. §2.163(b). See TMEP §1604.16.

### **1604.17(c) Defects That Cannot be Cured After Expiration of the Grace Period**

The registration will be cancelled if an affidavit or declaration of use or excusable nonuse is not filed before expiration of the grace period set forth in §8(c)(1) of the Act, or if the affidavit or declaration is filed by someone other than the current owner of the registration. 37 C.F.R. §2.164(b). Untimely filing and filing in the name of the wrong party cannot be cured after expiration of the grace period, even with a deficiency surcharge. *In re Media Central IP Corp.*, 65 USPQ2d 1637 (Dir USPTO 2002); *In re ACE III Communications, Inc.*, 62 USPQ2d 1049 (Dir USPTO 2001). See TMEP §1604.04 regarding the deadline for filing the affidavit, and TMEP §§1604.07 *et seq.* regarding ownership.

### **1604.18 Petition Under 37 C.F.R. §2.146**

The action of an examiner on a §8 affidavit may not be appealed to the Trademark Trial and Appeal Board, but the owner may file a petition for review of the examiner's action under 37 C.F.R. §§2.146(a)(2) and 2.165(b). A petition fee is required by 37 C.F.R. §§2.6 and 2.146(c). See TMEP Chapter 1700 regarding petitions.

### **1604.18(a) Response to Examiner's Refusal Required Before Petition**

A response to the examiner's initial refusal to accept an affidavit or declaration is required before filing a petition, unless the examiner directs otherwise or there is no time remaining to respond to the examiner's refusal. 37 C.F.R. §2.165(a).

If the examiner continues the refusal to accept the affidavit or declaration, the owner may file a petition for review of the examiner's action under 37 C.F.R. §2.146(a)(2) within six months of the mailing date of the action continuing the refusal. If no petition is filed within six months, the registration will be cancelled. 37 C.F.R. §2.165(b).

### **1604.18(b) Decision on Petition is Final Action of the Office**

The decision on a petition under 37 C.F.R. §2.146 is the final action of the USPTO. In the absence of a request for reconsideration (see TMEP §1604.18(c)), or an appeal to an appropriate court (see TMEP §1604.18(d))

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

within two months of the mailing date of the decision on petition, the registration will be cancelled.

### **1604.18(c) Request for Reconsideration of Denial of Petition**

Under Trademark Rule 2.146(j), if a petition is denied, the petitioner may file a request for reconsideration within two months of the mailing date of the decision denying the petition. A second petition fee must be paid with the request for reconsideration. See TMEP §1705.08 regarding requests for reconsideration of petition decisions.

### **1604.18(d) Appeal to Federal Court**

The owner of the registration may appeal to the United States Court of Appeals for the Federal Circuit or commence a civil action for review of the decision denying a petition. 15 U.S.C. §§1071(a)(1) and (b)(1); 37 C.F.R. §§2.145(a) and 2.145(c).

The deadline for filing an appeal or commencing a civil action is two months from the mailing date of the decision on petition. 15 U.S.C. §§1071(a)(2) and (b)(1); 37 C.F.R. §2.145(d)(1). Under 37 C.F.R. §2.145(d)(2), one day is added to any two-month period that includes February 28.

Under 37 C.F.R. §2.165(c), a decision on petition is necessary before the owner can file an appeal or commence a civil action in any court.

### **1604.19 Section 8 Affidavit or Declaration of Use or Excusable Nonuse Combined with Renewal Application**

Under 37 C.F.R. §2.166, an affidavit or declaration under §8 of the Act and a renewal application under §9 of the Act may be combined into a single document, if the document meets the requirements of both §§8 and 9 of the Act. 37 C.F.R. §2.166.

The filing fee for the combined §8 and §9 filing is the sum of the cost of the individual filings. For example, if the filing fee for the §8 affidavit is \$100 per class, and the filing fee for the renewal application is \$400 per class, then the filing fee for the combined §8 and §9 document is \$500 per class.

If the combined §8 and §9 document is filed during the grace period, the filing fees per class and the grace period surcharge per class must be paid for *both* the §8 affidavit and the §9 renewal application.

*Example:* A registration expires on January 19, 2005. A combined §8 and §9 document is filed January 21, 2005, during the six-month grace period. The proper fees are as follows:  
(1) filing fee for the §8 affidavit, per class; (2) grace period surcharge for the §8 affidavit, per class; (3) filing fee for the §9

## REGISTRATION AND POST REGISTRATION PROCEDURES

renewal application, per class; *and* (4) grace period surcharge for the §9 renewal application, per class.

Failure to include the proper fees is a deficiency that may require a deficiency surcharge. See TMEP §§1604.17 *et seq.* and 1606.13 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

Only a single deficiency surcharge is required for curing one or more deficiencies in a combined §8 and §9 filing, even if both the §8 affidavit and the §9 renewal application are deficient. Similarly, only a single deficiency surcharge is required to correct several deficiencies within one document.

To expedite processing, it is recommended that the combined §8 and §9 filing be submitted through TEAS, at <http://www.uspto.gov/teas/index.html>. When the combined filing is submitted electronically, the USPTO immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission. This confirmation is evidence of filing should any question arise as to the filing date. See TMEP §301 for additional information about electronic filing.

Alternatively, the owner of the registration can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed form that can be mailed, faxed or hand-delivered to the USPTO.

See TMEP §1605.05 regarding a combined filing under §§8 and 15 of the Act.

### **1605 Affidavit of Incontestability Under §15**

Section 15 of the Trademark Act, 15 U.S.C. §1065, provides a procedure by which the exclusive right to use a registered mark in commerce on or in connection with the goods or services covered by the registration can become “incontestable,” if the owner of the registration files an affidavit stating that the mark has been in continuous use in commerce for a period of five years after the date of registration. To expedite processing, it is recommended that the owner file the §15 affidavit through TEAS, available at <http://www.uspto.gov>. See TMEP §1605.02.

Under §33(b) of the Act, 15 U.S.C. §1115(b), if the right to use the mark has become incontestable under §15, then the registration is conclusive evidence of the validity of the registered mark and its registration, of the registrant’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce, subject to certain defenses and exceptions. Sections 15 and 33(b) apply only to registrations issued on the Principal Register.

Filing an affidavit of incontestability under §15 of the Trademark Act (“§15 affidavit”) is optional. An eligible registrant may choose to claim the benefits of incontestability and file an appropriate affidavit, or may elect to retain the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

registration without those benefits. The requirements for maintaining and renewing a federal registration are not affected.

The USPTO does not “accept” §15 affidavits. *Arman’s Systems, Inc. v. Armand’s Subway, Inc.*, 215 USPQ 1048, 1050 n.2. (TTAB 1982). The Post Registration examiner reviews the affidavit to determine whether it is consistent with the requirements of the statute and rules (e.g., whether it is signed, whether it was filed at an appropriate time, and whether the §15 claims are properly set forth).

When a §15 affidavit complies with the requirements of the statute and rules, the USPTO updates its records to acknowledge receipt of the affidavit and sends a notice of acknowledgment to the owner of the registration. Acknowledging receipt of the affidavit provides notice to the public that an affidavit of incontestability has been filed; it is not a determination by the USPTO that the registration is in fact incontestable. The question of whether the registration is incontestable is determined by a court in a proceeding involving the mark.

If the §15 affidavit does not comply with the statute and rules, the USPTO issues a written action notifying the registrant of any inconsistency or error, but does not require correction. The USPTO does *not* update its records to acknowledge receipt of a noncompliant affidavit. The registrant has the option of filing a new §15 affidavit, with a new filing fee.

A fee is required for each class in the registration to which the §15 affidavit or declaration pertains. 37 C.F.R. §§2.6 and 2.167(g). If insufficient fees are included with the affidavit, the examiner will issue an Office action allowing applicant additional time to submit the required fees. 37 C.F.R. §2.167(g).

The limitation of grounds that a third party can raise in a petition to cancel a registered mark under 15 U.S.C. §1064 filed more than five years from the date of registration does *not* depend on the filing of a §15 affidavit. TMEP §1605.06.

See TMEP §1605.05 regarding a combined affidavit or declaration under §§8 and 15 of the Act, and TMEP §1216.02 regarding the effect of “incontestability” in *ex parte* examination.

### **1605.01 Registrations to Which §15 Affidavit Pertains**

The provisions of §15 of the Trademark Act apply only to registrations issued on the Principal Register under the Act of 1946 and to registrations issued under the Acts of 1905 and 1881 that have been “published” under §12(c) of the Act. See TMEP §1603 regarding §12(c).

## REGISTRATION AND POST REGISTRATION PROCEDURES

A §15 affidavit may be filed for a registered extension of protection of an international registration to the United States. Section 73 of the Trademark Act, 15 U.S.C. §1141m.

Section 15 affidavits may not be filed for marks registered on the Supplemental Register of the Act of 1946, marks registered under the Act of 1920, or marks registered under the Acts of 1905 and 1881 for which the benefits of the Act of 1946 have not been claimed under §12(c). If a §15 affidavit is filed for a registration that is not eligible for the benefits of §15, the USPTO will not review it and will refund the filing fee.

### **1605.02 Form for Filing Affidavit of Incontestability**

To expedite processing, it is recommended that the owner file the §15 affidavit through TEAS, available at <http://www.uspto.gov/teas/index.html>. When the affidavit is submitted electronically, the USPTO immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission. This confirmation is evidence of filing should any question arise as to the filing date. See TMEP §301 for additional information about electronic filing.

Alternatively, the owner can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed form that can be mailed, faxed or hand-delivered to the USPTO.

### **1605.03 Time for Filing Affidavit of Incontestability**

A §15 affidavit may not be filed until the federally registered mark has been in continuous use in commerce for at least five consecutive years after the date of registration. This may be any five-year period after the date of registration for marks registered under the Act of 1946, or after the date of publication under §12(c) for marks registered under the Acts of 1905 and 1881.

The registrant may file the affidavit within one year after the five-year period that is selected. 37 C.F.R. §2.167(f). The affidavit must be both executed and filed within that one-year period. If the affidavit is filed too early, the USPTO will not review it and will refund the filing fee. A new affidavit with fee can be submitted during the statutory filing period.

Under 37 C.F.R. §2.195(a)(2), an affidavit filed through TEAS is considered to have been filed on the date the USPTO receives the transmission, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See TMEP §301 for more information about electronic filing.

If the affidavit is filed on paper, the owner may use certificate of mailing or certificate of facsimile transmission procedures to avoid lateness. See TMEP §§305.02 and 306.05.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

See TMEP §1605.05 regarding a combined affidavit under §§8 and 15 of the Act.

### **1605.04 Requirements for Affidavit or Declaration of Incontestability**

Section 15 of the Act refers to the affidavit or declaration merely as “setting forth” the specified information. See 15 U.S.C. §1065(3). Therefore, no showing or proof beyond the owner’s verified statement is required.

*Must be Filed by Owner.* In order to be effective, the §15 affidavit or declaration must be filed by the person who is the owner of the registration at the time the affidavit is filed. If the affidavit was filed by the wrong party, the true owner may file a new affidavit, with a new filing fee.

*Fee.* A fee is required for each class in the registration to which the §15 affidavit or declaration pertains. See 37 C.F.R. §§2.6 and 2.167(g). If insufficient fees are included with the affidavit, the examiner will issue an Office action allowing applicant additional time to submit the required fees. 37 C.F.R. §2.167(g).

*Goods/Services Must be Recited.* The §15 affidavit must specify the goods or services recited in the registration on or in connection with which the mark has been in continuous use for the five-year period after the date of registration or publication under §12(c) and is still in use in commerce. 15 U.S.C. §1065(3); 37 C.F.R. §2.167(c). More than one affidavit may be filed at different times for different goods/services in the same registration.

*Mark Must be In Use in Commerce.* Regardless of the basis for registration, the use on which the §15 affidavit is based must be use in commerce. This applies to foreign as well as domestic registrants. It is not necessary to specify the type of commerce (e.g., interstate) in which the mark is used. The USPTO presumes that someone who states that the mark is in use in commerce is stating that the mark is in use in a type of commerce that the U.S. Congress can regulate, unless there is contradictory evidence in the record. See TMEP §§901 *et seq.* regarding use in commerce.

*No Adverse Decision or Pending Proceeding Involving Rights in the Mark.* The §15 affidavit must state that there has been no final decision adverse to the owner’s claim of ownership of the mark for the goods or services, or to the owner’s right to register the mark or to keep the mark on the register. It must also state that there is no proceeding involving these rights pending in the USPTO or in a court and not finally disposed of. 15 U.S.C. §§1065(1) - 1065(3); 37 C.F.R. §§2.167(d) and (e). If the USPTO finds facts contrary to either of the foregoing statements, the USPTO will not acknowledge receipt of the §15 affidavit. See TMEP §1605. (The USPTO does not consider a proceeding involving the mark in which the owner is the plaintiff, and there is no counterclaim involving the owner’s rights in the mark, to be a “proceeding

## REGISTRATION AND POST REGISTRATION PROCEDURES

involving these rights” that would preclude the filing or acknowledgment of a §15 affidavit.)

If the USPTO finds that there is a proceeding pending that involves the owner’s right to register the mark or to keep the mark on the register, the USPTO will not acknowledge the affidavit, even if the proceeding was instituted after the owner filed the §15 affidavit but before the affidavit was reviewed by the examiner. If a pending proceeding is later dismissed, the owner may file a new affidavit, with a new filing fee.

*Verification.* The §15 affidavit must be signed and verified (sworn to) or supported by a declaration under 37 C.F.R. §2.20 by a person properly authorized to sign on behalf of the owner of the registration. A “person who is properly authorized to sign on behalf of the owner” is: (1) a person with legal authority to bind the owner; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or (3) an attorney as defined in 37 C.F.R. §10.1(c) who has an actual written or verbal power of attorney or an implied power of attorney from the owner. Generally, the USPTO does not question the authority of the person who signs a §15 affidavit, unless there is an inconsistency in the record as to the signatory’s authority to sign.

See TMEP §§301 and 804.05 regarding signature of electronically filed affidavits or declarations.

*Affidavit May not be Amended or Corrected.* The owner may not amend or correct a §15 affidavit, but may file a new affidavit.

### **1605.05 Combining §15 Affidavit With §8 Affidavit**

Under 37 C.F.R. §2.168(a), the affidavit or declaration filed under §15 of the Act may be combined with the affidavit or declaration required by §8 of the Act, if the combined affidavit or declaration meets the requirements of both §§8 and 15.

The filing fee for the combined §8 and §15 affidavit or declaration is the sum of the cost of the individual filings. For example, if the filing fee for the §8 affidavit is \$100 per class, and the filing fee for the §15 affidavit is \$200 per class, then the filing fee for the combined affidavit or declaration under §§8 and 15 is \$300 per class.

If the combined §8 and §15 affidavit is filed during the §8 grace period, the grace period surcharge per class for the §8 affidavit must be paid. There is no grace period surcharge for a §15 affidavit.

If a combined §8 and §15 affidavit is filed, and the §8 affidavit is deficient, the deficiency may be corrected before expiration of the relevant deadline set forth in §8 of the Act for no fee, or after expiration of the relevant deadline



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

with the deficiency surcharge required by §8(c)(2) of the Act. See TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies in a §8 affidavit. There is no deficiency surcharge for a §15 affidavit.

To expedite processing, it is recommended that the owner file the combined §8 and §15 affidavit through TEAS, available at <http://www.uspto.gov/teas/index.html>. When the combined affidavit is submitted electronically, the USPTO immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission. This confirmation is evidence of filing should any question arise as to the filing date. See TMEP §301 for additional information about electronic filing. Alternatively, the owner can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed form that can be mailed, faxed or hand-delivered to the USPTO.

### **1605.06 Section 14 Limitation is Independent of §15 Affidavit**

Section 14 of the Trademark Act, 15 U.S.C. §1064, limits the grounds that a third party can raise in a petition to cancel a mark registered on the Principal Register when the petition is filed more than five years from the date of registration or publication under §12(c). This limitation of grounds does *not* depend on the filing of a §15 affidavit. *Trademark Trial and Appeal Board Manual of Procedure* ("TBMP") §307.02(b).

### **1606 Renewal of Registration Under Trademark Act §9**

*15 U.S.C. §1059. Renewal.*

*(a) Subject to the provisions of section 8, each registration may be renewed for periods of 10 years at the end of each successive 10-year period following the date of registration upon payment of the prescribed fee and the filing of a written application, in such form as may be prescribed by the Director. Such application may be made at any time within 1 year before the end of each successive 10-year period for which the registration was issued or renewed, or it may be made within a grace period of 6 months after the end of each successive 10-year period, upon payment of a fee and surcharge prescribed therefor. If any application filed under this section is deficient, the deficiency may be corrected within the time prescribed after notification of the deficiency, upon payment of a surcharge prescribed therefor.*

*(b) If the Director refuses to renew the registration, the Director shall notify the registrant of the Director's refusal and the reasons therefor.*

*(c) If the registrant is not domiciled in the United States the registrant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by*

## REGISTRATION AND POST REGISTRATION PROCEDURES

*leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Director.*

### **1606.01 Which Registrations Must be Renewed Under §9**

#### **1606.01(a) Registrations Based on Applications Under §1 or §44 Must Be Renewed Under §9**

Section 9 of the Trademark Act, 15 U.S.C. §1059, requires that registrations resulting from applications based on §1 or §44 of the Trademark Act be renewed periodically. See TMEP §§1606.02 *et seq.* for information about the requirements for renewal under §9.

#### **1606.01(b) Section 9 Does Not Apply to Extensions of Protection of International Registrations to the United States**

Section 9 of the Trademark Act does not apply to registered extensions of protection of international registrations to the United States. Renewal of international registrations must be made at the IB, in accordance with Article 7 of the Madrid Protocol. 37 C.F.R. §7.41(a). See TMEP §1614 for further information about renewal of international registrations.

#### **1606.01(c) Renewal of Registrations Issued Under Prior U.S. Trademark Acts Must Be Renewed Under §9**

An application for renewal of a registration issued under a prior Act, where required, must meet all the requirements of 15 U.S.C. §1059 and 37 C.F.R. §2.183. See TMEP §1602.02 regarding the renewal of registrations issued under the Acts of 1881 and 1905, and TMEP §1602.03 regarding the renewal of registrations issued under the Act of 1920.

### **1606.02 Requirements for Renewal Under §9**

*37 C.F.R. §2.183. Requirements for a complete renewal application.*

*A complete renewal application must include:*

- (a) A request for renewal of the registration, signed by the registrant or the registrant's representative;*
- (b) The fee required by §2.6 for each class;*
- (c) The additional fee required by §2.6 for each class if the renewal application is filed during the six-month grace period set forth in section 9(a) of*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*the Act;*

*(d) If the renewal application covers less than all the goods or services in the registration, a list of the particular goods or services to be renewed.*

*(e) If at least one fee is submitted for a multi-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. Additional fee(s) may be submitted if the requirements of §2.185 are met. If the required fee(s) are not submitted and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class.*

### **1606.03 Time for Filing §9 Renewal Application**

The application for renewal must be filed within one year before the expiration of the registration, or within the six-month grace period after the expiration of the registration with an additional grace period surcharge. If no renewal application is filed before the end of the grace period, the registration will expire. 15 U.S.C. §1059(a); 37 C.F.R. §2.182. See TMEP §§1602 *et seq.* as to the term of a registration.

A renewal application may be filed on the anniversary dates of the statutory period.

*Example:* For a registration issued on November 5, 1998, an application for renewal may be filed as early as November 5, 2007, and as late as November 5, 2008, before entering the six-month grace period.

Under 37 C.F.R. §2.195(a)(2), a renewal application filed through TEAS is considered to have been filed on the date the USPTO receives the transmission, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. When the renewal application is submitted electronically, the USPTO immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission. This confirmation is evidence of filing should any question arise as to the filing date. See TMEP §301 for additional information about electronic filing.

An application for renewal of a registration filed on paper is considered timely if it is mailed or transmitted by the due date with a certificate of mailing or facsimile transmission in accordance with 37 C.F.R. §2.197. See TMEP §§305.02 and 306.05 for certificate of mailing and certificate of facsimile transmission procedures to avoid lateness.

## REGISTRATION AND POST REGISTRATION PROCEDURES

### **1606.03(a) Premature Filing of §9 Renewal Application**

A renewal application may not be filed before the period specified in §9 of the Act. *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984). If an application for renewal is filed more than one year before the expiration date of the registration, the USPTO will advise the registrant: that the renewal application is premature; of the appropriate time period for filing a renewal application; that the fees submitted will be held; and that the registrant may file a new renewal application at the appropriate time or may request a refund at any time. The prematurely filed renewal application will be placed in the record for informational purposes only. A timely renewal application must be filed before the end of the grace period, or the registration will expire and the fees will be refunded. There is no deficiency surcharge for filing a timely substitute renewal application.

### **1606.04 Form for Filing §9 Renewal Application**

To expedite processing, it is recommended that the owner file the renewal application through TEAS. See TMEP §301 for more information about electronic filing.

Because the deadlines for filing renewal applications coincide with the deadlines for filing affidavits of use or excusable nonuse under 15 U.S.C. §1058(a)(3) at the end of each ten-year period following the date of registration, the USPTO has created a form for filing a §8 affidavit combined with a renewal application. See TMEP §1604.19 for more information about combined filings under §§8 and 9 of the Act.

The form for the combined filing is available through TEAS at <http://www.uspto.gov/teas/index.html>. Alternatively, the owner can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed form that can be mailed, faxed, or hand-delivered.

The USPTO's §9 renewal form cannot be used to renew an international registration. See TMEP §1614 for information about renewal of international registrations.

### **1606.05 Fees for §9 Renewal Applications**

#### **1606.05(a) Fee for Filing Application for Renewal Under §9**

A renewal application must include the fee required by 37 C.F.R. §2.6 for each class of goods/services for which renewal is sought. 15 U.S.C. §1059(a); 37 C.F.R. §2.183(b). See TMEP §§1401.02, 1401.04 and 1601.06 regarding use of international classification or prior United States classification for calculation of fees due. See TMEP §1606.05(c) regarding renewal applications filed with insufficient fees.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1606.05(b) Grace Period Surcharge and Deficiency Surcharge**

If the renewal application is filed during the six-month grace period, there is an additional grace period surcharge for each class for which renewal is sought. 15 U.S.C. §1059(a); 37 C.F.R. §§2.6 and 2.183(c).

Under §9(a) of the Trademark Act, a deficiency surcharge is required for correcting a deficiency after expiration of the relevant deadline specified in §9 of the Act. If the renewal application is filed within one year before the expiration of the registration, a deficiency surcharge is required for correcting deficiencies after the expiration date of the registration. If the renewal application is filed during the grace period, a deficiency surcharge is required for correcting deficiencies after expiration of the grace period. See TMEP §§1606.13 *et seq.* for further information regarding the procedures, deadlines and surcharge for correcting deficiencies.

Only a single deficiency surcharge is required for correcting one or more deficiencies in a multi-class registration. Similarly, only a single deficiency surcharge is required to correct several deficiencies within one renewal application or one combined filing under §§8 and 9. See TMEP §1604.19 regarding combined filings under §§8 and 9.

The grace period surcharge applies only if no filing was made within the year before the expiration of the registration. Someone who files within one year before the expiration of the registration, but corrects a deficiency after expiration of the registration, will be subject to the deficiency surcharge only. On the other hand, someone who files during the grace period and cures a deficiency after the grace period expires will be subject to both the grace period surcharge (for the ability to file the renewal application during the grace period) *and* the deficiency surcharge (for the ability to correct a deficiency after the expiration of the grace period). H.R. Rep. No. 194, 105<sup>th</sup> Congress, 1<sup>st</sup> Sess. 17 (1997).

### **1606.05(c) Processing §9 Renewal Application Filed With Insufficient Fees**

A renewal application that does not include a fee, or does not include sufficient fees to cover the filing fee for all the classes to which the application pertains (and the grace period surcharge, where applicable), is deficient. If the renewal application is filed within one year before the expiration date of the registration, the deficiency may be corrected before the expiration date of the registration for no fee, or after the expiration date of the registration with the deficiency surcharge required by §9(a) of the Act. If the renewal application is filed during the grace period, the deficiency may be corrected before expiration of the grace period for no fee, or after expiration of the grace period with the deficiency surcharge required by §9(a) of the Act. See TMEP

## REGISTRATION AND POST REGISTRATION PROCEDURES

§§1606.13 *et seq.* for information about the procedures, deadlines and surcharge for correcting deficiencies.

If the renewal application was filed without sufficient fee(s), but included an authorization to charge additional fees to a USPTO deposit account, the required fee (and grace period surcharge, where applicable) will be charged to the deposit account. If the deposit account authorization was included with the renewal application as filed, and the deposit account had sufficient funds to cover the fee(s) in question, there is no fee deficiency and no deficiency surcharge is required.

An authorization to charge fees to a deposit account with insufficient funds to cover the fee is regarded as a deficiency.

If a check submitted as payment of a filing fee for a renewal application is returned unpaid, or an EFT or credit card payment is refused or charged back by a financial institution, this is also regarded as a deficiency. In addition to the deficiency surcharge (where applicable), there is a \$50 fee for processing the payment that was refused. 37 C.F.R. §2.6(b)(12). See TMEP §405.06.

If at least one fee is submitted for a multi-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Post Registration examiner will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. If the required fee(s) are not submitted and the class(es) to which the original fee(s) should be applied are not specified, the USPTO will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class. 37 C.F.R. §2.183(e).

### **1606.06 Ownership, and Who May File §9 Renewal Application**

The Trademark Act and the Trademark Rules of Practice do not require that a renewal application be filed by the owner of the registration.

Therefore, if the renewal applicant is not the owner of record, the USPTO does not require that the renewal applicant show continuity of title from the original registrant before granting renewal.

However, registrations are renewed in the name of the party who is the owner of record of the registration, as shown in the automated records of the Trademark Operation (*i.e.*, TRAM, TARR, X-Search and TESS). The registration will be renewed in the name of the new owner only if the owner: (1) records an assignment or other document of title with the Assignment Services Division; and (2) notifies the Post Registration examiner at the time the renewal application is filed that the document has been recorded with the Assignment Services Division. See TMEP §§504 *et seq.* regarding the circumstances in which the ownership field in the trademark databases will be automatically updated after recordation of a document with the Assignment

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Services Division, even if the new owner does not notify the Trademark Operation that the document has been recorded.

See TMEP §502.03 regarding issuance of a new certificate in the name of a new owner.

### **1606.07 Execution of §9 Renewal Application**

Under 37 C.F.R. §2.183(a), a renewal application must be signed by “the registrant or the registrant’s representative.” Verification is not required.

Generally, the USPTO does not question the authority of the person who signs a renewal application unless there is an inconsistency in the record as to the signatory’s authority to sign.

The Trademark Act and the Trademark Rules of Practice do not require that a renewal application be executed within any particular time period. Therefore, the USPTO will accept undated renewal applications, and will not issue any inquiry or requirement regarding the date of execution of a renewal application.

### **1606.08 Goods and/or Services Set Forth in §9 Renewal Application**

#### **1606.08(a) Listing of Goods and/or Services Required Only for Partial Renewal**

Neither the Trademark Act nor the Trademark Rules of Practice requires a listing of the goods and/or services in the registration if the renewal application covers all the goods/services in the registration. Under 37 C.F.R. §2.183(e), the renewal application must include a list of the goods/services only if the renewal application covers less than all the goods/services in the registration.

#### **1606.08(b) No Goods or Services Listed**

If no goods or services are specified in the renewal application, it will be presumed that renewal is sought for all the goods/services in the registration.

#### **1606.08(c) Some Goods and/or Services Listed**

If the renewal application lists only some of the goods/services set forth in the registration, it will be presumed that renewal is sought for only the goods/services listed, and the goods/services omitted from the renewal application will be deleted from the registration.

## REGISTRATION AND POST REGISTRATION PROCEDURES

### **1606.08(d) Goods and/or Services Not Listed in Registration May Not Be Listed in Renewal Application**

Goods/services that are not listed in the registration may not be listed in the renewal application.

### **1606.09 Affidavit of Use in Commerce or Excusable Nonuse Not Required**

The Trademark Act does not require that a renewal application include an affidavit or declaration of use in commerce, a specimen of use, or a showing that any nonuse is due to special circumstances that excuse the nonuse, and not due to any intention to abandon the mark. See notice at 1228 TMOG 187 (Nov. 30, 1999). See also TMEP §§1604 *et seq.* regarding affidavits of use or excusable nonuse under 15 U.S.C. §1058.

### **1606.10 Designation of Domestic Representative by Foreign Applicant for Renewal Under §9**

A renewal applicant who is not domiciled in the United States may set forth the name and address of a United States resident on whom notices or process in proceedings affecting the registration may be served. The USPTO encourages parties who do not reside in the United States to designate domestic representatives. 15 U.S.C. §1059(c); 37 C.F.R. §2.183(d). See TMEP §604.

### **1606.11 Office Actions and Notices Regarding §9 Renewal Application**

Upon receipt of a §9 renewal application, the prosecution history of the registration in the USPTO's automated database is updated to show that the renewal application has been filed. This information is reflected in TRAM and TARR.

When a renewal application is filed through TEAS, the USPTO immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission. This confirmation is evidence of filing should any question arise as to the filing date of the renewal application. For renewal applications filed on paper, no acknowledgment of receipt of the application is sent before it is examined.

If the renewal application is examined and found acceptable, the USPTO sends the registrant a notice that renewal has been granted. The USPTO does not issue an Updated Registration Certificate ("URC") for renewed registrations.



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If the renewal application is not acceptable, the USPTO issues an action stating the reasons for refusal. 15 U.S.C. §1059(b); 37 C.F.R. §2.184(a).

The propriety of the original registration is not re-examined on renewal.

### **1606.12 Response to Office Action**

If the renewal application is not acceptable, the USPTO will notify the renewal applicant of the reason(s) for refusal. 15 U.S.C. §1059(b); 37 C.F.R. §2.184(a). Under 37 C.F.R. §2.184(b), a response to a refusal of renewal must be filed within six months of the mailing date of the Post Registration examiner's Office action, or before the expiration date of the registration, whichever is later, or the registration will expire.

The registrant may file a petition under 37 C.F.R. §§2.146(a)(3) and 2.146(a)(5) to waive 37 C.F.R. §2.184(b) and accept a late response to an Office action. However, a rule will be waived only in an extraordinary situation, where justice requires and no other party is injured. See TMEP §1708. The failure to receive an Office action has been found to be an extraordinary circumstance that warrants a waiver of 37 C.F.R. §2.184(b). The "unintentional delay" standard of 37 C.F.R. §2.66 does not apply to a registrant's failure to respond to an Office action issued in connection with a renewal application. TMEP §1714.01(f)(ii).

The renewal applicant may correct deficiencies if the requirements of 37 C.F.R. §2.185 are met. See TMEP §§1606.13 *et seq.* for information about the procedures, deadlines and surcharge for correcting deficiencies.

### **1606.13 Correction of Deficiencies in §9 Renewal Applications**

*37 C.F.R. §2.185. Correcting Deficiencies in Renewal Application.*

*(a) If the renewal application is filed within the time periods set forth in section 9(a) of the Act, deficiencies may be corrected, as follows:*

*(1) Correcting deficiencies in renewal applications filed within one year before the expiration date of the registration. If the renewal application is filed within one year before the expiration date of the registration, deficiencies may be corrected before the expiration date of the registration without paying a deficiency surcharge. Deficiencies may be corrected after the expiration date of the registration with payment of the deficiency surcharge required by section 9(a) of the Act and §2.6.*

*(2) Correcting deficiencies in renewal applications filed during the grace period. If the renewal application is filed during the six-month grace period, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge. Deficiencies may be corrected after the expiration of the grace period with payment of the deficiency surcharge required by section 9(a) of the Act and §2.6.*

## REGISTRATION AND POST REGISTRATION PROCEDURES

*(b) If the renewal application is not filed within the time periods set forth in section 9(a) of the Act, the registration will expire. This deficiency cannot be cured.*

### **1606.13(a) Correcting Deficiencies in §9 Renewal Applications Filed Within the Year Before the Expiration Date of the Registration**

If the renewal application is filed within one year before the expiration date of the registration, deficiencies may be corrected before the expiration date without paying a deficiency surcharge, or after the expiration date with payment of the deficiency surcharge required by §9(a) of the Act. 37 C.F.R. §2.185(a)(1).

Any deficiency must be cured within the set period for response to the Post Registration examiner's Office action, *i.e.*, within six months of the mailing date of the action, or before the expiration date of the registration, whichever is later. 37 C.F.R. §2.184(b). See TMEP §1606.12.

### **1606.13(b) Correcting Deficiencies in Renewal Applications Filed During the Grace Period**

If the renewal application is filed during the grace period, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge, or after the expiration of the grace period with the deficiency surcharge required by §9(a) of the Act. 37 C.F.R. §2.185(a)(2).

Any deficiency must be cured within six months of the mailing date of the Office action. 37 C.F.R. §2.184(b). See TMEP §1606.12.

### **1606.13(c) Late Filing Cannot be Cured**

If the renewal application is not filed before the end of the grace period, the registration will expire. Filing after the expiration of the grace period is not a deficiency that can be cured, even with a deficiency surcharge. 37 C.F.R. §§2.182 and 2.185(b).

### **1606.14 Petition Under 37 C.F.R. §2.146**

The action of an examiner on a §9 renewal application may not be appealed to the Trademark Trial and Appeal Board, but the registrant may file a petition for review of the examiner's action under 37 C.F.R. §§2.146(a)(2) and 2.186(b). A petition fee is required by 37 C.F.R. §§2.6 and 2.146(c). See TMEP Chapter 1700 regarding petitions.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1606.14(a) Response to Examiner's Refusal Required Before Petition**

A response to the examiner's initial refusal to accept a renewal application is required before filing a petition, unless the examiner directs otherwise or there is no time remaining to respond to the examiner's refusal. 37 C.F.R. §2.186(a).

If the examiner continues the refusal of the renewal application, the registrant may file a petition for review of the action under 37 C.F.R. §2.146(a)(2) within six months of the mailing date of the action continuing the refusal. If no petition is filed within six months, the registration will expire. 37 C.F.R. §2.186(b).

### **1606.14(b) Decision on Petition is Final Action of the Office**

The decision on a petition under 37 C.F.R. §2.146 is the final action of the USPTO. In the absence of a request for reconsideration of the decision (see TMEP §1606.14(c)), or an appeal to federal court (see TMEP §1606.14(d)) within two months of the mailing date of the decision on petition, the registration will expire.

### **1606.14(c) Request for Reconsideration of Denial of Petition**

Under Trademark Rule 2.146(j), if a petition is denied, the petitioner may file a request for reconsideration within two months of the mailing date of the decision denying the petition. A second petition fee must be paid with the request for reconsideration. See TMEP §1705.08 regarding requests for reconsideration of petition decisions.

### **1606.14(d) Appeal to Federal Court**

The registrant may appeal to the United States Court of Appeals for the Federal Circuit or commence a civil action for review of the decision on petition. 15 U.S.C. §§1071(a)(1) and (b)(1); 37 C.F.R. §§2.145(a) and 2.145(c).

The deadline for filing an appeal or commencing a civil action is two months from the mailing date of the decision on petition. 15 U.S.C. §§1071(a)(2) and (b)(1); 37 C.F.R. §2.145(d)(1). Under 37 C.F.R. §2.145(d)(2), one day is added to any two-month period that includes February 28.

Under 37 C.F.R. §2.186(c), a decision on petition is necessary before the registrant can file an appeal or commence a civil action in any court.

## REGISTRATION AND POST REGISTRATION PROCEDURES

### **1606.15            Section 9 Renewal Application Combined with Affidavit or Declaration of Use or Excusable Nonuse**

A renewal application and an affidavit or declaration under §8 of the Act may be combined into a single document, if the document meets the requirements of both §§8 and 9 of the Act. 37 C.F.R. §2.166. See TMEP §1604.19 for further information about combined filings under §§8 and 9.

### **1607                Cancellation of Registrations Under §§14 and 37 of the Trademark Act**

A petition to cancel a registration owned by another party may be filed with the Trademark Trial and Appeal Board under §14 of the Trademark Act, 15 U.S.C. §1064. See TBMP §§303, 307, 308, and 309, for the requirements and fees for filing a petition to cancel a registration. The petition can be filed through the Electronic System for Trademark Trials and Appeals (“ESTTA”) at <http://estta.uspto.gov/>.

See TMEP §1608 regarding the voluntary surrender of one’s own registration for cancellation.

Registrations can also be cancelled under §37 of the Trademark Act, 15 U.S.C. §1119, pursuant to the final order of the court in an action involving a registered mark. The party who has prevailed in the civil action must submit a certified copy of the court order or decree to the Office of the Solicitor of the USPTO. See TMEP §1610.

### **1608                Surrender of Registration for Cancellation**

The owner of a registration may voluntarily surrender his or her registration for cancellation, under §7(e) of the Trademark Act, 15 U.S.C. §1057(e). There is no fee.

A request to surrender a registration must be signed by the owner or owner’s attorney. 37 C.F.R. §2.172.

Filing a §8 affidavit or §9 renewal application for fewer than the total number of classes in the registration is regarded as a surrender of the registration as to the class(es) that are omitted.

Unless the registration is the subject of a cancellation proceeding before the Trademark Trial and Appeal Board, a request for surrender is handled by the Post Registration Section of the USPTO. See TBMP §602.02(a) as to the voluntary surrender of a registration that is the subject of a cancellation proceeding before the Board.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If the registration is surrendered in its entirety, the USPTO updates its records accordingly, and sends the owner of record a notice that the registration is cancelled.

If fewer than all classes are surrendered, the USPTO enters a notation in the record, and updates its automated records to indicate that specified classes have been cancelled under §7(e) of the Act. A certified copy of the updated registration certificate may be obtained from the Certification Division of the Office of Public Records for a fee. See TMEP §111.

A request to surrender a registered extension of protection of an international registration to the United States may be filed either directly with the IB or with the USPTO. See TMEP §§1906 *et seq.* regarding requests to record changes at the IB, and TMEP §1906.01(e) regarding renunciation, limitation or cancellation of an international registration.

### **1609 Amendment and Correction of Registrations**

#### **1609.01 Amendment of Registration - In General**

##### **1609.01(a) Registered Extension of Protection Cannot be Amended Under §7**

An extension of protection of an international registration remains part of the international registration even after registration in the United States. TMEP §1601.01(c). All requests to record changes to an international registration must be filed at the IB. The holder of a registered extension of protection cannot file an amendment under §7 of the Trademark Act. The USPTO will not accept an amendment of a registered extension of protection that has not been recorded in the International Register. See TMEP §§1906.01 *et seq.* regarding requests to record changes at the IB.

##### **1609.01(b) Amendment of Registration Resulting From §1 or §44 Application**

Under §7(e) of the Trademark Act, a registration based on an application under §1 or §44 of the Trademark Act may be amended “for good cause.” Any request for amendment of a mark must be accompanied by the required fee. 15 U.S.C. §1057(e); 37 C.F.R. §§2.6 and 2.173(a).

The request for amendment must be signed and verified (sworn to) or supported by a declaration under 37 C.F.R. §2.20, by the owner of the registration or a person properly authorized to sign on behalf of the owner. 37 C.F.R. §§2.173(a) and 2.175(b). The following persons are authorized to sign on behalf of the owner: (1) a person with legal authority to bind the owner; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or (3) an attorney as defined in 37 C.F.R. §10.1(c) who has an actual written or verbal power of attorney or

## REGISTRATION AND POST REGISTRATION PROCEDURES

an implied power of attorney from the owner. Generally, the USPTO does not question the authority of the person who signs a verification on behalf of the owner, unless there is an inconsistency in the record as to the signatory's authority to sign.

Applications to amend registrations that are not the subject of *inter partes* proceedings before the Trademark Trial and Appeal Board are handled by the Post Registration Section of the Office. Amendment of a registration that is the subject of an *inter partes* proceeding is governed by 37 C.F.R. §2.133. See TBMP §§514.01 *et seq.*

If the request for amendment is granted, the USPTO sends an updated registration certificate showing the amendment to the owner of record, and updates USPTO records accordingly.

### 1609.02            Amendment of Mark

#### ***Mark in Registered Extension of Protection Cannot be Amended***

As noted in TMEP §1609.01(a), the holder of a registered extension of protection of an international registration to the United States cannot file an amendment under §7 of the Trademark Act. Because a registered extension of protection remains part of the international registration, all requests to record changes to such a registration must be filed at the IB. However, the Madrid Protocol and the *Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to That Agreement* ("Common Regs.") do not permit amendment of the mark in an international registration. If the holder of the international registration wants to change the mark in any way, even slightly, the holder must file a new international application. The IB's *Guide to International Registration*, Para. B.II.69.02 (2004), provides as follows:

[T]here is no provision for a mark that is recorded in the International Register to be amended in any way, either on renewal or at any other time. If the holder wishes to protect the mark in a form which differs, even slightly, from the mark as recorded, he must file a new international application. This is true even if the mark has been allowed to be changed in the basic application, the registration resulting from the basic application or the basic registration....

Therefore, the mark in a registered extension of protection cannot be amended.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### ***Amendment of Mark in Registration Based on §1 or §44 Application***

Under 15 U.S.C. §1057(e), upon application by the owner and payment of the prescribed fee, a registration based on an application under §1 or §44 of the Trademark Act may be amended for good cause, if the amendment does not materially alter the character of the mark. See TMEP §§807.14 *et seq.* and 1609.02(a) regarding material alteration.

### **1609.02(a) Determining What Constitutes Material Alteration of Mark**

Section 7(e) of the Trademark Act prohibits an amendment that materially alters the character of the mark. “Material alteration” is the standard for evaluating amendments to marks at all relevant stages of processing, both during examination of the application and after registration. See 37 C.F.R. §§2.72 and 2.173(a); TMEP §§807.14 *et seq.*

In determining whether a proposed amendment is a material alteration of a registered mark, the USPTO will always compare the proposed amendment to the mark *as originally registered*.

The general test of whether an alteration is material is whether, if the mark in an application for registration had been published, the change would require republication in order to present the mark fairly for purposes of opposition. If republication would be required, the amendment is a material alteration.

An amendment of a registered mark is acceptable if the modified mark contains the essence of the original mark (*i.e.*, the mark as originally registered), and the mark as amended creates essentially the same impression as the original mark. *In re Umax Data System, Inc.*, 40 USPQ2d 1539 (Comm’r Pats. 1996). For example, in marks consisting of word(s) combined with a design, if the word is the essence of the mark and the design is merely background embellishment or display that is not integrated into the mark in any significant way, the removal or change of the design will not be a material alteration of the mark. See *Ex parte Petersen & Pegau Baking Co.*, 100 USPQ 20 (Comm’r Pats. 1953). On the other hand, if a design is integrated into a mark and is a distinctive feature necessary for recognition of the mark, then a change in the design would materially alter the mark. See *In re Dillard Department Stores, Inc.*, 33 USPQ2d 1052 (Comm’r Pats. 1993) (proposed deletion of highly stylized display features of mark “IN•VEST•MENTS” held to be a material alteration); *Ex parte Kadane-Brown, Inc.*, 79 USPQ 307 (Comm’r Pats. 1948) (proposed amendment of “BLUE BONNET” mark to delete a star design and to change the picture of the girl held a material alteration).

When a mark is solely a picture or design, an alteration must be evaluated by determining whether the new form has the same meaning as the original mark, *i.e.*, whether the form as altered would be likely to be recognized as the

## REGISTRATION AND POST REGISTRATION PROCEDURES

same mark. See *Ex parte Black & Decker Mfg. Co.*, 136 USPQ 379 (Comm'r Pats. 1963) (proposed amendment to delete circle found to be a material alteration, where the circle was determined to be a prominent element of a design mark).

Marks entirely comprised of words can sometimes be varied as to their style of lettering, size, and other elements of form without resulting in a material alteration of the mark. See *Ex parte Squire Dingee Co.*, 81 USPQ 258, *recon. denied*, 81 USPQ 543 (Comm'r Pats. 1949) (amendment from block lettering to script not a material alteration). However, changing from special form to standard characters, or the reverse, may be a material alteration. TMEP §807.03(d).

A generic or purely informational term may be deleted if the essence of the mark in appearance or meaning is not changed, but a word or feature that is necessary to the significance of the mark may not be deleted. Likewise, a unique or prominent design feature may not be deleted. See *In re Richards-Wilcox Mfg. Co.*, 181 USPQ 735 (Comm'r Pats. 1974) (proposed amendment to block lettering from mark comprising a diamond design surrounding the word "FYER-WALL" with an inverted channel bracket around the letters "RW" held a material alteration). See also TMEP §807.14(a) regarding amendments deleting matter from a mark.

### **1609.02(b) New Drawing Required**

When applying for an amendment to a registration that involves a change in the mark, the owner of the registration must submit a new drawing displaying the amended mark. 37 C.F.R. §2.173(a). See TMEP §§807 *et seq.* regarding drawings.

### **1609.02(c) Supporting Specimen and Declaration**

The owner of the registration must submit one specimen showing use of the proposed mark as amended on or in connection with the goods or services, and must include an affidavit or a declaration under 37 C.F.R. §2.20 stating that the specimen was in use in commerce at least as early as the date the §7 amendment was filed. 37 C.F.R. §2.173(a). The affidavit or declaration must be signed and verified (sworn to) or supported by a declaration under 37 C.F.R. §2.20 by the owner or a person properly authorized to sign on behalf of the owner of the registration. A "person properly authorized to sign on behalf of the owner" is: (1) a person with legal authority to bind the owner; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or (3) an attorney as defined in 37 C.F.R. §10.1(c) who has an actual written or verbal power of attorney or an implied power of attorney from the owner. Generally, the USPTO does not question the authority of the person who signs an affidavit or declaration



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

requesting an amendment under §7 of the Act, unless there is an inconsistency in the record as to the signatory's authority to sign.

A specimen showing use of the proposed mark as amended on or in connection with the goods or services is required even if the mark originally registered under 15 U.S.C. §1126(e), based on a foreign registration. See TMEP §§904 *et seq.* regarding specimens, and TMEP §1015 regarding the independence of a §44 registration from the underlying foreign registration.

### **1609.02(d) Amendment of Black and White Drawing of Mark for Which Color is Claimed to Substitute Color Drawing**

Prior to November 2, 2003, the USPTO did not publish marks or issue registrations in color. An applicant who wanted to show color in a mark was required to submit a black and white drawing, with a statement describing the color(s). Effective November 2, 2003, the USPTO accepts color drawings. Black and white drawings with a color claim, or drawings that show color by use of lining patterns, are no longer permitted. 37 C.F.R. §2.52(b)(1).

Color drawings must be accompanied by a color claim naming the colors that are a feature of the mark, and a separate statement describing where the color(s) appear on the mark. 37 C.F.R. §2.52(b)(1); TMEP §807.07(a).

In a registration based on an application filed before November 2, 2003, if the application included a black and white drawing with a statement claiming color, the owner may file a request under §7 of the Trademark Act to substitute a color drawing for the black and white drawing. The request must include: (1) a color drawing showing the same colors claimed in the registration; (2) a color claim naming the color(s) that are a feature of the mark; (3) a description of where the color(s) appear in the mark; and (4) the fee required by 37 C.F.R. §2.6. 37 C.F.R. §2.173(a). No specimen is required if the owner is merely substituting a color drawing for a legally equivalent black and white drawing, and is not amending the mark.

### **1609.03 Amendment of Identification of Goods or Services**

#### ***Identification of Goods/Services in Registered Extension of Protection Cannot be Amended Under §7***

The identification of goods/services in a registered extension of protection of an international registration to the United States cannot be amended under §7 of the Trademark Act. TMEP §1609.01(a). All requests to record changes to an international registration must be filed at the IB. See TMEP §§1906.01 *et seq.* regarding requests to record changes at the IB. Note that the IB does not permit amendments that expand the list of goods/services in an international registration. See TMEP §1906.01(i).

## REGISTRATION AND POST REGISTRATION PROCEDURES

### ***Amendment of Registration Based on §1 or §44 Application***

In registrations based on applications under §§1 and 44 of the Trademark Act, amendments may be made to the identification of goods/services to restrict the identification or otherwise to change it in ways that would not require republication of the mark. However, goods/services may not be added to a registration by amendment. See 37 C.F.R. §2.173(b). Changed circumstances (e.g., new technology) will not render acceptable an amendment that is not otherwise permissible. See *In re Capp Enterprises, Inc.*, 32 USPQ2d 1855 (Comm'r Pats. 1993); *In re Fortex Industries Inc.*, 18 USPQ2d 1224 (Comm'r Pats. 1990); *In re Carter Hawley Hale Stores, Inc.*, 200 USPQ 179 (Comm'r Pats. 1978). For example, if the goods in the registration are identified as "phonograph records," the identification of goods cannot be amended to "compact discs."

In a multiple-class registration, deletion of less than all the goods or services in a single class constitutes an amendment, whereas deletion of an entire class constitutes a surrender of the registration for cancellation as to the class deleted. See 37 C.F.R. §2.172. See TMEP §1608 regarding surrender.

### **1609.04            Amendment of Classification**

#### ***Classification of Goods/Services in Registered Extension of Protection Cannot be Amended Under §7***

The classification of goods/services in a registered extension of protection of an international registration to the United States cannot be amended under §7 of the Trademark Act. TMEP §1609.01(a). All requests to record changes to an international registration must be filed at the IB. See TMEP §§1906.01 *et seq.* regarding requests to record changes at the IB. See *also* TMEP §1401.03(d) regarding amendment of the classification in a pending application under §66(a) of the Trademark Act.

### ***Amendment of Registration Based on §1 or §44 Application***

In a registration that issued based on an application under §1 or §44 of the Trademark Act, the classification of the goods/services may be amended under §7 of the Trademark Act, if the requested international classification is consistent with the current version of the *Nice Agreement*. In such a case, the USPTO will amend the international classification of goods/services and issue an updated registration certificate with the new classification noted.

The owner of a registration may reclassify registrations from multiple U.S. classes into a single international classification. For example, goods in U.S. classes 21 and 26 often fall into only International Class 9. Hence, an owner

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

can request an amendment from U.S. classes 21 and 26 into International Class 9.

The amendment must include the fee required by 37 C.F.R. §2.6 for §7 amendments.

The owner must reclassify all the goods/services in the registration to the international classification system.

### **1609.05 Disclaimer of Mark**

A registered mark may be amended to disclaim part of the mark. 37 C.F.R. §2.173(a). However, no amendment seeking the elimination of a disclaimer will be permitted. 37 C.F.R. §2.173(b).

An amended registration must still contain registrable matter, and the mark as amended must be registrable as a whole. The disclaimer must not materially alter the character of the mark. 37 C.F.R. §2.173(a).

### **1609.06 Territorial Restrictions**

A registration cannot be restricted territorially by amendment under §7(e) of the Act. *In re Forbo*, 4 USPQ2d 1415 (Comm'r Pats. 1984). Generally, a concurrent use restriction cannot be removed from a registration by an amendment under §7(e). However, removal of a concurrent use restriction by amendment under §7(e) may be permitted where an entity that was the *only* exception to the owner's right to exclusive use of its registered mark assigns its rights in the mark to the owner of the registration, so that all rights in the mark are merged in the owner. *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383 (Comm'r Pats. 1987); TBMP §§1101.02 and 1114.

### **1609.07 Dates of Use**

The USPTO will accept an amendment changing the dates of use, even if the amended dates are later than the dates originally set forth in the registration. See *In re Pamex Foods, Inc.*, 209 USPQ 275 (Comm'r Pats. 1980); *Grand Bag & Paper Co., Inc. v. Tidy-House Paper Products, Inc.*, 109 USPQ 395 (Comm'r Pats. 1956). However, the USPTO will not enter an amendment if the amended dates are later than the dates that would have been accepted during examination. Therefore, the USPTO will not enter the following amendments:

- If the application for the registration was based on use in commerce under 15 U.S.C. §1051(a), the registration cannot be amended to specify a date of use that is later than the application filing date (see 37 C.F.R. §2.71(c)(1));

## REGISTRATION AND POST REGISTRATION PROCEDURES

- If the application for the registration was based on intent-to-use under 15 U.S.C. §1051(b), and a statement of use under 15 U.S.C. §1051(d) was filed, the registration cannot be amended to specify a date of use that is later than the statutory deadline for filing the statement of use (i.e., within six months of the mailing date of the notice of allowance or before the expiration of an extension of time for filing a statement of use) (see 37 C.F.R. §2.71(c)(2));
- If the application for the registration was based on intent-to-use under 15 U.S.C. §1051(b), and an amendment to allege use under 15 U.S.C. §1051(c) was filed, the registration cannot be amended to specify a date of use that is later than the filing date of the amendment to allege use (see TMEP §903.05); and
- The date of first use in commerce may not be earlier than the date of first use anywhere (see TMEP §903.04).

### **1609.08                    Effect of Amendment of Registration on Limitation of Grounds for Cancellation of a Registration**

Section 14 of the Trademark Act, 15 U.S.C. §1064, limits the grounds that a third party can raise in a petition to cancel a mark registered on the Principal Register when the petition is filed more than five years after the date of registration.

Ordinarily, the five-year period runs from the date of the registration of the mark for a registration issued on the Principal Register under the Act of 1946, and from the date of publication under §12(c) of the Act for registrations issued under prior Acts and published under §12(c) of the Act of 1946.

However, when a registration has been amended, the five-year period runs from the date of the amendment, to the extent that the amendment of the registration has in any way enlarged the owner's rights, as though the registration had issued on the date of the amendment. See TBMP §307.02(c)(2).

### **1609.09                    Amendment From Supplemental to Principal Register Not Permitted**

A registration on the Supplemental Register may not be amended to the Principal Register. If the owner of a registration wishes to seek registration on the Principal Register of a mark for which it owns a registration on the Supplemental Register, the owner must file a new application. Under 15 U.S.C. §1062(a), a mark must be published for opposition before it can be registered on the Principal Register.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1609.10 Correction of Mistake in Registration**

The USPTO may make a correction to a registration in appropriate cases, upon written request by the owner of the registration. See §7(g) of the Trademark Act, 37 C.F.R. §2.174, and TMEP §1609.10(a) regarding correction of USPTO errors; and §7(h) of the Act, 37 C.F.R. §2.175, and TMEP §1609.10(b) regarding correction of errors by the owner of a registration.

Requests for correction of registrations are handled by the Post Registration Section.

If the request for correction is granted, the USPTO sends an updated registration certificate to the owner of record, and updates USPTO records to show the correction.

### **1609.10(a) Correction of Office Error**

If a clerical error occurred through the fault of the USPTO, the USPTO will correct the error without charge. 15 U.S.C. §1057(g); 37 C.F.R. §2.174. Section 7(g) gives the Director the discretion to issue a certificate of correction of the existing registration, or to issue a new certificate of registration without charge.

The owner of the registration should submit a written request, specifying the error to be corrected. This request should be signed by the owner of the registration or the owner's attorney, and directed to the Post Registration Section of the Office.

The USPTO will issue a certificate of correction if the change is non-material, such as a slight misspelling in the mark or the identification of goods/services, or an error in entering the owner's name or address.

A USPTO error in classification may be corrected if the requested classification is consistent with the current version of the *Nice Agreement*. Republication is not required.

If correction of a USPTO error would result in a material change (e.g., a material change of the mark or a broadening of the identification of goods/services), the USPTO will not issue a certificate of correction under §7(g). Section 12(a) of the Trademark Act requires examination and publication prior to registration. Therefore, if the error results in a material change to the registration, the error can be corrected only by cancelling the registration as inadvertently issued and republishing it with the correct information. The USPTO will give the owner the option of either (1) keeping the registration as issued, or (2) having the registration cancelled as inadvertently issued and republished. If the owner chooses to have the mark

## REGISTRATION AND POST REGISTRATION PROCEDURES

republished, and registration is not successfully opposed, the USPTO will issue a new certificate of registration with a new registration date.

In some cases, further examination may be required to correct a USPTO error that would materially change the registration, *e.g.*, where a proposed amendment to the mark or the identification of goods/services was filed prior to registration, but not timely made of record and reviewed by the examining attorney. In this situation, the registration will be cancelled as inadvertently issued and returned to examination. The examining attorney will examine the amendment using standard examination procedures. If the examining attorney approves the amendment, the mark will be republished.

A request to have a registration cancelled as inadvertently issued should be directed to the Office of the Commissioner for Trademarks.

### **1609.10(b) Correction of Registrant's Error**

#### ***Error in Registered Extension of Protection Must be Corrected at International Bureau***

An extension of protection of an international registration remains part of the international registration even after registration in the United States. TMEP §1601.01(c). All requests to record changes to an international registration must be filed at the IB. See TMEP §§1906.01 *et seq.* regarding requests to record changes at the IB.

#### ***Registration Based on Application under §1 or §44***

Under §7(h) of the Trademark Act, if a mistake in a registration occurs in good faith through the fault of the owner of the registration, the Director may correct the error upon written request and payment of the fee required by 37 C.F.R. §2.6, *provided* the correction does not result in a change that would require republication of the mark.

The owner of the registration must file a written request specifying the error, explaining how the error occurred, and showing that it occurred in good faith. The request must be verified by the owner or a person who is properly authorized to sign on behalf of the owner. 37 C.F.R. §2.175(b). A "person properly authorized to sign on behalf of the owner" is: (1) a person with legal authority to bind the owner; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or (3) an attorney as defined in 37 C.F.R. §10.1(c) who has an actual written or verbal power of attorney or an implied power of attorney from the owner. The request for correction should be directed to the Post Registration Section of the Office.

As noted above, the owner of a registration cannot correct a mistake if the changes would require republication of the mark. 15 U.S.C. §1057(h);

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

37 C.F.R. §2.175(a). Thus, a correction cannot be made if it would materially alter the mark, or broaden the identification of goods/services. See TMEP §§807.14 and 1609.02(a) regarding material alteration, and TMEP §1609.03 regarding changes to the identification of goods/services.

A registration can be corrected to cure an inadvertent error in the manner in which the owner's name is set forth. However, the registration cannot be corrected to substitute another entity as the owner. See TMEP §1201.02(c) for examples of correctable and non-correctable errors in identifying the owner of an application or registration.

Section 7(h) gives the Director the discretion to issue a certificate of correction of the existing registration or to issue a new certificate of registration. See *In re Pamex Foods, Inc.*, 209 USPQ 275, 277-78 (Comm'r Pats. 1980). In either case, if the mistake was made by the owner of the registration, a fee is required. See 15 U.S.C. §1057(h); 37 C.F.R. §§2.6 and 2.175(b).

### **1609.11 Change of Owner's Address Can Be Filed Through TEAS**

It is not necessary to file a §7 amendment to change the address of the owner of a registration. This can be done through TEAS, at [www.uspto.gov/teas/index.html](http://www.uspto.gov/teas/index.html).

*Note: The owner's address often differs from the correspondence address. The correspondence address can also be changed through TEAS, using a different form. See TMEP §603.02(c) for information about changing the correspondence address after registration.*

### **1610 Court Orders Concerning Registrations**

The USPTO must rectify the register and make appropriate entry upon its records in response to a court order certified to the Office pursuant to 15 U.S.C. §1119. That section provides:

In any action involving a registered mark the court may determine the right to registration, order the cancellation of registrations, in whole or in part, restore cancelled registrations, and otherwise rectify the register with respect to the registrations of any party to the action. Decrees and orders shall be certified by the court to the Director, who shall make appropriate entry upon the records of the Patent and Trademark Office, and shall be controlled thereby.

Any such order affecting a registration must be *certified* to the Office, and should be addressed to the Office of the Solicitor, Mail Stop 8, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria,

## REGISTRATION AND POST REGISTRATION PROCEDURES

Virginia 22313-1450. 37 C.F.R. §1.1(a)(3)(iii). An uncertified copy of the court order is unacceptable. Once the Office receives the certified order, appropriate action will typically be taken by the Office without the necessity of any submission by an interested party. However, if it would be helpful for purposes of determining the scope or effect of an order, the Office may, at the Director's discretion, issue a show cause order directing the registrant and parties to the action from which the order arose to respond and provide information or arguments regarding the order.

### **1611                      Updating Automated Records to Show the Status of Registrations**

USPTO records will be automatically updated to indicate the status of registrations as follows:

- (1) When the owner of a registration timely files a §8 affidavit and/or §9 renewal application, Office records are updated to indicate receipt of the document and the action taken on it. This information appears in TRAM and TARR.
- (2) If no §8 affidavit is filed before the end of the grace period (see TMEP §1604.04 regarding the deadline for filing a §8 affidavit), Office records are automatically updated to indicate that the registration is cancelled, and this information appears in TRAM and TARR. However, Office records are not updated to show that the registration is cancelled until three months *after* the expiration of the grace period.
- (3) If no §9 renewal application is filed before the end of the grace period (see TMEP §1606.03 regarding the deadline for filing a renewal application), Office records are automatically updated to indicate that the registration is expired, and this information appears in TRAM and TARR. However, Office records are not updated to show that the registration is expired until three months *after* the expiration of the grace period.

The reason the USPTO waits until three months *after* the expiration of the grace period before updating its records to show that the registration is cancelled or expired is to avoid inadvertent cancellation or expiration of a registration due to a delay in entering a timely filed §8 affidavit or renewal application into the record.

If a the owner of a registration who has not timely filed a §8 affidavit or §9 renewal application wants to expedite cancellation or expiration of its own registration, the owner may request in writing that the Office expedite the processing of the cancellation or expiration of the registration. The request should be signed by the owner or the owner's attorney, and should specifically state that no §8 affidavit or renewal application was filed on or



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

before the end of the grace period. Such a request should be directed to the Post Registration Section; if it is sent to the examining attorney, the examining attorney should forward it to the Supervisor of the Post Registration Section.

See TMEP §716.02(e) regarding suspension of an application for a conflicting mark pending cancellation of the cited registration under §8 of the Act or expiration of the cited registration for failure to renew under §9 of the Act.

### **1612 Powers of Attorney and Designations of Domestic Representative Filed After Registration**

To expedite processing, the USPTO recommends that powers of attorney, requests to revoke powers of attorney, and designations of domestic representative be filed through TEAS, at <http://www.uspto.gov/teas/index.html>. When these documents are filed through TEAS, the data is automatically entered into the USPTO's automated TRAM system. Requests to withdraw as attorney cannot be filed through TEAS after registration.

The USPTO considers a power of attorney to end with registration.

When the owner of a registration files a new power of attorney or designation of domestic representative *on paper*, the USPTO scans an image of the power or designation into the record, but does not update the TRAM database unless the owner concurrently files a §8 or §15 affidavit, §9 renewal application, or request to amend or correct a registration under §7 of the Trademark Act. Likewise, when the owner of a registration files a *paper* request to revoke a power of attorney, or an attorney files a request to withdraw as attorney of record, the USPTO scans an image of the document into the record but does not change the attorney of record in TRAM.

When the owner of a registration files a §8 or §15 affidavit, §9 renewal application, or request to amend or correct a registration through an attorney, the USPTO will update TRAM to indicate the name of the attorney who filed the document, and any designation of domestic representative. If the owner does not have an attorney, the USPTO will update TRAM to indicate the owner's address as shown in the affidavit, renewal application or amendment.

See TMEP §§602.01 *et seq.* regarding powers of attorney, TMEP §604 regarding designations of domestic representative by parties not domiciled in the United States, and TMEP §603.02(c) regarding changes of correspondence address filed after registration.

## REGISTRATION AND POST REGISTRATION PROCEDURES

### 1613 Affidavit of Use in Commerce or Excusable Nonuse Under §71 of the Trademark Act

Under §71 of the Trademark Act, 15 U.S.C. §1141k, a registered extension of protection to the United States will be cancelled unless the holder of the international registration periodically files affidavits of use in commerce or excusable nonuse (“§71 affidavits”). The affidavits must include (1) a verified statement by the holder that the mark is in use in commerce, and a specimen of use, or (2) a verified statement setting forth that any nonuse is due to special circumstances that excuse such nonuse and is not due to any intention to abandon the mark. These affidavits must be filed:

- (1) Between the fifth and sixth year after the date on which the USPTO issues the certificate of extension of protection; and
- (2) Within the six-month period preceding the end of every ten-year period after the date on which the USPTO issues the certificate of extension of protection, or within a three-month grace period with an additional surcharge.

Section 71 provides a 3-month grace period for filing the ten-year §71 affidavit with an additional surcharge. There is *no grace period* for filing the six-year §71 affidavit. Unlike §8(c)(2) of the Trademark Act, §71 does not provide for correction of deficiencies after expiration of the statutory filing period. The requirements for a §71 affidavit are set forth in 37 C.F.R. §7.37.

Since the §71 affidavit cannot be filed until five years after the USPTO registers an extension of protection, the USPTO will not accept these affidavits until after November 2, 2008.

### 1614 Renewal of Registered Extension of Protection

The holder of a registered extension of protection of an international registration to the United States must renew the international registration with the IB. 37 C.F.R. §7.41(a). Renewal of international registrations is governed by Article 7 of the Madrid Protocol and Rules 29 - 31 of the Common Regs. See TMEP §1905.

Under §70(b) of the Trademark Act, 15 U.S.C. §1141j(b), and Article 3<sup>ter</sup>(2) of the Protocol, if the international registration is not renewed, the IB will notify the USPTO that the registration has expired. The corresponding extension of protection to the United States will expire as of the expiration date of the international registration. The USPTO will cancel the extension of protection.

Section 9 of the Trademark Act does not require renewal of a registered extension of protection with the USPTO. However, the holder must file affidavits of use or excusable nonuse under §71 of the Trademark Act. See TMEP §1613.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1615 Division of Registrations**

*§2.171(b). When ownership of a registration has changed with respect to some, but not all, of the goods and/or services, the registrant(s) may file a request that the registration be divided into two or more separate registrations. The fee required by §2.6(a)(8) must be paid for each new registration created by the division, and the change of ownership must be recorded in the Office.*

A registration can be divided only if ownership of the registration has changed with respect to some, but not all, of the goods/services. 37 C.F.R. §2.171(b). Requests to divide registrations are processed in the Post Registration Section.

See TMEP §1615.01 regarding division of registrations based on applications under §§1 and 44 of the Trademark Act, and TMEP §1615.02 regarding division of registered extensions of protection.

#### **1615.01 Division of Registration Based on Application Under §1 or §44 of the Trademark Act**

If ownership of a registration has changed with respect to some but not all of the goods/services, the owner may file a request that a registration be divided into two or more separate registrations. 37 C.F.R. §2.171(b).

The party requesting division must: (1) record the assignment with the Assignment Services Division of the USPTO; (2) file a request to divide; and (3) pay the fee required by 37 C.F.R. §2.6(a)(8) for each new registration created by the division. 37 C.F.R. §2.171(b). If the request does not meet these requirements, the Post Registration examiner will issue an Office action granting the party who filed the request six months in which to comply with the requirements of the rule. If there is no response, the request to divide will be dismissed.

A party who requests division of a registration issued under the old U.S. classification system (see TMEP §1401.02) must agree to adopt the international classification system for both the parent and child registration. See TMEP §1609.04 regarding amendment of classification.

Once the registration is divided, the USPTO will create a new registration number for the child and send new registration certificates to both the assignor and assignee.

A registration may be divided more than once.

## REGISTRATION AND POST REGISTRATION PROCEDURES

### 1615.02 Division of Registered Extension of Protection

When ownership of an international registration changes with respect to some but not all of the goods/services for all designated Contracting Parties, the IB will create a separate new international registration for the goods/services that have been transferred, and notify the USPTO accordingly. See the IB's *Guide to International Registration*, Para. B.II.65.01 (2004).

To obtain a new certificate(s) of registration of the extension of protection in the United States in this situation, the new owner(s) must:

- (1) file a request to divide with the USPTO, and
- (2) pay the fee required by 37 C.F.R. §2.6(a)(8) for each new registration created by the division. 37 C.F.R. §2.171(b). No application filing fee pursuant to 37 C.F.R. §2.6(a)(1) is required.

When the IB notifies the USPTO of the division of an international registration resulting from a change of ownership with respect to some but not all of the goods/services, the USPTO will record the partial change of ownership in the Assignment Services Division, divide out the assigned goods/services from the registered extension of protection (parent registration), issue an updated certificate for the parent registration, and publish notice of the parent registration in the *Official Gazette*.

The USPTO will create a new registration number for the child, and enter the information about the new registration in its automated records. However, the USPTO will not issue a new registration certificate for the child registration or publish notice of the child registration until the assignee submits a request to divide under 37 C.F.R. §2.171(b), and pays the required fee.

The USPTO will not divide a registered extension of protection to the United States unless the IB notifies the USPTO that the international registration has been divided.

A registration may be divided more than once.

See TMEP §1110.08 regarding division of a pending §66(a) application after ownership has changed with respect to some but not all of the goods/services, and TMEP §501.07 regarding assignment of extensions of protection.

### 1616 Replacement

If a U.S. national registration and a subsequently issued certificate of extension of protection of an international registration to the United States are (1) owned by the same person, (2) identify the same mark, and (3) list the same goods/services, the extension of protection shall have the same rights as those accrued to the U.S. national registration at the time the certificate of

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

extension of protection issues. Section 74 of the Trademark Act, 15 U.S.C. §1141n; Article 4<sup>bis</sup> of the Madrid Protocol; 37 C.F.R. §7.28(a).

Legally, replacement takes place automatically, by operation of law. However, the USPTO will note the replacement in its records (and notify the IB accordingly) only if the holder of a registered extension of protection files a request that it do so. A request to note replacement of a U.S. national registration with a registered extension of protection must include:

- (1) The serial number or registration number of the extension of protection to the United States;
- (2) The registration number of the replaced U.S. registration; and
- (3) The fee required by 37 C.F.R. §7.6.

37 C.F.R. §7.28(b).

The holder cannot file the request to note replacement of the U.S. national registration until the registration based on the request for extension of protection issues.

“Replacement” does not invalidate the U.S. national registration. The U.S. national registration remains on the register, with all the rights attaching to such a registration, as long as the holder renews the registration under §9 of the Trademark Act and files the necessary affidavits of use or excusable nonuse under §8 of the Trademark Act. 37 C.F.R. §7.29. It is up to the holder to decide whether to maintain the replaced U.S. national registration.

# Chapter 1700

## Matters Submitted to Director

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- 1701 Statutory Authority of Director**
- 1702 Petitions to the Director Under 37 C.F.R. §2.146 - In General**
- 1703 Specific Types of Petitions**
- 1704 Petitionable Matter**
- 1705 Petition Procedure**
  - 1705.01 Standing
  - 1705.02 Petition Fee
  - 1705.03 Evidence and Proof of Facts
  - 1705.04 Timeliness
  - 1705.05 Due Diligence
  - 1705.06 Stay or Suspension of Pending Matters
  - 1705.07 Signature of Petition
  - 1705.08 Request for Reconsideration of Denial of Petition
  - 1705.09 Appeal to Federal Court
- 1706 Standard of Review on Petition**
- 1707 Director's Supervisory Authority Under 37 C.F.R. §2.146(a)(3)**
- 1708 Waiver of Rules**
- 1709 Matters Delegated by Director**
- 1710 Petition to Make Special**
  - 1710.01 Basis for Granting or Denying Petition
  - 1710.02 Processing Petition Papers
- 1711 Review of Denial of Filing Dates**

# TRADEMARK MANUAL OF EXAMINING PROCEDURE

## **1712 Reinstatement of Applications and Registrations**

1712.01 Reinstatement of Applications Abandoned Due to Office Error

1712.02 Reinstatement of Registrations Cancelled or Expired Due to Office Error

## **1713 Petition to Reverse Holding of Abandonment for Failure to Respond Completely**

## **1714 Petition to Revive Abandoned Application**

1714.01 Procedural Requirements for Filing Petition to Revive

1714.01(a) Failure to Timely Respond to an Examining Attorney's Office Action

1714.01(b) Failure to File a Statement of Use or Extension Request - Notice of Allowance Received

1714.01(b)(i) Applicant Must File Statement of Use or Further Extension Requests During Pendency of a Petition

1714.01(c) Notice of Allowance Not Received

1714.01(d) Timeliness and Diligence

1714.01(e) Signed Statement That Delay Was Unintentional

1714.01(f) Applicability of Unintentional Delay Standard

1714.01(f)(i) Situations Where the Unintentional Delay Standard Applies

1714.01(f)(ii) Situations Where the Unintentional Delay Standard Does Not Apply

1714.01(g) Request for Reconsideration of Denial of Petition to Revive

## **1715 Letters of Protest in Pending Applications**

1715.01 Appropriate Subjects to be Raised in Letter of Protest

1715.01(a) Issues Appropriate as Subject of Letter of Protest

1715.01(b) Issues Inappropriate as Subject of Letter of Protest

1715.02 Letters of Protest Filed Before Publication

1715.03 Letters of Protest Filed After Publication

1715.03(a) Timely Filing of Letter of Protest

1715.03(b) Letter of Protest Does Not Stay or Extend Opposition Period

## MATTERS SUBMITTED TO DIRECTOR

- 1715.04 Tracking of Letters of Protest by the Protestor
- 1715.05 Approval of Applications for Publication or Issue After Grant of a Letter of Protest
- 1715.06 Recourse After Denial of Letter of Protest
- 1715.07 Requests for Copies of Letters of Protest

### **1701 Statutory Authority of Director**

The United States Patent and Trademark Office (“USPTO”) is led by the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“Director”). The Commissioner for Trademarks oversees the staff and operations of the USPTO with regard to trademark matters. 35 U.S.C. §3(b)(2). See TMEP §1709 regarding delegation of duties by the Director.

The Patent and Trademark Office Efficiency Act, Subtitle G of the American Inventors Protection Act of 1999, Pub. L. 106-113, 113 Stat. 1501A-572, amended Title 35 of the United States Code to reorganize the USPTO as a performance-based organization within the Department of Commerce. See *Reestablishment of the Patent and Trademark Office as the United States Patent and Trademark Office*, 1234 TMOG 41 (May 9, 2000). Section 4732(b)(1)(B) of the Patent and Trademark Office Efficiency Act, 113 Stat. 1501A-583, amended the Trademark Act of 1946, 15 U.S.C. 1051 *et. seq.* (except for §17) to strike “Commissioner” in each place that it appears and substitute “Director.” Section 4741(b) of the Patent and Trademark Office Efficiency Act, 113 Stat. 1501A-586, provides that:

Any reference in any other Federal law, Executive order, rule, regulation, or delegation of authority, or any document of or pertaining to the Patent and Trademark Office-

(1) to the Commissioner of Patents and Trademarks is deemed to refer to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office; [and]

\* \* \*

(3) to the Assistant Commissioner for Trademarks is deemed to refer to the Commissioner for Trademarks.

Under 15 U.S.C. §1123 and 35 U.S.C. §2(b)(2), the Director may establish regulations for the conduct of proceedings in the USPTO.



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1702                    **Petitions to the Director Under 37 C.F.R. §2.146 - In General**

*37 C.F.R. §2.146 Petitions to the Director.*

*(a) Petition may be taken to the Director: (1) From any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by §2.63(b); (2) in any case for which the Act of 1946, or Title 35 of the United States Code, or this Part of Title 37 of the Code of Federal Regulations specifies that the matter is to be determined directly or reviewed by the Director; (3) to invoke the supervisory authority of the Director in appropriate circumstances; (4) in any case not specifically defined and provided for by this Part of Title 37 of the Code of Federal Regulations; (5) in an extraordinary situation, when justice requires and no other party is injured thereby, to request a suspension or waiver of any requirement of the rules not being a requirement of the Act of 1946.*

*(b) Questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under §§2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions to the Director.*

*(c) Every petition to the Director shall include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief that is requested, and the fee required by § 2.6. Any brief in support of the petition shall be embodied in or accompany the petition. When facts are to be proved in ex parte cases, proof in the form of affidavits or declarations in accordance with § 2.20, and any exhibits, shall accompany the petition.*

*(d) A petition must be filed within two months of the mailing date of the action from which relief is requested, unless a different deadline is specified elsewhere in this chapter.*

*(e)(1) A petition from the grant or denial of a request for an extension of time to file a notice of opposition shall be filed within fifteen days from the date of mailing of the grant or denial of the request. A petition from the grant of a request shall be served on the attorney or other authorized representative of the potential opposer, if any, or on the potential opposer. A petition from the denial of a request shall be served on the attorney or other authorized representative of the applicant, if any, or on the applicant. Proof of service of the petition shall be made as provided by §2.119(a). The potential opposer or the applicant, as the case may be, may file a response within fifteen days from the date of service of the petition and shall serve a copy of the response on the petitioner, with proof of service as provided by §2.119(a). No further paper relating to the petition shall be filed.*

*(2) A petition from an interlocutory order of the Trademark Trial and Appeal Board shall be filed within thirty days after the date of mailing of the order from which relief is requested. Any brief in response to the petition shall be filed, with any supporting exhibits, within fifteen days from the date of service of the petition. Petitions and responses to petitions, and any papers accompanying a petition or response, under this subsection shall be served on every adverse party pursuant to §2.119(a).*

## MATTERS SUBMITTED TO DIRECTOR

(f) *An oral hearing will not be held on a petition except when considered necessary by the Director.*

(g) *The mere filing of a petition to the Director will not act as a stay in any appeal or inter partes proceeding that is pending before the Trademark Trial and Appeal Board nor stay the period for replying to an Office action in an application except when a stay is specifically requested and is granted or when §§2.63(b) and 2.65 are applicable to an ex parte application.*

(h) *Authority to act on petitions, or on any petition, may be delegated by the Director.*

(i) *Where a petitioner seeks to reactivate an application or registration that was abandoned, cancelled or expired because papers were lost or mishandled, the Director may deny the petition if the petitioner was not diligent in checking the status of the application or registration. To be considered diligent, a petitioner must:*

(1) *During the pendency of an application, check the status of the application every six months between the filing date of the application and issuance of a registration;*

(2) *After registration, check the status of the registration every six months from the filing of an affidavit of use or excusable nonuse under section 8 or 71 of the Act, or a renewal application under section 9 of the Act, until the petitioner receives notice that the affidavit or renewal application has been accepted; and*

(3) *If the status check reveals that the Office has not received a document filed by the petitioner, or that the Office has issued an action or notice that the petitioner has not received, the petitioner must promptly request corrective action.*

(j) *If the Director denies a petition, the petitioner may request reconsideration, if the petitioner:*

(1) *Files the request within two months of the mailing date of the decision denying the petition; and*

(2) *Pays a second petition fee under §2.6.*

Applicants, registrants, and parties to *inter partes* proceedings before the Trademark Trial and Appeal Board who believe they have been injured by certain adverse actions of the USPTO, or who believe that they cannot comply with the requirements of the Trademark Rules of Practice (37 C.F.R. Part 2) because of an extraordinary situation, may seek equitable relief by filing a petition under 37 C.F.R. §2.146.

Under 37 C.F.R. §2.146(a)(1), an applicant may file a petition to review an examining attorney's formal requirement if permitted by 37 C.F.R. §2.63(b). Under 37 C.F.R. §2.63(b)(1), a petition from a requirement that is repeated but not made final is permitted if the subject matter of the requirement is appropriate for petition. Under 37 C.F.R. §2.63(b)(2), a petition from a final requirement is permitted only if the final action *is limited to* subject matter appropriate for petition. See TMEP §1704 regarding petitionable subject

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

matter. If a petition under 37 C.F.R. §2.146(a)(1) is denied, the applicant has six months from the date of the Office action that repeated the requirement or made it final, or thirty days from the date of the decision on the petition, whichever is later, to comply with the requirement. 37 C.F.R. §2.63(a).

Under 37 C.F.R. §2.146(a)(2), a petition may be filed in any case for which the Trademark Act, Trademark Rules of Practice, or Title 35 of the United States Code specifies that the matter is to be determined directly or reviewed by the Director. This includes petitions to review the actions of Post Registration examiners under 15 U.S.C. §§1057, 1058, 1059 and 1141k.

Under 35 U.S.C. §2 and 37 C.F.R. §2.146(a)(3), the Director may invoke supervisory authority in appropriate circumstances. See TMEP §1707.

Under 37 C.F.R. §2.146(a)(5), a party may petition the Director to suspend or waive any requirement of the rules that is not a requirement of the statute, in an extraordinary situation, where justice requires and no other party is injured thereby. See TMEP §1708.

See TMEP §1703 for a list of issues that often arise on petition, and TMEP §§1705 *et seq.* regarding petition procedure.

### **1703 Specific Types of Petitions**

There are a variety of issues that may be reviewed on petition. The following is a list of issues that commonly arise:

*Petitions to Restore an Application Filing Date.* See TMEP §1711.

*Petitions to Make Special.* See TMEP §1710.

*Petitions to Reverse an Examining Attorney's Holding of Abandonment* for failure to file a complete response to an Office action are reviewed under 37 C.F.R. §2.146(a)(3). See TMEP §1713.

*Petitions to Revive Applications Abandoned Due to Unintentional Delay in Responding to an Office Action or Notice of Allowance* are considered under 37 C.F.R. §2.66. See TMEP §1714.

*Petitions to Restore Jurisdiction to the Examining Attorney* may be filed by the applicant under 37 C.F.R. §2.84, when the examining attorney does not have jurisdiction to review one of the applicant's amendments.

*Petitions to Review the Action of an Examining Attorney.* A petition to review an examining attorney's formal requirement may be filed under 37 C.F.R. §§2.63(b) and 2.146(a)(1), if the

## MATTERS SUBMITTED TO DIRECTOR

requirement is repeated or made final and the subject matter is appropriate for petition. See TMEP §1704 regarding petitionable subject matter, and TMEP §1706 regarding the standard of review.

*Petitions to Review the Action of the Post Registration Examiner* may be filed if an affidavit of use or excusable nonuse is refused under 15 U.S.C. §1058 or §1141k, a renewal application is refused under 15 U.S.C. §1059, or a proposed amendment or correction is refused under 15 U.S.C. §1057. See 37 C.F.R. §§2.165, 2.176 and 2.186; TMEP §§1604.18 and 1606.14.

*Petitions to Review the Refusal of the Madrid Processing Unit to Certify an application for international registration* are reviewed under 37 C.F.R. §2.146(a)(3). See TMEP §1902.03(a).

*Petitions to Reverse a Non-Final Decision of the Trademark Trial and Appeal Board* (37 C.F.R. §2.146(e)(2)) are reviewed under the standard of clear error or abuse of discretion, if the subject matter is appropriate for consideration on petition. *Riko Enterprises, Inc. v. Lindsley*, 198 USPQ 480 (Comm'r Pats. 1977). See *Trademark Trial and Appeal Board Manual of Procedure* ("TBMP") §§901.02(a) and 905.

*Petitions to Review a Decision to Deny or Grant a Request for an Extension of Time to Oppose* (37 C.F.R. §2.146(e)(1)) are reviewed to determine whether the Board correctly applied 37 C.F.R. §§2.101 and 2.102.

*Petitions to Add or Substitute a Basis After Publication* are reviewed under 37 C.F.R. §2.146(a)(2). See 37 C.F.R. §2.35(b)(3); TMEP §806.03(j).

See TMEP §1607 and TBMP §§303, 307, 308, and 309 regarding petitions to cancel registrations under 15 U.S.C. §1064, which are handled by the Trademark Trial and Appeal Board.

### **1704                      Petitionable Matter**

#### ***Ex Parte Examination***

Under 37 C.F.R. §2.63(b), an applicant may petition the Director to review an examining attorney's repeated or final requirement if the subject matter of the requirement is appropriate for petition. Under 37 C.F.R. §2.146(b), "[q]uestions of substance arising during the *ex parte* prosecution of applications, including, but not limited to, questions arising under §§2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions...."

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Procedural issues reviewable on petition include whether a disclaimer was properly printed in standardized format; whether an examining attorney acted properly in suspending an application; whether an examining attorney acted properly in holding an application abandoned for failure to file a complete response to an Office action (see TMEP §1713); and whether it was premature for an examining attorney to issue a final action.

Substantive issues that arise in *ex parte* examination are not proper subject matter for petition, and may be reviewed only by the Trademark Trial and Appeal Board on appeal. See TMEP §§1501 *et seq.* regarding appeal procedure. For example, an examining attorney's requirement for a special form drawing that agrees with the mark shown on the specimens of record may not be reviewed on petition, because it requires an analysis of the commercial impression of the mark. *In re Hart*, 199 USPQ 585 (Comm'r Pats. 1978). An examining attorney's requirement for a disclaimer of a feature of a mark is also improper subject matter for petition. *Ex parte Florida Citrus Cannery Cooperative*, 37 USPQ 463 (Comm'r Pats. 1938); *Ex parte Kleen-O-Dent Laboratories, Inc.*, 37 USPQ 232 (Comm'r Pats. 1938). The question of whether an amendment to a drawing is a material alteration of the mark is not petitionable, but the question of whether USPTO practice permits an applicant to correct an allegedly obvious typographical error on a drawing was found to be reviewable on petition. *In re Tetrafluor Inc.*, 17 USPQ2d 1160 (Comm'r Pats. 1990). The determination of what is appealable and what is petitionable is made on a case by case basis.

Some issues that arise in *ex parte* examination may be reviewed by either petition or appeal. For example, a requirement for amendment of an identification of goods may be reviewed either by petition or appeal. *In re Stenographic Machines, Inc.*, 199 USPQ 313 (Comm'r Pats. 1978). On the other hand, a requirement for amendment of the classification is a procedural matter that can only be reviewed on petition. *In re Tee-Pak, Inc.*, 164 USPQ 88 (TTAB 1969).

If an applicant files a petition from an examining attorney's formal requirement, the applicant may not subsequently appeal the requirement to the Trademark Trial and Appeal Board. 15 U.S.C. §1070; 37 C.F.R. §2.63(b).

See TBMP §1201.05 for further information about appealable versus petitionable subject matter in examination.

### **Post Registration**

Trademark Rule 2.146(b) applies only to questions of substance that arise during *ex parte* examination of applications for registration. The Director considers questions of substance, such as whether a proposed amendment materially alters a registered mark, or whether a specimen supports use of a registered mark, when reviewing the action of a Post Registration examiner in connection with a proposed amendment filed under 15 U.S.C. §1057, or an

## MATTERS SUBMITTED TO DIRECTOR

affidavit of use under 15 U.S.C. §1058 or §1141k. The decisions of Post Registration examiners under 15 U.S.C. §§1057, 1058, 1059, and 1141k may not be appealed to the Trademark Trial and Appeal Board.

### ***Inter Partes Proceedings Before Trademark Trial and Appeal Board***

In an *inter partes* proceeding before the Trademark Trial and Appeal Board, a party may petition the Director to review an order or decision of the Board that concerns a matter of procedure and does not put an end to the litigation before the Board. See TBMP §§901.02(a) and 905.

#### **1705                    Petition Procedure**

A petition should include a verified statement of the relevant facts, the points to be reviewed, the requested action or relief, and the fee required by 37 C.F.R. §2.6. 37 C.F.R. §2.146(c). The petition should be accompanied by a supporting brief and any evidence to be considered.

##### **1705.01                Standing**

A person must have standing to file a petition. See *Ex parte Lasek*, 115 USPQ 145 (Comm'r Pats. 1957).

There is no provision in the Trademark Act or Rules of Practice for intercession by a third party in an *ex parte* matter. Accordingly, petitions by third parties to review actions taken in *ex parte* matters are denied.

##### **1705.02                Petition Fee**

A petition must be accompanied by the fee required by 37 C.F.R. §2.6.

Any petition that is not accompanied by the required fee is incomplete. A staff attorney or paralegal in the Office of the Commissioner for Trademarks will notify the petitioner in writing that the petition is incomplete and grant the petitioner 30 days to submit the fee. If the fee is not submitted within the time allowed, the petition is denied without consideration on the merits, because the petitioner has not met the requirements for filing a petition. 37 C.F.R. §2.146(c).

A petition fee will be waived only if the record clearly shows that the petition was the result of a USPTO error. When requesting waiver of a fee, it is recommended that the petitioner submit the fee, but include a request that the fee be refunded because the petition was the result of a USPTO error. This will expedite consideration of the petition if the request for waiver of the petition fee is denied.

If a check submitted as a petition fee is returned to the USPTO unpaid, or an electronic funds transfer or credit card is refused or charged back by a

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

financial institution, the petitioner must resubmit the petition fee, along with a \$50 fee for processing the payment that was refused or charged back, before the petition will be considered on the merits. 37 C.F.R. §2.6(b)(12). See TMEP §405.06.

### **1705.03 Evidence and Proof of Facts**

A petition should include a statement of the relevant facts, and should be accompanied by any evidence to be considered. Under 37 C.F.R. §2.146(c), when facts are to be proved, proof in the form of an affidavit or declaration under 37 C.F.R. §2.20 must be submitted.

An affidavit or declaration supporting a petition should be based on firsthand knowledge. For example, if the petition arises from the loss or misplacement of a document submitted to the USPTO, it should be accompanied by the affidavit or declaration of the person who sent the document, attesting to the date of submission and identifying the document filed with the petition as a true copy of the document previously filed.

When a petition includes an unverified assertion that is not supported by evidence, a staff attorney or paralegal in the Office of the Commissioner for Trademarks will notify the petitioner that an affidavit or declaration is required, and grant the petitioner 30 days to submit the necessary verification. If the petitioner does not submit a verification within the time allowed, the petition will be denied, or, in appropriate cases, a decision on petition will be rendered based on the information in the record, without consideration of the unverified assertion.

This procedure is also followed with respect to physical evidence. If physical evidence is available, such as a postcard receipt that shows the date of actual receipt of a document in the USPTO (see TMEP §303.02(c)), or a copy of a cancelled check that shows receipt of the filing fee for a missing paper, the petitioner should include the evidence with the initial petition. However, if the evidence is omitted from the initial filing, the USPTO will give the petitioner an opportunity to supplement the petition within a specified time limit.

### **1705.04 Timeliness**

To avoid prejudicing the rights of third parties, petitions must be filed within a reasonable time after the disputed event. In many cases, deadlines for filing petitions are expressly stated in the rules. The following petition deadlines run from the mailing date of the action or order of which the petitioner seeks review:

- Denial of a request for an extension of time to file a notice of opposition -- 15 days (37 C.F.R. §2.146(e)(1));

## MATTERS SUBMITTED TO DIRECTOR

- Interlocutory order of the Trademark Trial and Appeal Board -- 30 days (37 C.F.R. §2.146(e)(2));
- Denial of a request for an extension of time to file a statement of use -- two months (37 C.F.R. §2.89(g));
- Section 7 rejection -- six months (37 C.F.R. §2.176);
- Section 8 rejection -- six months (37 C.F.R. §2.165(b));
- Section 9 rejection -- six months (37 C.F.R. §2.186(b));
- Petition to revive -- two months (37 C.F.R. §2.66(a));
- Examining attorney's formal requirement -- six months (15 U.S.C. §1062(b); 37 C.F.R. §§2.62 and 2.63(b));
- Request for reconsideration of decision on petition -- two months (37 C.F.R. §§2.66(f)(1) and 2.146(j)(1)).

If the rules do not provide an express deadline, the petition must be filed within two months of the date of mailing of the action from which relief is requested, under 37 C.F.R. §2.146(d).

If there is no "mailing of an action," the two-month "catchall deadline" of 37 C.F.R. §2.146(d) runs from the date of the phone call or other communication that prompts the filing of the petition. The two-month deadline of 37 C.F.R. §2.146(d) also applies where the petition alleges that the petitioner did not receive the action that prompts the filing of the petition, running from the date of the petitioner's actual knowledge of said action.

The time limits set forth in the rules are strictly enforced. Petitions filed after the expiration of the deadlines are denied as untimely. If the petitioner can show that extraordinary circumstances caused the delay in filing the petition, the petitioner may request waiver of these time limits, pursuant to 37 C.F.R. §§2.146(a)(5) and 2.148. See TMEP §1708 regarding waiver of rules.

The petition fee is refunded when a petition is denied as untimely.

Petitions filed using the certificate of mailing and certificate of transmission procedures of 37 C.F.R. §2.197 will be considered timely if mailed or transmitted to the USPTO by the due date, with a certificate that meets the requirements of 37 C.F.R. §2.197(a)(1) (see TMEP §§305.02 and 306.05 *et seq.*).

See TMEP §1705.05 regarding the duty to exercise due diligence in monitoring the status of pending matters.



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1705.05 Due Diligence

Applicants and registrants are responsible for tracking the status of matters pending before the USPTO. When a petitioner seeks to reactivate an application or registration that was abandoned, cancelled, or expired due to the loss or mishandling of documents sent to or from the USPTO, the USPTO may deny the petition if the petitioner was not diligent in checking the status of the application or registration, even if the petitioner can show that the USPTO actually received documents, or declares that a notice from the USPTO was never received by the petitioner.

The required showing of diligence is necessary to protect third parties who may be harmed by the removal and later reinsertion of an application or registration into the USPTO's database. For example, a third party may have diligently searched USPTO records and begun using a mark because the search showed no earlier-filed conflicting marks, or an examining attorney may have searched USPTO records and approved a later-filed application for a conflicting mark because the examining attorney was unaware of the earlier-filed application.

The USPTO generally processes applications, responses and other papers in the order in which they are received. Since it is reasonable to expect some notice from the USPTO about a pending matter within six months of the filing or receipt of a document, a party who has not received the expected written action or telephone call from the USPTO within that time frame should be on notice that the filing may have been lost. The party awaiting notification has the burden of inquiring as to the cause of the delay, and requesting corrective action in writing when necessary.

To be considered diligent, a petitioner must:

- Check the status of a pending application every six months between the filing date of the application and issuance of a registration;
- Check the status of a registration every six months after filing an affidavit of use or excusable nonuse under §8 or §71 of the Trademark Act, or a renewal application under §9 of the Trademark Act, until the petitioner receives notice that the affidavit or renewal application has been accepted; and
- Promptly request corrective action in writing where necessary.

37 C.F.R. §2.146(i). See notice at 68 FR 55748 (Sept. 26, 2003).

Applicants and registrants are encouraged to check the status on each six-month anniversary of the filing of an application for registration, §8 affidavit or §9 renewal application to avoid abandonment or cancellation and to ensure that they meet the diligence requirement. For example, if an application was filed on November 1, 2004, the applicant should check the

## MATTERS SUBMITTED TO DIRECTOR

status on May 1, 2005, November 1, 2005, and on each six-month anniversary thereafter, until a registration is issued.

However, to provide applicants, registrants and their attorneys with flexibility in docketing deadlines for both responses and status checks, an applicant or registrant will meet the diligence requirement if it checks the status within six months of the filing or receipt of a paper for which further action by the USPTO is expected.

Applicants and registrants can check the status of an application or registration through the Trademark Applications and Registrations Retrieval ("TARR") database on the USPTO website at <http://tarr.uspto.gov>, which is available 24 hours a day, seven days a week. The party should print the TARR screen and place it in the party's own file, in order to have a record of the status inquiry and the information learned.

A party who does not have access to the Internet can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to determine the status. After making a telephone status inquiry, a party should make a note in the party's own file as to the date of the status inquiry and the information learned. No further documentation is required to establish that the status inquiry was made. Written status inquiries are discouraged, because they may delay processing of the application or registration.

If a status inquiry reveals that a paper was not received, or that some other problem exists, corrective action should be promptly requested in writing. 37 C.F.R. §2.146(i)(3). Petitions should be directed to the Office of the Commissioner for Trademarks. Requests for reinstatement should be directed to the Paralegal Specialists in the Office of the Commissioner for Trademarks, the supervisory legal instruments examiner in the law office, or the supervisor of the ITU Unit or Post Registration Section. See TMEP §§1712 *et seq.* regarding requests for reinstatement.

Where a registrant has proof that a USPTO error caused a registration to expire or be cancelled due to failure to file an affidavit or declaration of use or excusable nonuse under 15 U.S.C. §1058 ("8 affidavit"), a renewal application under 15 U.S.C. §1059, or a response to an examiner's Office action refusing to accept a §8 affidavit or renewal application, the registrant may file a request for reinstatement. See TMEP §1712.02 regarding the types of proof of USPTO error that will support a request for reinstatement. Generally, where there is proof that a registration was cancelled solely due to a USPTO error, a request for reinstatement will not be denied solely because the registrant was not diligent in monitoring the status of the §8 affidavit or renewal application. However, if a registrant receives a written notice of cancellation, or has actual notice that a registration was cancelled, the USPTO will deny the request for reinstatement as untimely if it was not filed (1) within two months of the mailing date of the cancellation notice, or

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

(2) within two months of actual notice of cancellation, if the registrant did not receive a written cancellation notice. 37 C.F.R. §2.146(d).

A request to reinstate an *application* abandoned due to USPTO error (see TMEP §1712.01) will be denied if the applicant was not diligent in monitoring the status of the application.

### **1705.06 Stay or Suspension of Pending Matters**

*37 C.F.R. §2.146(g). The mere filing of a petition ... will not act as a stay in any appeal or inter partes proceeding that is pending before the Trademark Trial and Appeal Board nor stay the period for replying to an Office action in an application except when a stay is specifically requested and is granted or when §§2.63(b) and 2.65 are applicable to an ex parte application.*

Filing a petition does not stay the period for replying to an Office action, except when a stay is specifically requested and granted under 37 C.F.R. §2.146(g), or when 37 C.F.R. §§2.63(b) and 2.65 are applicable. Any request to stay a deadline for filing a response to an Office action or notice of appeal should be directed to the Office of the Commissioner for Trademarks. If such a request is sent to the examining attorney, the examining attorney should forward it to the Office of the Commissioner for Trademarks. The examining attorney should **not** suspend action on an application pending a decision on petition.

A request to suspend a proceeding before the Trademark Trial and Appeal Board pending a decision on petition should be directed to the Board. 37 C.F.R. §2.117(c). See TBMP §§510 *et seq.* and 1213 regarding suspension of Board proceedings.

Filing a petition to revive an application abandoned for failure to file a proper statement of use or request for an extension of time to file a statement of use does not stay the time for filing a statement of use or further extension request(s). See TMEP §1714.01(b)(i).

### **1705.07 Signature of Petition**

A petition should be signed by the petitioner or the petitioner's attorney.

If the petitioner has an attorney, the attorney must sign the response. 37 C.F.R. §10.18(a). If the petitioner is not represented by an attorney, the response must be signed by someone with legal authority to bind the petitioner (e.g., a corporate officer or general partner of a partnership). A non-attorney who is authorized to verify facts under 37 C.F.R. §2.33(a)(2) or §2.161(b) is *not* entitled to sign petitions, unless he or she has legal authority to bind the petitioner. Under 5 U.S.C. §500(d) and 37 C.F.R. §10.14(e), non-

## MATTERS SUBMITTED TO DIRECTOR

attorneys may not represent a party in a trademark proceeding before the USPTO.

See TMEP §§712.01(a) *et seq.* for guidelines on persons who have legal authority to bind various types of petitioners.

See TMEP 804.05 regarding signature of documents filed electronically.

### **1705.08 Request for Reconsideration of Denial of Petition**

Under 37 C.F.R. §2.146(j), if a petition is denied, the petitioner may request reconsideration by: (1) filing the request for reconsideration within two months of the mailing date of the decision denying the petition; and (2) paying a second petition fee under 37 C.F.R. §2.6.

If the petitioner presents new facts that warrant equitable relief, the request for reconsideration may be granted. Any request for reconsideration that merely reiterates or expands on arguments previously presented will be denied.

Since contested matters must be brought to a conclusion within a reasonable time, a second request for reconsideration of a decision on petition will be granted only in rare situations, when the petitioner presents significant facts or evidence not previously available to the petitioner. *In re American National Bank and Trust Company of Chicago*, 33 USPQ2d 1535 (Comm'r Pats. 1993).

### **1705.09 Appeal to Federal Court**

Under 15 U.S.C. §1071(a)(1) and 37 C.F.R. §2.145(a), a registrant who is adversely affected by the Director's decision regarding a renewal application or an affidavit or declaration under 15 U.S.C. §1058 may appeal to the United States Court of Appeals for the Federal Circuit or commence a civil action for review of the decision on petition. 15 U.S.C. §§1071(a)(1) and (b)(1); 37 C.F.R. §§2.145(a) and 2.145(c).

Other types of Director's decisions are not subject to appeal. See *In re Marriott-Hot Shoppes, Inc.*, 411 F.2d 1025, 162 USPQ 106 (C.C.P.A. 1969).

The deadline for filing an appeal or commencing a civil action is two months from the mailing date of the decision. 15 U.S.C. §§1071(a)(2) and (b)(1); 37 C.F.R. §2.145(d)(1). Under 37 C.F.R. §2.145(d)(2), one day is added to any two-month period that includes February 28.

### **1706 Standard of Review on Petition**

The standard of review on petition depends on the particular section of the rules under which the petition is filed.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

In review of an examining attorney's formal requirement under 37 C.F.R. §§2.63(b) and 2.146(a)(1), the standard of review is whether the examining attorney's judgment was correct, the same standard that the Trademark Trial and Appeal Board would use if it were considering the requirement on appeal. *In re Du Pont Merck Pharmaceutical Co.*, 34 USPQ2d 1778 (Comm'r Pats. 1995); *In re Stenographic Machines, Inc.*, 199 USPQ 313 (Comm'r Pats. 1978). However, in review of an examining attorney's action under 37 C.F.R. §2.146(a)(3), the Director will reverse the examining attorney only upon a finding of clear error or abuse of discretion. *In re GTE Education Services*, 34 USPQ2d 1478 (Comm'r Pats. 1994); *In re Direct Access Communications (M.C.G.) Inc.*, 30 USPQ2d 1393 (Comm'r Pats. 1993).

The Director also uses the clear error or abuse of discretion standard when reviewing an action of the Trademark Trial and Appeal Board under 37 C.F.R. §2.146(a)(3). *Riko Enterprises, Inc. v. Lindsley*, 198 USPQ 480 (Comm'r Pats. 1977).

The Director reviews the actions of Post Registration examiners on affidavits of use or excusable nonuse under 15 U.S.C. §1058 or §1141k, renewal applications under 15 U.S.C. §1059, and amendments to registrations under 15 U.S.C. §1057, to determine whether the judgment of the examiner was correct. See *In re Umax Data System, Inc.*, 40 USPQ2d 1539 (Comm'r Pats. 1996) (announcing change in standard of review of petitions to review Post Registration examiners' decisions on amendments to registrations under 15 U.S.C. §1057).

The Director reviews the denial of an application filing date to determine whether the denial was correct.

### **1707                      Director's Supervisory Authority Under 37 C.F.R. §2.146(a)(3)**

Under 35 U.S.C. §2 and 37 C.F.R. §2.146(a)(3), the Director may exercise supervisory authority on petition in appropriate circumstances. As noted in TMEP §1706, the Director may review the actions of an examiner or paralegal under 37 C.F.R. §2.146(a)(3), using the "clear error" standard of review.

In some cases, the Director will exercise supervisory authority under 37 C.F.R. §2.146(a)(3) even where there has been no clear error or abuse of discretion, if a petitioner can show that it has substantially complied with the requirements of the statute or rules. See *In re Carnicon Development Company*, 34 USPQ2d 1541 (Comm'r Pats. 1992) (assertion of verified date of first use, coupled with statement of current method of use, interpreted as substantially in compliance with minimum filing requirement of 37 C.F.R. §2.88(e)(3) for an allegation that the "mark is in use in commerce" in a statement of use).

## MATTERS SUBMITTED TO DIRECTOR

The Director may also exercise supervisory authority under 37 C.F.R. §2.146(a)(3) to make changes to USPTO practice. See *In re Umax Data System, Inc.*, 40 USPQ2d 1539 (Comm'r Pats. 1996) (announcing change in standard of review of petitions to review Post Registration examiners' decisions on amendments to registrations under 15 U.S.C. §1057).

### 1708 Waiver of Rules

Under 37 C.F.R. §§2.146(a)(5) and 2.148, the Director may waive any provision of the rules that is not a provision of the statute, when (1) an extraordinary situation exists, (2) justice requires, and (3) no other party is injured.

All three of the above conditions must be satisfied before a waiver will be granted, and the burden is on the petitioner to show that the situation is extraordinary. Disasters like fires, hurricanes and snow storms are considered to be extraordinary situations. Extraordinary circumstances have also been found in certain cases where a petitioner avers by affidavit or declaration that it did not receive an Office action issued regarding an affidavit of use under 15 U.S.C. §1058 or renewal application under 15 U.S.C. §1059.

On the other hand, oversights and inadvertent errors that could have been avoided with the exercise of reasonable care are not considered to be "extraordinary situations." *In re Universal Card Group, Inc.*, 25 USPQ2d 1157 (Comm'r Pats. 1992) (docketing error not extraordinary situation); *In re Merck & Co., Inc.*, 24 USPQ2d 1317 (Comm'r Pats. 1992) (inadvertent misidentification of serial number in request for extension of time to oppose not extraordinary situation); *In re Tetrafluor Inc.*, 17 USPQ2d 1160 (Comm'r Pats. 1990) (typographical error not extraordinary situation).

A change of attorneys is not considered to be an extraordinary situation, *In re Unistar Radio Networks, Inc.*, 30 USPQ2d 1390 (Comm'r Pats. 1993), nor is a misunderstanding or lack of awareness of the requirements of the Rules of Practice considered extraordinary. *In re Buckhead Marketing & Distribution, Inc.*, 71 USPQ2d 1620 (Dir USPTO 2004) (applicant's lack of knowledge of application filing fee increase not extraordinary situation); *B and E Sales Co. Inc. v. Andrew Jergens Co.*, 7 USPQ2d 1906 (Comm'r Pats. 1988); *Gustafson v. Strange*, 227 USPQ 174 (Comm'r Pats. 1985). Errors by attorneys are imputed to the client and the client is bound by the consequences. *In re Sotheby's Inc.*, 18 USPQ2d 1969 (Comm'r Pats. 1991).

Mail delays are not considered extraordinary, because the Trademark Rules of Practice provide procedures designed to avoid lateness due to mail delay. *In re Sportco, Inc.*, 209 USPQ 671 (Comm'r Pats. 1980); *In re Chicago Historical Antique Automobile Museum, Inc.*, 197 USPQ 289 (Comm'r Pats. 1978). See 37 C.F.R. §2.197 regarding certificates of mailing.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The Director has no authority to waive a statutory requirement, such as the deadline for filing a proper renewal application under 15 U.S.C. §1059 or affidavit of use of a registered mark under 15 U.S.C. §1058. *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984).

### **1709 Matters Delegated by Director**

Pursuant to 35 U.S.C. §3(a) and (b), the Director has delegated the authority to decide trademark-related petitions filed under 37 C.F.R. §§2.66 and 2.146, and to exercise supervisory authority in trademark-related matters pursuant to 35 U.S.C. §2, to the Commissioner for Trademarks.

Under 35 U.S.C. §3(b)(3)(B) and 37 C.F.R. §2.146(h), the Commissioner for Trademarks may redelegate this authority to the Deputy Commissioner for Trademark Examination Policy or the Deputy Commissioner for Trademark Operations, who may further redelegate the authority.

Authority to decide trademark-related petitions filed under 37 C.F.R. §2.146 has been delegated to the Deputy Commissioner for Trademark Examination Policy. Authority to decide the following petitions has been delegated to the staff attorneys and paralegal specialists in the Office of the Commissioner for Trademarks:

- Petitions to make special (TMEP §§1710 et seq.);
- Petitions to add or substitute a filing basis after publication (37 C.F.R. §2.35(b)(3); TMEP §806.03(j));
- Petitions to revive (37 C.F.R. §2.66; TMEP §§1714 et seq.);
- Requests by departments or agencies of the Government to waive fees pursuant to 15 U.S.C. §1113(b);
- Requests to reinstate abandoned applications (TMEP §1712.01); and
- Requests to review the denial of application filing dates (TMEP §1711).

### **1710 Petition to Make Special**

The USPTO generally examines applications in the order in which they are received. A petition to make “special” is a request to advance the examination of an application out of its regular order.

A petition to make “special” must be accompanied by: (1) the fee required by 37 C.F.R. §2.6; (2) an explanation of why special action is requested; and (3) a statement of facts that shows that special action is justified. The

## MATTERS SUBMITTED TO DIRECTOR

statement of facts should be supported by an affidavit or declaration under 37 C.F.R. §2.20.

When a new application for registration is accompanied by a petition to make “special,” the USPTO will give the application a serial number and process the fees before routing the application to the Office of the Commissioner for Trademarks for a decision on the petition.

An application for registration of a mark that was the subject of a previous registration that was inadvertently cancelled or expired will be made “special” upon applicant’s request. See TMEP §702.02. No petition is required in this situation. However, the mark and goods/services in the new application must be identical to the mark and goods/services in the previous registration, or the USPTO will not grant “special” status.

An application that has once been made “special” and advanced out of turn for examination will continue to be “special” until a date of publication in the *Official Gazette* is assigned to the application. See TMEP §702.02.

### **1710.01 Basis for Granting or Denying Petition**

Invoking supervisory authority under 37 C.F.R. §2.146 to make an application “special” is an extraordinary remedy that is granted only when very special circumstances exist, such as a *demonstrable* possibility of the loss of substantial rights. A petition to make “special” is denied when the circumstances would apply equally to a large number of other applicants.

The fact that the applicant is about to embark on an advertising campaign is *not* considered a circumstance that justifies advancement of an application out of the normal order of examination, because this situation applies to a substantial number of applicants.

The most common reasons for granting petitions to make “special” are the existence of actual or threatened infringement, or pending litigation, or the need for a registration as a basis for securing foreign registration.

### **1710.02 Processing Petition Papers**

Each petition to make “special,” together with the petition decision, is made part of the record. If the petition is granted, the Trademark Reporting and Monitoring (“TRAM”) System will reflect that the application has been marked for “special” handling.

### **1711 Review of Denial of Filing Dates**

If an application is denied a filing date and the applicant wants the filing date restored, the usual procedure is to file a petition under 37 C.F.R. §2.146.



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

However, in the limited circumstances listed below, the applicant may request restoration of the filing date without a formal petition:

- (1) The USPTO has no record of receipt of the application, but the applicant presents proof that a complete application was filed through the Trademark Electronic Application System ("TEAS"), in the form of a copy of an e-mail confirmation issued by the USPTO that includes the date of receipt and a summary of the submission.
- (2) The USPTO has no record of receipt of the application, but the applicant presents proof of actual receipt in the form of evidence that a USPTO employee signed for or acknowledged the envelope containing the application (e.g., a certified mail receipt that bears a USPTO date stamp or label, or the signature of a USPTO employee), accompanied by an affidavit or declaration under 37 C.F.R. §2.20 attesting to the contents of the envelope.
- (3) A filing date was denied, but the application itself clearly shows on its face that the applicant met all relevant filing date requirements on the filing date being requested. The applicant must resubmit (a) any returned papers showing the cancelled filing date, *and* (b) a copy of the Notice of Incomplete Trademark Application.
- (4) A filing date was denied to a paper application due to the omission of an element, such as a fee, but the element was in fact included in the application as originally submitted, *and* the applicant submits *all* of the following: (a) a return postcard indicating that the USPTO specifically acknowledged receipt of the element in question (see TMEP §303.02(c)), (b) a substitute to replace the lost element, (c) the application papers that were returned, *and* (d) a copy of the Notice of Incomplete Trademark Application.
- (5) Applicant provides evidence that applicant attempted to file the application through TEAS, but TEAS was unavailable due to technical problems (e.g. a computer screen printout showing receipt of a "Fatal Error - Access Denied" error message, or a copy of an e-mail message from the TEAS Help Desk stating that the TEAS application forms were temporarily unavailable). See *In re Henkel Loctite Corp.*, 69 USPQ2d 1638 (Dir USPTO 2003).

In the above situations, a Staff Attorney or Paralegal Specialist in the Office of the Commissioner for Trademarks may restore the original filing date without a formal petition or a petition fee. In all other circumstances, the applicant must file a formal petition, including the petition fee required by 37 C.F.R. §2.6.

The request should be directed to the Office of the Commissioner for Trademarks, and should include all the application materials and a cover

## MATTERS SUBMITTED TO DIRECTOR

letter identified as a “Request for Restoration of the Filing Date.” *In all requests to restore a filing date, the applicant must resubmit the application filing fee(s), even if the applicant has not yet received a refund of the fee(s) previously paid.*

All requests to restore filing dates, whether made by formal petition or informal request, must be filed promptly. If the USPTO mails an action advising the applicant of the denial or cancellation of the filing date, the request to restore the filing date must be filed within two months of the mailing date of the action. 37 C.F.R. §2.146(d).

Furthermore, applicants must exercise due diligence in monitoring the status of applications. 37 C.F.R. §2.146(i); TMEP §1705.05. To be considered diligent, an applicant must check the status of a pending application every six months between the filing date of the application and issuance of a registration. 37 C.F.R. §2.146(i)(1).

If the USPTO denies a filing date due to the omission of an element required by 37 C.F.R. §2.21, and the applicant declares that the missing element was in fact included with the application as filed, the Director will not grant a petition to restore or reinstate the filing date unless: (1) the applicant provides evidence that the element was received in the USPTO on the requested filing date; or (2) there is an image of the element in the USPTO’s Trademark Image Capture and Retrieval System (“TICRS”) database.

The USPTO scans images of applications almost immediately after they are received in the USPTO and uploads these scanned images into TICRS. Because very little time passes between receipt of the application and creation of the scanned image, it is highly likely that the TICRS file of an application will be an exact copy of what was received in the USPTO. Accordingly, if TICRS does not include an image of a missing element that a petitioner declares was submitted with the application, the Director will not find on petition that the element was submitted, unless there is evidence to corroborate the petitioner’s declaration. An example of corroborating evidence is a postcard submitted with the original application that bears (1) a USPTO date stamp, and (2) an itemized list of materials submitted that includes the missing element. *In re Group Falck A/S*, 62 USPQ2d 1797, 1798 (Dir USPTO 2002).

### **1712 Reinstatement of Applications and Registrations**

#### **1712.01 Reinstatement of Applications Abandoned Due to Office Error**

If an application was inadvertently abandoned due to a USPTO error, an applicant may file a request to reinstate the application, instead of a formal petition to revive. There is no fee for a request for reinstatement. Such a

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

request should be captioned as a “Request for Reinstatement.” Requests for reinstatement are handled by the Paralegal Specialists in the Office of the Commissioner for Trademarks, or by the supervisory legal instruments examiner in the ITU Unit or the law office to which the application is assigned.

The following are examples of situations where the USPTO may reinstate an application that was held abandoned for failure to timely file a statement of use or response to an Office action:

- (1) The applicant presents proof that a response to an Office action, statement of use or request for extension of time to file a statement of use was timely filed through TEAS, in the form of a copy of an e-mail confirmation issued by the USPTO that includes the date of receipt and a summary of the submission.
- (2) There is an image of a timely-filed response to Office action, statement of use, or request for extension of time to file a statement of use in TIGRS.
- (3) The timely-filed correspondence is found in the USPTO.
- (4) The applicant supplies a copy of the correspondence and proof that it was timely mailed to the USPTO in accordance with the certificate of mailing requirements of 37 C.F.R. §2.197 (for the specific requirements for providing proof, see TMEP §305.02(f)).
- (5) The applicant supplies a copy of the correspondence and proof that it was timely transmitted to the USPTO by fax in accordance with the certificate of facsimile transmission requirements of 37 C.F.R. §2.197 (for the specific requirements for providing proof, see TMEP §306.05(d)).
- (6) The applicant presents proof of actual receipt in the USPTO in the form of a return postcard showing a timely USPTO date stamp or label, on which the applicant specifically refers to the correspondence at issue (see TMEP §303.02(c)).
- (7) The applicant presents proof of actual receipt in the USPTO in the form of evidence that a USPTO employee signed for or acknowledged the envelope (e.g., a certified mail receipt that bears an Office date stamp or label, or the signature of a USPTO employee), accompanied by an affidavit or declaration under 37 C.F.R. §2.20 attesting to the contents of the envelope.
- (8) The papers that became lost were accompanied by a fee, and there is proof that the USPTO processed the fee (e.g., a cancelled check). The request for reinstatement must include an affidavit or declaration under 37 C.F.R. §2.20 that attests to the contents of the correspondence.

## MATTERS SUBMITTED TO DIRECTOR

- (9) The USPTO sent an Office action or notice of allowance to the wrong address due to a USPTO error. A “USPTO error in sending an action or notice to the wrong address” means that the USPTO either entered the correspondence address incorrectly or failed to enter a proper notice of change of address filed *before* the mailing date of the action or notice. See TMEP §603.03 regarding the applicant’s duty to notify the USPTO when the correspondence address changes.

A request for reinstatement must be filed within two months of the mailing date of the notice of abandonment or, if the applicant has not received a notice of abandonment, within two months of the date the applicant or the applicant’s attorney had actual knowledge that the application was abandoned. 37 C.F.R. §2.146(d).

If the applicant did not receive a notice of abandonment, the applicant must have been duly diligent in monitoring the status of the application, or the request for reinstatement will be denied. To be duly diligent, the applicant must check the status of a pending application every six months between the filing date of the application and issuance of a registration. 37 C.F.R. §2.146(i)(1); TMEP §1705.05.

When an application is reinstated, a computer generated notice of reinstatement is sent to the correspondence address of record. The TRAM System and TARR database are updated accordingly.

If the applicant is not entitled to reinstatement, a request for reinstatement may be considered as a petition to revive. Any petition to revive must meet all the requirements of 37 C.F.R. §2.66. See TMEP §§1714 *et seq.*

### **1712.02 Reinstatement of Registrations Cancelled or Expired Due to Office Error**

#### ***Request for Reinstatement***

A registrant may file a request to reinstate a cancelled or expired registration if the registrant has proof that USPTO error caused a registration to be cancelled or expired due to failure to file: (1) an affidavit or declaration of use or excusable nonuse under 15 U.S.C. §1058 (“§8 affidavit”); (2) a renewal application under 15 U.S.C. §1059; or (3) a response to an examiner’s Office action refusing to accept a §8 affidavit or renewal application. There is no fee for a request for reinstatement. A request that the USPTO reinstate a registration that has been cancelled or expired due to USPTO error should be captioned as a “Request for Reinstatement of Registration,” and should be directed to the Supervisor of the Post Registration Section of the Office.

The following are examples of situations where the USPTO may reinstate a cancelled or expired registration:

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- (1) The registrant presents proof that a proper §8 affidavit or renewal application was timely filed through TEAS, in the form of a copy of an e-mail confirmation issued by the USPTO that includes the date of receipt and a summary of the submission (see TMEP §301).
- (2) There is an image of a timely-filed §8 affidavit, renewal application, or response to Office action in TICRS.
- (3) The timely-filed §8 affidavit, renewal application, or response to Office action is found in the USPTO.
- (4) The registrant supplies a copy of the §8 affidavit, renewal application, or response with proof that it was timely mailed to the USPTO in accordance with the certificate of mailing requirements of 37 C.F.R. §2.197 (for the specific requirements for providing proof, see TMEP §305.02(f)).
- (5) The registrant supplies a copy of the §8 affidavit, renewal application, or response, with proof that it was timely transmitted to the USPTO by fax in accordance with the certificate of transmission requirements of 37 C.F.R. §2.197 (for the specific requirements for providing proof, see TMEP §306.05(d)).
- (6) The registrant presents proof of actual receipt in the USPTO in the form of a return postcard showing a timely USPTO date stamp or label, on which the registrant specifically refers to the §8 affidavit, renewal application, or response at issue (see TMEP §303.02(c)).
- (7) The registrant presents proof of actual receipt in the USPTO in the form of evidence that a USPTO employee signed for or acknowledged the envelope (e.g., a certified mail receipt that bears a USPTO date stamp or label, or the signature of a USPTO employee), accompanied by an affidavit or declaration under 37 C.F.R. §2.20 attesting to the contents of the envelope.
- (8) The papers that became lost were accompanied by a fee, and there is proof that the USPTO processed the fee (e.g., a cancelled check). The registrant must submit an affidavit or declaration under 37 C.F.R. §2.20 attesting to the contents of the original mailing.
- (9) The USPTO sent an Office action to the wrong address due to an Office error. A “USPTO error in sending an action to the wrong address” means that the USPTO either entered the correspondence address incorrectly or failed to enter a proper notice of change of address filed *before* the mailing date of the action.
- (10) The registrant supplies a copy of a response to an Office action, with proof that it was timely transmitted to the USPTO by Internet e-mail and accompanied by a certificate of transmission under 37 C.F.R.

## MATTERS SUBMITTED TO DIRECTOR

2.197. See notice at 64 Fed. Reg. 33056, 33063 (June 21, 1999).  
*NOTE: Section 8 affidavits and renewal applications cannot be filed by e-mail. TMEP §304.02.*

Generally, where there is proof that a registration was cancelled solely due to USPTO error, a request for reinstatement will not be denied solely because the registrant was not diligent in monitoring the status of the §8 affidavit or renewal application (see TMEP §1705.05). However, if a registrant receives a written notice of cancellation, or has actual notice that a registration was cancelled, the USPTO will deny the request for reinstatement as untimely if it was not filed (1) within two months of the mailing date of the cancellation notice, or (2) within two months of actual notice of cancellation, if the registrant did not receive a written cancellation notice. 37 C.F.R. §2.146(d). See TMEP §1705.04 regarding timeliness.

### **Formal Petition**

If a registrant unintentionally failed to timely respond to an examiner's Office action refusing to accept a §8 affidavit or renewal application, but the registrant does not have the proof of USPTO error that would support a request for reinstatement, the registrant may file a formal petition under 37 C.F.R. §§2.146(a)(3) and 2.146(a)(5) to waive a rule and accept a late response. Pursuant to 37 C.F.R. §2.146(d), the petition must be filed within two months of the cancellation notice. If the registrant did not receive the cancellation notice, the petition must be filed within two months of the date of actual notice of the cancellation, *and* the record must show that the registrant was diligent in monitoring the status of the registration, pursuant to 37 C.F.R. §2.146(i). See TMEP §§1705.04 and 1705.05 regarding timeliness and diligence.

The unintentional delay standard of 37 C.F.R. §2.66 does *not* apply to registered marks. TMEP 1714.01(f)(ii). Under 37 C.F.R. §§2.146(a)(5) and 2.148, the Director may waive any provision of the Rules that is not a provision of the statute, when an extraordinary situation exists, justice requires, and no other party is injured. See TMEP §1708. The failure to receive an Office action is considered an extraordinary situation that justifies a waiver of a rule. Therefore, if the registrant did not receive an examiner's Office action refusing to accept a §8 affidavit or renewal application, but the registrant does not have proof that non-receipt was due to USPTO error (see paragraph 9 above), the registrant may file a formal petition under 37 C.F.R. §2.146.

The Director has no authority to waive a statutory requirement, such as the deadline for filing a §8 affidavit or renewal application. *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984). Therefore, if the registrant did not timely file a §8 affidavit or renewal

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

application, a petition to extend or waive the statutory deadline will be denied, regardless of the reason for the delay.

If a registrant contends that a §8 affidavit or renewal application was timely filed, but the registrant does not have proof that the §8 affidavit or renewal application was received in the USPTO before the due date, the Director will not grant a petition to accept the affidavit or renewal application.

### **1713                    Petition to Reverse Holding of Abandonment for Failure to Respond Completely**

Under 37 C.F.R. §2.65(a), an application may become abandoned when an applicant's response, although received within the six-month response period, is incomplete. See TMEP §§718.03 *et seq.* regarding incomplete responses.

When an examining attorney holds an application abandoned because the applicant's response is incomplete, the applicant may petition to the Director to reverse the holding under 37 C.F.R. §2.146. However, the Director will reverse the examining attorney's holding of abandonment only if there is clear error or abuse of discretion. *In re GTE Education Services*, 34 USPQ2d 1478 (Comm'r Pats. 1994); *In re Legendary, Inc.*, 26 USPQ2d 1478 (Comm'r Pats. 1992). *Note:* The "unintentional delay" standard for reviving abandoned applications pursuant to 37 C.F.R. §2.66(a) does *not* apply to applications held abandoned under 37 C.F.R. §2.65(a). See TMEP §1714.01(f)(ii).

### **1714                    Petition to Revive Abandoned Application**

*37 C.F.R. §2.66. Revival of abandoned applications.*

*(a) The applicant may file a petition to revive an application abandoned because the applicant did not timely respond to an Office action or notice of allowance, if the delay was unintentional. The applicant must file the petition:*

- (1) Within two months of the mailing date of the notice of abandonment; or*
- (2) Within two months of actual knowledge of the abandonment, if the applicant did not receive the notice of abandonment, and the applicant was diligent in checking the status of the application every six months in accordance with § 2.146(i).*

*(b) The requirements for filing a petition to revive an application abandoned because the applicant did not timely respond to an Office action are:*

- (1) The petition fee required by §2.6;*
- (2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the response on or before the due date was unintentional; and*
- (3) Unless the applicant alleges that it did not receive the Office action, the proposed response.*

## MATTERS SUBMITTED TO DIRECTOR

*(c) The requirements for filing a petition to revive an application abandoned because the applicant did not timely respond to a notice of allowance are:*

*(1) The petition fee required by §2.6;*

*(2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the statement of use (or request for extension of time to file a statement of use) on or before the due date was unintentional;*

*(3) Unless the applicant alleges that it did not receive the notice of allowance and requests cancellation of the notice of allowance, the required fees for the number of requests for extensions of time to file a statement of use that the applicant should have filed under §2.89 if the application had never been abandoned;*

*(4) Unless the applicant alleges that it did not receive the notice of allowance and requests cancellation of the notice of allowance, either a statement of use under §2.88 or a request for an extension of time to file a statement of use under §2.89; and*

*(5) Unless a statement of use is filed with or before the petition, or the applicant alleges that it did not receive the notice of allowance and requests cancellation of the notice of allowance, the applicant must file any further requests for extensions of time to file a statement of use under §2.89 that become due while the petition is pending, or file a statement of use under §2.88.*

*(d) In an application under section 1(b) of the Act, the Director will not grant the petition if this would permit the filing of a statement of use more than 36 months after the mailing date of the notice of allowance under section 13(b)(2) of the Act.*

*(e) The Director will grant the petition to revive if the applicant complies with the requirements listed above and establishes that the delay in responding was unintentional.*

*(f) If the Director denies a petition, the applicant may request reconsideration, if the applicant:*

*(1) Files the request within two months of the mailing date of the decision denying the petition; and*

*(2) Pays a second petition fee under §2.6.*

Upon a proper submission, an abandoned application can be revived under 37 C.F.R. §2.66 if the delay in responding to an Office action or notice of allowance was unintentional. 15 U.S.C. §§1051(d)(4) and 1062(b). Petitions filed under 37 C.F.R. §2.66 are handled by the paralegal specialists in the Office of the Commissioner for Trademarks. See TMEP §1709 regarding the delegation of authority to decide petitions.

To expedite processing, the USPTO recommends that all petitions to revive be filed through TEAS, at <http://www.uspto.gov/teas/index.html>.



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1714.01 Procedural Requirements for Filing Petition to Revive**

The procedural requirements for filing a petition to revive an application abandoned for failure to respond to an examining attorney's Office action are set forth in 37 C.F.R. §2.66(b) and TMEP §1714.01(a). The procedural requirements for filing a petition to revive an application abandoned for failure to timely file a statement of use or request for extension of time to file a statement of use are set forth in 37 C.F.R. §2.66(c) and TMEP §§1714.01(b) and (c).

When a petition does not meet the procedural requirements of 37 C.F.R. §2.66, a paralegal in the Office of the Commissioner for Trademarks will notify the petitioner that the petition does not meet the requirements of the rule, and grant the petitioner 30 days to supplement the petition by submitting the missing element(s). If the petitioner does not submit the necessary information or fees within the time allowed, the petition will be denied.

#### **1714.01(a) Failure to Timely Respond to an Examining Attorney's Office Action**

To expedite processing, the USPTO recommends that all petitions to revive be filed through TEAS, at <http://www.uspto.gov/teas/index.html>.

The procedural requirements for filing a petition to revive an application abandoned for failure to respond to an examining attorney's Office action are listed in 37 C.F.R. §2.66(b). The petition must include all of the following:

- (1) The petition fee required by 37 C.F.R. §2.6;
- (2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the response on or before the due date was unintentional. The statement does not have to be verified; and
- (3) Unless the applicant alleges that it did not receive the Office action, the applicant's proposed response to the Office action should accompany the petition.

*NOTE: Response to Final Action.* The USPTO will not grant a petition to revive an application abandoned for failure to respond to a final Office action unless the applicant submits a proper response, as defined in 37 C.F.R. §2.64(a), or states that it did not receive the Office action. If a petition does not include a proper response to a final action, the petition will be treated as incomplete. The applicant will be given an opportunity to perfect the petition by submitting a proper response to the final action. If the applicant does not submit a proper response within the time allowed, the petition will be denied. After a final action, the only response that an applicant may make as a matter of right is (1) either an appeal to the Trademark Trial and

## MATTERS SUBMITTED TO DIRECTOR

Appeal Board (see TMEP §1501 *et seq.*) or a petition under 2.63(b), whichever is appropriate, or (2) compliance with any requirement made by the examining attorney. TMEP §715.01. A request for reconsideration is not a proper response to a final action. See TMEP §§715.03 and 1714.01(f)(ii). In some cases, after a final refusal of registration on the Principal Register, an amendment requesting registration on the Supplemental Register or registration under 15 U.S.C. §1052(f) may also be a proper response. See TMEP §§714.05(a)(i), 816.04 and 1212.02(h).

If the petition states that applicant did not receive the Office action, and the petition is granted, the USPTO will remail the Office action.

See TMEP §§1705.04 and 1714.01(d) regarding petition timeliness, and TMEP §1705.05 regarding due diligence in monitoring the status of an application.

### **1714.01(b) Failure to File a Statement of Use or Extension Request - Notice of Allowance Received**

To expedite processing, the USPTO recommends that all petitions to revive be filed through TEAS, at <http://www.uspto.gov/teas/index.html>.

The procedural requirements for filing a petition to revive an application abandoned for failure to respond to a notice of allowance are listed in 37 C.F.R. §2.66(c). *If the applicant received the notice of allowance*, the petition must include all of the following:

- (1) The petition fee required by 37 C.F.R. §2.6;
- (2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the statement of use (or request for extension of time to file a statement of use) on or before the due date was unintentional. The statement does not have to be verified;
- (3) Either a statement of use under 37 C.F.R. §2.88 or a request for an extension of time to file a statement of use under 37 C.F.R. §2.89;
- (4) The required fees for the number of extension requests that the applicant should have filed if the application had never been abandoned;

*Example:* If a notice of allowance was issued June 14, 2004, and a petition to revive was filed December 23, 2004, the petition must be accompanied by: (1) either a statement of use or request for an extension of time to file a statement of use, with the required filing fee; and (2) the fee for the first extension request due that was

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

December 14, 2004. These fees are in addition to the standard petition fee; and

- (5) Unless a statement of use is filed with or before the petition, the applicant must file any further requests for extensions of time to file a statement of use that become due while the petition is pending, or file a statement of use. See TMEP §1714.01(b)(i).

The USPTO will *not* grant a petition to revive an intent-to-use application if granting the petition would extend the period for filing the statement of use beyond thirty-six months after the mailing date of the notice of allowance. 15 U.S.C. §§1051(d)(1) and (2); 37 C.F.R. §2.66(d). In these cases, the petition will be denied, and the petition fee will be refunded.

See TMEP §§1705.04 and 1714.01(d) regarding petition timeliness, and TMEP §1705.05 regarding due diligence in monitoring the status of an application.

### **1714.01(b)(i) Applicant Must File Statement of Use or Further Extension Requests During Pendency of a Petition**

Filing a petition to revive does not stay the time for filing a statement of use or further extension request(s). When a petition is granted, the term of the six-month extension that was the subject of the petition runs from the date of the expiration of the previously existing deadline for filing a statement of use. 37 C.F.R. §2.89(g). Thus, a petitioner must either file a statement of use or file additional extension requests as they become due during the pendency of a petition.

If the applicant fails to file a statement of use or further request(s) for extension of time to file the statement of use while the petition is pending, the USPTO will give the applicant an opportunity to perfect the petition by paying the fees for each missed extension request and filing a copy of the last extension request, or statement of use, that should have been filed. *In re Moisture Jamzz, Inc.*, 47 USPQ2d 1762 (Comm'r Pats. 1997).

### **1714.01(c) Notice of Allowance Not Received**

To expedite processing, the USPTO recommends that all petitions to revive be filed through TEAS, at <http://www.uspto.gov/teas/index.html>.

The procedural requirements for filing a petition to revive an application abandoned for failure to respond to a notice of allowance are listed in 37 C.F.R. §2.66(c). *If the applicant did not receive the notice of allowance*, the petition must include the following:

- (1) The petition fee required by 37 C.F.R. §2.6; and

## MATTERS SUBMITTED TO DIRECTOR

- (2) A statement, signed by someone with firsthand knowledge of the facts, that the applicant did not receive the notice of allowance, and that the delay in filing the statement of use (or request for extension of time to file a statement of use) on or before the due date was unintentional. The statement does not have to be verified.

If the applicant did not receive the notice of allowance, it is not necessary to file a statement of use or request for an extension of time to file a statement of use, or the fees for the number of extension requests that would have been due if the application had never been abandoned. 37 C.F.R. §§2.66(c)(3) and (4). If the petitioner files an extension request with a petition that alleges nonreceipt of the notice of allowance, the USPTO will cancel the notice of allowance, refund the filing fee for the extension request, and forward the file to the Publication and Issue Section of the USPTO to reissue the notice of allowance.

If the petitioner files a statement of use with a petition that alleges nonreceipt of the notice of allowance, the USPTO will give the petitioner the option of: (1) having the notice of allowance cancelled and reissued, and the filing fee for the statement of use refunded; or (2) paying the additional filing fees for the extension requests that would have been due if the application had never been abandoned, so that the statement of use can be processed.

### **1714.01(d) Timeliness and Diligence**

Under 37 C.F.R. §2.66(a), a petition to revive an abandoned application must be filed: (1) within two months of the mailing date of the notice of abandonment; or (2) within two months of actual knowledge of the abandonment, if the applicant did not receive the notice of abandonment, *and* the applicant was diligent in checking the status of the application. See TMEP §1705.04 regarding petition timeliness, and TMEP §1705.05 regarding an applicant's duty to exercise due diligence in monitoring the status of an application. If a petition is untimely, or if the applicant was not diligent, the USPTO will deny the petition and refund the petition fee. To be considered diligent, the applicant should check the status of a pending application every six months between the filing date of the application and issuance of a registration. 37 C.F.R. §§2.66(a)(2) and 2.146(i)(1).

The applicant may file a petition to revive before the applicant receives the notice of abandonment.

### **1714.01(e) Signed Statement That Delay Was Unintentional**

Under 37 C.F.R. §§2.66(b)(2) and (c)(2), a petition to revive must include a statement, signed by someone with firsthand knowledge of the facts, that the delay in responding to the Office action or notice of allowance was unintentional. This statement does not have to be verified.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Except when alleging non-receipt of an Office action or notice of allowance, it is not necessary to explain the circumstances that caused the unintentional delay. If the applicant did not receive the Office action or notice of allowance, this should be stated; no further explanation is necessary.

The USPTO will generally not question the applicant's assertion that the delay in responding to an Office action or notice of allowance was unintentional, unless there is information in the record indicating that the delay was in fact intentional. An example of an intentional delay is when an applicant intentionally decides not to file a response or intent-to-use document because it no longer wishes to pursue registration of the mark, but later changes its mind and decides that it does wish to pursue the application.

See TMEP §804.05 regarding signature of documents filed through TEAS.

### **1714.01(f) Applicability of Unintentional Delay Standard**

#### **1714.01(f)(i) Situations Where the Unintentional Delay Standard Applies**

Trademark Rule 2.66 applies only to the "failure" to respond to an Office action or notice of allowance. This includes the failure to meet minimum filing requirements for a statement of use or request for an extension of time to file a statement of use.

The minimum filing requirements for a statement of use are listed in 37 C.F.R. §2.88(e): (1) the fee for at least a single class of goods or services; (2) at least one specimen or facsimile of the mark as used in commerce; and (3) a verification or declaration signed by the applicant stating that the mark is in use in commerce.

The minimum filing requirements for a request for extension of time to file a statement of use are: (1) a verified statement that the applicant has a continued bona fide intention to use the mark in commerce; (2) a specification of the goods or services on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce; and (3) payment of the prescribed fee for at least one class of goods or services. *In re El Taurino Restaurant, Inc.*, 41 USPQ2d 1220, 1222 (Comm'r Pats. 1996).

An applicant who fails to meet the minimum filing requirements for a statement of use or request for an extension of time to file a statement of use has, in effect, not filed the statement of use or extension request. Therefore, if the failure to meet the minimum filing requirements was unintentional, the applicant may file a petition to revive under 15 U.S.C. §1051(d)(4) and 37 C.F.R. §2.66.

An applicant may also file a petition to revive under 37 C.F.R. §2.66 if the applicant timely files a notice of appeal from an examining attorney's final

## MATTERS SUBMITTED TO DIRECTOR

refusal, but unintentionally fails to include the appeal fee required by 15 U.S.C. §1070.

### **1714.01(f)(ii) Situations Where the Unintentional Delay Standard Does Not Apply**

#### ***Examining Attorney's Holding of Abandonment for Failure to File Complete Response to Office Action - 37 C.F.R. §2.65(a)***

The unintentional delay standard of 37 C.F.R. §2.66 does *not* apply to an incomplete response to an examining attorney's Office action. Incomplete responses to examining attorneys' Office actions are governed by 37 C.F.R. §2.65(b), which gives the examining attorney discretion to grant an applicant additional time to respond if the applicant's failure to file a complete response is inadvertent. If the examining attorney holds the application abandoned for failure to file a complete response to an Office action, the applicant may file a petition to the Director to review the examining attorney's action under 37 C.F.R. §2.146. The Director will reverse the examining attorney's action only if there is clear error or abuse of discretion. See TMEP §1713.

A request for reconsideration of a final refusal (see TMEP §§715.03 *et seq.*) that is not accompanied by a proper notice of appeal will be treated as an incomplete response to the final Office action. If the examining attorney denies the request for reconsideration, the time for appeal runs from the mailing date of the final action. TMEP §715.03(c). If the time for appeal has expired, the applicant may not file a petition to revive under 37 C.F.R. §2.66.

#### ***Examining Attorney's Refusal of Registration on Ground That Applicant Did Not Meet Statutory Requirements Before Expiration of Deadline For Filing Statement of Use***

If the applicant unintentionally fails to meet the minimum requirements for *filing* a statement of use, as set forth in 37 C.F.R. §2.88(e), the applicant may file a petition to revive under 37 C.F.R. §2.66. However, the applicant may not file a petition to revive under 37 C.F.R. §2.66 if the applicant met the minimum filing requirements of 37 C.F.R. §2.88(e), but the examining attorney later refuses registration on the ground that the applicant failed to satisfy the statutory requirements for a *complete* statement of use (15 U.S.C. §1051(d); 37 C.F.R. §2.88(b)) on or before the statutory deadline (*e.g.*, because the specimen is unacceptable, the dates of use are subsequent to the deadline for filing the statement of use, or the statement of use was not filed in the name of the owner of the mark). The applicant may appeal the examining attorney's refusal of registration to the Trademark Trial and Appeal Board. See TMEP §§1109.16(a) regarding the requirements that must be met within the statutory period for filing the statement of use.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### ***Registered Marks***

Trademark Rule 2.66 applies only to abandoned applications, not to registered marks. If a registrant fails to timely respond to an Office action regarding an affidavit or declaration of use or excusable nonuse under 15 U.S.C. §1058 or §1141k, or a renewal application under 15 U.S.C. §1059, the registrant may file a petition to the Director under 37 C.F.R. §§2.146(a)(3) and 2.146(a)(5) to waive a rule and accept a late response. However, the Director will waive a rule only in an extraordinary situation, where justice requires and no other party is injured. The Director has no authority to waive a statutory requirement. See TMEP §1708 regarding the waiver of rules.

See TMEP §1712.02 regarding requests to reinstate cancelled or expired registrations.

### ***Dismissal of Appeal for Failure to File a Brief***

An applicant cannot file a petition to revive under 37 C.F.R. §2.66 if an application is abandoned because the Board dismisses an appeal for failure to file a brief. In this situation, the applicant may file a motion with the Board to set aside the dismissal and accept a late-filed brief. TBMP §1203.02(a). If the Board denies this motion, the applicant may file a petition to the Director under 37 C.F.R. §2.146, asking the Director to reverse the Board's order. The petition must be filed within thirty days of the mailing date of the Board's order. 37 C.F.R. §2.6(e)(2). The Director will reverse the Board's action only if the Board clearly erred or abused its discretion.

### **1714.01(g) Request for Reconsideration of Denial of Petition to Revive**

Under 37 C.F.R. §2.66(f), if a petition to revive is denied, the applicant may request reconsideration by: (1) filing the request for reconsideration within two months of the mailing date of the decision denying the petition; and (2) paying a second petition fee under 37 C.F.R. §2.6. See TMEP §1705.08.

### **1715 Letters of Protest in Pending Applications**

Protests from third parties who object to the registration of marks in pending applications must be sent in writing to the Office of the Commissioner for Trademarks. The Administrator for Trademark Identifications, Classification and Practice ("Administrator") will determine whether the information should or should not be given to the examining attorney for consideration. Third parties may not contact an examining attorney directly, either orally or in writing, regarding a particular application. If a third party attempts to contact an examining attorney, the examining attorney should refer the third party to the Office of the Commissioner for Trademarks. If an examining attorney receives a letter of protest without any indication that it has been granted by

## MATTERS SUBMITTED TO DIRECTOR

the Administrator, the letter should be referred to the Administrator for consideration. If the letter of protest was mistakenly entered in the record as a paper received from the applicant, all evidence of that receipt should be expunged from the records of the USPTO.

The purpose of a letter of protest is to permit third parties to bring facts relevant to the registrability of the mark to the attention of the USPTO. The procedure is intended to achieve this objective without causing undue delay in the examination process and without compromising the objectivity or the *ex parte* character of the examination process. *In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375 (Comm'r Pats. 1988). The letter of protest must contain factual, objective evidence.

The Administrator will grant a letter of protest only if the protestor submits *prima facie* evidence supporting a refusal of registration, such that publication of the mark without consideration of the issue and evidence presented in the letter of protest was or would be a clear error by the USPTO. See TMEP §§1715.02 and 1715.03.

When a protest is granted, the actual letter of protest is not made part of the record, or forwarded to the examining attorney or the applicant. The examining attorney receives a form letter from the Administrator indicating that a letter of protest was filed and briefly indicating the nature of the protest, with the factual evidence filed with the letter of protest attached.

### **1715.01 Appropriate Subjects to be Raised in Letter of Protest**

It is inappropriate to use the letter of protest procedure to delay registration or to present purely adversarial arguments. The USPTO denies letters of protest that are merely adversarial arguments that registration should be refused. Adversarial arguments in letters of protest are not sent to the examining attorney. These objections to registration should be made in an opposition proceeding after publication or, in the case of the Supplemental Register, a cancellation proceeding after registration. The letter of protest procedure may not be used to circumvent the requirements for filing an opposition.

#### **1715.01(a) Issues Appropriate as Subject of Letter of Protest**

Appropriate subjects for letters of protest are those that the examining attorney has the authority and resources to pursue to a legal conclusion without the need of further intervention by third parties. The following are examples of three of the most common areas of protest:

- (1) A third party files an objection to the registration of a term because it is allegedly generic or descriptive. The objection must be accompanied by *evidence* of genericness or descriptiveness. The



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

evidence should be objective, independent, factual evidence that the examining attorney can use to support the suggested refusal. Personal opinions are subjective and may be self-serving, and are not forwarded to the examining attorney. If the protest is granted, the examining attorney is informed that an objection to registration has been filed on the ground that the mark is generic or descriptive, and is given a copy of any factual evidence submitted with the letter of protest.

- (2) A third party notifies the USPTO of the existence of a federally registered mark or prior-pending application and alleges that there is a likelihood of confusion between this mark and the mark in the application that is the subject of the letter of protest. If the protest is granted, the examining attorney is notified that an objection to the registration of the mark has been made on the ground of an alleged likelihood of confusion with a registered mark or prior-pending application, and is given a copy of the registration or application information as it appears in the automated records of the USPTO.
- (3) A third party files a request that prosecution of an application be suspended because of pending litigation that is relevant to the registrability of the mark. The litigation must be specifically identified and a copy of the relevant pleadings must be enclosed. The litigation must involve a federally registered mark or prior-pending application of the protestor and grounds that are clearly relevant to the right of the applicant to register the mark in the application that is the subject of the letter of protest. If the protest is granted, the examining attorney is informed that a request for suspension has been received based on the existence of pending litigation. Copies of the relevant pleadings are placed in the record.

To preserve the integrity and objectivity of the *ex parte* examination process, the Administrator will consider and act on the letter of protest without consulting with the examining attorney. The Administrator considers only the record in the application and the protestor's submissions. *In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375 (Comm'r Pats. 1988).

### **1715.01(b) Issues Inappropriate as Subject of Letter of Protest**

The following are examples of issues that are *not* appropriate to raise in a letter of protest:

- (1) A third party claims earlier common law use of a trademark but does not have a federal registration or previously-filed pending application for that mark. The examining attorney can only consider registrations and prior-pending applications when determining likelihood of confusion. Earlier common law use, state registrations and other

## MATTERS SUBMITTED TO DIRECTOR

claims based on evidence other than federal registrations and prior-pending applications for federal registration are not appropriate for presentation to examining attorneys during *ex parte* examination.

- (2) A third party claims that the applicant is not the proper owner of the mark. This issue requires proof that is beyond the scope of authority of an examining attorney to require during *ex parte* examination. *In re Apple Computer, Inc.*, 57 USPQ2d 1823 (Comm'r Pats. 1998).
- (3) Numerous third parties set forth the opinion that the mark should not register but do not offer any evidence or legal reason to support the refusal. The trademark registration process is governed by statutory laws and federal regulations. Public opinion cannot be used to influence the application process; therefore, mass mailings by special interest groups will not be made part of the record.

### **1715.02 Letters of Protest Filed Before Publication**

If a letter of protest is filed before the mark is published for opposition, the Administrator will determine whether the letter contains sufficient evidence to establish a *prima facie* case that supports a refusal of registration. If the Administrator determines that publication of the mark for opposition without consideration of the issue and evidence presented in the letter of protest might result in a clear error by the USPTO, the Administrator will grant the protest and forward the evidence in the letter of protest to the examining attorney in the manner described in TMEP §1715. The examining attorney should issue any refusal or requirement supported by the evidence, and should notify the applicant that a letter of protest was filed and provide the applicant with a copy of the information that has been made a part of the record. See notice at 1172 TMOG 93 (March 28, 1995).

Letters of protest that are filed before an examining attorney has taken a first action in the application that is the subject matter of the protest will not be decided until such action is taken. This is to give the examining attorney the opportunity to make an initial decision in the application and to provide a basis for a determination by the Administrator as to whether or not that action constituted a "clear error."

### **1715.03 Letters of Protest Filed After Publication**

When a letter of protest is filed after publication, the Administrator will first determine whether the letter is timely, *i.e.*, whether it was filed within 30 days of the date of publication. If not, the letter of protest will generally be denied. See TMEP §1715.03(a).

When a letter of protest is filed within 30 days after the date of publication, the Administrator will make an initial determination of whether publication of the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

mark constituted clear error, *i.e.* whether the protester presents *prima facie* evidence that supports a refusal of registration. *In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375 (Comm'r Pats. 1988).

If a mark has been published for opposition but no notice of allowance has issued, the examining attorney does not have jurisdiction to consider the information in the letter of protest. Therefore, if the Administrator determines that the letter of protest should be granted, the Administrator will submit a formal request to the Commissioner for Trademarks to restore jurisdiction of the application to the examining attorney. The Administrator will include copies of the relevant evidence with this request. If the Commissioner agrees that the letter of protest should be granted and restores jurisdiction to the examining attorney, the Administrator will grant the protest and refer the application with the relevant evidence to the examining attorney. If the Commissioner does not agree that the letter of protest should be granted, the Administrator will deny the letter of protest.

If a notice of allowance has issued in an application based on 15 U.S.C. §1051(b), the examining attorney has jurisdiction over the application, so a formal restoration of jurisdiction is unnecessary. Therefore, if the Administrator grants the letter of protest, the Administrator will make the relevant evidence part of the record for consideration by the examining attorney during examination of the statement of use.

### **1715.03(a) Timely Filing of Letter of Protest**

The most appropriate time for filing a letter of protest is before publication of a mark, because the purpose of the letter of protest is to assist the USPTO in the examination of applications. Circumstances may preclude filing during that period in certain cases. For example, the protester may not be aware of an application until publication, or the evidence relevant to registrability may not be available until after publication.

Letters of protest filed more than 30 days after publication are generally denied as untimely, because a letter of protest filed after publication may delay the registration process significantly. *In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375 (Comm'r Pats. 1988). This applies to all applications, including intent-to-use applications under 15 U.S.C. §1051(b). *In re G. Heileman Brewing Co., Inc.*, 34 USPQ2d 1476 (Comm'r Pats. 1994).

Exceptions to the 30-day rule are made only in special circumstances, where the protestor could not earlier have obtained the information provided in the letter. *In re Pohn*, 3 USPQ2d 1700 (Comm'r Pats. 1987).

Filing a request for extension of time to oppose does not extend the 30-day deadline for filing a letter of protest.

## MATTERS SUBMITTED TO DIRECTOR

The letter of protest procedure applies *only* to pending applications. The Director has no authority to cancel a registration in order to consider a letter of protest. Therefore, a letter of protest will be denied as untimely if the mark registers before issuance of the decision on the letter.

### **1715.03(b) Letter of Protest Does Not Stay or Extend Opposition Period**

Filing a letter of protest does not stay or extend the opposition period. Therefore, a party who files a letter of protest after publication should also file a timely request(s) for extension of time to oppose (15 U.S.C. §1063) with the Trademark Trial and Appeal Board. See TBMP §215 for further information. The Board will not suspend a potential opposer's time to file a notice of opposition because a letter of protest has been filed. See notice at 68 Fed. Reg. 55748, 55760 (Sept. 26, 2003).

### **1715.04 Tracking of Letters of Protest by the Protestor**

A protestor will always receive a response from the Administrator either granting or denying the letter of protest. Generally, the Administrator will make every effort to respond to letters of protest within sixty days of the time they are received in the Office of the Commissioner for Trademarks, or within sixty days after the examining attorney's initial Office action, whichever is later. If a protestor has not received a response from the Administrator within six months of submitting a letter of protest, the protestor should ascertain whether or not a first action has been taken in the application that is the subject of the letter of protest. If such an action has been taken, the protestor should contact the Office of the Commissioner for Trademarks to make sure the letter of protest has been received in that Office. The protestor can check the TARR database at <http://tarr.uspto.gov> to determine whether an action has been taken.

### **1715.05 Approval of Applications for Publication or Issue After Grant of a Letter of Protest**

If the Administrator grants a letter of protest, the examining attorney will issue a requirement or refusal consistent with the Administrator's action, except in unusual circumstances. However, granting a letter of protest does not constitute a binding determination by the Administrator as to the merits. In some circumstances, the examining attorney may discover additional evidence that would justify approval of the application after the grant of a letter of protest, or the applicant may overcome the refusal or satisfy the requirement. If the Administrator grants a letter of protest and the examining attorney later determines that the mark should be approved for publication, republication or issue, the Administrator must approve the examining attorney's approval of the application for publication, republication or issue.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Due to the possibility that the application may be approved for publication, republication or issue, protestors should continue to monitor the status of the application being protested so that they may take appropriate action (such as filing a notice of opposition) if the refusal or requirement raised as a result of the letter of protest is successfully overcome by the applicant.

### **1715.06 Recourse After Denial of Letter of Protest**

If the Administrator denies a letter of protest, the protester may pursue remedies otherwise available, such as an opposition proceeding, if the protester complies with all relevant requirements and deadlines. Filing a letter of protest does not stay or extend the time for filing a notice of opposition. TMEP §1715.03(b).

The protester may not request reconsideration of the denial of the letter of protest from the Administrator, because the request would unduly delay final disposition of the application. *In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375 (Comm'r Pats. 1988). However, the protester may petition the Director to review the Administrator's decision to deny the letter of protest under 37 C.F.R. §2.146(a)(3).

The Administrator has broad discretion in determining whether to grant a letter of protest. In any petition to review the denial of a letter of protest, the Administrator's action will be reversed only where there has been a clear error or abuse of this broad discretion. *In re Pohn*, 3 USPQ2d 1700 (Comm'r Pats. 1987).

The protester may not present additional evidence with the petition. On petition, the Director will consider only the evidence that was properly before the Administrator in acting on the letter of protest. *In re BPJ Enterprises, supra*.

### **1715.07 Requests for Copies of Letters of Protest**

Any party who requests a copy of a letter of protest should mail the request to the Office of the Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, or fax the request to (571) 273-8900. All requests should be directed to the attention of the Administrator for Trademark Identifications, Classification and Practice. Upon review of the letter of protest material, the Administrator will usually forward a copy of the letter of protest and its attachment to the requester. The Administrator will deny the request for a copy of the letter of protest only if the letter of protest or its attachments contain material that would potentially be exempt from disclosure under the Freedom of Information Act ("FOIA"). If, in the opinion of the Administrator, any part of the letter of protest materials should be exempt from disclosure under FOIA, the matter will be forwarded to the Office of General Counsel of the USPTO for further review.

# Chapter 1800 — Public Inquiries About Applications and Registrations

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## **1801 Office Personnel May Not Express Opinion on Validity of Registered Trademark**

1801.01 Office Personnel Cannot Testify

## **1802 Congressional Inquiries**

## **1803 Freedom of Information Act Requests**

## **1804 Inquiries from Members of the Press**

## **1805 General Inquiries from the Public**

## **1806 Contacts With Third Parties Regarding *Ex Parte* Matters**

## **1807 United States Patent and Trademark Office World Wide Web Page**

## **1801 Office Personnel May Not Express Opinion on Validity of Registered Trademark**

A certificate of registration of a mark on the Principal Register is *prima facie* evidence of the validity of the registration. 15 U.S.C. §1057(b). Public policy demands that every employee of the United States Patent and Trademark Office (“USPTO”) refuse to express to any person any opinion as to the validity of any registered mark, except to the extent necessary to carry out *inter partes* proceedings at the Trademark Trial and Appeal Board in cancellation and similar proceedings authorized by law.

The question of the validity of a registered mark is otherwise exclusively a matter to be determined by a court. Members of the Trademark Examining Operation are cautioned to be especially wary of any inquiry from any person outside the USPTO, including an employee of another Government agency, the answer to which might indicate that a particular registration should not have been published or issued.

An employee of the USPTO, particularly a trademark examining attorney who examined an application, should not discuss or answer inquiries from any person outside the USPTO as to whether a certain registration or other particular evidence was considered during the examination of the application, or whether a mark would have been published or registered if the registration or other evidence had been considered during the examination. Likewise, employees should not answer any

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

inquiry concerning any entry in a registration file, including the extent of the field of search. The record of the file of a registration or *inter partes* proceeding before the Trademark Trial and Appeal Board must speak for itself.

Employees should refuse to discuss these matters with members of the public, and this refusal should not be considered discourteous. Practitioners should not make improper inquiries of members of the Trademark Examining Operation.

See TMEP §1806 regarding contacts with third parties about *ex parte* matters.

### **1801.01 Office Personnel Cannot Testify**

#### **37 C.F.R. Part 104.**

#### **Subpart A--General Provisions**

##### *37 C.F.R. §104.1 Definitions.*

*Demand means a request, order, or subpoena for testimony or documents for use in a legal proceeding.*

*Director means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (see §1.9(j)).*

*Document means any record, paper, and other property held by the Office, including without limitation, official letters, telegrams, memoranda, reports, studies, calendar and diary entries, maps, graphs, pamphlets, notes, charts, tabulations, analyses, statistical or informational accumulations, any kind of summaries of meetings and conversations, film impressions, magnetic tapes, and sound or mechanical reproductions.*

*Employee means any current or former officer or employee of the Office.*

*Legal proceeding means any pretrial, trial, and posttrial stages of existing or reasonably anticipated judicial or administrative actions, hearings, investigations, or similar proceedings before courts, commissions, boards or other tribunals, foreign or domestic. This phrase includes all phases of discovery as well as responses to formal or informal requests by attorneys or others involved in legal proceedings.*

*Office means the United States Patent and Trademark Office, including any operating unit in the United States Patent and Trademark Office, and its predecessors, the Patent Office and the Patent and Trademark Office.*

*Official business means the authorized business of the Office.*

*General Counsel means the General Counsel of the Office.*

*Testimony means a statement in any form, including personal appearances before a court or other legal tribunal, interviews, depositions, telephonic, televised, or videotaped statements or any responses given during discovery or similar proceedings, which response would involve more than the production of documents, including a declaration under 35 U.S.C. 25 or 28 U.S.C. 1746.*

*United States means the Federal Government, its departments and agencies, individuals acting on behalf of the Federal Government, and parties to the extent they are represented by the United States.*

## **PUBLIC INQUIRIES ABOUT APPLICATIONS AND REGISTRATIONS**

*37 C.F.R. §104.2 Address for mail and service; telephone number.*

*(a) Mail under this part should be addressed to General Counsel, United States Patent and Trademark Office, P.O. Box 15667, Arlington, VA 22215.*

*(b) Service by hand should be made during business hours to the Office of the General Counsel, Crystal Park Two, Suite 905, 2121 Crystal Drive, Arlington, Virginia.*

*(c) The Office of the General Counsel may be reached by telephone at 703-308-2000 during business hours.*

*37 C.F.R. §104.3 Waiver of rules.*

*In extraordinary situations, when the interest of justice requires, the General Counsel may waive or suspend the rules of this part, sua sponte or on petition of an interested party to the Director, subject to such requirements as the General Counsel may impose. Any petition must be accompanied by the petition fee set forth in §1.17(h) of this title.*

*37 C.F.R. §104.4 Relationship of this Part to the Federal Rules of Civil or Criminal Procedure.*

*Nothing in this part waives or limits any requirement under the Federal Rules of Civil or Criminal Procedure.*

### **Subpart B--Service of Process**

*37 C.F.R. §104.11 Scope and purpose.*

*(a) This subpart sets forth the procedures to be followed when a summons and complaint is served on the Office or on the Director or an employee in his or her official capacity.*

*(b) This subpart is intended, and should be construed, to ensure the efficient administration of the Office and not to impede any legal proceeding.*

*(c) This subpart does not apply to subpoenas, the procedures for which are set out in subpart C.*

*(d) This subpart does not apply to service of process made on an employee personally on matters not related to official business of the Office or to the official responsibilities of the employee.*

*37 C.F.R. §104.12 Acceptance of service of process.*

*(a) Any summons and complaint to be served in person or by registered or certified mail or as otherwise authorized by law on the Office, on the Director, or on an employee in his or her official capacity, shall be served as indicated in §104.2.*

*(b) Any employee of the Office served with a summons and complaint shall immediately notify, and shall deliver the summons and complaint to, the Office of the General Counsel.*

*(c) Any employee receiving a summons and complaint shall note on the summons and complaint the date, hour, and place of service and whether service was by hand or by mail.*

*(d) When a legal proceeding is brought to hold an employee personally liable in connection with an action taken in the conduct of official business, rather than liable in*



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*an official capacity, the employee by law is to be served personally with process. See Fed. R. Civ. P. 4(e). An employee sued personally for an action taken in the conduct of official business shall immediately notify and deliver a copy of the summons and complaint to the General Counsel.*

*(e) An employee sued personally in connection with official business may be represented by the Department of Justice at its discretion (28 CFR 50.15 and 50.16).*

*(f) The Office will only accept service of process for an employee in the employee's official capacity.*

### **Subpart C--Employee Testimony and Production of Documents in Legal Proceedings**

*37 C.F.R. §104.21 Scope and purpose.*

*(a) This subpart sets forth the policies and procedures of the Office regarding the testimony of employees as witnesses in legal proceedings and the production or disclosure of information contained in Office documents for use in legal proceedings pursuant to a demand.*

*(b) Exceptions. This subpart does not apply to any legal proceeding in which:*

*(1) An employee is to testify regarding facts or events that are unrelated to official business; or*

*(2) A former employee is to testify as an expert in connection with a particular matter in which the former employee did not participate personally while at the Office.*

*37 C.F.R. §104.22 Demand for testimony or production of documents.*

*(a) Whenever a demand for testimony or for the production of documents is made upon an employee, the employee shall immediately notify the Office of the General Counsel at the telephone number or addresses in §104.2 and make arrangements to send the subpoena to the General Counsel promptly.*

*(b) An employee may not give testimony, produce documents, or answer inquiries from a person not employed by the Office regarding testimony or documents subject to a demand or a potential demand under the provisions of this subpart without the approval of the General Counsel. The General Counsel may authorize the provision of certified copies not otherwise available under Part 1 of this title subject to payment of applicable fees under §1.19.*

*(c)(1) Demand for testimony or documents. A demand for the testimony of an employee under this subpart shall be addressed to the General Counsel as indicated in §104.2.*

*(2) Subpoenas. A subpoena for employee testimony or for a document shall be served in accordance with the Federal Rules of Civil or Criminal Procedure or applicable state procedure, and a copy of the subpoena shall be sent to the General Counsel as indicated in §104.2.*

*(3) Affidavits. Except when the United States is a party, every demand shall be accompanied by an affidavit or declaration under 28 U.S.C. 1746 or 35 U.S.C. 25(b) setting forth the title of the legal proceeding, the forum, the requesting party's interest in the legal proceeding, the reason for the demand, a showing that the desired testimony or document is not reasonably available from any other source, and, if*

## PUBLIC INQUIRIES ABOUT APPLICATIONS AND REGISTRATIONS

*testimony is requested, the intended use of the testimony, a general summary of the desired testimony, and a showing that no document could be provided and used in lieu of testimony.*

*(d) Failure of the attorney to cooperate in good faith to enable the General Counsel to make an informed determination under this subpart may serve as a basis for a determination not to comply with the demand.*

*(e) A determination under this subpart to comply or not to comply with a demand is not a waiver or an assertion of any other ground for noncompliance, including privilege, lack of relevance, or technical deficiency.*

*(f) Noncompliance. If the General Counsel makes a determination not to comply, he or she will seek Department of Justice representation for the employee and will attempt to have the subpoena modified or quashed. If Department of Justice representation cannot be arranged, the employee should appear at the time and place set forth in the subpoena. In such a case, the employee should produce a copy of these rules and state that the General Counsel has advised the employee not to provide the requested testimony nor to produce the requested document. If a legal tribunal rules that the demand in the subpoena must be complied with, the employee shall respectfully decline to comply with the demand, citing United States ex rel. Touhy v. Ragen, 340 U.S. 462 (1951).*

*37 C.F.R. §104.23 Expert or opinion testimony.*

*(a)(1) If the General Counsel authorizes an employee to give testimony in a legal proceeding not involving the United States, the testimony, if otherwise proper, shall be limited to facts within the personal knowledge of the employee. Employees, with or without compensation, shall not provide expert testimony in any legal proceedings regarding Office information, subjects, or activities except on behalf of the United States or a party represented by the United States Department of Justice.*

*(2) The General Counsel may authorize an employee to appear and give the expert or opinion testimony upon the requester showing, pursuant to §104.3 of this part, that exceptional circumstances warrant such testimony and that the anticipated testimony will not be adverse to the interest of the Office or the United States.*

*(b)(1) If, while testifying in any legal proceeding, an employee is asked for expert or opinion testimony regarding Office information, subjects, or activities, which testimony has not been approved in advance in writing in accordance with the regulations in this subpart, the witness shall:*

*(i) Respectfully decline to answer on the grounds that such expert or opinion testimony is forbidden by this subpart;*

*(ii) Request an opportunity to consult with the General Counsel before giving such testimony; and*

*(iii) Explain that upon such consultation, approval for such testimony may be provided.*

*(2) If the tribunal conducting the proceeding then orders the employee to provide expert or opinion testimony regarding Office information, subjects, or activities without the opportunity to consult with the General Counsel, the employee shall respectfully refuse to provide such testimony, citing United States ex rel. Touhy v. Ragen, 340 U.S. 462 (1951).*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*(c) If an employee is unaware of the regulations in this subpart and provides expert or opinion testimony regarding Office information, subjects, or activities in a legal proceeding without the aforementioned consultation, the employee shall, as soon after testifying as possible, inform the General Counsel that such testimony was given and provide a written summary of the expert or opinion testimony provided.*

*(d) Proceeding where the United States is a party. In a proceeding in which the United States is a party or is representing a party, an employee may not testify as an expert or opinion witness for any party other than the United States.*

*37 C.F.R. §104.24 Demands or requests in legal proceedings for records protected by confidentiality statutes.*

*Demands in legal proceedings for the production of records, or for the testimony of employees regarding information protected by the confidentiality provisions of the Patent Act (35 U.S.C. 122), the Privacy Act (5 U.S.C. 552a), the Trade Secrets Act (18 U.S.C. 1905), or any other confidentiality statute, must satisfy the requirements for disclosure set forth in those statutes and associated rules before the records may be provided or testimony given.*

### **Subpart D--Employee Indemnification**

*37 C.F.R. §104.31 Scope.*

*The procedure in this subpart shall be followed if a civil action or proceeding is brought, in any court, against an employee (including the employee's estate) for personal injury, loss of property, or death, resulting from the employee's activities while acting within the scope of the employee's office or employment. When the employee is incapacitated or deceased, actions required of an employee should be performed by the employee's executor, administrator, or comparable legal representative.*

*37 C.F.R. §104.32 Procedure for requesting indemnification.*

*(a) After being served with process or pleadings in such an action or proceeding, the employee shall within five (5) calendar days of receipt, deliver to the General Counsel all such process and pleadings or an attested true copy thereof, together with a fully detailed report of the circumstances of the incident giving rise to the court action or proceeding.*

*(b)(1) An employee may request indemnification to satisfy a verdict, judgment, or award entered against that employee only if the employee has timely satisfied the requirements of paragraph (a) of this section.*

*(2) No request for indemnification will be considered unless the employee has submitted a written request through the employee's supervisory chain to the General Counsel with:*

*(i) Appropriate documentation, including copies of the verdict, judgment, appeal bond, award, or settlement proposal;*

*(ii) The employee's explanation of how the employee was acting within the scope of the employee's employment; and*

*(iii) The employee's statement of whether the employee has insurance or any*

## PUBLIC INQUIRIES ABOUT APPLICATIONS AND REGISTRATIONS

*other source of indemnification.*

### **Subpart E--Tort Claims**

*37 C.F.R. §104.41 Procedure for filing claims.*

*Administrative claims against the Office filed pursuant to the administrative claims provision of the Federal Tort Claims Act (28 U.S.C. 2672) and the corresponding Department of Justice regulations (28 CFR Part 14) shall be filed with the General Counsel as indicated in §104.2.*

*37 C.F.R. §104.42 Finality of settlement or denial of claims.*

*Only a decision of the Director or the General Counsel regarding settlement or denial of any claim under this subpart may be considered final for the purpose of judicial review.*

It is the policy of the USPTO that its employees, including trademark examining attorneys, will not appear as witnesses or give testimony in legal proceedings, except under the conditions specified in 37 C.F.R. Part 104. Any employee who testifies contrary to this policy will be dismissed or removed.

Whenever an employee of the USPTO, including a trademark examining attorney, is asked to testify or receives a subpoena, the employee shall immediately notify the Office of the General Counsel. Inquiries requesting testimony should also be referred immediately to the Office of the General Counsel.

Trademark examining attorneys and other USPTO employees who perform or assist in the performance of quasi-judicial functions, are forbidden to testify as experts or to express opinions as to the validity of any registration.

Any individual desiring the testimony of an employee of the USPTO, including the testimony of a trademark examining attorney or other quasi-judicial employee, must comply with the provisions of 37 C.F.R. Part 104.

A request for testimony of an employee of the USPTO should be made to the Office of the General Counsel at least ten working days prior to the date of the expected testimony.

If an employee is authorized to testify, the employee will be limited to testifying about facts within the employee's personal knowledge. Employees are prohibited from giving expert or opinion testimony. *Fischer & Porter Co. v. Corning Glass Works*, 61 F.R.D. 321, 181 USPQ 329 (E.D. Pa. 1974). Likewise, employees are prohibited from answering hypothetical or speculative questions. *Shaffer Tool Works v. Joy Mfg. Co.*, 167 USPQ 170 (S.D. Tex. 1970) (deposition of examiner should be limited to matters of fact and must not go into hypothetical or speculative areas or the bases, reasons, mental processes, analyses, or conclusions of the examiner); *In re Mayewsky*, 162 USPQ 86, 89 (E.D. Va. 1969) (deposition of an examiner must be restricted to relevant matters of fact and must avoid any hypothetical or speculative

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

questions or conclusions). Employees will not be permitted to give testimony with respect to subject matter that is privileged. Several court decisions limit testimony with respect to quasi-judicial functions performed by employees. *U.S. v. Morgan*, 313 U.S. 409, 422 (1941) (improper to inquire into mental processes of quasi-judicial officer or to examine the manner and extent to which the officer considered an administrative record); *Western Electric Co., Inc. v. Piezo Technology, Inc.*, 860 F.2d 428, 8 USPQ2d 1853 (Fed. Cir. 1988) (patent examiner may not be compelled to answer questions that probe the examiner's technical knowledge of the subject matter of a patent); *In re Nilssen*, 851 F.2d 1401, 7 USPQ2d 1500 (Fed. Cir. 1988) (technical or scientific qualifications of examiners-in-chief are not legally relevant in appeal under 35 U.S.C. §134 since board members need not be skilled in the art to render obviousness decision); *McCulloch Gas Processing Co. v. Department of Energy*, 650 F.2d 1216, 1229 (Temp. Emer. Ct. App. 1981) (discovery of degree of expertise of individuals performing governmental functions not permitted); *Lange v. Commissioner*, 352 F. Supp. 116, 176 USPQ 162 (D.D.C. 1972) (technical qualifications of examiners-in-chief not relevant in Sec. 145 action).

In view of the discussion above, if an employee is authorized to testify in connection with the employee's involvement or assistance in a quasi-judicial proceeding that took place before the USPTO, the employee will not be permitted to give testimony in response to questions that seek:

- (1) Information about that employee's:
  - (A) Background.
  - (B) Expertise.
  - (C) Qualifications to examine or otherwise consider a particular patent or trademark application.
  - (D) Usual practice or whether the employee followed a procedure set out in any USPTO manual of practice (including the MPEP or TMEP) in a particular case.
  - (E) Consultation with another USPTO employee.
  - (F) Understanding of:
    - (i) A patented invention, an invention sought to be patented, or patent application, patent, reexamination or interference file.
    - (ii) Prior art.
    - (iii) Registered subject matter, subject matter sought to be registered, or a trademark application, registration, opposition, cancellation, interference or concurrent use file.
    - (iv) Any USPTO manual of practice.

## **PUBLIC INQUIRIES ABOUT APPLICATIONS AND REGISTRATIONS**

- (v) USPTO regulations.
  - (vi) Patent, trademark, or other law.
  - (vii) The responsibilities of another USPTO employee.
- (G) Reliance on particular facts or arguments.
- (2) To inquire into the manner in and extent to which the employee considered or studied material in performing the quasi-judicial function.
  - (3) To inquire into the bases, reasons, mental processes, analyses, or conclusions of that USPTO employee in performing the quasi-judicial function.

Any request for testimony addressed or delivered to the Office of the General Counsel must comply with 37 C.F.R. §104.22(c). All requests must be in writing. The need for a subpoena may be obviated where the request complies with 37 C.F.R. §104.22(c) only if the party requesting the testimony meets the following conditions:

- (1) The party requesting the testimony identifies the civil action or other legal proceeding for which the testimony is being taken. The identification shall include:
  - (A) the style of the case,
  - (B) the civil action number,
  - (C) the district in which the civil action is pending,
  - (D) the judge assigned to the case, and
  - (E) the name, address, and telephone number of counsel for all parties in the civil action.
- (2) The party agrees not to ask questions seeking information that is precluded by 37 C.F.R. §104.23.
- (3) The party must comply with applicable provisions of the Federal Rules of Civil Procedure, including Rule 30, and give ten working days notice to the Office of the General Counsel prior to the date a deposition is desired. Fifteen working days notice is required for any deposition that is desired to be taken between November 15 and January 15.
- (4) The party agrees to notice the deposition at a place convenient to the USPTO. The Conference Room in the Office of the General Counsel is deemed to be a place convenient to the USPTO.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- (5) The party agrees to supply a copy of the transcript of the deposition to the USPTO for its records.

Absent a written agreement meeting the conditions specified in paragraphs (1) through (5), a party must comply with the specific terms of 37 C.F.R. §104.22(c), and the USPTO will not permit a deposition without issuance of a subpoena.

See notice at 1099 TMOG 44 (February 28, 1989).

### **1802 Congressional Inquiries**

Inquiries from congressional offices should be directed to the Congressional Liaison Staff of the Office of External Affairs at (571) 272-9300.

### **1803 Freedom of Information Act Requests**

Freedom of Information Act ("FOIA") requests should be sent by e-mail to [efoia@uspto.gov](mailto:efoia@uspto.gov), or by mail to the following address:

USPTO FOIA Officer  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Such requests may be addressed to the attention of the Freedom of Information Act/Privacy Act Officer.

Copies of final agency decisions of the USPTO and our most frequently requested FOIA documents are available on the USPTO website at [www.uspto.gov](http://www.uspto.gov).

### **1804 Inquiries from Members of the Press**

Inquiries from members of the press should be directed to the Office of Public Affairs, at (571) 272-8400.

### **1805 General Inquiries from the Public**

USPTO employees will gladly answer questions about the procedures for obtaining and maintaining a registration. For general information, callers may telephone the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199. See TMEP §108.02.

However, USPTO employees cannot:

- comment on the validity of registered marks (see TMEP §1801);

## PUBLIC INQUIRIES ABOUT APPLICATIONS AND REGISTRATIONS

- provide a legal opinion on whether a particular mark or type of mark is eligible for registration; or
- offer legal advice or opinions about common law rights in a mark, state registrations, or trademark infringement claims.

For a legal opinion about a trademark matter, a party must consult a private trademark attorney. The USPTO cannot aid in the selection of an attorney. 37 C.F.R. §2.11. Private trademark attorneys are general listed in the yellow pages under the heading “Lawyers, Patent and Trademark,” or “Lawyers, Trademark.”

See TMEP §104 regarding trademark searches.

See TMEP §1806 regarding contacts with third parties about *ex parte* matters.

### **1806                      Contacts With Third Parties Regarding *Ex Parte* Matters**

An examining attorney or other USPTO employee may not discuss the merits of any particular application or registration with a third party. If a third party attempts to contact an examining attorney about an *ex parte* matter, either orally or in writing, the examining attorney should refer the third party to the Office of the Commissioner for Trademarks. See TMEP §§1715 *et seq.* regarding letters of protest.

An examining attorney may contact those in the relevant trade to obtain generally available information about an industry and its marketing practices, but the inquiry must be limited to eliciting factual information. It is inappropriate to discuss or request opinions about the registrability of a particular mark. See *In re Lutron Electronics Co. Inc.*, 8 USPQ2d 1701 (Comm'r Pats. 1988).

### **1807                      United States Patent and Trademark Office World Wide Web Page**

The USPTO has a website at [www.uspto.gov](http://www.uspto.gov) that provides access to a wide variety of information about trademarks and offers electronic filing of trademark applications and other trademark documents. See TMEP §102 for further information.



# Chapter 1900

## Madrid Protocol

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### **1901 Overview of the Madrid System of International Registration**

### **1902 International Application Originating From the United States**

1902.01 Who Can File

1902.02 Minimum Requirements for Date of Receipt of International Application in USPTO

1902.02(a) Form of International Application

1902.02(b) Basic Application or Registration Number

1902.02(c) Name and Address of Applicant

1902.02(d) Reproduction (Drawing) of Mark

1902.02(e) Color Claim

1902.02(f) Identification of Goods/Services

1902.02(g) Classification in International Applications

1902.02(g)(i) Reclassifying Goods/Services

1902.02(g)(ii) U.S. Classes A, B & 200

1902.02(g)(iii) Kits, Gift Baskets

1902.02(h) List of Contracting Parties

1902.02(i) Fees

1902.02(j) Statement of Entitlement

1902.02(k) Description of Mark

1902.02(l) Indication of Type of Mark

1902.02(m) E-Mail Address

1902.03 Certification of International Application in USPTO

1902.03(a) Petition to Review Refusal to Certify

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- 1902.04 Date of International Registration
- 1902.05 IB Requirements for Complete International Application.
- 1902.06 Examination of Application by IB
- 1902.07 Irregularities in International Application
  - 1902.07(a) Irregularities that Must Be Remedied by the USPTO
  - 1902.07(b) Irregularities that Must Be Remedied by the Applicant – Applicant Must Respond Directly to the IB
    - 1902.07(b)(i) Fee Irregularities
  - 1902.07(c) Irregularities that Must Be Remedied by the Applicant – Applicant Must Respond Through the USPTO
    - 1902.07(c)(i) Classification of Goods and Services
    - 1902.07(c)(ii) Identification of Goods and Services
  - 1902.07(d) Other Irregularities that Must Be Remedied By Applicant – Applicant May Respond Directly to the IB or Through the USPTO
  - 1902.07(e) Filing Response Directly With the IB
  - 1902.07(f) Responding to Notice of Irregularity Through the USPTO
- 1902.08 Subsequent Designation - Request for Extension of Protection Subsequent to International Registration
  - 1902.08(a) USPTO Requirements
  - 1902.08(b) Form for Filing Subsequent Designation Through the United States Patent and Trademark Office
  - 1902.08(c) Fees for Subsequent Designation
  - 1902.08(d) IB Requirements for Subsequent Designation
  - 1902.08(e) Irregularities in Subsequent Designation
- 1902.09 Dependence & “Central Attack”: Restriction, Abandonment, Cancellation or Expiration of Basic Application or Registration During First 5 Years
- 1902.10 Transformation When the USPTO is the Office of Origin
- 1902.11 Representative

## MADRID PROTOCOL

1902.12 USPTO Must Notify IB of Division or Merger of Basic Application or Registration

### **1903 Payment of Fees**

1903.01 Payment of USPTO Fees

1903.02 Payment of International Fees

### **1904 Request for Extension of Protection of International Registration to the United States**

1904.01 Filing Request for Extension of Protection to United States

1904.01(a) Section 66(a) Basis

1904.01(b) Filing Date

1904.01(c) Declaration of Intent to Use Required

1904.01(d) Use Not Required

1904.01(e) Priority

1904.01(f) Filing Fee

1904.01(g) Constructive Use

1904.01(h) Cannot be Based on USPTO Basic Application or Registration

1904.02 Examination of Request for Extension of Protection to the United States

1904.02(a) Examined as Regular Application

1904.02(b) Examination of Identification and Classification of Goods/Services in §66(a) Applications

1904.02(c) Mark Must Be Registrable on Principal Register

1904.02(d) Refusal Must Be Made Within 18 Months

1904.02(e) Issuing Office Actions

1904.02(f) Correspondence Address

1904.02(g) Mark Cannot Be Amended

1904.02(h) Jurisdiction

1904.03 Notice of Refusal

1904.03(a) Notice Must be Sent Within 18 Months

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- 1904.03(b) Requirements for Notice of Refusal
- 1904.03(c) §66(a) Applicant Must Respond to Notification of Refusal
- 1904.03(d) Refusal Pertaining to Less Than All the Goods/Services
- 1904.03(e) Confirmation or Withdrawal of Provisional Refusal

1904.04 Opposition

1904.05 Certificate of Extension of Protection

1904.06 Assignment of Extension of Protection to the United States

1904.07 Invalidation of Protection in United States

1904.08 Cancellation of International Registration By IB

1904.09 Transformation to Application Under §1 or §44

- 1904.09(a) Requirements for Transformation

- 1904.09(b) Examination of Transformed Application

1904.10 Affidavits of Use or Excusable Nonuse Required

1904.11 Incontestability

1904.12 Replacement

1904.13 Amendment of Registered Extension of Protection to the United States

### **1905 Renewal of International Registrations**

### **1906 Communications With International Bureau Regarding International Registrations**

1906.01 Recording Changes in International Register

- 1906.01(a) Change in Ownership of International Registration

- 1906.01(a)(i) Requirements for Submitting Changes in Ownership of International Registration Through the USPTO

- 1906.01(a)(ii) International Fees for Recording Changes of Ownership of International Registration

- 1906.01(a)(iii) Effect of Change of Ownership of International Registration

- 1906.01(a)(iv) Dividing an International Registration After Change of Ownership With Respect to Some But Not All of the Goods

## MADRID PROTOCOL

- 1906.01(b) Restriction of Holder's Rights of Disposal
- 1906.01(c) Change of the Holder's Name or Address
- 1906.01(d) Change of Name or Address of Representative
- 1906.01(e) Limitation, Renunciation, Cancellation of International Registration
- 1906.01(f) Correction of Errors in International Registration
- 1906.01(g) Merger of International Registrations
- 1906.01(h) License
- 1906.01(i) Changes That Cannot Be Made to International Registration

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks ("Madrid Protocol") is an international treaty that allows a trademark owner to seek registration in any of the countries or intergovernmental organizations that have joined the Madrid Protocol by submitting a single application, called an international application. The International Bureau ("IB") of the World Intellectual Property Organization ("WIPO"), in Geneva, Switzerland administers the international registration system.

The Madrid Protocol became effective in the United States on November 2, 2003. The Madrid Protocol Implementation Act of 2002, Pub. L. 107-273, 116 Stat. 1758, 1913-1921 ("MPIA") amended the Trademark Act to provide that: (1) the owner of a U.S. application or registration may seek protection of its mark in any of the countries or intergovernmental organizations party to the Madrid Protocol by submitting a single international application to the IB through the United States Patent and Trademark Office ("USPTO"); and (2) the holder of an international registration may request an extension of protection of the international registration to the United States. A notice of final rulemaking amending the Trademark Rules of Practice to incorporate the MPIA was published at [68 Fed. Reg. 55748 \(Sept. 26, 2003\)](#). A notice of final rulemaking amending some of the rules that govern the submission of documents under the Madrid Protocol was published at [69 Fed. Reg. 57181 \(Sept. 24, 2004\)](#). See correction notice published at [69 Fed. Reg. 63320 \(Nov. 1, 2004\)](#).

The Madrid Protocol, *Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to That Agreement* (April 1, 2004) ("Common Regs."), *Guide to International Registration* (2004), *Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*Protocol Relating Thereto* (April 1, 2004) (“Admin. Instrs.”) are available on the IB’s website, currently at <http://www.wipo.int/madrid/en/>. The Common Regs. are the procedures agreed to by the parties to the Madrid Protocol regarding the administration of the Madrid Protocol, pursuant to Madrid Protocol Article (“Article”) 10(2)(iii).

### **1901 Overview of the Madrid System of International Registration**

The Madrid system of international registration is governed by two treaties: the Madrid Agreement Concerning the International Registration of Marks, which dates from 1891, and the Protocol Relating to the Madrid Agreement, which became effective December 1, 1995. The United States is party only to the Protocol, not to the Agreement.

The Madrid system is administered by the IB. To apply for an international registration under the Madrid Protocol, an applicant must be a national of, be domiciled in, or have a real and effective business or commercial establishment in one of the countries or intergovernmental organizations that are members of the Protocol (“Contracting Parties”). The application must be based on one or more trademark application(s) filed in or registration(s) issued by the trademark office of one of the Contracting Parties (“basic application(s)” or “basic registration(s)”). The international application must be for the same mark and include a list of goods/services that is identical to or narrower than the list of goods/services in the basic application or registration. The international application must designate one or more Contracting Parties in which an extension of protection of the international registration is sought.

The applicant must submit the international application through the trademark office of the Contracting Party in which the basic application or registration is held (“Office of Origin”). The Office of Origin must certify that the information in the international application corresponds with the information in the basic application or registration and forward the international application to the IB. If the IB receives the international application within two months of the date of receipt in the Office of Origin, the date of the international registration is the date of receipt in the Office of Origin. If the IB does not receive the international application within two months of the date it was received by the Office of Origin, the date of the international registration is the date the international application was received by the IB. See TMEP §1902.04 for information regarding filing requirements that may affect the international registration date.

The international registration is dependent on the basic application or registration for five years from the international registration date. If the basic application or registration is abandoned, cancelled or expired, in whole or in part, during this five-year period, the IB will cancel the international registration accordingly. See TMEP §1902.09 for further information.

## MADRID PROTOCOL

The holder of an international registration may request protection in additional Contracting Parties by submitting a subsequent designation. A subsequent designation is a request by the holder of an international registration for an extension of protection of the registration to additional Contracting Parties.

Each Contracting Party designated in an international application or subsequent designation will examine the request for extension of protection as a national trademark application under its domestic laws. Under Article 5 and Common Regs. 16 and 17, there are strict time limits (a maximum of 18 months) for the trademark office of a Contracting Party to enter a refusal of an extension of protection. If the Contracting Party does not notify the IB of a refusal within this time period, the mark is automatically protected. However, the extension of protection may be invalidated in accordance with the same procedures for invalidating a national registration, *e.g.*, by cancellation.

The Madrid Protocol may apply to the USPTO in three ways:

- *Office of Origin.* The USPTO is the Office of Origin if an international application or registration is based on an application pending in or a registration issued by the USPTO. See TMEP §§1902 *et seq.*
- *Office of a Designated Contracting Party.* The USPTO is the Office of a Designated Contracting Party if the holder of an international registration requests an extension of protection of that registration to the United States. See TMEP §§1904 *et seq.*
- *Office of the Contracting Party of the Holder.* If the holder of an international registration is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States, the holder can file certain requests with the IB through the USPTO, such as requests to record changes of ownership (see TMEP §1906.01(a)(i)) and restrictions on the holder's right to dispose of an international registration (see TMEP §1906.01(b)). The expression "Contracting Party of the Holder" includes the "Office of Origin," as well as any other Contracting Party in which a holder is a national, is domiciled, or has a real and effective industrial or commercial establishment. Common Reg. 1(xxvi)<sup>bis</sup>).

### **1902 International Application Originating From the United States**

This section covers international applications and registrations *originating from* the United States, *i.e.*, international registrations based on an application pending in the USPTO or a registration issued by the USPTO. See TMEP §§1904 *et seq.* for information about requests for extension of protection to the United States by the holder of an international registration originating in

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

another country. International applications originating from the United States are processed by the USPTO's Madrid Processing Unit ("MPU").

### **1902.01 Who Can File**

Under Section 61 of the Trademark Act and Article 2(1), a qualified owner of a basic application pending in the USPTO or a qualified owner of a basic registration issued by the USPTO may file an application for international registration through the USPTO. To qualify, the international applicant must:

- (1) Be a national of the United States;
- (2) Be domiciled in the United States; or
- (3) Have a real and effective industrial or commercial establishment in the United States.

If joint applicants file, each applicant must meet at least one of these requirements. Common Reg. 8(2).

### **1902.02 Minimum Requirements for Date of Receipt of International Application in USPTO**

The minimum requirements for accordance of a date of receipt of an international application in the USPTO are set forth in 37 C.F.R. §7.11.

*§7.11 Requirements for international application originating from the United States.*

*(a) The Office will grant a date of receipt to an international application that is either filed through TEAS, or typed on the official paper form issued by the International Bureau. The international application must include all of the following:*

- (1) The filing date and serial number of the basic application and/or the registration date and registration number of the basic registration;*
- (2) The name of the international applicant that is identical to the name of the applicant or registrant as it appears in the basic application or basic registration and applicant's current address;*
- (3) A reproduction of the mark that is the same as the mark in the basic application and/or registration and that meets the requirements of §2.52.*
  - (i) If the mark in the basic application and/or registration is depicted in black and white and the basic application or registration does not include a color claim, the reproduction of the mark in the international application must be black and white.*
  - (ii) If the mark in the basic application or registration is depicted in black and white and includes a color claim, the international application must include both a black and white reproduction of the mark and a color reproduction of the mark.*



## MADRID PROTOCOL

*(iii) If the mark in the basic application and/or registration is depicted in color, the reproduction of the mark in the international application must be in color.*

*(iv) If the international application is filed on paper, the mark must be no more than 3.15 inches (8 cm) high by 3.15 inches (8 cm) wide, and must appear in the box designated by the International Bureau on the International Bureau's official form;*

*(4) A color claim as set out in §7.12, if appropriate;*

*(5) A description of the mark that is the same as the description of the mark in the basic application or registration, as appropriate;*

*(6) An indication of the type of mark if the mark in the basic application and/or registration is a three-dimensional mark, a sound mark, a collective mark or a certification mark;*

*(7) A list of the goods and/or services that is identical to or narrower than the list of goods and/or services in each claimed basic application or registration and classified according to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks;*

*(8) A list of the designated Contracting Parties. If the goods and/or services in the international application are not the same for each designated Contracting Party, the application must list the goods and/or services in the international application that pertain to each designated Contracting Party;*

*(9) The certification fee required by §7.6;*

*(10) If the application is filed through TEAS, the international application fees for all classes, and the fees for all designated Contracting Parties identified in the international application ( see §7.7);*

*(11) A statement that the applicant is entitled to file an international application in the Office, specifying that applicant: is a national of the United States; has a domicile in the United States; or has a real and effective industrial or commercial establishment in the United States. Where an applicant's address is not in the United States, the applicant must provide the address of its U.S. domicile or establishment; and*

*(12) If the international application is filed through TEAS, an e-mail address for receipt of correspondence from the Office.*

*(b) For requirements for certification, see §7.13.*

### **1902.02(a) Form of International Application**

Trademark Rule 7.11(a), 37 C.F.R. §7.11(a), requires that an international application be filed either through the Trademark Electronic Application System ("TEAS"), or on the official paper form issued by the IB.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### ***TEAS Form***

TEAS will require the applicant to select between two different forms, a prepopulated form or a free-text form. The applicant should use the prepopulated form if: (1) the international application is based on a single basic application or registration; and (2) applicant's changes to the international application are limited to:

- Narrowing the list of goods or services;
- Changing the classification;
- Changing the applicant's address; and/or
- Attaching a color reproduction of the mark where the mark in the basic application or registration is in black and white with a color claim (see TMEP §1902.02(d)).

The prepopulated form will automatically display the exact information that is in the USPTO database for one specific U.S. serial number or registration number. However, if the international application is based on a newly filed application that has not yet been uploaded into the trademark database, the TEAS form will instruct the applicant to wait for the USPTO to upload the data or use the free-text form. It normally takes 48 to 72 hours for the USPTO to upload a newly filed application. To determine whether the basic application data has been entered, the applicant should check the TARR database on the USPTO website at: <http://tarr.uspto.gov>.

The free-text form should be used if an applicant wishes to change other data in the international application, or if the international application is based on more than one basic application or registration.

### ***Paper Form***

When filing on paper, applicants must submit the official international application form issued by the IB, the MM2 form, to the USPTO. The MM2 form is available on the IB website at <http://www.wipo.int/madrid/en/>. The IB will not accept paper applications that are not presented on the official IB form. The form cannot be handwritten. Article 3(1); Common Regs. 9(2)(a) and 11(4)(a)(i); Madrid Admin. Instr. §2(b). The applicant should complete the MM2 form online, print the completed form, and submit it to the USPTO by mail.

The completed paper application form must be mailed to the following address:

Commissioner for Trademarks  
P.O. Box 16471

## MADRID PROTOCOL

Arlington, VA 22215-1471  
Attn: MPU

37 C.F.R. §§2.190(e) and 7.4(b). International applications may be delivered by hand or courier to the Trademark Assistance Center (“TAC”), at James Madison Building – East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia, Attention: MPU. TAC is open 8:00 a.m. to 5:00 p.m., Eastern Standard Time, Monday through Friday, except on Federal holidays within the District of Columbia. 37 C.F.R. §7.4(c).

If an international application is mailed to the USPTO via the Express Mail Service of the United States Postal Service (“USPS”), the USPTO will deem that the application was received in the USPTO on the day it was deposited with the USPS, provided that the applicant complies with the requirements for correspondence sent by Express Mail set forth in 37 C.F.R. §2.198. See TMEP §305.03 regarding submission of documents by Express Mail. The certificate of mailing or transmission procedures of 37 C.F.R. §2.197 do not apply to international applications. 37 C.F.R. §§2.197(a)(2)(ii) and 7.4(e).

The IB’s *Guide to International Registration*, Paras. B.II.07.01 - B.II.20.12 (2004) contains instructions for completing the international application form.

The applicant should include a self-addressed, stamped postcard with the international application. Upon receipt of the international application, the USPTO will place a control number and a label indicating the receipt date on the papers and return the postcard to the applicant. The applicant should reference the control number whenever contacting the USPTO about the application.

International applications cannot be filed by fax. 37 C.F.R. §§2.195(d)(5) and 7.4(d)(1).

### **1902.02(b) Basic Application or Registration Number**

The international application must include the filing date and serial number of the basic application, or the registration date and registration number of the basic registration. 37 C.F.R. §7.11(a)(1). The USPTO will not certify the international application if this information is incorrect or is omitted.

The international application must be based on an active application or registration. It cannot be based on an abandoned application, or on a cancelled or expired registration.

### **1902.02(c) Name and Address of Applicant**

Under Section 61 of the Trademark Act, only the owner of the basic application or registration can file an international application. 15 U.S.C. §1141a(a). The international application must include the name and current

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

address of the applicant. The name of the applicant must be identical to the name of the applicant/registrant in the basic application or registration. 37 C.F.R. §7.11(a)(2).

On the prepopulated TEAS form, the applicant's name cannot be changed, so the international applicant's name will always be identical to the name of the owner of record for the basic application or registration.

When the applicant submits a paper form or a free-text TEAS form, an MPU paralegal will check the Trademark Reporting and Monitoring ("TRAM") System to verify that the name of the owner of the basic application or registration is identical to the name of the international applicant.

If the names are not identical, the MPU Paralegal will check the Assignment Services Division's database to determine whether an assignment or other document affecting title that is not reflected in TRAM has been recorded in the Assignment Services Division. If assignment records do not show a clear chain of title to the international applicant, the USPTO will notify the applicant that the application cannot be certified. If Assignment records do show a clear chain of title, the MPU Paralegal will update the ownership field in TRAM.

Because a delay in certifying and forwarding an international application to the IB may affect the date of the international registration, any request to record a change in ownership of a U.S. basic application or registration should be filed well in advance of the filing of the international application to allow sufficient processing time. The USPTO strongly recommends use of the Electronic Trademark Assignment System ("ETAS"), at <http://etas.uspto.gov>. Assignments filed electronically are recorded much faster than assignments filed on paper. If there is an unrecorded change in ownership, and the international applicant does not use ETAS to record the change, the USPTO may be unable to certify or forward the international application to the IB within two months after the application was received in the USPTO. In this situation, the date of the international registration will be the date of receipt of the application in the IB. See TMEP §1902.04.

Applicants can search the Assignment Services Division's database at <http://assignments.uspto.gov/assignments/> to determine whether an assignment or other document of title has been recorded, and can search the TARR database at <http://tarr.uspto.gov/>, to determine whether the ownership information in the Trademark databases has been updated. See TMEP §§504 *et seq.* regarding automatic updating of ownership information in the TRAM and TARR databases.

If an international applicant is relying on an assignment (or other document transferring title) that has recently been filed for recordation but has not yet been recorded in the Assignment Services Division, the applicant should include a copy of the assignment with the international application.

## MADRID PROTOCOL

### 1902.02(d)      **Reproduction (Drawing) of Mark**

An international application must include a reproduction of the mark that (1) is the same as the mark in the basic application or registration; and (2) meets the requirements of 37 C.F.R. §2.52. 37 C.F.R. §7.11(a)(3).

For paper filers, the mark must appear no larger than 3.15 inches (8 cm) high by 3.15 inches (8 cm) wide and must be placed in the box designated by the IB on the MM2 form. 37 C.F.R. §§2.52(d) and 2.54(b); Common Reg. 9(4)(a)(v); *Guide to International Registration*, Paras. B.II.14.01 *et seq.* (2004). For international applications filed electronically, an image of the mark taken from TRAM will appear automatically on the prepopulated TEAS form. If an applicant uses the free-text TEAS form, the applicant must type the mark in the appropriate field or attach a digitized image of the mark that meets the requirements of 37 C.F.R. §2.35(c).

*Standard Character Reproductions.* If the mark in the basic application or registration is in standard characters, the reproduction of the mark in the international application must be in standard characters. To claim standard characters, an applicant must check the appropriate box on the IB's official application form MM2, or on the TEAS form. The applicant may not claim standard characters in the international application unless the mark in the basic application or registration is in standard character (or typed) format. See TMEP §§807.03 *et seq.* for information about standard character drawings in applications for registration of marks in the United States. The USPTO's standard character chart is posted on the USPTO website at <http://www.uspto.gov/teas/StandardCharacterSet.html>.

*Special Form Reproductions.* If the mark in the basic application or registration is in special form, the reproduction of the mark in the international application must be in special form.

*Use of Color.* If the mark in the basic application or registration is depicted in black and white and does not include a color claim, the reproduction of the mark in the international application must be black and white. If the mark in the basic application or registration is in color, the reproduction of the mark in the international application must be in color. If the mark in the basic application or registration is depicted in black and white and includes a color claim, the international application must include *both* a black and white reproduction of the mark *and* a color reproduction of the mark that meet the requirements of 37 C.F.R. §2.52. 37 C.F.R. §7.11(a)(3); Common Reg. 9(4)(a)(vii). For example, if the basic application or registration includes a color claim and a black and white drawing that depicts the color by the use of color lining or by a statement describing the color, an applicant must include both a color reproduction of the mark and a black and white reproduction of the mark. See the note regarding color drawings in United States basic applications or registrations in TMEP §1902.02(e).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If filing on paper, the applicant must place the drawings in the appropriate boxes designated by the IB on the MM2 form. If using the TEAS prepopulated form, the black and white drawing will automatically prepopulate the form, and the applicant must attach the color reproduction of the mark. For the TEAS free-text form, however, the applicant must attach a digitized image of both the black and white reproduction of the mark and the color reproduction of the mark. See TMEP §§807 *et seq.* for general information about the requirements for drawings in applications for registration of marks in the United States.

### **1902.02(e) Color Claim**

If color is claimed as a feature of the mark in the basic application and/or registration, the international application must include a statement that color is claimed as a feature of the mark and set forth the same name(s) of the color(s) claimed in the basic application and/or registration. 37 C.F.R. §§7.11(a)(4) and 7.12(a).

If the basic application or registration includes a black and white reproduction with a description of the mark indicating that color is used on the mark, or a reproduction that is lined for color (see Note below), the USPTO will presume that color is a feature of the mark, unless the basic application or registration includes a statement that “no claim is made to color” or “color is not a feature of the mark.”

If color is not claimed as a feature of the mark in the basic application and/or registration, an applicant may not claim color as a feature of the mark in the international application. 37 C.F.R. §7.12(b).

*Note Regarding Color Drawings in United States Basic Applications or Registrations: Prior to November 2, 2003, the USPTO did not accept color drawings. An applicant who wanted to show color in a mark had to submit a black and white drawing, with a statement identifying the color(s) and describing where they appeared in the mark. Alternatively, the applicant could submit a black and white drawing that showed color by using the USPTO’s color lining chart (see TMEP §808.01(d)). The USPTO began accepting color drawings on November 2, 2003. Effective November 2, 2003, the Office no longer accepts black and white drawings with a color claim, or drawings that show color by use of lining patterns. 37 C.F.R. §2.52(b)(1).*

### **1902.02(f) Identification of Goods/Services**

An international application must include a list of goods/services that is identical to or narrower than the goods/services in the basic application or registration. 37 C.F.R. §7.11(a)(7). If the applicant makes any change that broadens the scope of the identification of goods/services, the USPTO will not certify the international application.

## MADRID PROTOCOL

The prepopulated TEAS form will include the list of goods/services in the basic application or registration. An applicant may edit the list of goods/services by either deleting particular goods/services or revising the wording in the identification. On the MM2 paper form and the free-text TEAS form, the applicant must enter the goods/services manually and may omit goods or services, or revise the wording in the identification.

If the list of goods/services in an international application is not identical to the list of goods/services in the basic application or registration, the MPU paralegal must determine whether the applicant has identified any goods/services that are broader than the goods/services in the basic application or registration.

### **1902.02(g) Classification in International Applications**

The goods/services should be classified according to the current version of the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks* ("Nice Agreement"). 37 C.F.R. §7.11(a)(7). Both the prepopulated and the free-text TEAS forms will allow an applicant to change the classification of goods/services in an international application.

The MPU does not certify classification of the goods/services in an international application. Therefore, the owner of the United States application or registration does not have to classify the goods/services in the international application in the same class(es) in which they are classified in the United States basic application or registration. However, failure to properly classify goods or services in an international application according to the international classification system will result in an IB notice of irregularity. Because the final decision on the classification of the goods/services in an international application rests with the IB, the USPTO will not reclassify or give advice in response to specific inquiries regarding the reclassification of particular goods/services. The IB provides guidance on its website, currently at <http://www.wipo.int/classifications/en/>. See TMEP §1401.02(a) for further information about the international classes, and TMEP §§1902.07 *et seq.* for further information about irregularities in the international application.

### **1902.02(g)(i) Reclassifying Goods/Services**

If the goods or services in the basic application or registration are classified in Classes A, B or 200 (which are not part of the international classification system) (see TMEP §1902.02(g)(ii)), or are classified in other classes under the old U.S. classification system, it is advisable to reclassify the goods/services into international classes in the international application. Applicants using the prepopulated TEAS form will have to reclassify goods or services into international classes because the form does not recognize Classes A, B or 200.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

In addition, if the identification of goods in the basic application or registration comprises kits or gift baskets (see TMEP §1902.02(g)(iii)), it is advisable for the international applicant to either narrow the identification in order to classify the goods in a single international class, or pay additional fees for additional international classes.

In the situations discussed below, it is advisable for the international applicant to reclassify the goods/services in the international application, in order to avoid issuance of a notice of irregularity by the IB.

### **1902.02(g)(ii) U.S. Classes A, B & 200**

Classes A, B & 200 are classes from the old U.S. classification system that are still used in the United States to classify certification marks for goods (Class A), certification marks for services (Class B) and collective membership marks (Class 200). These classes are not included in the International Classes under the Nice Agreement. Therefore, an international application based on a U.S. application or registration in U.S. Classes A, B or 200 should be reclassified. If the applicant does not reclassify its goods or services into the proper International Class, the IB will issue a notice of irregularity.

Amendment of the classification in the corresponding basic U.S. application or registration is not permitted.

### ***U.S. Classes A & B***

It has been the longstanding practice in the United States to accept identifications of goods or services for Classes A, B and 200 that are broader than those that would be accepted in applications for goods/services in other classes. TMEP §1306.06(f). In many situations, it will be difficult to reclassify these broad identifications into appropriate international classes. For example, a goods certification mark in U.S. Class A for “remanufactured, refurbished and reconditioned electrical equipment” could include goods in International Classes 7, 9 and/or 11, and possibly others. In such situations, the U.S. applicant should specify the type of electrical equipment that is being certified, and either apply and pay the fees for all appropriate classes, or limit the specification of “electric equipment” to cover goods in one class only.

In some certification mark applications/registrations, the goods/services will be easily classified in one class of the international classification system. For example, a services certification mark for “testing laboratory and calibration laboratory accreditation services” would be classified in International Class 42. However, it is important to be aware that multiple classes may be required when reclassifying goods/services from U.S. Classes A and B.



## MADRID PROTOCOL

### ***U.S. Class 200***

Class 200 presents a similar problem and a similar solution. A broad identification of the subject organization in a collective membership mark application or registration is difficult to reclassify. For example, the wording “indicating membership in a conservative youth organization” is too broad and vague for classification in an international class. On the other hand, “indicating membership in an organization of consulting communications engineers” is easily classified in International Class 42. As with the certification marks, an applicant may have to clarify, specify, or narrow the description of the organization in the international application in order to classify the organization in an International Class.

### **1902.02(g)(iii) Kits, Gift Baskets**

The USPTO policy regarding the identification and classification of kits and gift baskets differs from the policy of the IB regarding the classification of these goods.

The USPTO permits registration of a kit or gift basket in a single international class, even if the identification of goods lists items that are classified in other classes. The IB and most foreign countries will not accept an identification of goods in a particular class that includes a reference to goods that are classified in other classes. If an international application includes kits and gift baskets, and the identification of goods refers to items classified in more than one class, the IB is likely to issue a notice of irregularity requiring the applicant to separate the goods into their respective classes and to pay additional fees for added classes. To avoid issuance of a notice of irregularity by the IB, an international applicant may wish to either narrow the identification to refer only to items in a single international class, or submit additional fees for multiple international classes.

### **1902.02(h) List of Contracting Parties**

An international application must list at least one Contracting Party (*i.e.*, country or intergovernmental organization party to the Madrid Protocol) in which the applicant seeks an extension of protection of the international registration. 37 C.F.R. §7.11(a)(8). If the goods/services in the international application are not the same for all designated Contracting Parties, the application must include a list of the goods/services in the international application that pertain to each designated Contracting Party.

An international applicant designating the European Community for an extension of protection may claim seniority of one or more earlier registrations in or for a Member State of the European Community for the same mark covering the same goods or services in the international application. A claim of seniority must be presented on the IB’s official form, MM17, and annexed

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

to the international application. Common Reg. 9(g)(i). The USPTO does not have a TEAS form for a claim of seniority. Therefore, an applicant wishing to claim seniority should not submit an international application through TEAS. Instead, the applicant should complete both the MM2 and MM17 forms online, print the completed forms, and mail them to the USPTO.

An international applicant may not designate the United States as a Contracting Party. Section 65(b) of the Trademark Act, 15 U.S.C. §1141e(b); Article 3<sup>bis</sup>; TMEP §1904.01(h).

### **1902.02(i) Fees**

*USPTO Certification Fee.* An international application must include the USPTO certification fee for each class of goods/services, or it will not be certified. The certification fee per class increases if the international application is based on more than one basic application or registration. 37 C.F.R. §§7.6(a) and 7.11(a)(9).

*International Fees.* Trademark Rule 7.11(a)(10) requires that if an international application is submitted through TEAS, the international fees for all classes and all designated Contracting Parties be paid at the time of submission. International fees for paper applications must be paid directly to the IB, and may be paid either before or after the international application is submitted to the USPTO. 37 C.F.R. §7.7(c). However, international fees paid after the IB receives the international application could result in a notice of irregularity issued by the IB (see TMEP §1902.07(b)(i)). Applicants filing on paper may submit a bank check for the international fees in Swiss francs made payable to the IB with the international application. If the international application meets the requirements for certification, the USPTO will forward the check with the international application to the IB. If the USPTO denies certification, the check will be returned with the international application to the applicant.

See *also* TMEP §1903.02 regarding payment of international fees.

### **1902.02(j) Statement of Entitlement**

An international application must include a statement that the applicant is entitled to file an international application, specifying that the applicant: (i) is a national of the United States; (ii) has a domicile in the United States; or (iii) has a real and effective industrial or commercial establishment in the United States. Where an applicant's address is not in the United States, the applicant must provide the address of the U.S. domicile or establishment. Section 61 of the Trademark Act, 15 U.S.C. §1141a; 37 C.F.R. §7.11(a)(11).

For joint applicants, the application must include a statement of entitlement for each applicant.

## MADRID PROTOCOL

### **1902.02(k) Description of Mark**

If the basic application or registration includes a description of the mark, an international application must include the same description. 37 C.F.R. §7.11(a)(5). The applicant cannot include a description of the mark in the international application if the basic application or registration does not contain a description of the mark.

### **1902.02(l) Indication of Type of Mark**

An international application must include an indication of the type of mark, if the mark in the basic application or registration is a three-dimensional mark, a sound mark, a collective mark, or a certification mark. 37 C.F.R. §7.11(a)(6).

### **1902.02(m) E-Mail Address**

An international application must include an e-mail address for receipt of correspondence from the USPTO, if the international application is filed through TEAS. 37 C.F.R. §7.11(a)(12). Applicants submitting international applications on paper are encouraged to include an e-mail address on the form.

### **1902.03 Certification of International Application in USPTO**

Under Section 62 of the Trademark Act, 15 U.S.C. §1141b, if the information contained in an international application corresponds to the information in the basic application or basic registration, the USPTO will certify the international application and forward it to the IB.

If an applicant uses the prepopulated TEAS form without changing any of the information (see TMEP §1902.02(a)), the international application will be certified and forwarded to the IB without MPU review. In all other cases, an MPU paralegal must review the data in the international application before it can be certified.

Under Article 3(1) and Common Reg. 9(5)(d), the USPTO must sign the international application and certify:

- The date on which the USPTO received the international application;
- That the mark in the international application is the same as the mark in the basic application or registration;
- That the applicant is the same person or entity listed as the owner of the basic application or registration;
- That the goods/services identified in the international application are covered by the basic application or registration;

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- That the applicant is qualified to file an international application under Section 61 of the Trademark Act and Article 2(1);
- That, if the international application includes a description of the mark, the description is consistent with the basic application or registration (Common Regs. 9(4)(a)(xi) and 9(5)(d)(iii));
- That, if the international application indicates that the mark is a color or combination of colors, this indication is consistent with the basic application or registration (Common Regs. 9(4)(a)(vii<sup>bis</sup>) and 9(5)(d)(iii));
- That, if color is claimed as a feature of the mark in the basic application or registration, the same claim is included in the international application (Common Reg. 9(5)(d)(v));
- That, if the international application indicates that the mark is three-dimensional, this indication is consistent with the basic application or registration (Common Regs. 9(4)(a)(viii) and 9(5)(d)(iii));
- That, if the international application indicates that the mark is a sound mark, this indication is consistent with the basic application or registration (Common Regs. 9(4)(a)(ix) and 9(5)(d)(iii));
- That, if the international application indicates that the mark is a collective or certification mark, this indication is consistent with the basic application or registration (Common Regs. 9(4)(a)(x) and 9(5)(d)(iii)).

If the international application meets the requirements of 37 C.F.R. §7.11(a), the USPTO will certify the application and send it to the IB. 37 C.F.R. §7.13(a). The MPU will send a notice of certification to the applicant.

If the application does not meet the requirements of 37 C.F.R. §7.11(a), the USPTO will not certify the application, or forward it to the IB. The USPTO will notify the applicant of the reason(s) why the application cannot be certified. The USPTO will refund any international fees paid through TEAS. The USPTO certification fee will not be refunded. 37 C.F.R. §7.13(b).

An applicant should periodically check the status of the international application online using TARR. If the applicant does not receive a notice of certification or refusal within two months of filing, the applicant should contact the MPU. However, once an international application is certified and forwarded to the IB, questions concerning the international application should be directed to the IB. See TMEP §1906 for information on contacting the IB. The USPTO will update TARR when the IB issues a certificate of international registration or a notice of irregularity concerning the international application.

## MADRID PROTOCOL

See TMEP §1902.06 regarding the IB's examination of international registrations.

### **1902.03(a) Petition to Review Refusal to Certify**

If an applicant believes that a refusal to certify an international application was erroneous, the applicant may file a petition to review the refusal. The petition should refer to the USPTO control number and include the petition fee required by 37 C.F.R. §2.6. If the denial of certification was due to USPTO error, the USPTO will grant the petition and refund the petition fee. See TMEP Chapter 1700 for information about petitions.

The petition should be filed immediately. If the international application is not certified within two months of the date of receipt of the application in the USPTO, the date of registration will be affected. Article 3(4); Common Reg. 15. See TMEP §1902.04.

The petition should be mailed to:

Commissioner for Trademarks  
P.O. Box 16471  
Arlington, VA 22215-1471  
Attn: MPU

37 C.F.R. §§2.190(e) and 7.4(b). If the applicant is paying the petition fee using a USPTO deposit account, the applicant may e-mail the request to [madridpetitions@uspto.gov](mailto:madridpetitions@uspto.gov), with an authorization to charge the petition fee to a deposit account.

The applicant can also hand-deliver the petition to the Trademark Assistance Center at James Madison Building – East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia, Attention: MPU. TAC is open 8:00 a.m. to 5:00 p.m. Eastern Standard Time, Monday through Friday, except on Federal holidays within the District of Columbia. 37 C.F.R. §7.4(c).

### **1902.04 Date of International Registration**

If the IB receives an international application within two months of the date of receipt in the USPTO, the date of the international registration is the date of receipt in the USPTO. If the IB does not receive the international application within two months of the date of receipt in the USPTO, the date of the international registration is the date of receipt in the IB. Article 3(4); Common Reg. 15.

Common Reg. 15 sets forth the IB's minimum requirements that may affect the date of the international registration:

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- Adequate identification of the applicant with sufficient information to contact the applicant or the applicant's representative;
- Reproduction of the mark;
- Indication of the goods or services; and
- Designation of Contracting Party or Parties for which extension of protection is sought.

If any of these elements is omitted from the international application, the IB will notify both the applicant and the USPTO. If the missing element(s) is received in the IB within two months of the date of receipt of the international application in the USPTO, the international registration will bear the date of receipt of the international application in the USPTO. If the missing element(s) is not received in the IB within two months of the date of receipt of the international application in the USPTO, the date of the international registration is the date of receipt of the last of the missing elements in the IB. In either case, the missing element(s) must be received in the IB on or before the deadline specified in the notice of irregularity. Article 3(4); Common Reg. 15(1).

See TMEP §§1902.07 *et seq.* for information about correcting irregularities in an international application.

### **1902.05 IB Requirements for Complete International Application.**

The requirements for an international application are set forth in Article 3 and Common Reg. 9. If the application meets the minimum requirements set forth in 37 C.F.R. §7.11(a) (see TMEP §§1902.02 *et seq.*), the USPTO will certify the application and send it to the IB. *The USPTO will not examine the international application to determine whether it is complete.* Only the IB will examine it for completeness. The requirements for a complete international application originating from the United States are:

- *Name and Address.* The name and address of the applicant;
- *Basic Application(s) or Registration(s).* The serial number(s) and filing date(s) of the basic application(s), or the registration number(s) and registration date(s) of the basic registration(s). The international application may be based on more than one basic application or registration;
- *Entitlement to File.* An indication that the applicant (1) is a national of the United States; (2) is domiciled in the United States; or (3) has a real and effective industrial or commercial establishment in the United States (Common Reg. 9(5)(b));

## MADRID PROTOCOL

- *Fees.* The international application must include the basic filing fee charged by the IB; the supplementary fee for each class of goods or services beyond 3 classes; the complementary fee for designation of each country to which extension of the international registration is sought; and the transmittal fee that the USPTO charges to process the international application. Articles 8(1) and 8(2); Common Regs. 9(4)(a)(xiv), 10(2) and 34.
- *Goods/Services.* A list of the goods or services on or in connection with which the applicant seeks international registration (Article 3(2); Common Reg. 9(4)(a)(xiii));
- *Class.* The international class of goods or services, if known (Article 3(2); Common Reg. 9(4)(a)(xiii));
- *Contracting Parties.* The names of the Contracting Party or Parties in which an applicant seeks protection (Common Reg. 9(4)(a)(xv));
- *Declaration of Intent to Use.* A verified statement that applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application, if any of the Contracting Parties designated in the international application require such a declaration (Common Reg. 9(5)(f)). Under Common Reg. 7(2), a Contracting Party may notify the IB that it requires a signed declaration of intention to use the mark.
- *Reproduction (Drawing) of Mark.* A clear reproduction of the mark that is no more than 8 cm high by 8 cm wide. Common Reg. 9(4)(a)(v). The mark must be the same as the mark in the basic application or registration. If the mark in the basic application or registration has color, the mark in the international application must be in color. If the mark in the basic application or registration is black and white, the mark in the international application must be in black and white<sup>7</sup>. If the mark in the basic application or registration is presented in black and white but contains a color claim, the applicant must submit *both* a black and white and a color reproduction. Common Reg. 9(4)(a)(vii);
- *Color.* If color is claimed as a distinctive feature of the mark in the basic application or registration, the international application must include an indication to that effect, and must set forth the name of the color(s) (Article 3(3); Common Reg. 9(4)(a)(vii)). If the mark in the basic application or registration consists of color(s), the international application must include a statement to that effect (Common Reg. 9(4)(a)(vii<sup>bis</sup>));
- *Transliteration.* If the mark consists of or contains non-Latin characters or numerals other than Arabic or Roman numerals, a

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

transliteration of that matter in Latin characters and Arabic numerals (Common Reg. 9(4)(a)(xii));

- *Signature.* The USPTO must sign the international application. The IB does not require the applicant's signature (Common Reg. 9(2)(b));
- *Three-Dimensional Mark.* If the mark is three-dimensional, the indication "three-dimensional mark" (Common Reg. 9(4)(a)(viii));
- *Sound Mark.* If the mark is a sound mark, the indication "sound mark" (Common Reg. 9(4)(a)(ix));
- *Collective or Certification Mark.* If the mark is a collective mark or a certification mark, an indication to that effect (Common Reg. 9(4)(a)(x));
- *Standard Characters.* If the applicant wishes that the mark be considered as a mark in standard characters, an indication to that effect (Common Reg. 9(4)(a)(vi));
- *Description of Mark.* If there is a description of the mark in the basic application or registration, the international application must include the same description. 37 C.F.R. §7.11(a)(5) and Common Reg. 9(4)(a)(xi).
- *Language.* International applications originating from the United States must be in English. 37 C.F.R. §7.3; Common Regs. 6(1)(b) and 6(2)(b)(iii).
- *Indication of Second Language.* If an applicant designates the European Community as a Contracting Party, applicant is required to indicate a second language, in addition to the language in the international application (Common Reg. 9(5)(g)(i)).

### *Additional Elements That May Be Included in International Application*

The following elements may also be included, but are not mandatory under the Common Regulations:

- *Translation.* If the mark consists of or contains non-English wording, an English translation (Common Reg. 9(4)(b)(iii));
- *Citizenship/State of Incorporation or Organization* (Common Regs. 9(4)(b)(i) and (ii)). The citizenship of the applicant(s); or if the applicant is a juristic person, the state or nation under the laws of which the applicant is organized;
- *Disclaimer.* If an applicant wishes to disclaim any element of the mark, the applicant may do so (Common Reg. 9(4)(b)(v));



## MADRID PROTOCOL

- *Representative.* See TMEP §1902.11;
- *Priority.* An international applicant may claim a right of priority within the meaning of Article 4 of the Paris Convention if: (1) the international application contains a claim of priority; and (2) the filing date of the application that forms the basis of the priority claim (within the meaning of Article 4 of the Paris Convention) was not more than six months before the date of the international registration. Madrid Protocol Article 4(2) and Common Reg. 9(4)(a)(iv). The applicant must specify the serial number (if available), filing date and country of the earlier filing. If the earlier filing does not relate to all the goods/services listed in the international application, the applicant must set forth the goods/services to which it does relate. *NOTE For Paper Filers: If the applicant is claiming priority based upon the basic application, the applicant should list the U.S. application serial number and filing date in **both** Box 5 (Basic Application Section) and Box 6 (Priority Claimed Section) of the MM2 international application form.*
- *Seniority.* An applicant designating the European Community may claim seniority of one or more earlier registrations in or for a Member State of the European Community for the same mark covering the same goods or services in the international application by indicating the following four elements: (1) each Member State in or for which the earlier mark is registered; (2) the date from which the registration was effective; (3) the registration number; and (4) the goods/services covered by the earlier registration (Common Reg. 9(5)(g)(i)). The information must be submitted on the IB's official MM17 form. The MM17 form should be annexed to the international application form.

### **1902.06 Examination of Application by IB**

Upon certification, the USPTO forwards the international application to the IB. If the international application meets the applicable requirements (see TMEP §1902.05), the IB will immediately register the mark and publish the registration in the *WIPO Gazette of International Marks*. The IB will send the certificate to the holder and notify the Office of Origin and the Offices of the designated Contracting Parties to which extension of the registration is sought. Article 3(4); Common Reg. 14(1). If an international application is unacceptable, the IB will notify both the applicant and the USPTO of the "irregularity." See TMEP §§1902.07 *et seq.*

### **1902.07 Irregularities in International Application**

If an international application is unacceptable, the IB will notify both the applicant and the USPTO of the "irregularity." Some types of irregularities must be remedied by the USPTO, some must be remedied by the applicant,

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

and some may be remedied by either the applicant or the USPTO. See 37 C.F.R. §7.14 and Common Reg. 11.

The MPU paralegals review all incoming notices of irregularities. If the irregularity is one that must be remedied by the USPTO (see TMEP §1902.07(a)), the MPU paralegal will respond to the notice and send the applicant a copy of the response.

If the irregularity is not one that must be remedied by the USPTO, the USPTO will note receipt of the notice of irregularity in its automated records, but will not take any other action. The USPTO will not respond to the notice on behalf of the applicant. The USPTO will not send a copy of the notice to the applicant because the IB has already notified the applicant of the irregularity.

Applicants must file responses to irregularities in classification and identification of goods/services through the USPTO (see TMEP §§1902.07(c) *et seq.*). With the exception of fees for correcting irregularities (see TMEP §1902.07(b)(i)), responses to all other types of irregularities may be filed directly at the IB or through the USPTO.

**To be considered timely, responses to IB notices of irregularities must be received by the IB before the end of the response period set forth in the IB's notice. Receipt of the response in the USPTO does not satisfy this requirement.**

For responses to IB notices of irregularities that may be submitted through the USPTO, applicants may file the response either through TEAS or on paper. When correcting irregularities through the USPTO, the applicant should submit the response as soon as possible, and at least one month before the end of the response deadline set forth in the IB's notice. The USPTO will not process any response submitted after the IB response deadline. 37 C.F.R. §7.14(e). See TMEP §1902.07(f) regarding responses to notices of irregularity submitted through the USPTO.

### **1902.07(a) Irregularities that Must Be Remedied by the USPTO**

The following irregularities must be remedied by the USPTO within three months of the date of notification of the irregularity:

- Application is not presented on the official form or is not typed (Common Reg. 11(4)(a)(i); *Guide to International Registration* Para. B.II.25.03(a) (2004));
- Omission of reproduction of mark;
- Omission of list of goods/services;
- Omission of designation of Contracting Party or Parties;

## MADRID PROTOCOL

- Insufficient identification of applicant;
- Irregularities relating to the entitlement of the applicant to file an international application;
- Application not signed by USPTO (Signature may be replaced with seal);
- Certification by USPTO is defective;
- Omission of date and number of basic application or registration.

Common Regs. 11(4) and 15(1).

If the USPTO does not cure the irregularity within three months, the international application is abandoned. Common Regs. 11(4)(b) and 11(5).

When responding to a notice of an irregularity that must be remedied by the USPTO, the MPU paralegal will send the applicant a copy of the response.

### **1902.07(b) Irregularities that Must Be Remedied by the Applicant – Applicant Must Respond Directly to the IB**

#### **1902.07(b)(i) Fee Irregularities**

Where international fees for the international application are insufficient, the IB will notify both the applicant and the USPTO of the deficiency. The USPTO will not respond to the notice on behalf of applicant even if the international application fees were paid through TEAS.

**Fees for correcting irregularities in an international application must be paid directly to the IB** in Swiss currency, even if the applicant is filing a response to correct other irregularities through the USPTO. 37 C.F.R. §7.14(c). If any fees for correcting irregularities are submitted to the USPTO, the USPTO will return the fees to the applicant. The USPTO will not forward the fees to the IB. If the fees are not received by the IB on or before the deadline set forth in the IB's notice of irregularity, the international application may be abandoned. See TMEP §1903.02 for information about the payment of fees to the IB.

### **1902.07(c) Irregularities that Must Be Remedied by the Applicant – Applicant Must Respond Through the USPTO**

#### **1902.07(c)(i) Classification of Goods and Services**

If the IB finds an irregularity in classification, it will make a proposal and send it to both the applicant and the USPTO. The notice will state whether any additional fees are due. Common Reg. 12(1). The USPTO will not respond

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

to the notice on behalf of applicant or advise the applicant as to how to reclassify the goods/services.

The applicant cannot send its response directly to the IB. The applicant must submit the response through the USPTO. The IB must receive the response within 3 months of the date of the IB notification. 37 C.F.R. §7.14(b); Common Reg. 12(2). See TMEP §1902.07(f) regarding responses to notices of irregularity submitted through the USPTO.

The USPTO will not review the applicant's response, but will forward it to the IB and notify the applicant accordingly.

If additional fees are due as a result of reclassification of goods/services, the applicant must pay the fees directly to the IB in Swiss currency. See TMEP §1903.02 for further information about the payment of fees to the IB.

Under Article 3(2), the IB controls classification and has the final say on classification of goods/services. Therefore, the IB may modify, withdraw or maintain its proposal after reviewing the applicant's response. Common Reg. 12.

See also TMEP §1401.03(d).

### **1902.07(c)(ii) Identification of Goods and Services**

If the IB determines that the identification of goods/services is too vague or is incomprehensible or linguistically incorrect, it will notify both the applicant and the USPTO. Common Reg. 13. The IB may include a suggested amendment in the notification. The USPTO will not respond to the notice on behalf of applicant or advise the applicant as to how to identify the goods/services.

The applicant cannot send a response directly to the IB. Any response regarding the identification of goods/services must be sent through the USPTO. The IB must receive the response within 3 months of the date of the IB notification. 37 C.F.R. §§7.14(a) and 7.14(b); Common Reg. 13(2). See TMEP §1902.07(f) regarding responses to notices of irregularity submitted through the USPTO.

An MPU paralegal will review the applicant's response to ensure that the goods/services identified in the response are within the scope of the identification in the basic application or registration at the time the response is filed. If an amendment to the goods/services in the basic application or registration has been entered into the trademark database since the date the international application was submitted to the USPTO, the goods/services in the response to the IB notice must be within the scope of the amended goods/services. If the goods/services in the response exceed the scope of the goods/services in the basic application or registration as amended, the MPU paralegal will notify the applicant that the goods/services cannot be

## MADRID PROTOCOL

certified. If there is time remaining in the IB response period, the applicant may submit a corrected response. If the goods/services in the corrected response do not exceed the scope of the goods/services in the basic application or registration as amended, and the IB response period has not expired, the MPU will certify the goods/services and forward the response to the IB.

If no proposal acceptable to the IB for remedying the irregularity is made within 3 months, and all other requirements have been met, the IB will either (1) include the term in the international registration with an indication that the IB considers the term to be unacceptable, if the class of the vague term was specified in the application; or (2) if the class was not specified, delete the term and notify both the USPTO and the applicant accordingly. Common Reg. 13(2)(b).

### **1902.07(d) Other Irregularities that Must Be Remedied By Applicant – Applicant May Respond Directly to the IB or Through the USPTO**

Other irregularities to be remedied by applicant include but are not limited to insufficient information about the applicant's representative; missing transliteration; insufficient information about a priority claim; unclear reproduction of the mark; and color claim with no color reproduction. The applicant must remedy the irregularities within three months of the date of the notification. Common Reg. 11(2).

An applicant may either file the response to these irregularities directly with the IB or through the USPTO either electronically or on paper. To be considered timely, responses to IB notices of irregularities must be received by the IB before the end of the response period set forth in the IB's notice. Receipt in the USPTO does not fulfill this requirement.

If the response is filed through the USPTO, the USPTO will not review the response to the irregularity but will forward the response to the IB, and notify the applicant accordingly. See TMEP §1902.07(f) for information about responding to a notice of irregularity through the USPTO.

### **1902.07(e) Filing Response Directly With the IB**

Information about filing responses directly with the IB is available on the WIPO website, currently at <http://www.wipo.int/madrid/en/>. An applicant may contact the IB by mail to 34 chemin des Colombettes, P.O. Box 18, 1211 Geneva 20, Switzerland; by telephone at 41 22 338 9111; by fax to 41 22 740 1429; or by e-mail to [intreg.mail@wipo.int](mailto:intreg.mail@wipo.int).

**1902.07(f) Responding to Notice of Irregularity Through the USPTO**

Under Trademark Rule 7.14(e), 37 C.F.R. §7.14(e), an applicant may file a response to an IB notice of irregularity through the USPTO for forwarding to the IB before the IB's response deadline. The response may be filed electronically or on paper. **However, receipt in the USPTO does not fulfill the requirement that the response be received by the IB before the IB response deadline.** Therefore, applicants should submit responses to the USPTO as soon as possible and at least one month before the end of the IB response period.

The IB does not have a form for responses to irregularity notices. Applicants are strongly encouraged to use the TEAS form for responses to notices of irregularity. Applicants submitting paper responses to the USPTO for forwarding to the IB should include with the response: (1) the USPTO control number assigned to the international application; and (2) a copy of the IB's irregularity notice. The applicant may include a self-addressed, stamped postcard with the response. Upon receipt, the USPTO will place a label indicating the receipt date on the papers and return the postcard to the applicant. However, to be considered timely, the response must be received by the IB before the end of the response period set forth in the IB's notice, and receipt in the USPTO does not fulfill the IB deadline requirement.

Applicants submitting responses on paper should mail the document to the following address:

Commissioner for Trademarks  
P.O. Box 16471  
Arlington, VA 22215-1471  
Attn: MPU

37 C.F.R. §§2.190(e) and 7.4(b). The response may be delivered by hand or courier to the Trademark Assistance Center, at James Madison Building – East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia, Attention: MPU. TAC is open 8:00 a.m. to 5:00 p.m. Eastern Standard Time, Monday through Friday, except on Federal holidays within the District of Columbia. 37 C.F.R. §7.4(c). The certificate of mailing or transmission procedures of 37 C.F.R. §2.197 and Express Mail provisions of 37 C.F.R. §2.198 do not apply to responses to notices of irregularity. 37 C.F.R. §§2.197(a)(2)(ii), 7.4(b)(2) and 7.4(e).

Please note that fees for correcting irregularities in an international application must be paid directly to the IB in Swiss currency, even if the applicant is filing a response to correct irregularities through the USPTO. 37 C.F.R. §7.14(c). See TMEP §1903.02 for further information about the payment of fees to the IB.

## MADRID PROTOCOL

Responses to notices of irregularity cannot be filed by fax. 37 C.F.R. §§2.195(d)(5) and 7.4(d)(3).

### **1902.08 Subsequent Designation - Request for Extension of Protection Subsequent to International Registration**

A subsequent designation is a request by the holder of an international registration for an extension of protection of the international registration to Contracting Parties made after the IB registers the mark. The requirements for a subsequent designation are set forth in Article 3<sup>ter</sup>(2) and Common Reg. 24. The holder may file the subsequent designation directly with the IB. There is a form for filing a subsequent designation on the IB website at <http://www.wipo.int/madrid/en/>.

A holder may file a subsequent designation through the USPTO if (1) the international registration is based on a basic application filed with the USPTO or a basic registration issued by the USPTO, and (2) the holder is a national of, is domiciled in, or has a real and effective business or commercial establishment in the United States. Section 64 of the Trademark Act, 15 U.S.C. §1141d; 37 C.F.R. §7.21(a).

#### **1902.08(a) USPTO Requirements**

The minimum requirements for a date of receipt of a subsequent designation in the USPTO are set forth in 37 C.F.R. §7.21(b), and are reproduced below:

- The international registration number;
- The name and address of the holder of the international registration;
- A statement that the holder is entitled to file a subsequent designation through the USPTO, specifying that the holder: (i) is a national of the United States; (ii) has a domicile in the United States; or (iii) has a real and effective industrial or commercial establishment in the United States. If a holder's address is not in the United States, the holder must provide the address of its U.S. domicile or establishment;
- A list of goods/services that is identical to or narrower than the goods/services in the international registration;
- A list of the Contracting Parties designated for an extension of protection;
- The USPTO transmittal fee;
- The international fees required by the IB, if the subsequent designation is filed through TEAS; and

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- An e-mail address for receipt of correspondence from the USPTO, if the subsequent designation is filed through TEAS.

See TMEP §1902.08(b) regarding the form for filing a subsequent designation through the USPTO, and TMEP §1902.08(c) regarding the international fees for a subsequent designation.

The USPTO does not certify subsequent designations. If a subsequent designation meets the requirements set forth in 37 C.F.R. §7.21(b), the USPTO will forward it to the IB. 37 C.F.R. §7.21(c). If the subsequent designation does not meet these requirements, the USPTO will not forward the subsequent designation, and will notify the holder of the reasons. The USPTO transmittal fee is nonrefundable. 37 C.F.R. §7.21(d).

If the subsequent designation meets the requirements of Common Reg. 24, the IB will record it and notify both the USPTO and the holder of the recordation. Common Reg. 24(7). The subsequent designation will bear the date of receipt in the USPTO, provided that the IB receives it within two months of that date. If the IB does not receive the subsequent designation within two months of the date of receipt in the USPTO, the subsequent designation will bear the date of receipt in the IB. Common Reg. 24(6)(b).

### **1902.08(b) Form for Filing Subsequent Designation Through the United States Patent and Trademark Office**

Under Trademark Rule 7.21(b), 37 C.F.R. §7.21(b), the holder of an international registration submitting a subsequent designation through the USPTO may file either through TEAS or on the official paper form issued by the IB.

When filing through TEAS, the holder must enter the required information in the data fields of the free-text TEAS form. Holders filing subsequent designations on paper through the USPTO should use the official IB form MM4 posted on the IB website at <http://www.wipo.int/madrid/en/>. The IB will not accept paper applications that are not presented on the official IB form. The form cannot be handwritten. Article 3<sup>ter</sup>(2); Common Reg. 24(2)(b); Madrid Admin. Instr. §3(b). The holder should complete the MM4 form online, print the completed form, and submit it to the USPTO via mail, hand delivery or courier service.

The IB's *Guide to International Registrations*, available on the IB's website at: [www.wipo.int/madrid/en/](http://www.wipo.int/madrid/en/), contains instructions for completing the subsequent designation form, at B.II.43.01-44.03.

Once the subsequent designation form is completed, it may be mailed to the USPTO at the following address:

Commissioner for Trademarks



## MADRID PROTOCOL

P.O. Box 16471  
Arlington, VA 22215-1471  
Attn: MPU

37 C.F.R. §§2.190(e) and 7.4(b). Subsequent designations may also be delivered by hand or courier to the Trademark Assistance Center, at James Madison Building – East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia, Attention: MPU. TAC is open 8:00 a.m. to 5:00 p.m. Eastern Standard Time, Monday through Friday, except on Federal holidays within the District of Columbia. 37 C.F.R. §7.4(c).

If a subsequent designation is mailed to the USPTO via the Express Mail Service of the USPS, the USPTO will deem that the subsequent designation was submitted on the day it was deposited as Express Mail, provided that the holder complies with the requirements for correspondence sent by Express Mail set forth in 37 C.F.R. §2.198. See TMEP §305.03 regarding the requirements for submission of documents by Express Mail. The certificate of mailing or transmission procedures of 37 C.F.R. §2.197 do not apply to subsequent designations. 37 C.F.R. §§2.197(a)(2)(ii) and 7.4(e).

With a paper-filed subsequent designation, a holder should include a self-addressed, stamped postcard. Upon receipt of the subsequent designation, the USPTO will place a label indicating the receipt date on the papers and return the postcard to the holder.

Subsequent designations cannot be filed by fax. 37 C.F.R. §§2.195(d)(5) and 7.4(d)(2).

### **1902.08(c) Fees for Subsequent Designation**

*USPTO Transmittal Fee.* The subsequent designation must include the USPTO transmittal fee, or the USPTO will not forward it to the IB. 37 C.F.R. §7.21(a)(7).

*International Fees.* Trademark Rule 7.21(a)(8) requires that if the subsequent designation is filed through TEAS, all international fees for the subsequent designation must be paid at the time of submission. International fees for subsequent designations filed on paper must be paid directly to the IB in Swiss currency, either before or after submission of the subsequent designation. However, international fees paid after the IB receives the subsequent designation could result in a notice of irregularity issued by the IB. Holders may submit a bank check for international fees in Swiss francs made payable to the IB when submitting the subsequent designation on paper to the USPTO. The USPTO will forward the check with the subsequent designation to the IB.

See TMEP §1903.02 regarding payment of international fees.

**1902.08(d) IB Requirements for Subsequent Designation**

The subsequent designation requirements are set forth in Article 3<sup>ter</sup> and Common Reg. 24. If the subsequent designation meets the minimum requirements for a date of receipt set forth in 37 C.F.R. §7.21(b) (see TMEP §1902.08(a)), the USPTO will forward the subsequent designation to the IB. *The USPTO will not examine it to determine whether it is complete.* The IB will examine it for completeness.

If the subsequent designation meets the applicable requirements, the IB will record it in the International Register and notify the holder, the Offices of the designated Contracting Parties and the USPTO, if the subsequent designation was submitted through the USPTO. Common Reg. 24(8).

**1902.08(e) Irregularities in Subsequent Designation**

If a subsequent designation is sent to the IB through the USPTO, the IB will notify both the holder and the USPTO of any irregularity. Common Reg. 24(5)(a). Corrections of any irregularity in a subsequent designation must be sent directly to the IB, even if the subsequent designation was sent through the USPTO. 37 C.F.R. §7.21(e). The USPTO will make note of the notice of irregularity in its automated records, but will not take any other action.

**1902.09 Dependence & “Central Attack”: Restriction, Abandonment, Cancellation or Expiration of Basic Application or Registration During First 5 Years**

For a period of 5 years from the date of the international registration, the registration is dependent on the basic application or basic registration. Article 6(3). Under §63 of the Trademark Act, 15 U.S.C. §1141c, and Article 6(4), the USPTO must notify the IB if the basic application or registration is restricted, abandoned, cancelled, or expired, with respect to some or all of the goods/services listed in the international registration:

- (1) Within five years after the international registration date; or
- (2) More than five years after the international registration date if the restriction, abandonment, or cancellation of the basic application or basic registration resulted from an action that began before the end of the five-year period.

The IB will cancel (or restrict) the international registration accordingly. Article 6(4); Common Reg. 22(2)(b). This is sometimes called “central attack.”

The USPTO must notify the IB if there is an appeal, opposition or cancellation proceeding (or a court proceeding, if the USPTO is aware of the proceeding) pending at the end of the five-year period. The USPTO must notify the IB of the final decision once the proceeding is concluded. Common Regs. 22(1)(b)

## MADRID PROTOCOL

and (c). The IB will record this notice in the International Register and notify the holder and the designated Contracting Parties.

In view of the above notification requirements, applicants and registrants are encouraged to exercise diligence in monitoring the status of their basic application or basic registration (see TMEP §1705.05). Once the IB cancels or restricts an international registration, it cannot be reinstated. If a problem arises with the basic application or registration or a status inquiry reveals that the basic application or registration has become improperly abandoned or cancelled, the applicant or registrant should promptly take corrective action. See TMEP §1712 for information regarding reinstatement of abandoned applications and cancelled registrations; and TMEP §1714 regarding petitions to revive abandoned applications.

### **1902.10 Transformation When the USPTO is the Office of Origin**

If the IB cancels an international registration as a result of the cancellation or restriction of the USPTO basic application and/or USPTO basic registration under Article 6(4) (see TMEP §1902.09), the holder may “transform” the international registration into national applications in the offices of the Contracting Parties that were designated for extension(s) of protection in the international registration. Transformation must be requested within three months from the date of cancellation of the international registration. Article 9<sup>quinquies</sup>. The filing date for the new national application(s) that results from the transformation of an extension of protection will be the international registration date (or the date of recordal of the subsequent designation requesting an extension of protection to that Contracting Party). The goods/services in the national application(s) must have been covered by the cancelled international registration.

Transformation of an extension of protection may take place only if the IB cancels or restricts the international registration at the request of the USPTO, due to cancellation of the USPTO basic application or USPTO basic registration. It is not available if the international registration is cancelled at the request of the holder, or expires for failure to renew. Transformation is not available at the Office of Origin.

The request for transformation must be filed directly with the designated Contracting Party, and will be examined as a regular application under the laws of that Contracting Party. The USPTO and the IB are not involved.

See TMEP §§1904.09 *et seq.* regarding transformation of a request for extension of protection to the United States into an application under §1 or §44 of the Trademark Act.

**1902.11 Representative**

An applicant for or holder of an international registration may appoint a representative to represent the applicant or holder before the IB by indicating the representative's name in the appropriate box on the international application or subsequent designation form. Common Reg. 3(2)(a). The applicant/holder may also appoint a representative in a subsequent communication submitted to the IB (see TMEP §1906.01(d)). Common Reg. 3(2)(b). There is a form for appointing a representative on the IB website at <http://www.wipo.int/madrid/en/>.

See TMEP §§603.01(a) and 1904.02(f) regarding the correspondence address in a request for extension of protection to the United States.

**1902.12 USPTO Must Notify IB of Division or Merger of Basic Application or Registration**

Under Common Reg. 23, an Office of Origin must notify the IB if the basic application or registration is divided into several applications or registrations, or if several applications or registrations are merged into a single application or registration, within 5 years after the date of the international registration. See TMEP §§1110 *et seq.* regarding division of a United States application and TMEP §§1615 *et seq.* regarding division of a United States registration.

**1903 Payment of Fees**

**1903.01 Payment of USPTO Fees**

The fees required by the USPTO for processing correspondence relating to international applications and registrations under the Madrid Protocol are set forth in 37 C.F.R. §7.6. The USPTO charges a fee for processing the following Madrid related documents:

- International applications under 37 C.F.R. §7.11;
- Subsequent designations under 37 C.F.R. §7.21;
- Requests to record assignments, restrictions or release of restrictions of an international registration under 37 C.F.R. §§7.23 and 7.24;
- Notices of replacement under 37 C.F.R. §7.28; and
- Affidavits under Section 71 of the Act (see 37 C.F.R. §7.36).

These fees must be paid in U.S. dollars at the time of submission regardless of whether the document is submitted electronically or on paper.

## MADRID PROTOCOL

### **1903.02 Payment of International Fees**

In addition to the fees required by the USPTO, there are international fees for processing international applications and registrations required by the IB. Fees for international applications, subsequent designations, and requests to record changes of ownership of international registrations may be paid either directly to the IB or through the USPTO if the document is filed through TEAS. 37 C.F.R. §7.7(a). Applicants/holders filing on paper must pay all international fees directly to the IB in Swiss currency. 37 C.F.R. §7.7(c); see Common Regs. 34 to 38 regarding payment of fees. There is a fee calculator and a schedule of fees on the IB website at <http://www.wipo.int/madrid/en/>.

The IB will accept the following forms of payment:

- Debit to a current account established with the IB;
- Payment into the Swiss postal check account or to any of the specified bank accounts of the IB;
- Banker's check in Swiss currency; and
- Payment in cash at the IB.

Admin. Instr. §19.

The conditions for opening, using, and closing a current account with the IB are posted on the IB website at <http://www.wipo.int/madrid/en/>.

When submitting international applications, subsequent designations and requests to record changes of ownership of international registrations on paper to the IB through the USPTO, the applicant/holder may include a banker's check payable to the IB in Swiss francs for forwarding to the IB with the submission.

Questions concerning payment of international fees should be directed to the IB by mail to the World Intellectual Property Organization, 34 chemin des Colombettes, P.O. Box 18, 1211 Geneva 20, Switzerland; by telephone at 41 22 338 9111; by fax to 41 22 740 1429; or by e-mail to [intreg.mail@wipo.int](mailto:intreg.mail@wipo.int). The USPTO cannot assist applicants/holders in calculating the appropriate international fees or in selecting a method of payment of fees to the IB.

### **1904 Request for Extension of Protection of International Registration to the United States**

#### **1904.01 Filing Request for Extension of Protection to United States**

The holder of an international registration may file a request for extension of protection of that registration to the United States. Section 66(a) of the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Trademark Act, 15 U.S.C. §1141f. The request for extension of protection to the United States may be included in the international application, or in a subsequent designation made after the IB registers the mark. The IB will transmit the request for extension of protection to the United States to the USPTO electronically. The USPTO refers to a request for extension of protection to the United States as a “§66(a) application.” 37 C.F.R. §7.25(b).

### **1904.01(a) Section 66(a) Basis**

Section 66(a) of the Trademark Act provides a basis for filing in the United States. See 37 C.F.R. §2.34(a)(5). A §66(a) applicant cannot change the basis or claim more than one basis. 37 C.F.R. §§2.34(b)(3) and 2.35(a).

### **1904.01(b) Filing Date**

If a request for extension of protection of an international registration to the United States is made in an international application, the filing date of the §66(a) application is the international registration date. If a request for extension of protection to the United States is made in a subsequent designation, the filing date of the §66(a) application is the date that the subsequent designation was recorded by the IB. 15 U.S.C. §1141f(b); 37 C.F.R. §7.26.

### **1904.01(c) Declaration of Intent to Use Required**

Section 66(a) of the Trademark Act requires that a request for extension of protection to the United States include a declaration that the applicant has a bona fide intention to use the mark in commerce that can be controlled by the United States Congress. 15 U.S.C. §1141f(a). The declaration must include a statement that the person making the declaration believes the applicant to be entitled to use the mark in commerce; and that to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive. Section 60(5) of the Trademark Act, 15 U.S.C. §1141(5).

The declaration must be signed by (1) a person with legal authority to bind the applicant; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant; or (3) an attorney authorized to practice before the USPTO under 37 C.F.R. §10.14 who has an actual written or verbal power of attorney or an implied power of attorney from the applicant. 37 C.F.R. §2.33(a).

The USPTO has provided the IB with wording for the declaration of the applicant's bona fide intention to use the mark in commerce, which is part of

## MADRID PROTOCOL

the official IB form for international applications and subsequent designations in which the United States is designated for an extension of protection (IB Form MM18). Instructions as to who is a proper party to sign the declaration pursuant to 37 C.F.R. §2.33(a) have also been provided to the IB.

The IB will check to ensure that the MM18 form is annexed to the international application or subsequent designation in which there is a request for extension of protection to the United States, that the wording of the declaration has not been altered, and that the document has been signed before forwarding the request for extension of protection to the USPTO. The IB will not send the verified statement to the USPTO with the request for extension of protection.

The verified statement remains part of the international registration on file at the IB. 37 C.F.R. §2.33(e). The examining attorney will not review the international registration to determine whether there is a proper declaration of intent to use, or issue any inquiry regarding the verification of the application. See TMEP §804.06 for further information about declarations in §66(a) applications.

### **1904.01(d) Use Not Required**

Use in commerce prior to registration is not required. Section 68(a)(3) of the Trademark Act, 15 U.S.C. §1141h(a)(3). However, after registration, periodic affidavits of use or excusable nonuse are required to maintain a registered extension of protection. Section 71 of the Trademark Act, 15 U.S.C. §1141k. See TMEP §1613 for information about these affidavits.

### **1904.01(e) Priority**

A holder may claim a right of priority within the meaning of Article 4 of the Paris Convention if:

- (1) The request for extension of protection contains a claim of priority;
- (2) The request for extension of protection specifies the filing date, serial number and the country of the application that forms the basis for the claim of priority; *and*
- (3) The date of international registration or the date of the recordal of the subsequent designation requesting an extension of protection to the United States is not later than 6 months after the date of the first regular national filing (within the meaning of Article 4(A)(3) of the Paris Convention) or a subsequent application (within the meaning of Article 4(C)(4) of the Paris Convention).

Section 67 of the Trademark Act, 15 U.S.C. §1141g; Madrid Protocol Article 4(2).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

To be eligible for a claim of priority in a 66(a) application, a holder must file a request for extension of protection to the United States within 6 months of the date of the filing that forms the basis of the priority claim. If the United States is designated for an extension of protection in an international application, the international registration date cannot be later than 6 months after the date of the filing that formed the basis of the priority claim. If a request for extension of protection to the United States is made in a subsequent designation, the date of recordal of the subsequent designation cannot be later than 6 months after the date of the filing that formed the basis of the priority claim.

### **1904.01(f) Filing Fee**

The filing fee for a §66(a) application will be sent to the USPTO by the IB. The examining attorney should not require additional fees during examination. See Article 8 and Common Regs. 34 through 38 regarding international fees.

### **1904.01(g) Constructive Use**

Under §66(b) of the Trademark Act, unless extension of protection is refused, the filing of the request for extension of protection constitutes constructive use of the mark, conferring the same rights as those specified in §7(c) of the Trademark Act, 15 U.S.C. §1057(c), as of the earliest of the following:

- (1) The international registration date, if the request for extension of protection was filed in the international application;
- (2) The date of recordal of the subsequent designation requesting extension of protection, if the request for extension of protection to the United States was made after the international registration date;  
or
- (3) The date of priority claimed pursuant to §67 of the Trademark Act.

### **1904.01(h) Cannot be Based on USPTO Basic Application or Registration**

An international registration in which the United States is the Office of Origin (*i.e.*, an international registration based on a basic application pending in the USPTO or a basic registration issued by the USPTO) cannot be used to obtain an extension of protection to the United States. Section 65(b) of the Trademark Act, 15 U.S.C. §1141e(b); Article 3<sup>bis</sup>. The IB will not send a request for extension of protection to the United States if the international registration is based on a USPTO basic application or registration.



## MADRID PROTOCOL

### **1904.02 Examination of Request for Extension of Protection to the United States**

#### **1904.02(a) Examined as Regular Application**

Under Section 68(a) of the Trademark Act, 15 U.S.C. §1141h, a request for extension of protection will be examined under the same standards as any other application for registration on the Principal Register. It is unnecessary for the examining attorney to review the international registration on file at the IB, since the IB will forward all the necessary information with the request for extension of protection.

Except for 37 C.F.R. §§2.130-2.131, 2.160-2.166, 2.168, 2.173, 2.175, 2.181-2.186 and 2.197, all rules in 37 C.F.R. Part 2 apply to a request for extension of protection of an international registration to the United States, including sections related to proceedings before the Trademark Trial and Appeal Board, unless stated otherwise. All rules in 37 C.F.R. Part 10 also apply to requests for extension of protection. 37 C.F.R. §7.25(a).

#### **1904.02(b) Examination of Identification and Classification of Goods/Services in §66(a) Applications**

The examining attorney will examine the identification of goods/services in a §66(a) application according to the same standards of specificity used in examining applications under §1 and §44 of the Trademark Act, 15 U.S.C. §§1051 and 1126. Specifically, the examining attorney must follow the procedures set forth in the TMEP and identify the goods/services in accordance with the USPTO's *Manual of Acceptable Identification of Goods and Services* ("USPTO ID Manual") whenever possible.

However, the international classification of goods/services in a §66(a) application **cannot be changed** from the classification given to the goods/services by the IB. Under Article 3(2), the IB controls classification. The §66(a) application (and any resulting registration) remains part of the international registration, and a change of classification in the United States would have no effect on the international registration. TMEP §1401.03(d).

If the IB's classification of goods/services in the §66(a) application is different from the classification set forth in the USPTO ID Manual, the examining attorney will not request an amendment of the classification. The goods/services cannot be moved to another class identified in the application.

Accordingly, if the mark in a §66(a) application appears to be a certification or collective membership mark, the USPTO **will not** reclassify it into U.S. Class A, B or 200. However, the applicant must comply with all other U.S. requirements for certification and collective membership marks, regardless of the classification chosen by the IB. See TMEP §§1304 *et seq.* and 1306 *et seq.*

**1904.02(c) Mark Must Be Registrable on Principal Register**

There is no provision in the Trademark Act for registration of a mark in a request for an extension of protection on the Supplemental Register. If the proposed mark is not registrable on the Principal Register, the extension of protection must be refused. Section 68(a)(4) of the Trademark Act, 15 U.S.C. §1141h(a)(4); 37 C.F.R. §§2.47(c) and 2.75(c).

**1904.02(d) Refusal Must Be Made Within 18 Months**

Under §68(c) of the Trademark Act and Article 5 of the Protocol, the USPTO must notify the IB of any refusal entered in a §66(a) application within 18 months of the date the IB transmits the request for extension of protection to the USPTO. See TMEP §1904.03(a).

**1904.02(e) Issuing Office Actions**

The USPTO will send the first Office action in a §66(a) application to the IB. The first Office action is known as a provisional refusal and must be reviewed by the IB. If the provisional refusal meets the applicable requirements, (see TMEP §1904.03 *et seq.*), the IB will send it to the holder (*i.e.*, the §66(a) applicant).

An examiner's amendment or a combined examiner's amendment/priority action (see TMEP §§707 *et seq.* and 708.05) may not be issued as a first Office action because the IB will not accept such amendments. Examiner's amendments and combined examiner's amendments/priority actions may be issued as second and subsequent actions.

The USPTO will send second and subsequent Office actions directly to the applicant, at the correspondence address set forth in the request for extension of protection to the United States, or to the correspondence address provided in a subsequent communication filed in the USPTO. See TMEP §1904.02(f) regarding applicant's correspondence address.

**1904.02(f) Correspondence Address**

The USPTO will send second and subsequent Office actions to the applicant's correspondence address of record. The USPTO will accept a notice of change of the correspondence address in a §66(a) application or a registered extension of protection to the United States, and will send correspondence to the new address. See TMEP §§603 *et seq.* regarding the procedures for establishing and changing the correspondence address in the USPTO.

An applicant should not use as its correspondence address the address of an attorney who is not qualified to practice before the USPTO in trademark

## MADRID PROTOCOL

cases under 37 C.F.R. §10.14(c). See TMEP §§602.03, 603.05 and 1904.03(c).

A change of the correspondence address in the USPTO records will not affect the address of the holder's representative designated in the international registration, to which the IB sends correspondence. A request to record a change of the name or address of the representative designated in the international registration must be filed with the IB; it cannot be filed through the USPTO. See TMEP §1906.01(c). There are forms for changing the name or address of the representative on the IB website at <http://www.wipo.int/madrid/en/>. See Common Reg. 36(i).

### **1904.02(g) Mark Cannot Be Amended**

The Madrid Protocol and the Common Regulations do not permit amendment of a mark in an international registration. If the holder of the international registration wants to change the mark in any way, even slightly, the holder must file a new international application. The IB's *Guide to International Registration*, Para. B.II.69.02 (2004), provides as follows:

[T]here is no provision for a mark that is recorded in the International Register to be amended in any way, either on renewal or at any other time. If the holder wishes to protect the mark in a form which differs, even slightly, from the mark as recorded, he must file a new international application. This is true even if the mark has been allowed to be changed in the basic application, the registration resulting from the basic application or the basic registration, as the case may be....

Accordingly, because an application under §66(a) is a request to extend protection of the mark in an international registration to the United States, the Trademark Rules of Practice make no provision for amendment of the mark in a §66(a) application, and the USPTO will not permit such amendments. See 37 C.F.R. §2.72; TMEP §807.13(b).

### **1904.02(h) Jurisdiction**

The provisions with respect to requesting jurisdiction over published §66(a) applications are similar to those for applications under §§1(a) and 44 of the Trademark Act. 37 C.F.R. §2.84. However, when deciding whether to grant requests for jurisdiction of §66(a) applications, the Director must consider the time limits for notifying the IB of a refusal of a §66(a) application, set forth in Article 5(2) of the Protocol and §68(c) of the Trademark Act.

**1904.03 Notice of Refusal**

**1904.03(a) Notice Must be Sent Within 18 Months**

Within 18 months of the date the IB forwards a request for extension of protection, the USPTO must transmit:

- (1) A notification of refusal based on examination;
- (2) A notification of refusal based on the filing of an opposition; or
- (3) A notification of the possibility that an opposition may be filed after expiration of the 18-month period. If the USPTO notifies the IB of the possibility of opposition, it must send the notification of refusal within 7 months after the beginning of the opposition period or within one month after the end of opposition period, whichever is earlier.

Section 68(c) of the Trademark Act, 15 U.S.C. §1141h(c); Article 5.

If the USPTO does not send a notification of refusal of the request for extension of protection to the IB within 18 months, the request for extension of protection cannot be refused. Section 68(c)(4) of the Trademark Act; Article 5(5); Common Reg. 17(2)(iv). If the USPTO sends a notification of refusal, no grounds of refusal other than those set forth in the notice can be raised more than 18 months after the date the IB forwards the request for extension of protection to the USPTO. Section 68(c)(3) of the Trademark Act.

**1904.03(b) Requirements for Notice of Refusal**

A final decision is not necessary; a provisional refusal is sufficient to meet the 18-month requirement. Under Common Reg. 17, a notice of provisional refusal must be dated and signed by the USPTO and must contain:

- The number of the international registration, preferably accompanied by an indication of the mark;
- All grounds of refusal;
- If there is a conflicting mark, the filing date, number, priority date (if any), the registration date and number (if available), the name and address of the owner, reproduction of the conflicting mark, and list of goods/services;
- A statement that the provisional refusal affects all the goods and/or services, or a list of the goods/services affected;
- The procedures and time limit for contesting the refusal, *i.e.*, period for response or appeal of the refusal, and the authority with which an appeal can be filed;

## MADRID PROTOCOL

- If the refusal is based on an opposition, the name and address of the opposer.

The IB will record the provisional refusal in the International Register and transmit it to the holder of the registration. Article 5(3); Common Reg. 17(4).

### **1904.03(c) §66(a) Applicant Must Respond to Notification of Refusal**

A holder of an international registration who applies for an extension of protection to the United States will receive any notification of refusal through the IB. The holder must respond directly to the USPTO. The holder may be represented by an attorney who meets the requirements of 37 C.F.R. §10.14 (see TMEP §§601 and 602). Standard examination procedures are used to examine §66(a) applications.

A foreign attorney who does not meet the requirements of 37 C.F.R. §10.14 cannot represent the applicant or sign a response to an Office action on behalf of the applicant. See TMEP §§712.01 and 712.03.

### **1904.03(d) Refusal Pertaining to Less Than All the Goods/Services**

If a notification of refusal in a §66(a) application does not pertain to all the goods/services, the mark is protected for the remaining goods/services, even if the holder does not respond to the notification of refusal. Sections 68(c) and 69(a) of the Trademark Act, 15 U.S.C. §§1141h(c) and 1141i(a), provide that an application under §66(a) of the Trademark Act is automatically protected with respect to any goods or services for which the USPTO has not timely notified the IB of a refusal.

Accordingly, 37 C.F.R. §2.65(a) provides that if a refusal or requirement is expressly limited to only certain goods/services and the applicant fails to file a response (or a complete response) to the refusal or requirement, the application shall be abandoned only as to those particular goods/services. See TMEP §718.02(a) for further information about partial abandonment.

### **1904.03(e) Confirmation or Withdrawal of Provisional Refusal**

If the USPTO has sent a notice of provisional refusal, once procedures regarding the refusal are complete, the USPTO must notify the IB that:

- (1) protection is refused for all goods/services;
- (2) the mark is protected for all goods/services; or
- (3) the mark is protected for some specified goods/services.

Common Reg. 17(5). The IB will record this notice and send it to the holder.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1904.04 Opposition

Section 68(a)(2) of the Trademark Act, 15 U.S.C. §1141h(a)(2), provides that a request for extension of protection is subject to opposition under §13 of the Trademark Act. As noted above, the USPTO must notify the IB within 18 months of the date the IB sends the request for extension of protection to the USPTO of: (1) a notification of refusal based on the filing of an opposition; or (2) a notification of the possibility that an opposition may be filed after expiration of the 18-month period.

The notice must state the dates on which the opposition period begins and ends, if known. If the dates are unknown, the USPTO must communicate them to the IB “at the latest at the same time as any notification of a provisional refusal based on an opposition.” Common Reg. 16(1)(b).

Any notification of refusal on the basis of opposition must be received by the IB within 7 months after the beginning of the opposition period or within one month after the end of the opposition period, whichever is earlier. 15 U.S.C. §1141h(c)(2); Article 5(2)(c)(ii).

An opposition to a §66(a) application must be filed through the Electronic System for Trademark Trials and Appeals (“ESTTA”). 37 C.F.R. §2.101(b)(2). *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019 (TTAB 2005). The notice of opposition must include all fees for each party opposer to oppose the registration in all classes specified in the opposition. 37 C.F.R. §2.101(d)(2). Once filed, an opposition to a §66(a) application may not be amended to change or add to the grounds for opposition or to add to the goods or services opposed. 37 C.F.R. §2.107(b).

*Request for Extension of Time to Oppose.* A request for extension of time to oppose a §66(a) application must be filed through ESTTA. 37 C.F.R. §2.102(a)(2).

No more than three requests to extend the time for filing an opposition may be filed. The time for filing an opposition may not be extended beyond 180 days from the date of publication. 37 C.F.R. §2.102(c).

See TMEP §§1503 *et seq.* for further information about oppositions.

### 1904.05 Certificate of Extension of Protection

If the mark in a §66(a) application is published for opposition and is not opposed, or if an application survives all oppositions filed, the USPTO will issue a certificate of extension of protection and publish notice of such certificate in the *Official Gazette*. Section 69(a) of the Trademark Act, 15 U.S.C. §1141i(a). From the date of issuance of the certificate, the extension of protection has the same effect and validity as a registration on the Principal Register, and the holder of the international registration has the

## MADRID PROTOCOL

same rights and remedies as the owner of a registration on the Principal Register. Section 69(b) of the Trademark Act. The certificate of registration will look the same as the certificate issued for registrations resulting from applications under §§1 and 44 of the Trademark Act.

Upon registration, the USPTO will refer to an extension of protection to the United States as a “registration,” “registered extension of protection,” or a “§66(a) registration.” 37 C.F.R. §7.25(c).

A registered extension of protection always remains part of and dependent upon the international registration. In this respect, a registered extension of protection differs from a §44 registration, which is independent from the underlying foreign registration, pursuant to 15 U.S.C. §1126(f).

See TMEP §§1613 and 1904.10 regarding the requirement for an affidavit of use or excusable nonuse under §71 of the Trademark Act, 15 U.S.C. §1141k, TMEP §1905 regarding renewal and expiration of international registrations in general, and TMEP §1614 for information about renewal of registered extensions of protection to the United States.

### **1904.06            Assignment of Extension of Protection to the United States**

Under §72 of the Trademark Act, 15 U.S.C. §1141*l*, an extension of protection to the United States may be assigned, together with the goodwill associated with the mark, only to a person who is a national of, is domiciled in, or has a bona fide and effective industrial or commercial establishment in a country that is party to the Madrid Protocol (or in a country that is a member of an intergovernmental organization that is a party to the Madrid Protocol).

Because an extension of protection remains part of the international registration, assignments of extensions of protection to the United States must first be recorded at the IB. A holder or assignee cannot file an assignment (or other document transferring title) of an extension of protection to the United States directly with the Assignment Services Division of the USPTO. The USPTO will record only those assignments (or other documents transferring title) that have been recorded in the International Register. The IB will notify the USPTO of any changes in ownership recorded in the International Register, and the USPTO will automatically update the trademark database and the assignment database to reflect the change(s). See TMEP §501.07.

See TMEP §§1906.01 and 1906.01(a) regarding requests to record a change of ownership in the International Register.

Section 10 of the Trademark Act and 37 C.F.R. Part 3 do not apply to assignments of international registrations or extensions of protection to the United States. 37 C.F.R. §7.22.

**1904.07           Invalidation of Protection in United States**

An extension of protection to the United States may be invalidated in an administrative or judicial proceeding, governed by U.S. law, such as a cancellation proceeding before the Trademark Trial and Appeal Board or a federal court proceeding. The USPTO must notify the IB if an extension of protection to the United States is invalidated. Article 5(6). The requirements for a notice of invalidation are set forth in Common Reg. 19.

**1904.08           Cancellation of International Registration By IB**

If the IB notifies the USPTO that an international registration has been cancelled with respect to some or all of the goods/services, the USPTO will cancel the extension of protection of that international registration to the United States with respect to such goods/services as of the date that the IB cancelled the international registration. 15 U.S.C. §1141j(a); 37 C.F.R. §7.30.

See TMEP §1905 regarding renewal and expiration of international registrations in general, and TMEP §1614 for information about renewal of registered extensions of protection to the United States.

**1904.09           Transformation to Application Under §1 or §44**

An international registration is dependent on the basic application and/or basic registration for five years after the date of the international registration. Article 6(3). If the basic application or registration is restricted, abandoned, cancelled, or expired with respect to some or all of the goods or services listed in the international registration, the Office of Origin will notify the IB, and the IB will cancel (or restrict) the international registration and notify the USPTO. Article 6(4). See TMEP §1902.09. The USPTO will cancel, in whole or in part, the corresponding registered extension of protection (or request for extension of protection) of the international registration to the United States.

In this situation, the holder of the international registration may “transform” the cancelled registered extension of protection (or request for extension of protection) into an application under §1 or §44 of the Trademark Act for registration of the same mark for any or all of the cancelled goods/services that were covered by the extension of protection. 15 U.S.C. §1141j; Article 9<sup>quinquies</sup>.

**1904.09(a)       Requirements for Transformation**

A request for transformation must be filed within three months after the date on which the international registration was cancelled, in whole or in part. Article 9<sup>quinquies</sup>(i); Section 70(c) of the Trademark Act. The request must include:



## MADRID PROTOCOL

- (1) The serial number or registration number of the extension of protection to the United States;
- (2) The name and address of the holder of the international registration;
- (3) The domestic application filing fee required by 37 C.F.R. §2.6(a)(1) for at least one class of goods or services; and
- (4) An e-mail address for receipt of correspondence from the USPTO.

37 C.F.R. §7.31(a).

The holder must file the request for transformation directly with the USPTO, which will be examined as a domestic application.

Under §70(c) of the Trademark Act and Article 9<sup>quinquies</sup>, transformation may take place only if the international registration is cancelled or restricted *at the request of the Office of Origin under Article 6(4), due to the cancellation of the basic application and/or registration*. It is not available if the international registration expires for failure to renew, is cancelled or restricted at the request of the holder, or is cancelled or restricted for any other reason.

The request for transformation should be mailed to the following address:

Commissioner for Trademarks  
P.O. Box 16471  
Arlington, VA 22215-1471  
Attn: MPU

37 C.F.R. §§2.190(e) and 7.4(b). The request may also be delivered by hand or courier to the Trademark Assistance Center, at James Madison Building – East Wing, 600 Dulany Street, Alexandria, Virginia, Attention: MPU. TAC is open 8:00 a.m. to 5:00 p.m. Eastern Standard Time, Monday through Friday, except on Federal holidays within the District of Columbia. 37 C.F.R. §7.4(c). The certificate of mailing or transmission procedures of 37 C.F.R. §2.197 and Express Mail provisions of 37 C.F.R. §2.198 do not apply to requests for transformation. 37 C.F.R. §§2.197(a)(2)(ii), 7.4(b)(2) and 7.4(e).

Requests for transformation cannot be filed by fax. 37 C.F.R. §§2.195(d)(5) and 7.4(d)(6).

### **1904.09(b) Examination of Transformed Application**

A “transformed” application under §1 or §44 of the Trademark Act resulting from the transformation of a cancelled extension of protection must comply with all the requirements of the Trademark Act and Trademark Rules of Practice. 37 C.F.R. §7.31(c). The USPTO will assign a new serial number, and will link the prosecution history of the cancelled extension of protection to the new “transformed” application.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The USPTO will treat the “transformed” application as if it had been filed on (1) the international registration date, if the request for extension of protection to the United States was made in the international application, or (2) the date of recordal of the subsequent designation with the IB, if the request for extension of protection to the United States was made in a subsequent designation. If the extension of protection was entitled to priority under §67 of the Trademark Act, the new application is entitled to the same priority.

If an examining attorney has already performed a search for conflicting marks, he or she does not have to conduct a new search, since the effective filing date will not change.

The examining attorney should inquire as to whether the holder seeks registration for all of the goods/services that were covered by the cancelled extension of protection.

Even if the mark in the extension of protection was already published or registered, republication will be required.

Generally, in examining a “transformed” application where the extension of protection was published or registered, the Office will only issue requirements or refusals related to the new §1 or §44 basis. However, in some cases, where a significant length of time has elapsed since the initial examination of the request for extension of protection, refusal of registration may be appropriate due to changed circumstances. For example, the mark may have become descriptive or generic as applied to the goods or services.

### **1904.10            Affidavits of Use or Excusable Nonuse Required**

Under §71 of the Trademark Act, 15 U.S.C. §1141k, a registered extension of protection to the United States will be cancelled unless the holder of the international registration periodically files affidavits of use in commerce or excusable nonuse (“§71 affidavit”). See TMEP §1613 for further information.

Since the §71 affidavit cannot be filed until five years after the USPTO registers an extension of protection, the USPTO will not accept these affidavits until after November 2, 2008.

### **1904.11            Incontestability**

Under §73 of the Trademark Act, 15 U.S.C. §1141m, if a holder files an affidavit that meets the requirements of §15 of the Trademark Act, a registered extension of protection to the United States may become “incontestable”. See TMEP §§1605 *et seq.* regarding the requirements for an affidavit of incontestability under §15 of the Trademark Act.

The USPTO will not accept these affidavits until after November 2, 2008.

## MADRID PROTOCOL

### **1904.12 Replacement**

If a U.S. national registration and a subsequently issued certificate of extension of protection of an international registration to the United States are (1) owned by the same person, (2) identify the same mark, and (3) list the same goods or services, the extension of protection shall have the same rights as those accrued to the U.S. national registration at the time the certificate of extension of protection issues. Section 74 of the Trademark Act, 15 U.S.C. §1141n; 37 C.F.R. §7.28(a); Article 4<sup>bis</sup>. See TMEP §1616 for further information.

### **1904.13 Amendment of Registered Extension of Protection to the United States**

All requests to record changes to an international registration and extensions of associated extensions of protection must be filed at the IB. Accordingly, the holder of a registered extension of protection of an international registration to the United States cannot file an amendment under §7 of the Trademark Act. TMEP §§1609.01(a) and 1609.02. The USPTO will not accept an amendment of a registered extension of protection that has not been recorded in the International Register. See TMEP §§1906.01 *et seq.* regarding requests to record changes at the IB.

### **1905 Renewal of International Registrations**

The term of an international registration is ten years, and it may be renewed for ten years upon payment of the renewal fee. Articles 6(1) and 7(1). Renewal of international registrations must be made at the IB, in accordance with Article 7 and Common Regs. 29 - 31. There is a renewal form on the IB website at <http://www.wipo.int/madrid/en/>.

The USPTO will not process a request to renew an international registration nor forward it to the IB. 37 C.F.R. §7.41.

See TMEP §1614 regarding renewal of a registered extension of protection to the United States.

### **1906 Communications With International Bureau Regarding International Registrations**

Information about communicating directly with the IB is available on the WIPO website at <http://www.wipo.int/madrid/en/>. The IB can be contacted by mail to 34 chemin des Colombettes, P.O. Box 18, 1211 Geneva 20, Switzerland; by telephone at 41 22 338 9111; by fax to 41 22 740 1429; or by e-mail to [intreg.mail@wipo.int](mailto:intreg.mail@wipo.int).

**1906.01 Recording Changes in International Register**

The IB will record changes and other matters concerning international registration in the International Register. Such requests are governed by Articles 9 and 9<sup>bis</sup> and Common Reg. 25. Some of the changes that can be recorded in the International Register include:

- Change in ownership of the registration;
- Change of holder's name and address;
- Change in name or address of holder's representative;
- Limitation, renunciation, or cancellation of international registration.

Most requests to record changes must be filed with the IB on the IB's forms, available on the IB website at <http://www.wipo.int/madrid/en/>. There are only two limited situations in which a request to record a change may be filed with the IB through the USPTO:

- (1) an assignment that meets the requirements of 37 C.F.R. §7.23(a) (see TMEP §1906.01(a)(i)); or
- (2) a security interest or other restriction of a holder's right to dispose of an international registration (or the release of such a restriction) that meets the requirements of 37 C.F.R. §§7.24(a) and (b) (see TMEP §1906.01(b)).

37 C.F.R. §7.22.

**1906.01(a) Change in Ownership of International Registration**

The IB will record a change in ownership by assignment, merger, court decision, or operation of law, at the request of the holder, the Contracting Party of the holder, or an interested person. Article 9; Common Reg. 25(1)(a)(i). The change may relate to some or all of the goods/services in some or all of the designated Contracting Parties. A fee is required.

Most requests to record changes of ownership must be filed directly with the IB. 37 C.F.R. §§7.22 and 7.23. There is a form available on the IB website at <http://www.wipo.int/madrid/en/>. The IB does not require copies of assignments or other supporting documents. See TMEP §1906.01(a)(i) regarding the limited circumstances in which a request to record a change in ownership may be filed with the IB through the USPTO.

## MADRID PROTOCOL

### **1906.01(a)(i) Requirements for Submitting Changes in Ownership of International Registration Through the USPTO**

The USPTO will accept for submission and forward to the IB a request to record a change of ownership only if *all of the following conditions have been met*:

- (1) the assignee cannot obtain the assignor's signature on the request to record the change;
- (2) the assignee is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States;
- (3) the assigned goods/services must apply to the designation to the United States.

37 C.F.R. §7.23.

No other requests to record changes of ownership can be filed through the USPTO. 37 C.F.R. §§7.22 and 7.23.

A request to record a change of ownership filed through the USPTO must include:

- The international registration number;
- The name and address of the holder of the international registration;
- The name and address of the assignee of the international registration;
- A statement that the assignee: (i) is a national of the United States; (ii) has a domicile in the United States; or (iii) has a real and effective industrial or commercial establishment in the United States. Where an assignee's address is not in the United States, the assignee must provide the address of its U.S. domicile or establishment;
- A statement that the assignee could not obtain the assignor's signature for the request to record the assignment;
- An indication that the assignment applies to the designation to the United States;
- A statement that the assignment applies to all the goods/services in the international registration, or if less, a list of the goods/services in the international registration that have been assigned that pertain to the designation to the United States; and
- The USPTO transmittal fee required by 37 C.F.R. §7.6.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

37 C.F.R. §7.23(a).

The USPTO currently does not have a TEAS form available for requests to record a change of ownership of an international registration. A holder must use the official IB form MM5 available on the IB website at:

<http://www.wipo.int/madrid/en>. The IB will not accept paper requests that are not presented on the official IB form. The form cannot be handwritten. Comm Regs. 25(1)(a); Madrid Admin. Instr. §4(a). The holder should complete the form online, print the completed form and submit it to the USPTO by mail, hand delivery or courier services.

The completed form submitted through the USPTO must be mailed to:

Commissioner for Trademarks  
P.O. Box 16471  
Arlington, VA 22215-1471  
Attn: MPU

37 C.F.R. §§2.190(e) and 7.4(b). Requests to record changes of ownership may be delivered by hand or courier to the Trademark Assistance Center at James Madison Building – East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia, Attention: MPU. TAC is open 8:00 a.m. to 5:00 p.m. Eastern Standard Time, Monday through Friday, except on Federal holidays within the District of Columbia. 37 C.F.R. §7.4(c).

Requests to record changes of ownership cannot be filed by fax. 37 C.F.R. §§2.195(d)(5) and 7.4(d)(4).

If a request to record a change of ownership is mailed to the USPTO via the Express Mail Service of the USPS, the USPTO will deem that the request to record was submitted on the day it was deposited as Express Mail, provided that the holder complies with the requirements for correspondence sent by Express Mail set forth in 37 C.F.R. §2.198. See TMEP §305.03 regarding the requirements for submission of documents by Express Mail.

The holder should include a self-addressed, stamped postcard with the paper-filed request to record a change of ownership. Upon receipt, the USPTO will place a label indicating the receipt date on the postcard and return it to the holder.

If the request meets the requirements of 37 C.F.R. §7.23(a), the USPTO will forward it to the IB. 37 C.F.R. §7.23(b). If the request does not meet these requirements, the USPTO will not forward the request to the IB, and will notify the holder of the reasons. The USPTO will not refund the transmittal fee. 37 C.F.R. §7.23(c).

If the IB determines that a request to record a change sent through the USPTO is irregular, the IB will notify both the USPTO and the holder. Common Reg. 26(1). The holder must file a response to any notice of

## MADRID PROTOCOL

irregularity with the IB; the response cannot be filed through the USPTO. 37 C.F.R. §7.23(d).

Section 10 of the Trademark Act and 37 C.F.R. Part 3 do not apply to assignments of an international registration. 37 C.F.R. §7.22.

### **1906.01(a)(ii) International Fees for Recording Changes of Ownership of International Registration**

The international fee for a request to record a change of ownership must be paid directly to the IB in Swiss currency either before or after submission of the request to record. 37 C.F.R. §7.7(c). However, fees paid after the document is received by the IB could result in a notice of irregularity. Holders submitting requests to record a change of ownership through the USPTO (see TMEP §1906.01(a)(i)) may submit a bank check for international fees in Swiss francs made payable to the IB with the request to record. The USPTO will forward the check with the request to record to the IB.

See TMEP §1903.02 regarding payment of international fees.

### **1906.01(a)(iii) Effect of Change of Ownership of International Registration**

The validity of a change in ownership with respect to a particular Contracting Party is governed by the law of that Contracting Party. The Office of a designated Contracting Party may declare that a change in ownership has no effect in its territory. The declaration must be sent to the IB within 18 months of the date of IB's notification of the change. Common Reg. 27(4).

### **1906.01(a)(iv) Dividing an International Registration After Change of Ownership With Respect to Some But Not All of the Goods**

When ownership of an international registration changes with respect to some but not all of the goods/services for all designated Contracting Parties, the IB will create a separate new international registration for the goods/services that have been transferred, and notify the USPTO accordingly. See the IB's *Guide to International Registration*, Para. B.II.65.01 (2004).

See TMEP §1110.08 regarding division of a pending §66(a) application after ownership of an international registration has changed with respect to some, but not all, of the goods/services, and §1615.02 regarding division of a registered extension of protection to the United States after ownership of an international registration has changed with respect to some, but not all, of the goods/services.

**1906.01(b) Restriction of Holder's Rights of Disposal**

Under Common Reg. 20(1)(a), a holder of an international registration or a Contracting Party of the holder (*i.e.* a Contracting Party in which the holder is a national, is domiciled, or has a real and effective business or commercial establishment) may inform the IB that the holder's right to dispose of the international registration has been restricted in whole or in part. Under Common Reg. 20(1)(b), the Office of any designated Contracting Party may inform the IB that the holder's right of disposal has been restricted in the territory of that Contracting Party. Examples of restrictions on the holder's right to dispose are security interests, and court orders concerning the disposal of the assets of the holder.

The USPTO will accept for submission and forward to the IB a request to record a restriction of a holder's right to dispose of an international registration, or the release of such a restriction *only if all of the following conditions have been met*:

- (1) (i) the restriction is the result of a court order; or (ii) the restriction is the result of an agreement between the holder of the international registration and the party restricting the holder's right of disposal, and the signature of the holder of the international registration cannot be obtained;
- (2) the party who obtained the restriction is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States;
- (3) the restriction or release applies to the holder's right to dispose of the international registration in the United States; and
- (4) the restriction or release must apply to the designation to the United States.

37 C.F.R. §7.24(a).

All other requests to record restrictions must be filed directly with the IB. 37 C.F.R. §§7.22 and 7.24(a).

A request to record a restriction filed through the USPTO must include:

- The international registration number;
- The name and address of the holder of the international registration;
- The name and address of the party who obtained the restriction;
- A statement that the party who submitted the request: (i) is a national of the United States; (ii) has a domicile in the United States; or (iii) has a real and effective industrial or commercial establishment



## MADRID PROTOCOL

in the United States. Where a party's address is not in the United States, the party must provide the address of its U.S. domicile or establishment;

- A statement that (i) the restriction is the result of a court order, or (ii) where the restriction is the result of an agreement between the holder of the international registration and the party restricting the holder's right of disposal, a statement that the signature of the holder of the international registration could not be obtained for the request to record the restriction or release of the restriction;
- A summary of the main facts concerning the restriction;
- An indication that the restriction, or the release of the restriction, of the holder's right of disposal of the international registration applies to the designation to the United States; and
- The U.S. transmittal fee required by 37 C.F.R. §7.6.

37 C.F.R. §7.24(b).

A request to record a restriction or release submitted through the USPTO must be mailed to:

Commissioner for Trademarks  
P.O. Box 16471  
Arlington, VA 22215-1471  
Attn: MPU

37 C.F.R. §§2.190(e) and 7.4(b). Requests to record restrictions or releases may be delivered by hand or courier to the Trademark Assistance Center, at James Madison Building – East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia, Attention: MPU. TAC is open 8:00 a.m. to 5:00 p.m. Eastern Standard Time, Monday through Friday, except on Federal holidays within the District of Columbia. 37 C.F.R. §7.4(c).

Requests to record restrictions or releases cannot be filed by fax. 37 C.F.R. §§2.195(d)(5) and 7.4(d)(5).

If a request to record a restriction or release is mailed to the USPTO via the Express Mail Service of the USPS, the USPTO will deem that the request was submitted on the day it was deposited as Express Mail, provided that the holder complies with the requirements for correspondence sent by Express Mail set forth in 37 C.F.R. §2.198. See TMEP §305.03 regarding the requirements for submission of documents by Express Mail.

If the request meets the requirements of 37 C.F.R. §7.24(b), the USPTO will forward it to the IB. 37 C.F.R. §7.24(c). If the request does not meet these requirements, the USPTO will refuse to forward the request to the IB, and will

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

notify the holder of the reasons. The USPTO will not refund the transmittal fee. 37 C.F.R. §7.24(d).

If the IB determines that a request to record a restriction sent through the USPTO is irregular, the IB will notify both the USPTO and the holder. Common Reg. 26(1). The holder must file a response to any notice of irregularity with the IB; the response cannot be filed through the USPTO. 37 C.F.R. §7.24(e).

Section 10 of the Trademark Act and 37 C.F.R. Part 3 do not apply to restrictions of a holder's right to dispose of an international registration. 37 C.F.R. §7.22.

### **1906.01(c) Change of the Holder's Name or Address**

A request to record a change of the holder's name or address must be filed with the IB; it cannot be filed through the USPTO. 37 C.F.R. §7.22. There is a form on the IB website at <http://www.wipo.int/madrid/en/>. Article 9<sup>bis</sup>; Common Reg. 25(2).

### **1906.01(d) Change of Name or Address of Representative**

A request to record a change of the representative's name or address must be filed with the IB; it cannot be filed through the USPTO. 37 C.F.R. §7.22. There are forms on the IB website at <http://www.wipo.int/madrid/en/>. See Common Reg. 36(i).

See TMEP §§603.01(a) and 1904.02(f) regarding the correspondence address in a request for extension of protection to the United States.

### **1906.01(e) Limitation, Renunciation, Cancellation of International Registration**

Requests to record a limitation, renunciation or cancellation of an international registration must be filed with the IB; they cannot be filed through the USPTO. 37 C.F.R. §7.22. There are forms for such requests on the IB website at <http://www.wipo.int/madrid/en/>. Under Article 9<sup>bis</sup>, a holder may record the following restrictions:

- Limitation of the list of goods/services with respect to some or all of the designated Contracting Parties (Common Reg. 25(1)(a)(ii))
- Cancellation of the international registration with respect to all the designated Contracting Parties for some or all of the goods/services (Common Reg. 25(1)(a)(v))

## MADRID PROTOCOL

- Renunciation with respect to some but not all of the designated Contracting Parties for all the goods/services (Common Reg. 25(1)(a)(iii)).

The office of a designated Contracting Party may declare that a limitation has no effect in its territory, e.g., because it considers that the change requested is an extension rather than a limitation. Such declaration must be sent to the IB within 18 months of the date of the IB's notification of the limitation. Common Reg. 27(5).

### **1906.01(f) Correction of Errors in International Registration**

The IB will correct errors in an international registration at the request of the holder or the Office of Origin. Common Reg. 28(1). Requests to correct errors in international registrations in which the USPTO was the Office of Origin must be filed directly with the IB, unless the error was made by the USPTO.

The office of a designated Contracting Party may declare in a notification of provisional refusal that protection can no longer be granted to an international registration as corrected. A new refusal period under Article 5 of the Protocol and Common Regs. 16-17 starts to run from the date of the correction, but only in respect to grounds that did not exist prior to the correction. Common Reg. 28(3).

### **1906.01(g) Merger of International Registrations**

Where the same party is the holder of two or more international registrations of the same mark due to a partial change in ownership, the party may request the IB to record a merger of the registrations. Common Reg. 27(3). The request must be filed with the IB; it cannot be filed through the USPTO. 37 C.F.R. §7.22.

### **1906.01(h) License**

Under Common Reg. 20<sup>bis</sup>(1), a holder may file a request to record a license, a request for amendment of the recording of a license, or a request for cancellation of the recording of a license. Requests to record a license, or to cancel or amend the recording of a license, cannot be filed through the USPTO. 37 C.F.R. §7.22. There are forms for these requests on the IB website at <http://www.wipo.int/madrid/en/>. A designated Contracting Party may declare that the recording of a license has no effect in its territory. The declaration must be sent within 18 months of the IB's notification of recording of the license. Common Reg. 20<sup>bis</sup>(5).

**1906.01(i) Changes That Cannot Be Made to International Registration**

*Mark in International Registration Cannot Be Changed.* There is no provision for a mark to be amended in any way, at any time, even if the mark in the basic application or basic registration changes. *Guide to International Registration*, Para. B.II.69.02 (2004).

*Goods/Services in International Registration Cannot be Expanded.* It is not possible to expand the list of goods/services, even if the added goods/services were listed in the basic application or registration. *Guide to International Registration*, Para. B.II.69.03 (2004).

# **APPENDIX A**

## **Examining Attorneys' Appeal Briefs**

The following format should be used by examining attorneys when preparing an appeal brief in an appeal before the Trademark Trial and Appeal Board. The purpose of this format is to promote uniformity in the manner in which appeal briefs are presented and to suggest content guidelines. The substance of the appeal brief is a matter of individual effort within this format.

If, at the time an application file is sent to an examining attorney for preparation of the appeal brief, the examining attorney determines that jurisdiction should be restored to him or her for further examination (e.g., to make a new refusal, to correct informalities or to suspend), this request should be submitted in lieu of the appeal brief. This request would usually be entitled "Request for Remand to Examining Attorney." The request should be a brief statement of the reason for the request and an explanation of what action the examining attorney intends to take. The filing of such a request should be approved by the managing attorney.

If the examining attorney's request is granted, the Trademark Trial and Appeal Board will stay further proceedings in connection with the appeal. If the request is denied, the Trademark Trial and Appeal Board will reset the time for submission of the examining attorney's appeal brief.

### FORM FOR EXAMINING ATTORNEY'S APPEAL BRIEF

#### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	:	BEFORE THE
Trademark:	:	TRADEMARK TRIAL
Serial No.:	:	AND
Attorney:	:	APPEAL BOARD
Address:	:	ON APPEAL

#### EXAMINING ATTORNEY'S APPEAL BRIEF

The first paragraph should be an introduction, similar to the "Question Presented" section in a memo, e.g.:

The applicant has appealed the trademark examining attorney's refusal to register the trademark \_\_\_\_\_ on the ground that it is merely descriptive within the meaning of §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

#### FACTS

This section should be a brief recital of the facts, such as what mark and goods were applied for, what refusal was made and the basis for it, summary of any evidence submitted by either party, etc. Since the examining attorney is an advocate at this stage of the proceeding, the appeal brief should be written in a style that will make his or her position convincing to the Board.

# TRADEMARK MANUAL OF EXAMINING PROCEDURE

## ARGUMENT

The argument presented in this section should be complete. The examining attorney should clearly and concisely present each substantive argument in support of his or her position and address all of the applicant's arguments and distinguish any significant cases cited. Reference should not be made to earlier correspondence such as the final refusal. If appropriate, arguments that were made in earlier office actions may be repeated in whole or in part in this section of the appeal brief.

The following format for organizing arguments under sub-headings is recommended:

- (1) A sub-heading or sub-headings should be used. If there is only one issue with one point, one sub-heading should be used, *e.g.*:  
THE MARK IS MERELY DESCRIPTIVE BECAUSE IT DESCRIBES A CHARACTERISTIC OF THE GOODS.
- (2) If there is one issue with several points, use additional sub-headings, *e.g.*:  
\_\_\_\_\_ IS LIKELY TO CAUSE CONFUSION WITH \_\_\_\_\_.
  - A. \_\_\_\_\_ is visually similar to \_\_\_\_\_.  
(argument)
  - B. \_\_\_\_\_ is phonetically similar to \_\_\_\_\_.  
(argument)
  - C. ETC.
- (3) If there is more than one issue, each issue should head a separate section, and be identified by Roman numerals, *e.g.*:

## ARGUMENTS

- I. \_\_\_\_\_ IS LIKELY TO CAUSE CONFUSION . . . .  
(See (2) for example)
- II. \_\_\_\_\_ IS PRIMARILY MERELY A SURNAME.  
(argument)

## CONCLUSION

Reiterate the main reasons if necessary. If not, end with a sentence such as the following:

For the foregoing reasons, the refusal to register on the basis of § \_\_\_\_\_ of the Trademark Act, 15 U.S.C. § \_\_\_\_\_, for the reason that \_\_\_\_\_, should be affirmed.

Respectfully submitted,

Trademark Examining Attorney  
(\_\_\_\_\_, Managing Attorney)  
Law Office \_\_\_\_\_  
(571) 272-\_\_\_\_\_

## APPENDIX B

The following is a list of members of international trademark agreements to which the United States is also a party.

If there is a discrepancy between the expiration of a foreign registration as listed here and the date listed on the foreign registration, the date listed on the foreign registration will be controlling.

### Paris Convention for the Protection of Industrial Property

Under the Paris Convention, foreign applicants may seek U.S. registration, based on either (a) a valid registration, or (b) an application to register in any of the member countries listed below, with a right of priority if the United States application is filed within 6 months of the date of the first filing of the foreign application. For updates to the list below, see the World Intellectual Property Organization's home page at

<http://www.wipo.int/treaties/en/ip/paris/index.html>.

Country	Term of Registration (in years)	Renewal Period (in years)
ALBANIA	10 (from date of application)	10
ALGERIA	10 (from date of application)	10
ANDORRA	10 (from date of registration)	10
ANTIGUA and BARBUDA	14 (from date of application)	14
ARGENTINA	10 (from date of registration)	10
ARMENIA (Russian Federation)	10 (from date of application)	10
AUSTRALIA	10 (from date of application)	10
AUSTRIA	10 (from end of month in which mark is registered)	10
AZERBAIJAN (Russian Federation)	10 (from date of application)	10
BAHAMAS	14 (from date of application)	14
BAHRAIN	10 (from date of application)	10
BANGLADESH	7 (from date of application)	15
BARBADOS	10 (from date of registration)	10
BELARUS (Russian Federation)	10 (from date of application)	10
BELGIUM (Benelux Nations)	10 (from date of application) (1 to 10 years for service marks)	10
BELIZE	Term dependent on United Kingdom registration	Renewal dependent on United Kingdom registration
BENIN (African Union Nations) (OAPI)	10 (from date of application)	10
BHUTAN	10 (from date of application)	10
BOLIVIA	10 (from date of registration)	10

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Country	Term of Registration (in years)	Renewal Period (in years)
BOSNIA and HERZEGOVINA	Unlimited as long as fees are paid (usually 10 years)	Dependent on fee payment
BOTSWANA	10 (from date of application)	10
BRAZIL	10 (from date of registration)	10
BULGARIA	10 (from date of application)	10
BURKINA FASO (OAPI)	10 (from date of application)	10
BURUNDI	Unlimited	
CAMBODIA	10 (from date of application)	10
CAMEROON (OAPI)	10 (from date of application)	10
CANADA	15 (from date of registration)	15
CENTRAL AFRICAN REPUBLIC (OAPI)	10 (from date of application)	10
CHAD (OAPI)	10 (from date of application)	10
CHILE	10 (from date of registration)	10
CHINA (PEOPLE'S REPUBLIC)	10 (from date of registration)	10
COLOMBIA	10 (from date of registration)	10
CONGO (OAPI)	10 (from date of application)	10
COSTA RICA	10 (from date of registration)	10
CÔTE D'IVOIRE (OAPI)	10 (from date of application)	10
CROATIA	Unlimited as long as fees are paid (usually 10 years)	Dependent on fee payment
CUBA	10 (from date of application)	10
CYPRUS	7 (from date of application)	14
CZECH REPUBLIC	10 (from date of application)	10
DENMARK	10 (from date of registration)	10
DJIBOUTI	10 (from date of application)	10
DOMINICA	14 (from date of application)	14
DOMINICAN REPUBLIC	5, 10, 15 or 20 (from date of registration)	Any new period
ECUADOR	10 (from date of registration)	10
EGYPT	10 (from date of application)	10
EL SALVADOR	10 (from date of registration)	10
ESTONIA	10 (from date of application)	10
FINLAND	10 (from date of registration)	10
FRANCE (including Overseas Departments and Territories)	10 (from date of application)	10
GABON (OAPI)	10 (from date of application)	10
GAMBIA	14 (from date of application)	14
GEORGIA	10 (from date of application)	10
GERMANY	10 (beginning on filing date of application and ending the last day of the month in which the application had been filed)	10
GHANA	7 (from date of application)	14
GREECE	10 (from day following application date)	10
GRENADA	Term dependent on United Kingdom registration	Renewal dependent on United Kingdom registration



## APPENDIX B

Country	Term of Registration (in years)	Renewal Period (in years)
GUATEMALA	10 (from date of registration)	10
GUINEA (OAPI)	15 (from date of application)	15
GUINEA-BISSAU	10 (from date of registration)	10
GUYANA	7 (from date of application)	14
HAITI	10 (from date of registration)	10
HOLY SEE (Italy)	10 (from date of application)	10
HONDURAS	10 (from date of registration)	10
HUNGARY	10 (from date of application)	10
ICELAND	10 (from date of registration)	10
INDIA	7 (from date of application)	7
INDONESIA	10 (from date of application)	10
IRAN	10 (from date of application)	10
IRAQ	15 (from date of application)	15
IRELAND	7 (from date of application)	14
ISRAEL	7 (from date of application)	14
ITALY	10 (from date of application); 20 (from date of application) for registrations due for renewal prior to 2004	10
IVORY COAST	See CÔTE D'IVOIRE	
JAMAICA	7 (from date of application)	14
JAPAN	10 (from date of registration)	10
JORDAN	7 (from date of application)	14
KAZAKHSTAN (Russian Federation)	10 (from date of application)	10
KENYA	7 (from date of application)	14
KOREA, NORTH (DEMOCRATIC PEOPLE'S REPUBLIC OF KOREA)	10 (from date of application)	10
KOREA, SOUTH (REPUBLIC OF KOREA)	10 (from date of registration)	10
KYRGYZSTAN (Russian Federation)	10 (from date of application)	10
LAOS	10 (from date of application)	10
LATVIA	10 (from date of application)	10
LEBANON	15 (from date of application)	15
LESOTHO	10 (from date of application)	10
LIECHTENSTEIN	10 (from date of application)	10
LIBERIA	15 (from date of registration)	15
LIBYA	10 (from date of application)	10
LIECHTENSTEIN	20 (from date of application)	20
LITHUANIA	10 (from date of application)	10
LUXEMBOURG (Benelux Nations)	10 (from date of application) (1 to 10 years for service marks)	10
MADAGASCAR <sup>1</sup>		

<sup>1</sup> A new industrial property law covering patents, trademarks and designs was promulgated in Madagascar on July 31, 1989. Certain regulations have been promulgated, notably those covering the appointment of local trademark agents. In addition, due to Madagascar's prior involvement in OAPI, trademark owners can claim rights in OAPI registrations filed before

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Country	Term of Registration (in years)	Renewal Period (in years)
MALAWI	7 (from date of application)	14
MALAYSIA	10 (from date of application)	10
MALI (OAPI)	10 (from date of application)	10
MALTA	14 (from date of application)	14
MAURITANIA (OAPI)	10 (from date of application)	10
MAURITIUS	7 (from date of application)	14
MEXICO	10 (from date of application)	10
MOLDOVA (REPUBLIC OF) (Russian Federation)	10 (from date of application)	10
MONACO	10 (from date of application)	10
MONGOLIA	10 (from date of application)	10
MOROCCO	20 (from date of registration)	20
MOZAMBIQUE	10 (from date of application)	10
NAMIBIA	10 (from date of registration)	10
NEPAL	7 (from date of registration)	Unlimited
NETHERLANDS (Benelux Nations)	10 (from date of application) (1 to 10 years for service marks)	10
NEW ZEALAND	7 (from date of application)	14
NICARAGUA	10 (from date of registration)	10
NIGER (OAPI)	10 (from date of application)	10
NIGERIA	7 (from date of application)	14
NORWAY	10 (from date of registration)	10
OMAN	10 (from date of application)	10
PANAMA	10 (from date of registration)	10
PAPUA NEW GUINEA	10 (from date of application)	10
PARAGUAY	10 (from date of registration)	10
PERU	10 (from date of registration)	10
PHILIPPINES	20 (from date of registration)	20
POLAND	10 (from date of application)	10
PORTUGAL	10 (from date of registration)	10
QATAR	10 (from date of application)	10
ROMANIA	10 (from date of application)	10
RUSSIAN FEDERATION	10 (from date of application)	10
RWANDA	Unlimited	
SAINT KITTS and NEVIS	14 (from date of application)	14
SAINT LUCIA	14 (from date of application)	14
SAINT VINCENT and the GRENADINES	Term dependent on United Kingdom registration	Renewal dependent on United Kingdom registration
SAN MARINO <sup>2</sup>		

December 31, 1976. December 9, 1994 was the cut-off date for filing Maintenance in Vigour applications. Because rights in Madagascar are acquired on a first-to-file basis, trademark registration applications should be filed as soon as is possible. Trademarks may be protected through publication of cautionary notices. *Trademarks Throughout the World* (J. M. Politi, 4th ed. 2003).

<sup>2</sup> San Marino has no trademark law. However, trademark protection obtained in Italy applies here by virtue of the Pact Of Amity And Good Neighborhood, dated March 31, 1939. *Trademarks Throughout the World* (J. M. Politi, 4th ed. 2003).

## APPENDIX B

Country	Term of Registration (in years)	Renewal Period (in years)
SAUDI ARABIA	10 (from date of application)	10
SENEGAL (OAPI)	10 (from date of application)	10
SEYCHELLES	7 (from date of application)	14
SINGAPORE	10 (from date of application)	10
SIERRA LEONE	14 (from date of application)	14
SLOVAKIA	10 (from date of application)	10
SLOVENIA	10 (from date of application)	10
SOUTH AFRICA	10 (from date of application)	10
SPAIN	10 (from date of application)	10
SRI LANKA	10 (from date of application)	10
SUDAN	10 (from date of application)	10
SURINAME	10 (from date of registration)	10
SWAZILAND	10 (from date of registration)	10
SWEDEN	10 (from date of registration)	10
SWITZERLAND	10 (from date of application)	10
SYRIA	10 (from date of registration)	10
TAJIKISTAN (Russian Federation)	10 (from date of application)	10
TANZANIA (UNITED REPUBLIC OF)	14 (from date of application)	14
TOBAGO	See TRINIDAD and TOBAGO	
TOGO (OAPI)	10 (from date of application)	10
TONGA	Term dependent on United Kingdom registration	Renewal dependent on United Kingdom registration
TRINIDAD and TOBAGO	10 (from date of registration)	10
TUNISIA	15 (from date of application)	15
TURKEY	10 (from date of application)	10
TURKMENISTAN (Russian Federation)	10 (from date of application)	10
UGANDA	7 (from date of application)	14
UKRAINE	10 (from date of application)	10
UNITED ARAB EMIRATES	10 (from date of application)	10
UNITED KINGDOM	10 (from date of application)	10
URUGUAY	10 (from date of registration)	10
UZBEKISTAN (Russian Federation)	10 (from date of application)	10
VENEZUELA	10 (from date of registration)	10
VIETNAM	10 (from date of application)	10
YUGOSLAV REPUBLIC OF MACEDONIA, FORMER	Unlimited as long as fees are paid (usually 10 years)	Dependent on fee payment
ZAMBIA	7 (from date of application)	14
ZIMBABWE	10 (from date of application)	10

### Inter-American Convention

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Under the Inter-American Convention for Trademarks and Commercial Protection (also known as the “Pan-American Convention”), foreign applicants may seek U.S. registration, based on either (a) a valid registration, or (b) an application to register in any of the member countries listed below, with a right of priority if the United States application is filed within 6 months of the date of the first filing of the foreign application.

Country	Term of Registration (in years)	Renewal Period (in years)
COLOMBIA	10 (from date of registration)	10
CUBA	10 (from date of application)	10
GUATEMALA	10 (from date of registration)	10
HAITI	10 (from date of registration)	10
HONDURAS	10 (from date of registration)	10
NICARAGUA	10 (from date of registration)	10
PANAMA	10 (from date of registration)	10
PARAGUAY	10 (from date of registration)	10
PERU	10 (from date of registration)	10

### Buenos Aires Convention

Under the Buenos Aires Convention for the Protection of Trade Marks and Commercial Names, foreign applicants may seek registration based on a valid registration from a member country but *not* based on an application in the foreign country.

Country	Term of Registration (in years)	Renewal Period (in years)
BOLIVIA	10 (from date of registration)	10
BRAZIL	10 (from date of registration)	10
COSTA RICA	10 (from date of registration)	10
CUBA	10 (from date of application)	10
DOMINICAN REPUBLIC	5, 10, 15 or 20 (from date of registration)	Like periods
ECUADOR	10 (from date of registration)	10
GUATEMALA	10 (from date of registration)	10
HAITI	10 (from date of registration)	10
HONDURAS	10 (from date of registration)	10
NICARAGUA	10 (from date of registration)	10
PARAGUAY	10 (from date of registration)	10
URUGUAY	10 (from date of registration)	10

### European Community Trademark

On December 20, 1993, the European Council issued Regulation No. 40/94, establishing a single system of trademark registration, known as the Community Trade Mark (“CTM”), which is alternative to the various

## APPENDIX B

registration systems of each nation within the European Community. A foreign applicant may seek registration in the United States based on either (a) a valid CTM registration, or (b) a CTM application, with a right of priority if the United States application is filed within 6 months of the date of the first filing of the CTM application. European Community countries include Austria, Belgium, Denmark, Finland, France, Germany, Greece, Ireland, Italy, Luxembourg, the Netherlands, Portugal, Sweden, Spain and the United Kingdom. A CTM is registered for a period of 10 years, running from the date of filing, and may be renewed for 10 years. CTM registrations are issued by the Office for Harmonization in the Internal Market ("OHIM"). For further information about the CTM, see OHIM's website at <http://oami.eu.int/>.

### World Trade Organization

The World Trade Organization ("WTO"), established on January 1, 1995, is the embodiment of the results of the Uruguay Round trade negotiations and the successor to the General Agreement on Tariffs and Trade ("GATT"). Article 4 of the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPs") contains a most-favored-nation clause under which any advantage a member gives to the nationals of another member must normally be extended to the nationals of all members. Section 44(b) of the Trademark Act, 15 U.S.C. §1126(b), provides that any person whose country of origin is a party to any convention or treaty to which the United States is a member is entitled to the benefits of §44. Accordingly, foreign applicants may seek U.S. registration, based on either (a) a valid registration, or (b) an application to register in any of the member countries listed below, with a right of priority if the United States application is filed within 6 months of the date of the first filing of the foreign application. The WTO Agreement entered into force in the United States on January 1, 1996. The benefits accorded to nationals under this agreement by the United States date from January 1, 1996. The following is a list of WTO members who are not currently members of the Paris Convention. WTO members who are also members of the Paris Convention are not set forth in the list below because nationals from these countries have been able to base their U.S. registration on their home country application or registration since the date of the country's accession to the Paris Convention. For updates to the list of member below, see WTO's home page at <http://www.wto.org>.

Country	Effective Date of Membership	Term of Registration (in years)	Renewal Period (in years)
ANGOLA	Nov. 23, 1996	10 (from date of application)	10
BAHRAIN	Jan. 1, 1995	10 (from date of application)	10
BRUNEI DARUSSALAM	Jan. 1, 1995	7 (from date of application)	14

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Country	Effective Date of Membership	Term of Registration (in years)	Renewal Period (in years)
EUROPEAN COMMUNITY	Jan. 1, 1995	10 (from date of application)	10
FIJI	Jan. 14, 1996	14 (from date of application)	14
HONG KONG	Jan. 1, 1995	7 (from date of application)	14
INDIA	Jan. 1, 1995	7 (from date of application)	7
KUWAIT	Jan. 1, 1995	10 (from date of application)	10
MACAU	Jan. 1, 1995	7 (from date of registration)	7
MALDIVES <sup>3</sup>	May 31, 1995		
MALI	May 31, 1995	10 (from date of application)	10
MYANMAR	Jan. 1, 1995	Unlimited (from date of first use)	
PAKISTAN	Jan. 1, 1995	7 (from date of application)	15
SLOVENIA	July 30, 1995	10 (from date of application)	10
SOLOMON ISLANDS	July 26, 1996	Term dependent on United Kingdom registration	Renewal dependent on United Kingdom registration
THAILAND	Jan. 1, 1995	10 (from date of registration)	10

### Memorandum of Understanding Between United States and Taiwan

On the basis of a Memorandum of Understanding signed on April 10, 1996, between the American Institute in Taiwan and the Taipei Economic and Cultural Representative Office in the United States, a foreign applicant may seek U.S. registration based on either (a) a valid registration, or (b) an application filed in Taiwan, and may claim a right of priority if the United States application is filed within 6 months of the date of the first filing of the application in Taiwan. See notice at 1186 TMOG 50 (May 7, 1996). A registration in Taiwan is valid for 10 years from the date of registration, and may be renewed for 10 years.

<sup>3</sup> There is no trademark law in effect in the Republic of Maldives, whose closest financial ties are with India. The only means of obtaining protection is by publishing a cautionary note in the English section of a Maldives newspaper. *Trademarks Throughout the World* (J. M. Politi, 4th ed. 2000).

## APPENDIX B

### Other Countries Offering Reciprocal Registration Rights to United States Applicants

Applicants from countries that are not members of international trademark agreements to which the United States is also a party may register in the United States based upon their home country registration if their home country provides reciprocal registration rights to U.S. applicants. Following is a partial list of such countries. A claim of priority based on a foreign-filed application (15 U.S.C. §1126(d)) is not usually available to these applicants.

If the country is not on the following list, the examining attorney should require an English copy of the foreign trademark statute providing for reciprocal registration rights to U.S. applicants based on a U.S. registration.

<b>Country</b>	<b>Term of Registration (in years)</b>	<b>Renewal Period (in years)</b>
TONGA	Term dependent on United Kingdom registration	Renewal dependent on United Kingdom registration
TUVALU	Term dependent on United Kingdom registration	Renewal dependent on United Kingdom registration

### Additional Resources For Information About International Treaties and the Trademark Laws of Foreign Countries

For further information about the trademark laws of foreign countries, see *Trademarks Throughout the World* (J. M. Politi, 4<sup>th</sup> ed. 2003) and *World Trademark Law and Practice* (Ethan Horwitz, 2<sup>nd</sup> ed. 2003).

The United States Department of State puts out a list of members of treaties currently in force, available at

# **APPENDIX C**

## **NOTES OF OTHER STATUTES**

### **SOME U.S. CODE (AND C.F.R.) SECTIONS PROTECTING SPECIFIC NAMES, TERMS AND MARKS**

*(This is a partial listing of some of the names, terms, initials and marks which are protected under the United States Code (and Code of Federal Regulations). Almost all of these sections protect symbols, emblems, seals, insignia and badges, as well as the referenced name. Many sections also protect other names and initials. Some sections protect characters in addition to names. See the sections for specific information. See also the next listing which provides other important Code sections, many of which also protect certain names, terms, initials and marks, e.g. 18 U.S.C. §709. For further information on other sections, see the Index to the United States Code, and the Index to the Code of Federal Regulations, especially under the terms “decorations, medals and badges,” “coats of arms,” “character,” “insignia,” “names,” “seals” and “symbols.” Other sections also exist which are not indexed under these terms.)*

- American Ex-Prisoners of War, 36 U.S.C. §20907
- American Legion, 36 U.S.C. §21705
- The American National Theater and Academy, 36 U.S.C. §21904
- American Symphony Orchestra League, 36 U.S.C. §22306
- American Veterans of World War II, Korea, and Vietnam, 36 U.S.C. §22706
- American War Mothers, 36 U.S.C. §22505
- AMVETS (see American Veterans of World War II, Korea, and Vietnam)
- Big Brothers [and other names], 36 U.S.C. §30106
- Big Sisters [and other names], 36 U.S.C. §30106
- Blinded Veterans Association, 36 U.S.C. §30306
- Blue Star Mothers of America, Inc., 36 U.S.C. §30507
- Board for Fundamental Education, 36 U.S.C. §30706
- Boy Scouts of America, 36 U.S.C. §30905
- Central Intelligence Agency, 50 U.S.C. §403m
- Central Liquidity Facility, 18 U.S.C. §709
- CIA (see Central Intelligence Agency)
- Citius Altius Fortius (see Olympic)
- Civil Air Patrol, 36 U.S.C. §40306
- Coast Guard [and other names], 14 U.S.C. §639
- Commodity Credit Corporation, 15 U.S.C. §714m
- DEA (see Drug Enforcement Administration)
- Department of Housing & Urban Development [and other names], 18 U.S.C. §709
- Disabled American Veterans, 36 U.S.C. §90h
- Drug Enforcement Administration, 18 U.S.C. §709
- Fastener Quality Act, 15 U.S.C. §5401
- FFA (see Future Farmers of America)
- The Foundation of the Federal Bar Association, 36 U.S.C. §70506



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- 4-H Club [also specific reference to emblem consisting of a green four-leaf clover with stem and the letter H in white or gold on each leaflet], 18 U.S.C. §707
- F.B.I. (see Federal Bureau of Investigation)
- Federal Bureau of Investigation, 18 U.S.C. §709
- Federal Deposit Insurance Corporation [and other names], 18 U.S.C. §709
- Federal Home Loan Mortgage Corporation, 12 U.S.C. §1457; 12 U.S.C. §1723a
- Future Farmers of America, 36 U.S.C. §70907
- Geneva Cross (see Red Cross)
- Girl Scouts of America, 36 U.S.C. §80305
- Give a Hoot, Don't Pollute (see Woodsy Owl)
- The Golden Eagle [also specific reference to insignia of an American Golden Eagle (colored gold) and a family group (colored midnight blue) enclosed within a circle (colored white with a midnight blue border)], 18 U.S.C. §715
- Government National Mortgage Association, 12 U.S.C. §1723a; 18 U.S.C. §709
- HUD (See Department of Housing & Urban Development)
- International Olympic Committee (see Olympic)
- HCFA (see Social Security)
- Health Care Financing Administration (see Social Security)
- Ladies of the Grand Army of the Republic, 36 U.S.C. §130106
- Life Saving Service (see Coast Guard),
- Lighthouse Service (see Coast Guard),
- Little League; Little Leaguer, 36 U.S.C. §130506
- Marine Corps, 10 U.S.C. §7881
- Medicaid (see Social Security)
- Medicare (see Social Security)
- The Military Chaplains Association of the United States of America, 36 U.S.C. §140304
- NASA (see National Aeronautics and Space Administration)
- National Aeronautics and Space Administration [also flags, logo, seal], 42 U.S.C. §2459b; 14 C.F.R. §§1221.101, 1221.107
- National Conference of State Societies, Washington, District of Columbia, 36 U.S.C. §150507
- National Conference on Citizenship, 36 U.S.C. §150507
- National Credit Union [and other names and acronyms], 18 U.S.C. §709
- National Music Council, 36 U.S.C. §152306
- National Safety Council, 36 U.S.C. §152506
- National Society, Daughters of the American Colonists, 36 U.S.C. §152907
- National Society of the Daughters of the American Revolution, 36 U.S.C. §153104
- National Women's Relief Corps, Auxiliary of the Grand Army of the Republic, 36 U.S.C. §153706
- Naval Sea Cadet Corps, 36 U.S.C. §154106,
- NCOA (see Non Commissioned Officers Association of the United States of America)
- Non Commissioned Officers Association of the United States of America [and other names], 36 U.S.C. §154707
- Olympiad (see Olympic)
- Olympic [and other names] [also specific reference to (1) the symbol of the International Olympic Committee, consisting of five interlocking rings, and (2)

## APPENDIX C

the emblem consisting of an escutcheon having a blue chief and vertically extending red and white bars on the base with five interlocked rings displayed on the chief], 36 U.S.C. §220506

- OPIC (see Overseas Private Investment)
- Overseas Private Investment, 18 U.S.C. §709
- Paralyzed Veterans of America, 36 U.S.C. §170105
- Pearl Harbor Survivors Association, 36 U.S.C. §170307
- Peace Corps, 22 U.S.C. §2518
- Red Cross [and other names] [also specific reference to the emblem of the Greek red cross on a white ground], 18 U.S.C. §706
- Reserve Officers Association of the United States, 36 U.S.C. §190106
- SSA (see Social Security)
- Secret Service [and other names], 18 U.S.C. §709
- Smokey Bear, 18 U.S.C. §711; 16 U.S.C. §580p; 36 C.F.R. §261.20
- Social Security [and other names, symbols and emblems], 42 U.S.C. §1320b-10
- Sons of Union Veterans of the Civil War, 36 U.S.C. §200306
- Swiss Confederation [with specific reference to the coat of arms, consisting of an upright white cross with equal arms and lines on a red ground], 18 U.S.C. §708
- U.D. (see Secret Service)
- USCG (see Coast Guard)
- USCGR (see Coast Guard)
- USMC (see Marine Corps)
- USO (see United Service Organizations, Incorporated)
- U.S.S.S. (see Secret Service)
- United Service Organizations, Incorporated, 36 U.S.C. §220106
- United States Capitol Historical Society, 36 U.S.C. §220306
- United States Mint, 18 U.S.C. §709
- United States Railway Association , 45 U.S.C. §711
- United States Coast Guard (see Coast Guard)
- United States Olympic Association (see Olympic)
- United States Olympic Committee (see Olympic)
- 369th Veterans Association, 36 U.S.C. §210307
- Veterans of Foreign Wars of the United States, 36 U.S.C. §230105
- Veterans of World War I of the United States of America, Incorporated, 36 U.S.C. §230306
- Vietnam Veterans [and other names], 36 U.S.C. §230507
- Woodsy Owl, 18 U.S.C. §711a, 16 U.S.C. §580p; 36 C.F.R. §261.20

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### SOME SECTIONS OF THE UNITED STATES CODE WHICH RELATE TO TRADEMARKS

*(This is a partial listing of sections relating to trademarks.)*

- 7 U.S.C. §136, The Federal Insecticide, Fungicide and Rodenticide Act, relating to the requirements for labeling of economic poisons.
- 7 U.S.C. §§1551-1610, The Federal Seed Act, relating to requirements for labeling of seeds in interstate commerce.
- 15 U.S.C. §1, Sherman Act (Sec. 1), as amended by Miller-Tydings Act, relating to restraint of trade.
- 15 U.S.C. §45, relating to unfair methods of competition.
- 15 U.S.C. §52, relating to false advertisements.
- 15 U.S.C. §68, The Wool Products Labeling Act, relating to the labeling of wool products.
- 15 U.S.C. §69, The Fur Products Labeling Act, relating to the labeling of fur and fur products.
- 15 U.S.C. §70, the Textile Fiber Products Identification Act, relating to the use of trademarks and names in the advertising or labeling of textile fiber products.
- 15 U.S.C. §297, relating to use of marks, trade names, words and labeling in connection with the importation, exportation or carriage in interstate commerce of merchandise made of gold or silver or their alloys.
- 15 U.S.C. §§1261-1273, relating to the labeling of hazardous substances.
- 15 U.S.C. §1511, relating to jurisdiction of Department of Commerce over Patent and Trademark Office.
- 15 U.S.C. §5401 et seq., relating to the recordation of insignia of manufacturers and private label distributors to ensure the traceability of a fastener to its manufacturer or private label distributor. (See notice at 1192 TMOG 19 (Nov. 5, 1996)).
- 18 U.S.C. §701, relating to use of insignia of departments and independent offices of the United States.
- 18 U.S.C. §704, relating to decorations or medals authorized by Congress for the armed forces of the United States.
- 18 U.S.C. §705, relating to the unauthorized use on merchandise of any badge, medal, emblem, or other insignia or any colorable imitation thereof of any veteran's organization incorporated by enactment of Congress or of any organization formally recognized by any such veteran's organization as an auxiliary thereof.
- 18 U.S.C. §709, relating to false advertising or misuse of names to indicate Federal agency. Also, prohibitions against using certain terms and initials within the financial, insurance, agricultural, housing, protection, investigatory and other fields.
- 18 U.S.C. §712, relating to misuse by collecting agencies or private detective agencies of names, emblems, and insignia to indicate Federal agency.
- 18 U.S.C. §713, relating to the use of likenesses of the great seal of the United States, and of the seals of the President and Vice President.
- 18 U.S.C. §1001, relating to statements, representations, writings or documents made to any department or agency of the United States.
- 18 U.S.C. §1158, relating to counterfeiting or imitating Government trademarks for Indian products.

## APPENDIX C

- 18 U.S.C. §2320, relating to criminal penalties for trafficking in counterfeit goods and services.
- 19 U.S.C. §1337(a), Tariff Act of 1930, relating to unfair practices in import trade.
- 19 U.S.C. §1526(a), Tariff Act of 1930, barring importation into the United States of merchandise of foreign manufacture bearing a trademark registered in the Patent and Trademark Office by a person domiciled in the United States if copy of the registration certificate has been filed with the Secretary of the Treasury unless written consent of the trademark owner has been secured.
- 19 U.S.C. §2111 et seq., providing authority for trade agreements and also annual reports to Congress on barriers to trade include the treatment of intellectual property rights among acts, policies, and practices that constitute barriers to trade.
- 19 U.S.C. §2411, relating to foreign countries' provision for adequate and effective protection of the intellectual property rights of U.S. nationals.
- 19 U.S.C. §2462(b), relating to the consideration of intellectual property rights as a factor for foreign countries to receive benefits under the Generalized System of Preferences (GSP).
- 21 U.S.C. §§603-623, The Meat Inspecting Act, relating to the inspection and labeling of meat and products.
- 21 U.S.C. §§301, 321-392, The Federal Food, Drug, and Cosmetic Act, relating to the requirements for labeling of food, drugs, and cosmetics; avoiding trademarks in establishing official names.
- 21 U.S.C. §457, Poultry Products Inspection Act, relating to requirements for labeling of poultry products in interstate commerce.
- 27 U.S.C. §§201-212, The Federal Alcohol Administration Act, relating to certificates of label approval of alcoholic beverages.
- 28 U.S.C. §1254, relating to review of cases by the Supreme Court.
- 28 U.S.C. §1295, relating to jurisdiction of United States Court of Appeals for the Federal Circuit.
- 28 U.S.C. §1338, relating to jurisdiction of District Courts in trademark suits.
- 29 U.S.C. §§655, 657, 665, Williams-Steiger Occupational Safety and Health Act of 1970, relating to letters OSHA.
- 42 U.S.C. §1320b-10, relating to misuse of Social Security or Medicare names, symbols, emblems.
- 48 U.S.C. §734, Puerto Rico, relating to statutes applicable to.
- 48 U.S.C. §§1405(q), 1574(c) and 1643, Virgin Islands, relating to statutes applicable to, and to the non-applicability of certain provisions of the Trademark Act to the Virgin Islands.
- 48 U.S.C. §1421(c), Guam, relating to statutes applicable to (see also Public Law 87-845, October 18, 1962, 4-CZC-471, Canal Zone Code, relating to the application of U.S. patent, trademark and copyright laws in the Canal Zone.)
- 50 U.S.C. Appendix 43, Trading with the Enemy Act, amending, providing for disposition of vested trademarks.

### **District of Columbia Code**

Section 22-3423, relating to use of District of Columbia and other related names and initials used in connection with investigatory or collection services. (Oct. 16, 1962, 76 Stat. 1071)

# Table of Decisions

*In re 88Open Consortium Ltd.*, 28 USPQ2d 1314 (TTAB 1993)—1306.05(a)  
*800 Spirits Inc. v. Liquor By Wire, Inc.*, 14 F. Supp.2d 675 (D.N.J. 1998)—1209.03(l)  
*In re Abacab International Computers Ltd.*, 21 USPQ2d 1078 (Comm'r Pats. 1987)—503.06(b)  
*In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978)—1209; 1209.01(b)  
*In re ACE III Communications, Inc.*, 62 USPQ2d 1049 (Dir USPTO 2001)—1604.07(a); 1604.07(f); 1604.17(c)  
*Ex parte A.C. Gilbert Co.*, 99 USPQ 344 (Comm'r Pats. 1953)—1402.01; 1402.03(a)  
*In re Adair*, 45 USPQ2d 1211 (TTAB 1997)—1301.04(b)  
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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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- B and E Sales Co. Inc. v. Andrew Jergens Co.*, 7 USPQ2d 1906 (Comm'r Pats. 1988)—1708
- In re Babies Beat Inc.*, 13 USPQ2d 1729 (TTAB 1990)—814; 1202.02(a)(v)
- In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031 (TTAB 1997)—1102.01; 1210.04(a); 1210.02(c)
- Bakker v. Steel Nurse of America Inc.*, 176 USPQ 447 (TTAB 1972)—1201.06(a)
- In re BankAmerica Corp.*, 231 USPQ 873 (TTAB 1986).—1210.02(b)(iv); 1216.02
- In re BankAmerica Corp.*, 229 USPQ 852 (TTAB 1986).—1212.04(d)
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- Ex parte Bank of America National Trust and Savings Association*, 118 USPQ 165 (Comm'r Pats. 1958)—1202.06
- In re BASF A.G.*, 189 USPQ 424 (TTAB 1975)—1207.01(b)(ii)
- Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 6 USPQ2d 1475 (TTAB 1988)—1212.04(b); 1212.04(c)
- Bausch & Lomb Optical Co. v. Overseas Finance & Trading Co. Inc.*, 112 USPQ 6 (Comm'r Pats. 1956)—1213.08(d)
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- In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986)—1207.01(b)(viii); 1209.01(b)
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- In re Benetton Group S.p.A.*, 48 USPQ2d 1214 (TTAB 1998) —1202.05(a); 1202.11
- In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995)—1211.01; 1211.01(a)(v); 1211.01(b)(ii)
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## LIST OF DECISIONS CITED

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- Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003 (TTAB 1984)—1209.04
- In re Bio-Medicus Inc.*, 31 USPQ2d 1254 (TTAB 1993)—1202.02(a)(iv); 1202.02(a)(v)(A)
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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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- In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999)—1209.01(c)(ii); 1209.01(c)(iii); 1209.03(k); 1209.03(n); 1209.03(s); 1210.02(b)(iv); 1212.06(b)
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- In re Bright of America, Inc.*, 205 USPQ 63 (TTAB 1979)—904.05; 904.06; 904.07
- In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979)—1209.01(b); 1209.03(d); 1209.03(e)
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- In re Broadway Chicken Inc.*, 38 USPQ2d 1559 (TTAB 1996)—710.03
- In re Brock Residence Inns, Inc.*, 222 USPQ 920 (TTAB 1984)—1301.02(a)
- In re Broco*, 225 USPQ 227 (TTAB 1984)—1212.02(c)
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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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- In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998)—1210.02(a); 1210.04; 1210.02(c)(ii)
- In re Carolyn's Candies, Inc.*, 206 USPQ 356 (TTAB 1980)—1213.03(b)
- In re Carson*, 197 USPQ 554 (TTAB 1977)—1301.02(b)
- Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 218 USPQ 1 (6th Cir. 1983).—1203.03; 1203.03(c)
- In re Carter Hawley Hale Stores, Inc.*, 200 USPQ 179 (Comm'r Pats. 1978)—1609.03
- In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984)—1209.03(n); 1210.02(b)(iv); 1213.05(b)
- In re Caserta*, 46 USPQ2d 1088 (TTAB 1998)—1202.08
- In re Caterpillar Inc.*, 43 USPQ2d 1335 (TTAB 1997) —1202.02(a)(iv); 1202.02(a)(v)
- In re Cazes*, 21 USPQ2d 1796 (TTAB 1991)—1211.01(b)(vi); 1215.03
- In re Cedar Point, Inc.*, 220 USPQ 533 (TTAB 1983)—1301.03(a)
- In re Celanese Corp. of America*, 136 USPQ 86 (TTAB 1962)—1306.01; 1306.09(b)
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- In re Cell Therapeutics Inc.*, 67 USPQ2d 1795 (TTAB 2003)—1209.01(c)(iii); 1209.03(d)
- Central Fidelity Banks, Inc. v. First Bankers Corp. of Florida*, 225 USPQ 438 (TTAB 1984).—1201.03(f)
- In re Central Soya Company, Inc.*, 220 USPQ 914 (TTAB 1984)—1207.01(b)(ix)
- In re Central Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998) —1209.01(c)(iii); 1209.03(p)
- Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992), *cert. denied* 506 U.S. 1034 (1992)—1207.01(b)
- In re Chalk's International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991)—1202.11; 1210.03; 1210.04; 1210.02(c)(ii)
- In re Champion International Corp.*, 229 USPQ 550 (TTAB 1985).—1211.01(a)(iv)
- In re Champion International Corp.*, 220 USPQ 478 (TTAB 1982)—1201.07(a)
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## LIST OF DECISIONS CITED

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*In re Chung, Jeanne & Kim Co., Inc.*, 226 USPQ 938 (TTAB 1985)—1202.03(b)

*Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theatres Inc.*, 56 USPQ2d 1538 (TTAB 2000)—1214.01

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*In re Clarke*, 17 USPQ2d 1238 (TTAB 1990)—1202.13

*In re Clorox Company*, 578 F.2d 305, 198 USPQ 337 (C.C.P.A. 1978)—1207.01(b)(ix)

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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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- Community of Roquefort v. Santo*, 443 F.2d 1196, 170 USPQ 205 (C.C.P.A. 1971).—1306.06(a)
- Community of Roquefort v. William Faehndrich, Inc.*, 303 F.2d 494, 133 USPQ 633 (2d Cir. 1962).—1306.01; 1306.02
- In re Compagnie Nationale Air France*, 265 F.2d 938, 121 USPQ 460 (C.C.P.A. 1959).—1301.01(a)(i)
- Company of Cutlers of Hallamshire in the County of York v. Regent-Sheffield, Ltd.*, 155 USPQ 597 (TTAB 1967)—1203.02(b)
- In re Compute-Her-Look, Inc.*, 176 USPQ 445 (TTAB 1972)—1202.06
- In re Computer Systems Center Inc.*, 5 USPQ2d 1378 (TTAB 1987)—1207.01(b)(iii)
- ConAgra Inc. v. Saavedra*, 4 USPQ2d 1245 (TTAB 1987)—1210.04(c)
- In re Congoleum Corp.*, 222 USPQ 452 (TTAB 1984)—1301.01(a)(iii); 1301.01(b)(i)
- In re Conservation Technology Inc.*, 25 USPQ2d 1079 (Comm'r Pats. 1992)—1109.01; 1109.09
- In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995)—1209.03(k)
- In re Consolidated Cigar Corp.*, 13 USPQ2d 1481 (TTAB 1989)—1212.06(e)(iv)
- In re Consolidated Foods Corp.*, 187 USPQ 63 (TTAB 1975)—1203.03(b)
- Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752 (TTAB 1985)—1203.03(e)
- In re Consolidated Specialty Restaurants, Inc.*, 71 USPQ2d 1921 (TTAB 2004)—1210.04(b); 1210.05(b)(ii)
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- Ex parte Consulting Engineer Publishing Co.*, 115 USPQ 240 (Comm'r Pats. 1957)—.1402.05
- Continental Airlines Inc. v. United Airlines Inc.*, 53 USPQ2d 1385 (TTAB 1999)—1209.01(c)(iii); 1209.03(d)
- In re Continental Distilling Corp.*, 254 F.2d 139, 117 USPQ 300 (C.C.P.A. 1958)—1604.11; 1604.13
- Continental Nut Co. v. Cordon Bleu, Ltee*, 494 F.2d 1397, 181 USPQ 647 (C.C.P.A. 1974)—1207.01(b)(vi)
- In re Controls Corp. of America*, 46 USPQ2d 1308 (TTAB 1998)—815.05; 1202.02(a)(iii)(A); 1202.02(a)(v)
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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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- Ex parte Dallieux*, 83 USPQ 262 (Comm'r Pats. 1949).—1206.03(b)
- Damn I'm Good Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357, 212 USPQ 684 (S.D.N.Y. 1981)—1202.03(f)(i)
- In re Dana Corp.*, 12 USPQ2d 1748 (TTAB 1989)—1202.10
- In re Dartmouth Marketing Co., Inc.*, 154 USPQ 557 (TTAB 1967)—807.04(b)
- In re David Crystal, Inc.*, 296 F.2d 771, 132 USPQ 1 (C.C.P.A. 1961)—1202.03(f)(ii)
- In re Dayco Products-Eagle motive Inc.*, 9 USPQ2d 1910 (TTAB 1988).—1207.01(d)(iii)
- In re D.B. Kaplan Delicatessen*, 225 USPQ 342 (TTAB 1985)—1206.03(b)
- In re DC Comics, Inc.*, 689 F.2d 1042, 215 USPQ 394 (C.C.P.A. 1982)—1202.02(a)(iii)(C)
- DeCecco v. Wright*, 120 USPQ 20 (TTAB 1958)..—1206.02
- In re Decombe*, 9 USPQ2d 1812 (TTAB 1988)—1207.01(d)(vii)
- In re Deere & Co.*, 7 USPQ2d 1401 (TTAB 1988).—1202.05(a)
- In re Dekra e.V.*, 44 USPQ2d 1693 (TTAB 1997)—807.14(c); 807.14(d)
- In re Del E. Webb Corp.*, 16 USPQ2d 1232 (TTAB 1990).—1212.02(d)
- In re Delaware Punch Co.*, 186 USPQ 63 (TTAB 1975)—1213.05(c)
- In re Dell Inc.*, 71 USPQ2d 1725 (TTAB 2004)—904.06(b)
- In re Delta and Pine Land Co.*, 26 USPQ2d 1157 (TTAB 1993)—1202.12
- In re De Luxe, N.V.*, 990 F.2d 607, 26 USPQ2d 1475 (Fed. Cir. 1993)—1005; 1006
- Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991)—1213.05; 1213.06; 1213.07
- In re Denisi*, 225 USPQ 624 (TTAB 1985).—1207.01(b)(iii)
- Ex parte Denver Chemical Mfg. Co.*, 118 USPQ 106 (Comm'r Pats. 1958)—1604.11
- In re DeWitt International Corp.*, 21 USPQ2d 1620 (Comm'r Pats. 1991)—1604.13
- Dial-A-Mattress Franchise Corp. v. Page*, 880 F.2d 675, 11 USPQ2d 1644 (2d Cir. 1989).—1209.03(l)
- In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001)—1209.01(b); 1209.01(c); 1209.01(c)(i); 1209.01(c)(iii); 1209.03(l); 1212.04; 1212.04(b); 1212.09(a)
- In re Diamond Hill Farms*, 32 USPQ2d 1383 (TTAB 1994)—1202.01
- In re Diamond Walnut Growers, Inc., and Sunsweet Growers Inc.*, 204 USPQ 507 (TTAB 1979).—1201.03(f)
- In re Diet Center Inc.*, 4 USPQ2d 1975 (TTAB 1987)—1207.01(a)(iii)



## LIST OF DECISIONS CITED

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- In re Dimitri's Inc.*, 9 USPQ2d 1666 (TTAB 1988)—1202.03(a); 1202.03(f)(i)
- In re Direct Access Communications (M.C.G.) Inc.*, 30 USPQ2d 1393 (Comm'r Pats. 1993)—1208.02(c); 1706
- In re Directional Marketing Corp.*, 204 USPQ 675 (TTAB 1979)—1211.01(b)(ii); 1211.01(b)(v)
- In re Dixie Ins. Co.*, 223 USPQ 514 (TTAB 1984)—.1210.02(b)(i)
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- Dixie Rose Nursery v. Coe*, 131 F.2d 446, 55 USPQ 315 (D.C. Cir. 1942), *cert. denied*, 318 U.S. 782, 57 USPQ 568 (1943)—1202.12
- In re Dr. Pepper Co.*, 836 F.2d 508, 5 USPQ2d 1207 (Fed. Cir. 1987)—1301.01(a)(ii); 1301.01(a)(iii); 1301.01(b)(i)
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- Dranoff-Perlstein Associates v. Sklar*, 967 F.2d 852, 23 USPQ2d 1174 (3d Cir. 1992)—1209.03(l)
- In re Drilco Industrial Inc.*, 15 USPQ2d 1671 (TTAB 1990)—904.05; 904.06
- In re DTI Partnership LLP*, 67 USPQ2d 1699 (TTAB 2003)—814
- Du-Dad Lure Co. v. Creme Lure Co.*, 143 USPQ 358 (TTAB 1964).—906; 906.02
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- In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974).—710.03; 1207.01(c)(i)
- In re Du Pont Merck Pharmaceutical Co.*, 34 USPQ2d 1778 (Comm'r Pats. 1995)—1706
- In re Duratech Industries Inc.*, 13 USPQ2d 2052 (TTAB 1989)—1301.02; 1301.04(b)
- Dynacolor Corp. v. Beckman & Whitley, Inc.*, 134 USPQ 410 (TTAB 1962)—904.05
- In re Dynamit Nobel AG*, 169 USPQ 499 (TTAB 1971)—1402.03
- In re E.A. Miller & Sons Packing Co., Inc.*, 225 USPQ 592 (TTAB 1985)—904.04(c)
- In re Eagle Fence Rentals, Inc.*, 231 USPQ 228 (TTAB 1986)..—1301.04(b)

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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- In re EBSCO Industries, Inc.*, 41 USPQ2d 1917 (TTAB 1997)—1202.02(a)(v)(B)
- In re ECCS Inc.*, 94 F.3d 1578, 39 USPQ2d 2001 (Fed. Cir. 1996)—807.14(c)
- ECI Division of E Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980)—1207.01(b)
- In re Eddie Z's Blinds and Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005)—1209.01(c)(i); 1209.01(c)(iii); 1209.03(m); 1209.03(r); 1215.04; 1215.05
- In re Editel Productions, Inc.*, 189 USPQ 111 (TTAB 1975)—1301.02(a)
- In re Educational Communications, Inc.*, 231 USPQ 787 (TTAB 1986)—1212.02(c); 1212.02(h)
- In re Edward Ski Products, Inc.*, 49 USPQ2d 2001 (TTAB 1999)—1202.02(a)(v); 1202.02(a)(v)(A)
- Ex parte Edward Taylor and Isabelle Stone Taylor d/b/a Baby's Spray-Tray Co.*, 18 USPQ 292 (Comm'r Pats. 1933)—803.03(d)
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- E. I. du Pont de Nemours & Co. v. Yoshida International, Inc.*, 393 F. Supp. 502, 185 USPQ 597 (E.D.N.Y. 1975)—1306.06(a)
- In re E.I. Kane, Inc.*, 221 USPQ 1203 (TTAB 1984)—1212.06(b); 1212.06(d)
- In re Eilberg*, 49 USPQ2d 1955 (TTAB 1998)—1215.02(a)
- In re El Taurino Restaurant, Inc.*, 41 USPQ2d 1220 (Comm'r Pats. 1996)—1108.02(f); 1108.04; 1714.01(f)(i)
- In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988)—1207.01(b)(iii); 1301.02(a)
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- Electronic Communications, Inc. v. Electronic Components for Industry Co.*, 443 F.2d 487, 170 USPQ 118 (8th Cir. 1971), *cert. denied*, 404 U.S. 833, 171 USPQ 321 (1971)—904.04(a)
- In re Electronic Representatives Association*, 150 USPQ 476 (TTAB 1966)—807.04(b)
- Elmer v. ICC Fabricating Inc.*, 67 F.3d 1571, 36 USPQ2d 1417 (Fed. Cir. 1995)—1202.02(a)(v)

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*Express Mortgage Brokers Inc. v. Simpson Mortgage Inc.*, 31 USPQ2d 1371 (E.D. Mich. 1994)—1209.03(l)

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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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*In re Finlay Fine Jewelry Corp.*, 41 USPQ2d 1152 (TTAB 1996)—807.14(d)

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*In re Fisons Ltd.*, 197 USPQ 888 (TTAB 1978)—1002.04; 1002.05; 1006

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*In re Flex-O-Glass, Inc.*, 194 USPQ 203 (TTAB 1977)—1212.04(b); 1212.06(c)

*Florasynth Laboratories Inc. v. Mülhens*, 122 USPQ 284 (Comm'r Pats. 1959)—807.14(b)

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*Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580 (TTAB 1987)—1212.05(b)

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*Forschner Group Inc. v. Arrow Trading Co. Inc.*, 30 F.3d 348, 31 USPQ2d 1614 (2d Cir. 1994) —1210.02(b)(iii)

*In re Fortex Industries Inc.*, 18 USPQ2d 1224 (Comm'r Pats. 1990)—1609.03

*In re Fortune Star Products Corp.*, 217 USPQ 277 (TTAB 1982)—1203.02(b); 1203.03(b); 1210.03

## LIST OF DECISIONS CITED

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*In re Franklin Press, Inc.*, 597 F.2d 270, 201 USPQ 662 (C.C.P.A. 1979)—1213.09

*Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc.*, 38 USPQ2d 1691 (TTAB 1996)—1210.03; 1210.04(a); 1210.07(b)

*In re Frederick Warne & Co. Inc.*, 218 USPQ 345 (TTAB 1983)—1202.08

*In re Fre-Mar Industries, Inc.*, 158 USPQ 364 (TTAB 1968)—1202.02(b)(ii)

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*In re Gammon Reel, Inc.*, 227 USPQ 729 (TTAB 1985)—1212.01

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*In re Gastown, Inc.*, 326 F.2d 780, 140 USPQ 216 (C.C.P.A. 1964)—901.03

*Gastown Inc., of Delaware v. Gas City, Ltd.*, 187 USPQ 760 (TTAB 1975)—1207.01(b)(v)

*Gavel Club v. Toastmasters International*, 127 USPQ 88 (TTAB 1960)—1203.03(a)

*Gay Toys, Inc. v. McDonald's Corp.*, 585 F.2d 1067, 199 USPQ 722 (C.C.P.A. 1978)—1202.06(a)

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*General Foods Corp. v. MGD Partners*, 224 USPQ 479 (TTAB 1984)—1212.01

*General Foods Corp. v. Ralston Purina Co.*, 220 USPQ 990 (TTAB 1984)—1209.03(k); 1212.06(d)

*In re G. Heileman Brewing Company, Inc.*, 34 USPQ2d 1476 (Comm'r Pats. 1994)—1715.03(a)

*In re General Mills, Inc.*, 169 USPQ 244 (TTAB 1971).—1203.03(b)

*General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270 (TTAB 1992)—705.05

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*In re General Tire & Rubber Co.*, 404 F.2d 1396, 160 USPQ 415 (C.C.P.A. 1969)—1202.03(b); 1202.03(f)(ii)

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- In re General Tire & Rubber Co.*, 213 USPQ 870 (TTAB 1982)—1207.01(b)(vii)
- In re Generation Gap Products, Inc.*, 170 USPQ 423 (TTAB 1971)—1301.02(b)
- In re Geo. A. Hormel & Co.*, 227 USPQ 813 (TTAB 1985)—1209.03(g)
- In re Geo. J. Ball, Inc.*, 153 USPQ 426 (TTAB 1967)—1201.06(a)
- Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983)—1207.01(c)(ii); 1207.01(d)(ix); 1213.10
- In re Gibson Guitar Corp.*, 61 USPQ2d 1948 (TTAB 2001)—1202.02(a)(v); 1202.02(a)(v)(A); 1202.02(a)(v)(B)
- In re Gilbert Eiseman, P.C.*, 220 USPQ 89 (TTAB 1983)—1301.02(a)
- In re G.J. Sherrard Co.*, 150 USPQ 311 (TTAB 1966)—901.03
- In re Glaxo Group Ltd.*, 33 USPQ2d 1535 (Comm'r Pats. 1993)—718.01
- Gold Seal Co. v. Weeks*, 129 F. Supp. 928, 105 USPQ 407 (D.D.C. 1955), *aff'd sub nom. S. C. Johnson & Son, Inc. v. Gold Seal Co.*, 230 F.2d 832, 108 USPQ 400 (D.C. Cir. 1956) (*per curiam*), *cert. denied*, 352 U.S. 829, 111 USPQ 467 (1956)—1203.02(a); 1209.04
- In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074 (TTAB 1990)—1207.01(a)(ii)(A)
- Goodyear Tire & Rubber Co. v. Interco Tire Corp.*, 49 USPQ2d 1705 (TTAB 1998)—1202.02(a)(v)(A)
- Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598 (1888)—1209.03(m)
- In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987)—1209.01(c)(i); 1209.01(c)(iii); 1209.03(d); 1209.03(p)
- Grand Bag & Paper Co., Inc. v. Tidy-House Paper Products, Inc.*, 109 USPQ 395 (Comm'r Pats. 1956)—1609.07
- Ex parte Grand Chapter of Phi Sigma Kappa*, 118 USPQ 467 (Comm'r Pats. 1958)—1304.08(a)
- Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987)—1207.04(e)
- In re Gray Inc.*, 3 USPQ2d 1558 (TTAB 1987)—1212.05(a); 1212.06(c)
- In re Great Lakes Canning, Inc.*, 227 USPQ 483 (TTAB 1985)—1207.01(b)(iv)
- In re Gregory*, 70 USPQ2d 1792 (TTAB 2004)—710.01(c); 1211.01(a)(v)
- Greyhound Corp. v. Armour Life Ins. Co.*, 214 USPQ 473 (TTAB 1982)—1201.03(a); 1201.03(e); 1201.07(b)(iii)
- Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635 (TTAB 1988)—1203.01; 1203.03(c); 1203.03(d)
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## LIST OF DECISIONS CITED

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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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- In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987)—1207.01(b)(viii); 1207.01(d)(iii)
- In re Jockey International, Inc.*, 192 USPQ 579 (TTAB 1976)—1202.03(g)
- In re Johanna Farms Inc.*, 8 USPQ2d 1408 (TTAB 1988)—1209.03(h); 1217
- In re John Breuner Co.*, 136 USPQ 94 (TTAB 1963)—1301.01(a)(iii)
- In re John Harvey & Sons Ltd.*, 32 USPQ2d 1451 (TTAB 1994)—1210.03; 1210.04(a)
- In re John LaBatt Ltd.*, 26 USPQ2d 1077 (Comm'r Pats. 1992)—807.14(b)
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- In re Kalmbach Publishing Co.*, 14 USPQ2d 1490 (TTAB 1989)—1212.05(a)
- Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ2d 1501 (TTAB 1993)—1202.05(b)
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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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*Mutual of Omaha Insurance Co. v. Novak*, 648 F. Supp. 905, 231 USPQ 963 (D. Neb. 1986)—1207.01(b)(x)  
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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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804.05  
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1604.07(a)  
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1306.06(a)  
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1402.01; 1402.05  
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1976)—1301.02(e)  
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1212.02(c)  
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1306.03  
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1984)—1207.01(c)(i)  
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1207.01(a)(i)  
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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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- In re Shipley Co. Inc.*, 230 USPQ 691 (TTAB 1986)—904.06
- In re Shiva Corp.*, 48 USPQ2d 1957 (TTAB 1998)—1209.03(d)
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- Ex parte Sightmaster Corp.*, 95 USPQ 43 (Comm'r Pats. 1951)—816.05
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- In re Slack*, 54 USPQ2d 1504 (Comm'r Pats. 2000)—602.05
- In re Sloppy Joe's International Inc.*, 43 USPQ2d 1350 (TTAB 1997)—1203.03(e); 1203.03(f)
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- Specialty Brands, Inc. v. Spiceseas, Inc.*, 220 USPQ 73 (TTAB 1983)—1212.06(d)
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- In re SPX Corp.*, 63 USPQ2d 1592 (TTAB 2002)—814; 1209.03(d)
- Ex parte Squire Dingee Co.*, 81 USPQ 258, *recon. denied*, 81 USPQ2d 543 (Comm'r Pats. 1949)—1609.02(a)
- Stabilisierungsfonds fur Wein v. Peter Meyer Winery GmbH*, 9 USPQ2d 1073 (TTAB 1988)—1203.02; 1203.02(a); 1203.02(b); 1306.06(a)
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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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- In re Star Pharmaceuticals, Inc.*, 225 USPQ 209 (TTAB 1985)—1202.05(a); 1212.05(a)
- State of Florida, Department of Citrus v. Real Juices, Inc.*, 330 F. Supp. 428, 171 USPQ 66 (M.D. Fla. 1971)—1306.01
- In re Steak and Ale Restaurants of America, Inc.*, 185 USPQ 447 (TTAB 1975)—1206.01; 1206.02
- Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983)—1207.01(a)(ii)
- In re Stencel Aero Engineering Corp.*, 170 USPQ 292 (TTAB 1971)—1304.05
- In re Stenographic Machines, Inc.*, 199 USPQ 313 (Comm'r Pats. 1978)—1704; 1706
- In re Steury Corp.*, 189 USPQ 353 (TTAB 1975)—1207.01(c)
- Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477 (TTAB 1987)—1207.01(a)(ii)(A)
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- Stromgren Supports Inc. v. Bike Athletic Co.*, 43 USPQ2d 1100 (TTAB 1997)—1604.11
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- In re Styleclick.com Inc.*, 57 USPQ2d 1445 (TTAB 2000)—1209.03(d); 1216.01
- In re Sumitomo Electric Industries, Ltd.*, 184 USPQ 365 (TTAB 1974)—1201.07(b)
- In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001)—1209.03(a); 1209.03(d); 1216.01
- In re Sun Supermarkets, Inc.*, 228 USPQ 693 (TTAB 1986)—1207.01(c)(ii)
- In re Sun Valley Waterbeds Inc.*, 7 USPQ2d 1825 (TTAB 1988)—1301.01(b)(ii)
- In re Sunburst Products Inc.*, 51 USPQ2d 1843 (TTAB 1999)—1202.03(f)(ii)
- In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994)—1207.01(d)(vi); 1216.01
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## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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*In re Tia Maria, Inc.*, 188 USPQ 524 (TTAB 1975)—1207.01(b)(vi)

*Tiffany & Broadway v. Commissioner*, 167 F. Supp.2d 949 (S.D. Tex. 2001)—1207.01(d)(ix)

*In re Tilcon Warren, Inc.*, 221 USPQ 86 (TTAB 1984)—1202.04; 1212.02(i)

*In re Tinseltown, Inc.*, 212 USPQ 863 (TTAB 1981)—1203.01

*Tobacco By-Products & Chemical Corp. v. Smith*, 106 USPQ 293 (Comm'r Pats. 1955), *modified*, 243 F.2d 188, 113 USPQ 339 (C.C.P.A. 1957)—906.02

*In re Todd Co., Inc.*, 290 F.2d 597, 129 USPQ 408 (C.C.P.A. 1961)—1202.03(b)

*Tone Brothers, Inc. v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321 (Fed. Cir. 1994), *cert. denied*, 514 U.S. 1015 (1995)—1202.02(b)(ii)

*In re Tong Yang Cement Corp.*, 19 USPQ2d 1689 (TTAB 1991)—803.06; 1005; 1201.02(c)

*In re Toro Mfg. Corp.*, 174 USPQ 241 (TTAB 1972)—1402.05

*Toro Mfg. Corp. v. John B. Stetson Co.*, 161 USPQ 749 (TTAB 1969)—904.05

*Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)—1604.13

*In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999)—710.01(b); 710.01(c)

*In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002)—1209.03(d)

*In re Trackmobile Inc.*, 15 USPQ2d 1152 (TTAB 1990)—1207.01(a)(iii)

*TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001)—1202.02; 1202.02(a)(ii); 1202.02(a)(iii)(A); 1202.02(a)(iii)(B); 1202.02(a)(iii)(C); 1202.02(a)(iv); 1202.02(a)(v)(B); 1202.02(a)(v)(C); 1202.02(b); 1202.02(c); 1202.02(a)(v); 1212.02(i)

*In re Trans Continental Records, Inc.*, 62 USPQ2d 1541 (TTAB 2002)—1210.02(a)

*In re Triangle Club of Princeton University*, 138 USPQ 332 (TTAB 1963)—1304.03; 1304.09(c)

*In re Turbine Metal Technology, Inc.*, 219 USPQ 1132 (TTAB 1983)—1301.02(e)

*Turner v. HMH Publishing Co., Inc.*, 380 F.2d 224, 154 USPQ 330 (5th Cir. 1967), *cert. denied*, 389 U.S. 1006, 156 USPQ 720 (1967)—1201.03(f)

*Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081 (1992)—1202.02; 1202.02(b)(ii); 1202.02(e); 1202.02(f)

*In re Ultraflight Inc.*, 221 USPQ 903 (TTAB 1984)—904.05; 904.07

*In re Umax Data System, Inc.*, 40 USPQ2d 1539 (Comm'r Pats. 1996)—1609.02(a); 1706; 1707

*In re Unclaimed Salvage & Freight Co., Inc.*, 192 USPQ 165 (TTAB 1976)—1202.01

## LIST OF DECISIONS CITED

*In re Uncle Sam Chemical Co., Inc.*, 229 USPQ 233 (TTAB 1986)—1207.01(a)(iii); 1212.06(a)

*In re Underwater Connections, Inc.*, 221 USPQ 95 (TTAB 1983)—1209.03(f)

*In re Uniroyal, Inc.*, 215 USPQ 716 (TTAB 1982)—1209.03(d); 1213.05

*In re Unisearch Ltd.*, 21 USPQ2d 1559 (Comm'r Pats. 1991)—1008

*In re Unistar Radio Networks, Inc.*, 30 USPQ2d 1390 (Comm'r Pats. 1993)—1708

*In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000)—1211.01(a)(i); 1211.01(a)(vi)

*United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172 (TTAB 1987)—1207.01(d)(iii)

*In re United Merchants & Manufacturers, Inc.*, 154 USPQ 625 (TTAB 1967)—1202.06(a)

*United Rum Merchants Ltd. v. Distillers Corp. (S.A.) Ltd.*, 9 USPQ2d 1481 (TTAB 1988)—1011.01

*In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986)—1207.01(a)(ii); 1207.01(c)

*In re United Services Life Ins. Co.*, 181 USPQ 655 (TTAB 1973)—807.04(b)

*In re Univar Corp.*, 20 USPQ2d 1865 (TTAB 1991)—1202.01

*In re Universal Card Group, Inc.*, 25 USPQ2d 1157 (Comm'r Pats. 1992)—1708

*In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (C.C.P.A. 1973)—1301.01(a)(i); 1301.02; 1301.02(e); 1301.04(a)

*In re Universal Package Corp.*, 222 USPQ 344 (TTAB 1984)—1209.03(h)

*In re Universal Press Syndicate*, 229 USPQ 638 (TTAB 1986)—1301.01(a)(ii); 1301.01(a)(iii)

*In re University of Mississippi*, 1 USPQ2d 1909 (TTAB 1987)—1306.03

*University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983)—1203.03; 1203.03(e); 1203.03(f); 1206

*Upco Co. v. Speed Crete of La., Inc.*, 154 USPQ 555 (TTAB 1967)—904.05

*In re Upper Deck Co.*, 59 USPQ2d 1688 (TTAB 2001)—807.01; 1202.05(c); 1202.14; 1214.01

*In re Upsher-Smith Laboratories, Inc.*, 45 USPQ2d 1371 (Comm'r Pats. 1997)—1107; 1107.01

*In re Urbano*, 51 USPQ2d 1776 (TTAB 1999)—1203.03(f); 1210.02(b)(i)

*In re U.S. Bicentennial Society*, 197 USPQ 905 (TTAB 1978)—1203.03(f)

*In re U.S. Cargo, Inc.*, 49 USPQ2d 1702 (TTAB 1998)—1210.02(b)(iv); 1210.04

*In re U.S. Catheter & Instrument Corp.*, 158 USPQ 54 (TTAB 1968)—1501.06

*In re U.S. Dept. of the Interior*, 142 USPQ 506 (TTAB 1964)—803.01; 1204

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*In re U.S. Home Corp. of Texas*, 199 USPQ 698 (TTAB 1978)—1301.01(a)(iii)  
*U.S. v. Morgan*, 313 U.S. 409 (1941)—1801.01  
*U.S. Navy v. U.S. Mfg. Co.*, 2 USPQ2d 1254 (TTAB 1987)—1204  
*U.S. Olympic Committee v. Intelicense Corp., S.A.*, 737 F. 2d 263, 222 USPQ 766 (2d Cir. 1984), *cert. denied*, 469 U.S. 982 (1984)—1205.01  
*U.S. Olympic Committee v. International Federation of Body Builders*, 219 USPQ 353 (D.D.C. 1982)—1205.01  
*U.S. Olympic Committee v. Olymp-Herrenwaschefabriken Bezner GmbH & Co.*, 224 USPQ 497 (TTAB 1984)—1205.01  
*U.S. Olympic Committee v. Toy Truck Lines Inc.*, 237 F.3d 1331, 57 USPQ2d 1380 (Fed. Cir. 2001)—1205.01  
*U.S. Olympic Committee v. Union Sport Apparel*, 220 USPQ 526 (E.D. Va. 1983)—1205.01  
*U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613 (Comm'r Pats. 1974)—1201.02(c)  
*In re U.S. Plywood Corp.*, 138 USPQ 403 (TTAB 1963)—1203.02(b)  
*In re The U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985)—1207.01(a)(ii); 1207.01(b)(iii)  
*U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985)—1207.01(b)(viii)  
*U.S. Shoe Corp. v. J. Riggs West, Inc.*, 221 USPQ 1020 (TTAB 1984)—901.03  
*Ex parte U.S. Steel Corp.*, 157 USPQ 435 (Comm'r Pats. 1968)—1602.03  
*In re U.S. Tobacco Co.*, 1 USPQ2d 1502 (TTAB 1986)—1301.01(b)(i)  
*In re Usher, S.A.*, 219 USPQ 920 (TTAB 1983)—1202.02(b); 1202.03(b)(iv)  
*Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422 (Fed. Cir. 2002)—1202.02(a)(iii)(A); 1202.02(a)(iii)(B); 1202.02(a)(iv); 1202.02(a)(v); 1202.02(a)(v)(B)  
*Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991)—1212.04(b)  
*Ex parte Van Winkle*, 117 USPQ 450 (Comm'r Pats. 1958)—1306.05  
*Varian Associates v. IMAC Corp.*, 160 USPQ 283 (N.D. Ill. 1968)—904.05  
*In re Vaughan Furniture Co. Inc.*, 24 USPQ2d 1068 (TTAB 1992)—710.01(a)  
*In re Venice Maid Co., Inc.*, 222 USPQ 618 (TTAB 1984)—1210.04(b)  
*In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985)—1209.01(b); 1301.01(a)(ii); 1301.01(b)(iv)  
*In re Venturi, Inc.*, 197 USPQ 714 (TTAB 1977)—1209.01(b)  
*In re Vico Products Mfg. Co., Inc.*, 229 USPQ 364 (TTAB 1985), *recon. denied*, 229 USPQ 716 (TTAB 1986)—1202.02(a)(v); 1212.06(e)(ii); 1212.06(e)(iii)

## LIST OF DECISIONS CITED

- Victor Tool & Machine Corp. v. Sun Control Awnings, Inc.*, 299 F. Supp. 868, 162 USPQ 389 (E.D. Mich. 1968), *aff'd*, 411 F.2d 792, 162 USPQ 387 (6th Cir. 1969)—1213.11
- In re Vienna Sausage Mfg. Co.*, 16 USPQ2d 2044 (TTAB 1990)—807.14; 807.14(d)
- In re Villeroy & Boch S.A.R.L.*, 5 USPQ2d 1451 (TTAB 1987)—1202.03(b); 1202.03(f)(ii)
- In re Virshup*, 42 USPQ2d 1403 (TTAB 1997)—1202.02(a)(v); 1202.02(a)(v)(C)
- Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740 (TTAB 1983)—807.14; 807.14(d)
- VISA, U.S.A., Inc. v. Birmingham Trust National Bank*, 696 F.2d 1371, 216 USPQ 649 (Fed. Cir. 1982)—501.06
- In re Visual Communications Co., Inc.*, 51 USPQ2d 1141 (TTAB 1999)—1202.02(a)(v); 1202.02(a)(v)(A)
- In re Vitamin Beverage Corp.*, 37 USPQ2d 1537 (Comm'r Pats. 1995)—1108.02(e)
- In re Volante International Holdings*, 196 USPQ 188 (TTAB 1977)—807.12(d)
- In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998)—710.03; 1202.04
- In re Vsesoyuzny Ordena Trudovogo Krasnogo Znameni Nauchnoissledovatel'skiy Gorno-Metallurgicheskiy Institut Tsvetnykh Metallov "Vnitsvetmet"*, 219 USPQ 69 (TTAB 1983)—1301.02(e)
- In re Vycom Electronics Ltd.*, 21 USPQ2d 1799 (Comm'r Pats. 1986)—1501.06
- In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999)—1210.02(b); 1210.04(a); 1210.05(b)(i); 1210.02(c); 1210.06(b); 1210.07(b)
- In re Wakefern Food Corp.*, 222 USPQ 76 (TTAB 1984)—1212.02(i); 1213.05(b); 1301.02; 1301.02(a)
- In re Walker-Home Petroleum, Inc.*, 229 USPQ 773 (TTAB 1985)—807.01
- In re Walker Process Equipment Inc.*, 233 F.2d 329, 110 USPQ 41 (C.C.P.A. 1956)—1202.01
- In re Walker Research, Inc.*, 228 USPQ 691 (TTAB 1986)—1301.02(e)
- In re Wallyball, Inc.*, 222 USPQ 87 (TTAB 1984)—1209.03(p)
- Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000)—1202.02(a)(iii)(B); 1202.02(b); 1202.02(b)(i); 1202.02(b)(ii); 1202.02(e); 1202.02(f); 1202.05; 1202.05(a); 1202.05(h); 1202.05(i); 1202.11
- In re Waltham Watch Co.*, 179 USPQ 59 (TTAB 1973)—1204
- In re Wanstrath*, 7 USPQ2d 1412 (Comm'r Pats. 1987)—1213.08(b)
- In re Water Gremlin Co.*, 635 F.2d 841, 208 USPQ 89 (C.C.P.A. 1980)—807.08; 1202.02(d); 1213.03(b); 1402.05

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696 (TTAB 1971)—1207.01(b)(v)

*In re Watkins Glen International, Inc.*, 227 USPQ 727 (TTAB 1985)—1202.03(c)

*Ex parte Wayne Pump Co.*, 88 USPQ 437 (PO Ex. Ch. 1951)—903.09

*In re Web Communications*, 49 USPQ2d 1478 (TTAB 1998)—1209.01(c)(iii)

*In re Weber-Stephen Products Co.*, 3 USPQ2d 1659 (TTAB 1987)—1202.02(a)(v)

*In re Weider*, 212 USPQ 947 (Comm'r Pats. 1981)—1604.07(a)

*Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990)—1207.01(b)(ii); 1207.01(d)(ii)

*In re Wella A.G.*, 5 USPQ2d 1359 (TTAB 1987), *rev'd on other grounds*, 858 F.2d 725, 8 USPQ2d 1365 (Fed. Cir. 1988)—1201.07(a); 1201.07(b) 1201.07(b)(i); 1201.07(b)(ii)

*In re Wella A.G.*, 787 F.2d 1549, 229 USPQ 274 (Fed. Cir. 1986)—1201.07(a)

*In re Wella Corp.*, 565 F.2d 143, 196 USPQ 7 (C.C.P.A. 1977)—1212.06(e)(iv); 1213.03(b)

*Wells Cargo, Inc. v. Wells Cargo, Inc.*, 197 USPQ 569 (TTAB 1977), *aff'd*, 606 F.2d 961, 203 USPQ 564 (C.C.P.A. 1979)—1201.03

*In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986)—1209.03(d); 1213.05(c)

*Wells Fargo & Co. v. Lundeen & Associates*, 20 USPQ2d 1156 (TTAB 1991)—906.04

*Ex parte Wembley, Inc.*, 111 USPQ 386 (Comm'r Pats. 1956)—1301.01(b)(i)

*Western Electric Co. Inc. v. Piezo Technology, Inc.*, 860 F.2d 428, 8 USPQ2d 1853 (Fed. Cir. 1988)—1801.01

*Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992)—710.03; 1207.01(d)(iii)

*In re Whataburger Systems, Inc.*, 209 USPQ 429 (TTAB 1980)—1212.02(i); 1301.02(b); 1301.04(b)

*In re White*, 73 USPQ2d 1713 (TTAB 2004)—1203.03(e); 1203.03(f)

*In re Who? Vision Systems, Inc.*, 57 USPQ2d 1211 (TTAB 2000)—807.14; 807.14(c); 807.14(d)

*W. H. Snyder and Sons, Inc. v. Ladd*, 227 F. Supp. 185, 140 USPQ 647 (D.D.C. 1964)—1203.03(b)

*In re Wickerware, Inc.*, 227 USPQ 970 (TTAB 1985)—1209.03(r)

*In re Wickuler-Kupper-Brauerei KGaA*, 221 USPQ 469 (TTAB 1983)—1211.02(b)(i)

*In re Wilcher Corp.*, 40 USPQ2d 1929 (TTAB 1996)—1203.01

*Wilco Co. v. Automatic Radio Mfg. Co., Inc.*, 255 F. Supp. 625, 151 USPQ 24 (D. Mass. 1966)—1210.02(b)(iv)

*In re Wileswood, Inc.*, 201 USPQ 400 (TTAB 1978)—1209.03(n); 1210.02(b)(iv)

## LIST OF DECISIONS CITED

*In re Wilson*, 57 USPQ2d 1863 (TTAB 2001)—1216.01

*In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989)—807.14(d); 1011.03; 1207.01(b)(vii); 1210.02(c)(ii)

*In re Witco Corp.*, 14 USPQ2d 1557 (TTAB 1989)—1202.02(a)(v); 1202.02(a)(v)(A)

*In re Wolf*, 33 USPQ2d 1054 (Comm'r Pats. 1993)—1108.02(c)

*In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876 (TTAB 1992)—1209.01(c)(ii)

*In re Wood*, 217 USPQ 1345 (TTAB 1983)—1202.09

*In re Woodward & Lothrop Inc.*, 4 USPQ2d 1412 (TTAB 1987)—1209.04

*In re Woolley's Petite Suites*, 18 USPQ2d 1810 (TTAB 1991)—1211.01(b)(v); 1211.01(b)(vi)

*In re Woolrich Woolen Mills Inc.*, 13 USPQ2d 1235 (TTAB 1989)—1209.04

*In re World's Finest Chocolate, Inc.*, 474 F.2d 1012, 177 USPQ 205 (C.C.P.A. 1973)—1202.02(b)(ii)

*"X" Laboratories, Inc. v. Odorite Sanitation Service of Baltimore, Inc.*, 106 USPQ 327 (Comm'r Pats. 1955)—1213.05(a)(ii)

*Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988)—1212; 1212.01; 1212.02(b); 1212.05(a); 1212.06

*Yankee Candle Co. v. Bridgewater Candle Co., LLC*, 259 F.3d 25, 59 USPQ2d 1720 (1<sup>st</sup> Cir. 2001)—1202.02(b)(ii); 1212.06(d)

*In re Zanova, Inc.*, 59 USPQ2d 1300 (TTAB 2000)—1209.03(d)

*In re Zazzara*, 156 USPQ 348 (TTAB 1967)—1209.03(g)

*In re Zippo Mfg. Co.*, 50 USPQ2d 1852 (TTAB 1999)—1202.02(a)(v); 1202.02(a)(v)(B)

*Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991)—201.02

# INDEX

## A

- Abandonment of application (see also Abandoned application; Petition to revive abandoned application; Reinstatement of inadvertently abandoned application)
  - after ex parte appeal—718.05; 1501.04; 1714.01(f)(i)
  - after *inter partes* proceeding—718.06
  - defined—718
  - express—718.01
  - incomplete response resulting in—718-718.03(c); 1714.01(f)(ii)
  - location of files—109.02; 718.07
  - notice of, for failure to respond—718.04; 718.06
  - of multi-basis application—806.02(d)
  - of multi-class application—1403.05
  - ordering abandoned files —718.07
  - partial—718.02(a); 1402.13; 1403.05; 1904.03(d)
  - petition from examining attorney's holding of—1713
  - reconsideration of holding of—718.03(c)
  - through failure to file statement of use—718.04
  - through failure to prosecute appeal—718.05
  - through failure to respond to Office action —718.02; 718.03
- Abstracts of title—503.08(a)
- Acceptable Identification of Goods and Services Manual—1402.04
- Access by public to files
  - electronic images—109.01
  - paper files—109.02
- Accessibility
  - of assignment records—503.08
  - of files held by Office personnel—109
- Acquired distinctiveness (§2(f)) claim
  - as to a portion of the mark—1212.02(f); 1212.09(b)
  - based on five years' use—1212.05-1212.05(d)
  - based on ownership of prior registrations—1212.04-1212.04(e)
  - concession that matter is not inherently distinctive—1212.02(b)
  - evidence submitted to establish—1212.06-1212.06(e)
  - in part—1212.02(f); 1212.09(b)
  - in §1(b) application—1212.09-1212.09(b)
  - in §44 application—1010; 1212.08
  - in §66(a) application—1212.08
  - in the alternative—1212.02(c)
  - printing of—817; 1212.10
  - unnecessary—1212.02(d)
- Act of 1881—1601.04; 1602.02
- Act of 1905—1601.04; 1602.02
- Act of 1920—1601.05; 1602.03
- Act of 1946 (see Trademark Act of 1946)



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- Action after issuance of notice of allowance and before filing of statement of use—  
807.03(j); 1107
- Action by affidavit/renewal examiner
  - upon examination of §8 affidavit—1604.15
  - upon examination of renewal application—1606.11
- Action by examining attorney (*see also* Examination)
  - after final refusal—715.03(a); 715.03(b)
  - all arguments by applicant to be addressed in—713.03
  - all outstanding refusals and requirements to be noted in—713.02
  - citation of decisions in—705.05
  - citation of registrations in—705.03
  - date of—705.07
  - evidence supporting refusal in—710.01-710.01(c)
  - form paragraphs in—705.01
  - incomplete response to—718.03-718.03(c)
  - language in—705.01
  - non-receipt of—717.02
  - piecemeal action to be avoided—704.01
  - returned—403; 717.01
  - review by supervisory examining attorney—705.06
  - “search clause” in—704.02
  - statutory language in—705.01
  - to be complete—704.01
  - unpublished decisions not to be cited in—705.05
- Address
  - changing address of owner of registration—1609.11
  - changing correspondence address—603.02-603.02(c)
  - correspondence—603-603.05
  - for communications to the International Bureau—1906
  - for communications to U.S. Patent and Trademark Office (“USPTO”)—305.01
  - for electronic mail communications—304.08
  - for filing documents to be recorded in Assignment Division—503.04
  - of applicant—803.05
  - of assignee—502.02(a)-(b)
- Advisory statement cannot serve as foundation for final refusal—714.05(c)
- Aesthetic functionality—1202.02(a)(iii)(C)
- Affidavit of continued use or excusable nonuse (§8) (*See also* Affidavit of continued use or excusable nonuse (§71))
  - appeal to federal court—1604.19
  - combined with renewal application—1606.20
  - combined with §15 affidavit—1605.05
  - change from mark as registered—1604.13
  - character of use of mark—1604.10
  - deficiencies, correction of—1604.06(b); 1604.17-1604.17(c)
  - domestic representative, designation of—1604.14
  - execution of—1604.08-1604.08(d)
  - extension of protection to the United States (§71)—1613
  - fee for filing—1604.06-1604.06(c)
  - form for filing—1604.03
  - goods and services set forth in—1604.09-1604.09(e)

## INDEX

- grace period—1604.04; 1604.06(b)
- nonuse—1604.11
- notice on registration certificate—1604.02
- Office action upon examination of—1604.15
- ownership—1604.07-1604.07(f)
- petition to Director—1604.18-1604.18(c)
- premature filing of—1604.04(a)
- recourse after refusal—1604.18-1604.18(c); 1604.19
- response to Office action—1604.16
- requirements for—1604.05
- registrations in 20-year terms—1604.04(b)
- signature—1604.08-1604.08(d)
- specimen(s)—1604.12-1604.12(c)
- time for filing—1604.04; 1604.17(c)
- untimely filing cannot be cured—1712.02; 1604.17(c)
- use in commerce—1604.10
- who may file—1604.07
- Affidavit of continued use or excusable nonuse (§71)—1613 (*See also* Affidavit of continued use or excusable nonuse (§8))
- Affidavit of incontestability (§15)—1605-1605.06
  - combined with §8 affidavit—1605.05
  - form for filing—1605.02
  - premature—1605.03
  - requirements for—1605.04
  - §14 limitation independent of—1605.06
  - registered extension of protection of international registration—1605.01; 1904.11
  - substitute—1605.04
  - Supplemental Register registrations not eligible—1605.01
  - time for filing—1605.03
- Affidavit of use (*see* Affidavit of continued use or excusable nonuse)
- Affidavit under §8 (*see* Affidavit of continued use or excusable nonuse (§8))
- Affidavit under §71 (*see* Affidavit of continued use or excusable nonuse (§71))
- Agents—602
- Agreement of drawing and foreign registration in §44 application—807.03(f); 807.12(b); 1011.01
- Agreement of drawing and specimen—807.12(a); 1215.02(c)
- Allegations of use in §1(b) application (*see also* Amendment to allege use; Statement of use)—1103
- Alphabetical List, International—1401.02(c)
- Amendment of application
  - after decision on appeal—1501.06
  - after final action—715; 715.01; 715.02
  - after publication—1505-1505.02(d)
  - from Principal Register to Supplemental Register in §1(b) application—1102.03
  - prohibited during period between issuance of notice of allowance and filing of statement of use, except to delete specified goods or services (§1(b) application)—1107
  - to add or substitute a basis for registration—806.03-806.03(k)

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- to change filing basis from §1(a) to §1(b)—806.03(c)
- to change filing basis from §1(b) to §44—806.03(g); 806.03(j)(i); 806.03(j)(ii)
- to change basis from §44 to §1(b)—806.03(d)
- to claim priority—806.03(b)
- to delete §1(b) basis—806.04-806.04(a)
- to different register—816-816.05; 1102.03
- Amendment of dates of use
  - to reflect a change, must be verified—903.05
  - upon amendment of identification—903.09
- Amendment of mark in registration—1609.02-1609.02(d)
  - drawing—1609.02(b)
  - fee required—1609.02
  - in registered extension of protection—1609.02; 1904.13
  - material alteration of mark not permitted—1609.02(a)
  - specimen—1609.02(c)
  - who may request—1609.02
- Amendment of mark on drawing—807.15
  - amendment to cure “internal inconsistency” not permitted—807.14(c)
  - may not result in material alteration—807.03(d); 807.14-807.14(d); 1609.02-1609.02(d)
  - must be warranted by specimens or foreign registration—807.12(a); 807.12(b)
  - not permitted in §66(a) application—807.13(b); 1609.02; 1904.02(g); 1906.01(i)
  - procedures for—807.15; 807.16
  - processing unacceptable amendments—807.17
  - in marks comprising domain names—1215.08-1215.08(b)
  - in registered extension of protection—1609.02; 1904.02(g); 1904.13; 1906.01(i)
  - in registration based on §1 or §44 application—1609.02-1609.02(d)
  - in request for extension of protection of international registration—807.13(b); 1609.02; 1904.02(g); 1904.13; 1906.01(i)
- Amendment of registration (see *also* Amendment of mark in registration)—1609-1609.09
  - correction of mistake—1609.10-1609.10(b)
  - dates of use—1609.07
  - disclaimer—1609.04
  - effect on limitation of grounds for cancellation—1609.08
  - fee required—1609.02
  - from Supplemental to Principal Register not permitted—1609.08
  - of classification—1609.04
  - of identification of goods/services—1609.03
  - of mark—1609.02-1609.02(d)
  - of owner’s address—1609.11
  - of registered extension of protection—1609.01; 1609.02; 1609.04; 1904.13; 1906.01-1906.01(i)
  - of registrations with color claim—1609.02(d)
  - territorial restrictions—1609.06
  - who may request—1609.01(a); 1609.01(b)
- Amendment to allege use
  - approval of—1104.11
  - blackout period—1104.03(b); 1104.03(c)
  - dates of use—1104.09(d)

## INDEX

drawing—1104.09(f)  
examination of, by examining attorney—1104.09-1104.09(h)  
execution of—1104.09(b)  
*ex parte* appeals—1104.07  
fee for filing—1104.09(g)  
filed in conjunction with application—1104.05  
filing during pendency of *ex parte* appeal—1104.07  
form of—1104.02  
identification of goods/services in—1104.09(c)  
located after publication—1104.04  
minimum requirements for—1104.01  
necessary elements of—1104.08  
ownership—1104.09(a)  
papers prepared for filing as amendment to allege use may be submitted as  
statement of use—1109.05(a)  
review for compliance with minimum filing requirements—1104.01(a)-1104.01(c)  
specimen—1104.09(e)  
time for filing—1104.03  
use in commerce—1104.09(d)  
use on all goods/services before filing—1104.03(a)  
withdrawal of—1104.10  
“America” or “American,” marks comprising—1209.03(n); 1210.02(b)(iv)  
Apostille—804.01(a)(i)  
Appeal to Trademark Trial and Appeal Board  
amendment during—1501.05  
amendment after decision on—1501.06  
appealable matter—1501.01; 1704  
application record must be complete prior to—710.01(c)  
dismissal of—1501; 1714.01(f)(ii)  
fee for—1501.04  
in general—1501-1501.07  
time period for—1501  
withdrawal of refusal during—1501.03  
Appeal briefs, examining attorneys'  
failure to file—1501; 1714.01(f)(ii)  
format for—1501.02; App. A  
preparation of—1501.02  
unpublished decisions not to be cited in—705.05  
Appealable matter—1501.01  
Applicant  
address of—803.05  
application void if wrong party identified as—803.06; 1201.02(b)  
association as—803.03(c)  
citizenship of—803.04  
corporation as—803.02(c); 803.03(c)  
correcting mistake in name of—1201.02(c)  
eligible under §44—1002-1002.05  
foreign—803.03(i)

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- joint applicants as—803.03(d)
- joint venture as—803.03(b)
- may not be changed—803.06; 1201.02(b)
- minor—803.01
- must be natural or juristic person—803.01
- name of—803.02
- partnership as—803.03(b)
- verification of—804-804.05
- who may apply—803.01
- Applicant's name—803.02
- Applicants, joint—712.01(a)(i); 803.03(d)
- Application checklist—818
- Application files
  - electronic—109.03; 402-402.01
  - new, processing of—401.04
  - preparation of, for publication or registration of mark—817
  - to remain in Office—109
- Applications for international registration (see International applications for registration)
- Application for registration
  - abandoned (see *also* Abandoned application; Abandonment of application)—718
  - “amended”—702.01
  - approved for publication—1502
  - approved for registration on Supplemental Register—815.03
  - basis for (see Filing basis)
  - classification—1401-1401.08
  - combined (see Combined application)
  - concurrent use (see Concurrent use registration)
  - dates of use—903.01; 903.02
  - declaration in lieu of oath—804.01(b)
  - defective—204-204.03
  - electronic—109.01; 402
  - establishing ownership of—502-502.03
  - filing basis (see Filing basis)
  - filing date (see Filing date (application))
  - form for filing—802
  - informal—204-204.03
  - intent-to-use (see Intent-to-use applications)
  - multiple-class (see Combined application)
  - persons who can sign verification—804.04
  - priority under §44(d)—806.01(c); 1003-1003.08
  - should specify register on which registration is sought—801.02(a)
  - specimen—904-904.11
  - statutory averments—804.02
  - suspended (see *also* Suspension of Office action)—716-716.06
  - use in commerce—806.01(a)
  - verification made in foreign country—804.01(a)(i)
  - verification with oath—804.01(a)
  - written—802
- Application serial number—401.02

## INDEX

- Article 6<sup>ter</sup> of Paris Convention—1205.02
- Artists and authors, name of, as mark—1202.09; 1202.09(a); 1301.02(b)
- Assignee
  - entitled to prosecute application or registration—501.05; 502.01
  - establishing ownership in name of—502-502.03
  - issuance of new registration certificate to—502.03
  - issuance of original registration certificate in name of—502.02(a)-(b)
  - not domiciled in United States—501.04
  - stands in place of applicant or registrant—501.05
- Assignment (see also Assignee)
  - accessibility of records—503.08
  - conditional—503.01
  - definition of—501.01
  - documents—503.02; 503.03(a)
  - establishing ownership—502-502.03
  - examining attorney's action regarding—502.02(c)
  - failure to record—501.03
  - indexing against recorded document not permitted—503.07
  - of intent-to-use application—501.01(a)
  - of marks in applications or registrations—501.01
  - of §1(b) application—501.01(a)
  - of §44 application—501.04; 1006
  - of §66(a) application—501.01(b); 501.07; 502.01; 502.02(b); 503.05; 503.03(a); 1904.06; 1906.01(a)-1906.01(a)(iii)
  - of extension of protection of international registration—501.01(b); 501.07; 502.01; 502.02(b); 502.03; 503.05; 503.03(a); 1904.06; 1906.01(a)-1906.01(a)(iii)
  - partial—501.06; 1110.08; 1615
  - recordation of (see Assignment, recordation of)
  - records open to public—503.08
  - searching—104; 503.08
- Assignment, recordation of
  - address for submitting documents —503.04
  - automatic updating—504-504.05
  - correction of errors in—503.06-503.06(f)
  - cover sheet—503.03(e); 503.06(a)-503.06(a)(ii)
  - date of—503.05
  - documents eligible for—503.02
  - electronic filing—503.03(a); 503.03(b); 503.03(e)
  - effect of—503.01
  - errors, correction of—503.06-503.06(f)
  - fee for—503.03(d)
  - indexing not permitted—503.07
  - not a determination of validity—503.01
  - of extension of protection of international registration must be filed International Bureau—503.03(a); 503.05; 503.06; 503.06(b); 1904.06
  - of international registration—1906.01-1906.01(a)(iv)
  - original documents should not be filed—503.03(b)

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- petitions to correct or expunge assignment records—503.06(f)
- procedure for—503.05
- requirements for—503.03-503.03(e)
- resubmission of documents for—503.05
- searching may be done on USPTO website—104; 503.08
- Association
  - name of—803.02(c)
  - state or country of organization of—803.04
- Assumed business name—803.02; 803.02(a); 803.02(b)
- Attorney
  - associate power of—602.01(b)
  - change of —602.01(b); 602.04; 603.02(a)
  - communication with—602; 707.01; 708.02
  - correspondence sent to—603; 603.01; 603.02(a)
  - Office may not aid in selection of—601.01
  - powers of (see *also* Power of attorney)—602.01-602.01(c)
  - revocation of power of—602.04
  - representation of owner of mark by—601
  - signature of—602.02(a)
  - standards of conduct—602.02
  - withdrawal of—602.04; 602.05
- Author, name of, as mark—1202.09
- Averments, statutory—804.02

### B

- Background designs and shapes as mark—1202.11
- Banking institution as applicant—803.03(g)
- Basic Facts About Registering a Trademark—105
- Basis for filing (see Filing basis)
- Blackout period—1104.03(b)-1104.03(c)
- “Bona fide and effective industrial or commercial establishment”—1002.04
- Bona fide intention to use mark in commerce
  - acceptable language for statement of—1101
  - application filing basis, under §1(b)—806.01(b)
  - continued—1101; 1108.02
  - must be asserted in request for extension of time to file statement of use—1108.02(e)
  - must be asserted in §44 application, even if use has commenced—1008
  - must be asserted in §66(a) application—804; 804.06; 1904.01(c)
  - must be asserted in written application—806.01(b)-806.01(d); 1101
  - not necessary to repeat in multi-basis application—806.02(g)
- Bona fides* of applicant, in asserting intent to use mark in commerce, not inquired into by examining attorney—1101
- Bona fide use in ordinary course of trade—901.02
- Bulky specimens—904.03
- Business cards as specimens of service mark use—1301.04(c)
- Business trusts—803.03(e)(i)
- Business with Office to be transacted in writing—708.03; 709.03; 709.04; 709.05

# INDEX

## C

### Cancellation

- of inadvertently accorded filing date—204.01
  - of international registration—1904.08
  - of notice of allowance—1106.03
  - of registration for certification mark—1306.05(b); 1306.07
  - of registration for failure to file affidavit of continued use —1604; 1604.04
  - of registration under §8—1604; 1604.04
  - of registrations under §14 or §37—1607
  - of registrations under §71—1904.10
  - surrender of registration for—1608
- Catalogs as trademark specimens—904.06(a)
- Certificate of extension of protection of international registration—1904.05
- Certificate of mailing procedure
- effect of —305.02(e)
  - eligible correspondence—305.02(a)
  - correspondence returned by U.S. Post Office—305.02(g)
  - date used to determine timeliness—305.02(e)
  - location of certificate—305.02(c)
  - mailing requirements and address—305.01
  - non-receipt of correspondence by PTO—305.02(f)
  - not available for filing international applications—305.02(a)
  - not available for filing requests for transformation—305.02(a)
  - not available for filing requests to record changes to an international registration—305.02(a)
  - not available for filing responses to IB notices of irregularities—305.02(a)
  - not available for filing subsequent designations—305.02(a)
  - not available for filing trademark applications—305.02(a)
  - wording of certificate—305.02(d)
- Certificate of registration
- extension of protection of international registration—1904.05
  - indication that mark is on Principal Register in—1601.07
  - indication that mark is on Supplemental Register in—1601.07
  - issuance in name of assignee—502.02(a)-(b)
  - new, upon change of ownership—502.03
- Certificate of transmission (See Facsimile transmission, certificate of)
- Certification Division, Office of Public Records—111
- Certification mark
- amendment to different type of mark—1306.06(g)(vi)
  - authority of applicant to control use of geographic term—1306.02(b)
  - based on foreign registration—1306.08
  - cancellation of registration for—1306.07
  - cancellation of prior trademark registration as prerequisite to issuance of certification mark registration—1306.05(b)
  - certification statement in application to register—1306.06(g)(i)
  - certification versus performance of services and sale of goods—1306.04
  - characteristics of—1306.05



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

circumstances surrounding use—1306.05  
classification of goods/services in application to register—1306.06(e);  
1401.03(d); 1902.02(g)(ii); 1904.02(b)  
collective mark, distinguished from certification mark—1306.09(a)  
definition of—1306.01  
distinguished from other types of marks— 1306.01; 1306.09(a); 1306.09(b)  
drawing requirements—1306.06(b)  
examination of application to register—1306.06-1306.06(g)(vi)  
exercise of control—1306.06(g)(iii)  
foreign registration, basis for registration of certification mark—1306.08  
geographic term used to designate regional origin—1210.09; 1306.02-1306.02(c)  
geographically deceptive term not permitted—1306.02  
government as applicant for—1306.02(c)  
grounds for cancellation under §14, applicability to examination—1306.07  
identification of goods or services—1306.06(f)  
indication of regional origin versus description of goods—1306.02(a)  
labor performed by specific group or individual, term used to certify that—  
1306.03  
mark not used by applicant—1306.06(g)(v)  
may be geographically descriptive—1306.02  
not registrable as trademark or service mark—1306.05(a)  
ownership of—1306.04  
patent licenses, use of trademark or service mark by patent licensee  
distinguished from—1306.09(c)  
purpose is to certify, not indicate source—1306.01(b)  
quality control by owner not a requirement—1306.01(a)  
related company use of trademark or service mark distinguished from—  
1306.09(b)  
same mark not registrable as other type of mark—1306.05(a); 1306.05(b)  
specimens—1306.06(c); 1306.06(d)  
standards—1306.06(g)(ii)  
statement of control over use of mark—1306.06(g)(iii)  
statement of first use under authority of applicant—1306.06(g)(iv)  
statement that mark is not used by applicant—1306.06(g)(iv)  
statement of what mark certifies—1306.06(g)(i)  
uncertainty as to type of mark—1306.09  
use is by others—1306.01(a); 1306.06(g)(iv); 1306.06(g)(v)  
verification language in application to register—1306.06(g)(iii)  
Certification or certified copy of foreign registration required for §44(e)—1004.01  
Chain of title—502.01; 502.02(a)  
Change of correspondence address—603.02-603.02(c)  
Change of filing date of application—204.03; 205; 1711  
Character or person, as mark—1202.09; 1202.09(a); 1301.02(b)  
Check, in general—405.02  
Check, returned unpaid  
affidavit of continued use or excusable nonuse (§8)—405.06; 1604.06(c)  
amendment to allege use—405.06; 1104.09(g)  
application filing fee—202.03(a); 405.06  
extension of time to file statement of use—405.06; 1108.02(c)  
renewal fee—405.06; 1606.05(c)

## INDEX

- statement of use—405.06; 1109.15(a)
- Checklist, application—818
- Citizenship of applicant—803.04
- Claim of priority (*see also* Priority under §44(d))
  - amendment to add—806.03(b); 1003.02
  - form of—806.01(e); 806.01(c); 1003; 1904.01(e)
  - in application for international registration—1902.05
  - in request for extension of protection of international registration—206.02; 1904.01(e)
- Claiming benefits of Act of 1946 under §12(c)—1603-1603.03
- Class headings—1401.02(a)
- Classification of goods/services
  - amendment of—707.02; 1401.03; 1401.03(b); 1401.04(b); 1403.02; 1403.02(b)
  - amendment after publication —707.02; 1109.14; 1505.01(b)
  - amendment after registration—1401.02; 1609.04
  - amendment from U.S. to international classification system—1401.02; 1601.06; 1609.04
  - amendment not permitted in §66(a) application—1401.03(d); 1505.01(b); 1609.04; 1904.02(b)
  - cannot be changed in §66(a) application—1401.03(d); 1505.01(b); 1609.04; 1904.02(b)
  - certification mark—1306.06(e); 1401.03(d); 1902.02(g)(ii); 1904.02(b)
  - collective mark—1303.02(a)
  - collective membership mark—1304.09(a); 1401.03(d); 1902.02(g)(ii); 1904.02(b)
  - criteria for determining—1401.02(a); 1401.05
  - designation by applicant normally accepted—1401.03(a)
  - designation by International Bureau in §66(a) application controls—1401.03(d); 1904.02(b)
  - designation by Office—1401.03(b)
  - in application for international registration—1902.02(g)-1902.02(g)(iii)
  - in §66(a) application—1401.03(d); 1505.01(b); 1609.04; 1904.02(b)
  - international system—1401.02-1401.02(c)
  - plurality of uses—1401.07
  - republishing not required after amendment—1505.01(b)
  - services—1401.02(a); 1402.11
  - short titles of classes—1401.02(b)
  - should be designated by applicant, if known—1401.03
  - statutory authority for—1401.01
- Clear error in second examination—1109.08
- Closings of USPTO, unscheduled—309
- Coat of arms, refusal to register mark comprising—1204
- Collective mark, in general (*see also* Collective membership mark; Collective trademarks and service marks)
  - definition of—1302
  - history of—1302.01
- Collective membership mark
  - classification—1304.09(a); 1401.03(d); 1902.02(g)(ii); 1904.02(b)
  - control over use of—1304.09(d)(i); 1304.09(d)(ii)

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- distinguished from other types of marks—1302; 1304.01; 1306.09(a)
  - examination of application to register—1304.09-1304.09(d)(iii)
  - history of—1304.01
  - identifications—1304.09(b)
  - ownership of—1302; 1304.04; 1304.05
  - purpose of—1304.02
  - refusal to register—1304.08
  - special elements of—1304.09(d)(i); 1304.09(d)(iii)
  - specimens for—1304.09(c)
  - title or degree designations compared with—1304.08(c)
  - use is by members—1304.03; 1304.09(d)(iii)
  - Collective organization
    - use of collective mark by members of—1302; 1303.01
    - use of trademark or service mark by—1305
  - Collective trademarks and service marks
    - control over use of—1303.02(c)(i); 1303.02(c)(ii)
    - classification of—1303.02(a)
    - distinguished from other types of marks—1302; 1303; 1305; 1306.09(a)
    - examination of application to register—1303.02-1303.02(c)(ii)
    - ownership of—1303
    - special elements of—1303.02(c)(i); 1303.02(c)(ii)
    - specimens for—1303.02(b)
    - use is by members—1303.01; 1303.02(c)(ii)
  - Color
    - must be claimed as feature of the mark—807.07(a); 807.07(a)(i)
    - as a mark—1202.05-1202.05(h)
    - drawings of—807.07-807.07(e); 1202.05(d)-1202.05(d)(iii)
    - gray—807.07(e)
    - in the mark—807.07-807.07(e); 1202.05-1202.05(h)
    - lining—808.01(d)
    - specimens for marks comprising—904.02(c); 1202.05(f)
  - Color claim—807.07(a)-807.07(d)
  - Columns or sections of publications, marks that identify—1202.07-1202.07(b)
  - Combined affidavit under §§8 and 15—1605.05
  - Combined application
    - abandonment of—1403.05
    - addition of class number(s) in—1403.02(c)
    - amendment of—1403.02
    - correction of class(es) in—1403.02(b)
    - deletion of class(es) from—1403.02(a)
    - division of (*see also* Division of application)—1403.03
    - filing fees for—810.01; 1401.04; 1403.05(a)
    - goods/services not limited to one class—1403.01
    - refusal as to fewer than all classes in—1403.05
    - requirements for—1403.01
    - single certificate of registration issued, unless application divided—1403.01
    - specimens for—904.01(b)
  - Commerce
    - bona fide use in ordinary course of trade—901.02
    - commerce that may be lawfully regulated by Congress—901.03
-

## INDEX

- definition of—901.01
- use in (see Use in commerce)
- territorial—901.03
- type of—903.03
- with the United States—903.03
- Commercial name—1202.01
- Commissioner, change of title—1701
- Companion applications—702.03(a)-702.03(a)(iv)
- “Company”
  - does not identify legal entity in the United States—803.03; 803.03(c)
  - used in commonwealth countries to designate legal entity—803.03(i)
- Company, related (see Related company)
- Compliance with other laws—907
- Component or ingredient, mark used to identify—1402.05(a)
- Composition of goods—1402.05(b)
- Computer programs
  - identification of—1402.03(d)
  - specimens for—904.04(d)
- Concurrent use registration—1207.04-1207.04(f)(i)
  - permitted in §44 and §66(a) applications—1207.04(b)
- Conditional assignment—503.01
- Configuration of goods or packaging—1202.02-1202.02(e)
- Conflicting applications—702.03(b); 1207.01(d)(x); 1208-1208.02(f)
- Conflicting marks—702.03(b); 1207.01(d)(x); 1208-1208.02(f)
- Congressional inquiry—1802
- Consent agreement—1207.01(d)(viii)
- Consent to register by living individual—813; 1206.03-1206.03(b)
- Conservatorship as owner of mark—803.03(e)
- Constructive use—201.02; 1904.01(g)
- Control over nature and quality of goods/services—1201.01; 1201.03; 1201.03(a)
- Convention or treaty relating to trademarks—1001; 1002.01; 1002.02; 1900; App. B
- Copending (companion) applications—702.03(a)-702.03(a)(iv)
- Copies of documents, when acceptable for filing—302.01
- Copies of materials in files, requests for—111
- Copies of trademark applications and registrations, requests for—111
- Copying materials in files—109.03
- Corporation
  - address of—803.05
  - name of—803.02
  - non-profit—803.03(c)
  - signature on behalf of—712.01(a)(iv); 804.04
  - state or country of incorporation—803.04
  - tax-exempt—803.03(c)
- Correction of errors in cover sheet or recorded document—503.06-503.06(f)
- Correction of errors in international registration—1906.01(f)
- Correction of mistake in name of applicant—1201.02(c)
- Correction of mistake in registration—1609.10-1609.10(b)
- Correction of drawing—807.15-807.16

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Correspondence, returned as undeliverable—403  
Correspondence address—603-603.05  
    change of—603.02-603.02(c); 603.05  
    establishing—603.01  
    in §66(a) application—603.01(a)  
Correspondence with applicants not domiciled in United States—603.05  
Correspondence, with whom held—603-603.05  
Country of origin—1002.04  
Courier service, delivery of correspondence by—307  
Court orders concerning registrations—1610  
Cover sheet required for recording in Assignment Division—503.03(e)  
Credit card—405.01; 405.06  
    Charges refused or charged back—202.03(a)-202.03(a)(i); 405.06  
Cultivar names—1202.12

### D

#### Date

    of filing (see Filing date (application); “Office Date” stamp)  
    of first use in commerce—903.02  
    of first use of mark—903.01  
    of notarization of application—804.01(a)  
    of receipt stamped on hand-delivered papers—303.01; 303.02(b); 307  
    of signing of §2.20 declaration in application—804.01(a); 804.01(b); 804.03  
Date stamp (see “Office Date” stamp)  
Dates of use (see *also* Date of first use in commerce; Date of first use of mark)  
    amending—903.05  
    in allegation of use, may be earlier than application filing date—903  
    in another form—903.08  
    indefinite—903.07  
    must be specified in amendment to allege use—903; 1104.09(d)  
    must be specified in §1(a) application—806.01(a); 903  
    must be specified in statement of use—903; 1109.09(a)  
    must be verified—903  
    pertain to at least one item in class—903.09  
    relation between—903.04  
DBA designations—803.02; 803.02(a); 803.02(c)  
*De facto* functionality—1202.02(a)(iii)(B)  
*De jure* functionality—1202.02(a)(iii)(B)  
Dead languages, translation of—809; 1207.01(b)(vi); 1209.03(g)  
Deadline for response, how to compute—310  
Deceptive matter—1203.02-1203.02(b); 1210.05-1210.05(b)(ii)  
Deceptively misdescriptive geographic marks—1210.01(b); 1210.06(b); 1210.05(a);  
    1210.05(b)-1210.05(b)(ii)  
    basis for refusal—1210.05(a)  
    test—1210.01(b)-1210.01(c)  
Deceptively misdescriptive marks—1209.04  
Declaration under §8 (see Affidavit of continued use or excusable nonuse (§8))  
Declaration under §71 (see Affidavit of continued use or excusable nonuse (§71))  
Declaration in lieu of oath—804.01(b)

## INDEX

- Defective application materials—204-204.03
  - Degrees or titles—1304.08(c); 1306.03; 1306.06(a)
  - Delay between execution and filing of papers—804.03; 1104.09(b); 1108.02(b); 1109.05(a); 1109.11(c)
  - Deletion
    - of items from identification—1104.09(c); 1107; 1108.02(d); 1109.13; 1402.06(a)
    - of matter from mark on drawing—807.14(a)
  - Deposit accounts—405.03
  - Description
    - guidelines for requiring—808.01
    - of color in mark—807.07(a)(ii); 1202.05(c)
    - of designs of figurative elements—808.01(b)
    - of letters and numerals—808.01(a)
    - of location of mark on goods—808.01
    - of mark comprising configuration—808.01; 1202.02(d)
    - of sensory mark—807.09
    - of symbols in mark—808.01(b)
    - of three-dimensional mark—807.10; 808.01
    - printed in *Official Gazette*—808.03
    - printed on registration certificate—808.03
    - printing of—808.03; 817; 1202.02(d)
  - Descriptiveness, geographical—1210-1210.09
  - Descriptiveness, mere—1209; 1209.01-1209.03(s)
    - combined terms—1209.03(d)
    - design or picture—1209.03(f)
    - domain names—1209.03(m); 1215.04; 1215.05
    - first user—1209.03(c)
    - foreign equivalents—1209.03(g)
    - function or purpose—1209.03(p)
    - incongruity—1209.03(h)
    - laudatory terms—1209.03(k)
    - more than one meaning—1209.03(e)
    - no dictionary listing—1209.03(b)
    - phonetic equivalent—1209.03(j)
    - procedure for refusal—1209.02
    - retail store and distributorship services—1209.03(r)
    - slogans—1209.03(s)
    - source or provider of goods/services—1209.03(q)
    - third party registrations—1209.03(a)
  - Destruction of files—109.02; 718.07
  - Diligence (see Due diligence in monitoring status of pending matters)
  - Director, statutory authority of—1701
  - Disclaimer
    - alliteration—1213.05(e)
    - as to certain classes, or certain goods or services—1213
    - compound word marks—1213.05(a)-1213.05(a)(ii)
    - double entendre—1213.05(c)
    - form of—1213.08 - 1213.08(d)
-

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- history—1213.01
- in relation to likelihood of confusion—1213.09; 1213.10
- of domain name—1215.07
- of entire mark not permitted—1213.06
- of entity designations—1213.03(d)
- of foreign words—1213.08(d)
- of generic matter—1213.03(b)
- of geographic terms—1210.06(a) | 1210.06(b)
- of misspelled words—1213.08(c)
- of pictorial representations of descriptive matter—1213.03(c)
- of unregistrable matter in its entirety—1213.08(b)
- piecemeal disclaimer not permitted—1213.08(b)
- refusal to register because of failure to disclaim—1213.01(b)
- removal rather than—1213.07
- slogan not subject to—1213.05(b)
- sound patterns—1213.05(e)
- standardized printing format for—1213.08(a)(i)
- unitary mark not subject to—1213.05-1213.05(f)
- voluntary—1213.01(c)
- with respect to unitary marks—1213.05 - 1213.05(f)
- Disparagement—1203.03 - 1203.03(d)
- Distinctiveness under §2(f) (see Acquired distinctiveness (§2(f)) claim)
- Division
  - fee for—1110.02
  - of application—1110-1110.07
  - of application subject to Board proceeding—1110.06
  - of application under §44—1110.07
  - of application under §66(a)—1110.08
  - of international registration—1906.01(a)(iv)
  - of multiple class application—1403.03
  - of registration—1615
  - time for filing—1110.01
  - when statement of use is due—1110.04
  - when response to Office action is due—1110.05
- Divisions, operating or unincorporated—803.01
- Documents not returned to filer—404
- Documents that the Office will record—503.02
- Domain names, marks comprising—1209.03(m); 1215-1215.10
  - agreement of mark on drawing with mark on specimen—1215.02(c); 1215.08-1215.08(b)
  - combined with geographic matter—1215.06
  - combined with surname—1211.01(b)(vii); 1215.03
  - descriptiveness—1209.03(m); 1215.04; 1215.05
  - disclaimer of—1215.07
  - for domain name registry services—1215.02(d)
  - generic refusals—1209.03(m); 1215.05
  - intent-to-use applications—1215.02(e)
  - use as a mark—1215.02-1215.02(e)
- Domestic representative (of party not domiciled in United States)
  - designation by applicant—604

## INDEX

designation by assignee—501.04  
designation by renewal applicant—1606.10  
mailing of correspondence to—603.05  
with respect to affidavits under §8 —1604.14  
with respect to proceedings before Trademark Trial and Appeal Board—604

Drawing(s) (see also Special-form drawing; Standard character drawing)  
agreement with foreign registration in §44 application—807.03(f); 807.12(b);  
1011.01  
agreement with specimens—807.12(a); 1215.02(c)  
amendments (see Amendment of mark on drawing)  
broken lines on—807.08; 1202.02(d)  
clear drawing of—202.01  
code—807.18  
color —807.07-807.07(d); 1202.05(d)-1202.05(d)(iii)  
color lining—808.01(d)  
deletion of matter from—807.14(a)  
determining when special form exists—807.04-807.04(b)  
dotted lines on—807.08; 1202.02(d)  
electronically filed application—807.05-807.05(c)  
fax transmission not permitted—306.01  
for sensory marks—807.09  
gray tones in—807.07(e)  
in applications filed before November 2, 2003—807.03(i); 807.07(f)  
in §44 application—807.03(f); 1011-1011.03  
ink (see Special-form drawing)  
limited to mark—807.02  
limited to one mark—202.01; 807.01; 1011.02  
lining—808.01(d)  
long marks—807.05(a)(i); 807.06(b)  
mark drawing code—807.18  
motion, drawing of marks with—807.11  
multiple—202.01; 807.01  
not required for sound, scent or non-visual mark—807.09  
paper—807.06-807.06(c)  
required for marks other than sound and scent—807  
separate drawing page—807.06(b)  
showing position of mark—807.08  
size of—807.06(a)  
special-form (see Special-form drawing)  
standard character—807.03-807.03(i)  
substitute—807.15  
three-dimensional marks—807.10; 1202.02(d)  
transfer of (under 37 C.F.R. §2.26)—807.19  
type of paper for—807.06(a)  
typed (see Standard character drawing)

Dual citizenship asserted by applicant—803.04  
Due diligence in monitoring status of pending matters—108.04; 1705.05; 1712.01;  
1714.01(d)



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Duplicate registrations not issued—703  
Duration of registration—1602-1602.04

### E

Educational institution as owner of mark—803.03(f)  
Effective date  
    of Madrid Protocol Implementation Act—1900 (introductory text)  
    of Trademark Act of 1946—1601.02  
    of Trademark Law Revision Act of 1988—1602.01  
    of Trademark Law Treaty Implementation Act—1602.04  
Effective filing date of application—206-206.02  
Electronic filing through TEAS—301; 303.02(a)  
    confirmation of receipt of—303.02(a)  
    drawings—807.05 *et seq.*  
    signature—301; 804.05  
    specimens—904.02  
Electronic funds transfer—405; 406  
Electronic image files—109.01; 402  
Electronic mail—304-304.10  
    address for correspondence by—304.08  
    attachments must be in .jpg format—304.01; 304.07  
    authorization of—304.03  
    cannot be used to respond to examining attorneys' Office actions—304.02  
    communications that may be filed by—304.01; 304.02  
    filing date of—304.04  
    outgoing, 304.06; 403; 717.01  
    signature of—304.07; 804.05  
English, application must be in—802  
Enrollment and Discipline, Office of—602; 602.02; 602.03; 720  
Entity, legal—803.03  
Entity of foreign applicants, common terms designating—803.03(i)  
Equivalents, foreign—1207.01(b)(vi); 1209.03(g)  
Errors in cover sheet or recorded document, correction of—503.06-503.06(f)  
Establishing ownership of applications or registrations—502-502.03  
Estate as owner of mark—803.03(e)  
Evidence with respect to refusal or requirement—710-710.03  
    from Internet—710.01(b)  
    from research database—710.01(a)  
    indicating no refusal or requirement necessary—710.02  
    of third party registration—710.03  
    record must be complete prior to appeal—710.01(c); 1501.02  
    remand for introduction of new evidence—1504.05; 1504.05(a)  
Examination  
    checklist—818  
    initial (see *also* Intent-to-use applications, initial examination of)—704.01; 1102-1102.04  
    of related applications—702.03-702.03(b)  
    of §66(a) application—1904.02-1904.02(h)  
    order of—702.01

## INDEX

- procedure—704-704.03
- search—704.02
- “second” examination (see Statement of use, examination of)
- “special” applications—702.02; 1710-1710.02
- statutory authority for—701
- suspended applications—716-716.06
- Examiner’s amendment
  - approval of—707.01
  - combined with priority action—708.05
  - form of—707.03
  - may not be issued as first action in §66(a) application—707
  - objection to amendment of identification of goods/services—1402.07(e)
  - to enter standard character claim—707.02
  - when appropriate—707.01; 707.02
  - without prior authorization—707.02
- Examining attorneys’ appeal briefs (see Appeal briefs, examining attorneys’)
- Ex parte*, contacts with third parties regarding *ex parte* matters—1806
- Express abandonment of application—718.01
- “Express Mail,” filing of correspondence by—305.03
- Extension of protection of international registration to the United States (see *also*)
  - Registered extension of protection; Section 66(a)
    - affidavit of continued use or excusable nonuse—1613; 1904.11
    - affidavit of incontestability—1605.01; 1904.11
    - amendment to Supplemental Register not permitted—801.02(b); 815; 816.01; 816.04; 1904.02(c)
    - amendment of identification of goods/services—1402.01(c); 1609.01; 1904.02(b); 1906.01(i)
    - amendment of mark not permitted—807.13(b); 1609.02; 1904.02(g); 1906.01(i)
    - assignability of—501.01(b)
    - assignee, issuance of registration certificate in name of—502.02(b); 502.03
    - assignment of—501.01(b); 501.07; 502.01; 502.02(b); 502.03; 503.05; 503.03(a); 1904.06; 1906.01(a)-1906.01(a)(iii)
    - basis—806.01(e); 806.03(k); 1505.01(f); 1904.01(a)
    - cancellation of, by IB—1904.08
    - cannot be amended under §7—1609.01(a)
    - cannot be based on USPTO application—1904.01(h)
    - certificate of registration—1904.05
    - certificate of registration, issuance in name of new owner—502.02(b); 502.03
    - claim of acquired distinctiveness—1212.08
    - classification of goods and services—1401.03(d); 1403.02; 1403.02(b); 1403.02(c); 1505.01(b); 1609.04; 1904.02(b)
    - concurrent use registration permitted—1207.04(b)
    - constructive use—1904.01(g)
    - correction of errors—1906.01(f)
    - correspondence address—603.01(a); 1904.02(f)

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

declaration of intent to use required—804.06; 1904.01(c)  
dividing—1110.08; 1615.02  
drawing—202.10; 807.03(b); 807.03(g); 807.03(h); 807.07(b);  
807.12(c); 807.13(b)  
establishing right to take action—502.01  
examination of—1904.02-1904.02(h)  
express abandonment of—718.01  
filing basis—806.01(e); 806.03(k); 1505.01(f); 1904.01(a)  
filing date—201; 202; 203; 1904.01(b)  
filing fee—202.03; 810; 810.01; 1401.05(b); 1904.01(f)  
filing receipt—401.01  
identification of goods and services—1402.01(c); 1609.01;  
1904.02(b); 1906.01(i)  
incontestability, affidavit of—1605.01; 1904.11  
invalidation of—1904.07  
issuance of registration certificate in name of new owner—  
502.02(b); 502.03  
jurisdiction—1504.04; 1904.02(h)  
mark cannot be amended—807.13(b); 1609.02; 1904.02(g);  
1906.01(i)  
must be filed by holder of international registration—1201  
notice of refusal—1904.03-1904.03(e); 1904.04  
Office actions, issuing—1904.02(e)  
opposition—1503.01; 1503.06; 1504.02; 1504.05(a); 1904.04  
ownership, in general—501; 502; 1201; 1904.06  
ownership, change of—501.01(b); 501.07; 502.01; 502.02(b);  
502.03; 503.05; 503.03(a); 1904.06; 1906.01(a)-1906.01(a)(iii)  
priority claim—206.02; 1904.01(e)  
recording change of ownership—503.05; 1904.06; 1906.01(a)-  
1906.01(a)(iii)  
remains part of international registration—1904.05  
remand—1504.02; 1504.05(a)  
refusal of—711.02; 714.05(b); 1904.03; 1904.03(e); 1904.04  
renewal of—1602.01; 1606.01(b); 1614; 1905  
replacement—1616; 1904.12  
signature—804.04; 804.06; 1904.01(c)  
Supplemental Register, amendment to not a new issue—  
714.05(a)(i)  
Supplemental Register, not registrable on—801.02(b); 815;  
816.01; 816.04; 1904.02(c)  
transformation of—1904.09-1904.09(b)  
use not required—901; 1904.01(d)  
verification—804; 804.04; 804.06; 1904.01(c)  
Extension of time to file statement of use (see Request for extension of time to file  
statement of use)  
Extension of time to oppose—1503.04

## F

## INDEX

- Facsimile transmission, certificate of (see *also* Facsimile transmission, filing of correspondence by)
    - effect of—306.05(c)
    - eligible correspondence—306.01
    - non-receipt of correspondence by PTO—306.05(d)
    - not available for filing international applications—306.01
    - not available for filing requests for transformation—306.01
    - not available for filing requests to record changes to an international registration—306.01
    - not available for filing responses to IB notices of irregularities—306.01
    - not available for filing subsequent designations—306.01
    - not available for filing trademark applications—306.01
    - requirements for—306.05-306.05(c)
    - wording of certificate—306.05(b)
  - Facsimile transmission, filing of correspondence by (see *also* Facsimile transmission, certificate of)
    - documents excluded—306.01
    - documents included—306.01
    - effect of—306.03
    - not available for filing applications—306.01
    - procedure for—306.04; 306.05
  - False suggestion of connection—1203.03(e); 1203.03(f)
  - Fax copies of documents, filing of—302.01
  - Fax transmission (see Facsimile transmission)
  - Federal holiday, response period ending on—308
  - Fee(s)
    - for correcting irregularities in international application—1902.07(b)(i)
    - electronic funds transfer—405.05
    - for filing amendment to allege use—1104.09(g)
    - for filing application—202.03; 810-810.02; 1401.04; 1403.01; 1403.05(a)
    - for filing international application—1902.02(i)
    - for filing request for transformation—1904.09
    - for filing request to record changes to an international registration—1906.01(a)(i)
    - for filing subsequent designation—1902.08(c)
    - for filing multi-class application—810; 810.01; 1401.04; 1403.01; 1403.05(a)
    - for filing request for extension of time to file statement of use—1108.02(c)
    - for filing statement of use—1109.15
    - for recording document in Assignment Division—503.03(d)
    - for request to divide—1110.02
    - international, payment of—1903.02
    - number of—810; 810.01; 1401.04; 1403.01; 1403.05(a)
    - refund of (see Refund of fees)
    - refused by financial institution—405.06
    - returned check—202.03(a)-202.03(a)(i); 405.06; 1104.09(g); 1108.02(c); 1109.15(a); 1604.06(c); 1606.05(c)
  - Files, access to—109-109.03
  - Files, destruction of—109.02; 718.07
  - Files, electronic—109.03; 402-402.01
-

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### Filing basis

- abandonment of multi-basis application—806.02(d)
  - amendment after publication—806.03(j)-806.03(j)(ii); 1505.01(f)
  - amendment, effect on filing date—806.03(h); 806.04(b)
  - amendment from §1(a) to §1(b)—806.03(c)
  - amendment from §1(b) to §44—806.03(g)
  - amendment from §44 to §1(b)—806.03(d)
  - amendment of §66(a) basis not permitted—806.03(k); 1505.01(f); 1904.01(a)
  - amendment, verification of—806.02(e); 806.03(i)
  - bona fide intention to use mark in commerce—806.01(b)-806.01(d); 806.02(e); 807.02(g)
  - changing—806.03-806.03(k)
  - changing after publication—806.03(j)-806.03(j)(ii)
  - claim of priority under §44(d)—806.01(c); 806.02(f); 806.03(b); 806.04(b)
  - combining §1(a) and §1(b)—806.02(a); 806.02(b); 806.03(c)
  - combining §1 and §44—806.02(e); 806.02(f); 807.02(g); 806.03(d); 806.03(f); 806.04(b)
  - deletion of, in general—806.04
  - deletion of §1(b) basis—806.04-806.04(b)
  - extension of protection of international registration under §66(a)—806.01(e); 1904.01(a)
  - foreign registration under §44(e)—806.01(d); 806.02(e)
  - intent-to-use—806.01(b); 806.02(b); 806.03(c); 806.03(d); 806.03(e); 806.03(g); 806.04(a)
  - multiple—806.02-806.02(f)
  - must be stated in written application—806
  - requirements for establishing—806.01-806.01(d)
  - review prior to publication or issue—806.05
  - specimen, deferral of examination in multi-basis application—806.02(c)
  - use in commerce—806.01(a); 806.02(b); 806.03(c)
  - when basis can be changed—806.03(a)
- ### Filing date, application
- change of—204.03; 205; 1711
  - denial of—204-204.03; 1711
  - effective—206-206.02
  - in extension of protection of international registration—1904.01(b)
  - minimum requirements for—202
  - of §66(a) application—1904.01(b)
  - priority—206.02; 806.01(c); 1003-1003.02; 1003.05
  - request for restoration of—1711
  - requirements for receiving—202-202.03
  - restoration of—1711
  - review for compliance with minimum requirements—203
  - review of denial of—1711
  - section 66(a) application—1904.01(b)
  - what constitutes—201
- Filing date, for correspondence (in general)—205; 303.01; 304.04
- Filing date, for correspondence filed via electronic mail—304.04
- Filing date label—303.02(b)
- Filing fee, application—202.03; 810-810.02; 1403.01; 1403.05(a)

## INDEX

- in §66(a) application—202.03; 810; 810.01; 1904.01(f)
- varies depending on whether application filed on paper or through TEAS—202.03; 810; 1110.02; 1403.02(c)
- Filing of correspondence with USPTO—305.01
  - by courier or delivery service—307
  - by “Express Mail”—305.03
  - by fax (see Facsimile transmission, filing of certain papers and fee authorizations by)
  - by hand delivery—307
  - by mail—305-305.03
  - by unauthorized individual—602.03
  - certificate of mailing procedure for (see Certificate of mailing procedure)
  - certificate of transmission procedure for (See Facsimile transmission, certificate of)
  - time between execution and—804.03; 1104.09(b); 1108.02(b); 1109.05(a); 1109.11(c)
- Filing of correspondence with International Bureau—1906-1906.01(i)
- Filing receipt—401.01
- Final refusal
  - action after—715-715.04
  - for failure to provide information requested by examining attorney—814
  - issuance of, after removal of application from suspension—716.06
  - new issues requiring issuance of non-final action—714.05-714.05(c); 715.03(b)
  - not permissible on first action—714.01
  - not permissible on suspension—714.02
  - pertaining to identification—714.05(a)(ii)
  - pertaining to proposed amendment of drawing—807.17
  - premature—714.06
  - proper response to—715.01
  - request for reconsideration after—715.03-715.03(c); 1714.01(a); 1714.01(f)(ii)
  - statement of grounds of—714.04
  - when appropriate—714.03; 714.05-714.05(c)
  - with respect to §2(f) claim—714.05(a)(i); 1212.02(h)
- “Firm”—803.02(b)
- Flag, refusal to register mark comprising—1204
- Foreign applicant
  - common terms designating entity of—803.03(i)
  - signature on behalf of—712.01(a)(v); 804.04
- Foreign equivalents, doctrine of—1207.01(b)(vi); 1209.03(g)
- Foreign priority (see Priority under §44(d), application claiming)
- Foreign registration, application based on ownership of
  - assignment of home country application or registration—1006
  - bona fide intention to use mark in commerce —806.01(d); 806.02(e); 807.02(g); 1004; 1008
  - certification or certified copy of foreign registration required—806.01(d); 1004.01
  - drawing—807.03(f); 807.12(b); 1011-1011.03
  - establishing entitlement under a treaty—1002.01; 1002.03
  - from applicant’s country of origin—1002.04

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

identification of goods/services—1012; 1402.01(b)  
international registration as basis for §44 application—1016  
may not be filed before foreign registration has issued—1004  
must be in force—1004.01(a)  
ownership of foreign registration—1005  
requirements for receiving a filing date—202-202.03  
requirements for §44(e) basis—806.01(d)  
specimen not required—1009  
standard character claim in—807.03(f); 1011.01  
status of foreign registration  
suspension pending receipt of copy of foreign registration not permitted except in  
extraordinary situation—1004.01  
translation of —1004.01(b)  
use not required—1009  
“Foreign” commerce—903.03  
Form paragraphs—705; 705.01  
Forms, trademark—103; 301  
Fragrance as mark—807.09; 1202.13  
Franchisees, use of mark by—1201.03(f)  
Fraud—720  
Freedom of Information Act requests—1803  
for copies of letters of protest—1715.07  
Functionality—1202.02(a)-1202.02(a)(v)(C)

### G

Generic terms—1209.01(c)-1209.01(c)(iii); 1215.05  
Geographic terms  
“America” and “American”—1210.02(b)(iv)  
arbitrary use of—1210.04(d)  
as certification marks—1210.09; 1306.02-1306.02(c)  
combined with additional matter—1210.02(c)-1210.02(c)(iii); 1210.06-1210.06(b)  
combined with domain name—1215.06  
disclaimer of—1210.06(a); 1210.06(b); 1210.06(b)  
goods/place association—1210.04; 1210.04(a)  
misleading indication of origin of wines/spirits—1210.08  
more than one location with same name—1210.02(b)(ii)  
non-geographic characteristics—1210.02(b)(iii)  
obscure or remote—1210.04(c)  
origin of goods or services—1210.03  
other meanings—1210.02(b)(i)  
registrability on Supplemental Register—1210.07(a)  
registrability under §2(f)—1210.07(b)  
registration of, under §2(f)—1210.07(b)  
services/place association—1210.04; 1210.04(b)  
two geographic terms combined—1210.02(c)(i)  
used as certification mark to designate regional origin—1306.02  
with surname significance—1210.02(b)(i)(A)  
Geographical marks, deceptive (See *also* Geographically deceptively misdescriptive  
marks)—1203.02(a); 1210.01(b); 1210.01(c); 1210.05-1210.05(b)(ii)

## INDEX

- basis for refusal—1210.04(a)
- disclaimer—1210.06(b)
- materiality of deception—1210.05(b)-1210.05(b)(ii)
- registrability on Supplemental Register—1210.07(a)
- registrability under §2(f)—1210.07(b)
- test—1210.01(c)
- used on wines and spirits—1210.08
- Geographically deceptively misdescriptive marks (*See also* Geographical marks, deceptively)—1210.01(b); 1210.05(a)-1210.05(b)(ii); 1210.06(b)
  - basis for refusal—1210.04(a)
  - disclaimer—1210.06(b)
  - materiality of deception—1210.05(b)-1210.05(b)(ii)
  - registrability on Supplemental Register—1210.07(a)
  - registrability under §2(f)—1210.07(b)
  - test—1210.01(b)
- Geographically descriptive marks—1210.01(a); 1210-1210.09
  - disclaimer—1210.06(a)
  - registrability on Supplemental Register—1210.07(a)
  - registrability under §2(f)—1210.07(b)
  - test—1210.01(a)
- Geometric shapes—1202.11
- Good cause, showing of, in request for second or subsequent extension of time to file statement of use—1108.02(f)
- Goods (*see* Identification of goods/services; Classification of goods/services)
- Goods/place association—1210.04-1210.04(d)
- Goods in trade—1202.06-1202.06(c)
- Governmental body as owner of mark—803.03(f)
- Grade designation—1202.10
- Gray tones in drawings—807.07(e)

## H

- Hague convention—804.01(a)(i)
- Hand delivery of correspondence to USPTO—307
- Heading or caption for papers—302.03(a); 302.03(b)
- Holiday (*see* Federal holiday, response period ending on)
- Hologram—807.01; 1202.14
- House mark—1402.03(b)

## I

- Identification of goods/services
  - accuracy of—1402.05
  - ambiguous—1402.07(b)
  - amendment permitted to clarify or limit—1402.06-1402.06(b)
  - amendment of portion—1402.13
  - association services—1402.11(c)
  - broad terms in—1402.03; 1402.03(a)
  - certification mark—1306.06(f)



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

charitable services—1402.11(d)  
clarification of—1402.06-1402.06(b)  
components or ingredients—1402.05(a)  
computer programs—1402.03(d)  
computer services—1402.11(a)  
consulting services—1402.11(e)  
deletion of items from—1104.09(c); 1107; 1108.02(d); 1109.13; 1402.06(a)  
entitlement to filing date with respect to—202.02; 1402.02  
final refusal pertaining to—714.05(a)(ii)  
“full line of”—1402.03(c)  
house mark—1402.03(b)  
identical language in more than one class not permitted—1401.07  
in amendment to allege use—1104.09(c)  
in international application—1902.02(f)  
in response to IB notice of irregularity—1902.07(c)(ii)  
inappropriate in collective membership mark application—1304.09(b)  
inclusive terminology in—1402.03(a)  
in request for extension of time to file statement of use—1108.02(d)  
in §44 application may not exceed scope of those in foreign registration—1012  
in §66(a) application—1402.01(c); 1904.02(b)  
in statement of use—1109.13  
limitation of—1402.06(a)  
location of—1402.01(d)  
moving goods/services between companion applications—1402.08  
negative language in—1402.06(a)  
online publications—1402.11(a)  
“ordinary meaning” test for determining scope of—1402.07(a)  
parenthesis and brackets should not be used in—1402.12  
printed publications—1402.03(e); 1402.11(a)  
required for application to receive a filing date—202.02; 1402.02  
services—1402.11  
scope of, for amendment purposes—1402.07; 1402.07(e)  
specificity of terms in—1402.03; 1402.03(e)  
trademarks/service marks inappropriate in—1402.09  
unambiguous—1402.07(c)  
Immoral or scandalous matter—1203.01  
Improper use of registration notice—906.02  
Inadvertently issued registration—1109.15(a); 1503.01; 1609.10(a)  
Incomplete application materials—204-204.03  
Incomplete response to Office action—718.03-718.03(c); 1713; 1714.01(f)(ii)  
Incontestability  
    affidavit of (§15) (*see* Affidavit of incontestability)  
    effect in examination—1216.02  
Indexing against recorded document not permitted—503.07  
Individual as applicant  
    citizenship of—803.04  
    doing business under assumed name—803.02; 803.02(a); 803.02(c)  
    name of—803.02(a)  
Individual, living—813; 1206.02; 1206.03-1206.03(b)  
Individuals who may practice before Office in trademark matters—602

## INDEX

Informal application materials—204-204.03  
Information, examining attorney's request for—814  
Informational matter  
    as mark—1202.04; 1301.02(a)  
    on drawing, deletion of—807.14(a)  
Initial examination to be complete—704.01; 1102-1102.04  
Inquiry  
    by examining attorney—814  
    from Congressional office—1802  
    from member of press—1804  
    from third party regarding *ex parte* matter—1806  
    general inquiries from public—1805  
    letter of, with respect to suspended application—716.05  
    regarding status of pending matters—108-108.03; 1705.05  
Insignia, refusal to register mark comprising—1204  
Inspection of files on Office premises—109  
"Insurance" extension of time to file statement of use—1108.03-1108.03(a)  
Intent-to-use applications (see *also* Amendment to allege use; Notice of allowance;  
    Request for extension of time to file statement of use; Statement of use)  
    allegation of use required prior to registration—1103  
    assignment of—501.01(a)  
    distinctiveness under §2(f)—1102.04; 1212.09; 1212.09(b)  
    initial examination of:  
        color marks—1202.05(h)  
        configuration—1202.02(e)  
        drawings—1102.02; 1104.09(f); 1109.12  
        for use as mark—704.01; 1102-1102.04  
        identification of goods/services—1104.09(c); 1108.02(d); 1109.13  
        ornamentation—1202.03(e)  
        publication of—1105  
        under §2(d)—1102.01  
        under §§1, 2(a), 2(b), 2(c), 2(e)—1102.01  
        statutory averments—804.02; 806.01(b); 1101  
        Supplemental Register—1102.03  
Inter-American Convention—1001; App. B  
Interference, petition to declare—1208.03-1208.03(c); 1507  
"Internal inconsistencies," amendment of drawing to cure not permitted—807.14(c)  
International Alphabetical List—1401.02(c)  
International applications for registration—1902-1902.07(f)  
    classification in—1902.02(g)-1902.02(g)(iii)  
    fee for—1902.02(i)  
    form for filing—1902.02(a)  
    irregularities in—1902.07  
    requirements for receipt in USPTO—1902.02  
    requirements for registration by IB—1902.05  
    certification of—1902.03  
International Bureau—1900 (introductory text)  
International fees—1903.02

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

International registrations—1901  
    application for—1902-1902.07(f)  
    as basis for §44 application—1016  
    cancellation of, by International Bureau—1904.08  
    central attack—1902.09  
    changes to—1906.01-1906.01(i)  
    date of—1902.04  
    in general—1901  
    invalidation—1904.07  
renewal of—1905  
International trademark agreements—1001; App. B  
Internet domain names, marks comprising—1209.03(m); 1215-1215.10  
Internet, evidence from—710.01(b)  
Interview with applicant or attorney—709-709.06

### J

Joint applicants  
    application by—803.03(d)  
    signature by—712.01(a)(i); 804.04  
Joint venture  
    name of—803.03(b)  
    setting forth names and citizenship of joint venturers—803.03(b)  
    signature by—712.01(a)(iii); 804.04  
    state or country of organization—803.03(b)  
Jurisdiction over application—1504-1504.05(a); 1904.02(h)  
Jurisdiction, request for—1504.04(a)  
Juristic person—803.01

### L

Lanham Act (see Trademark Act of 1946)  
Laudatory terms in marks—1209.03(k)  
Legal advice, Office cannot render—108.02; 1801; 1805  
Legal entity of applicant set forth in application—803.03; 803.03(i)  
Letter of inquiry with respect to suspended application—716.05  
Letter of protest in pending application (see Protest)  
Letterhead stationery as specimen of service mark use—1301.04(c)  
License agreements, recording of—503.02; 1906.01(h)  
Licensees, use of mark by—1201.03(f)  
Likelihood of confusion  
    actual confusion unnecessary—1207.01(d)(ii)  
    attack on registration improper in *ex parte* proceeding—1207.01(d)(iv)  
    between collective and other marks—1304.08(b)  
    classification not relevant—1207.01(d)(v)  
    consent between parties—1207.01(d)(viii)  
    design marks—1207.01(c)-1207.01(c)(iii)  
    doubt resolved in registrant's favor—1207.01(d)(i)  
    famous mark—1207.01(d)(x)  
    foreign equivalents—1207.01(b)(vi)

## INDEX

legal equivalents—1207.01(c)(i)  
meaning, similarity in—1207.01(b)(v)  
no per se rule—1207.01(a)(iv)  
parody marks—1207.01(b)(x)  
past decisions of examining attorneys—1207.01(d)(vi); 1216-1216.02  
related companies and—1201.07-1201.07(b)(iv)  
relatedness of goods and/or services—1207.01(a)-1207.01(a)(vi)  
reliance on identification of goods/services in application/registration—  
1207.01(a)(iii)  
sophisticated purchasers—1207.01(d)(vii)  
sound, similarity in—1207.01(b)(iv)  
similarity of marks—1207.01(b)-1207.01(b)(x)  
third-party registrations—1207.01(d)(iii)  
transposition of terms—1207.01(b)(vii)  
weak marks—1207.01(b)(ix)  
Limited liability company—803.03(h)  
signature by—712.01(a)(vii); 804.04  
Lining statement—808.01(d)  
Living individual—813; 1206.02; 1206.03-1206.03(b)  
Loss of papers—305.02(f); 305.03; 1711; 1712.01; 1712.02

## M

Madrid Protocol (*See also* Extension of protection of international registration to the United States; Registered extension of protection; §66(a) application)—  
Chapter 1900  
Mail sent to USPTO related to trademarks—302.03(a); 302.03(b)  
Manner of use of mark (*see* Method-of-use)  
Mark drawing code—807.18  
Material alteration —807.03(d); 807.14 - 807.14(d); 1604.13; 1609.02(a)  
Material difference between mark on drawing and mark in foreign registration—  
807.12(a); 807.12(b); 1011.01  
Meaning of term in mark, inquiry as to—808.01(c); 814  
Membership mark (*see* Collective membership mark)  
Mere descriptiveness (*see* Descriptiveness, mere)  
Merger, documents of—503.02  
Method-of-use —905  
Minor as applicant—803.01  
“Misspelled” words—1209.03(j); 1213.08(c)  
Mistake in applicant’s name, correction of—1201.02(c)  
Mistake in registration, correction of—1609.10-1609.10(b)  
Model, style or grade designation—1202.10  
More than one mark—202.01; 807.01  
Motion, drawing of marks with—807.11  
Moving goods/services between companion applications—1402.08  
Multiple-class application (*see* Combined application)  
Multiple copies of papers should not be filed—302.02  
Multiple drawings—202.01; 807.01  
Multiple filing bases—806.02-806.02(f)

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Musical performer/group names—1202.09; 1202.09(a); 1301.02(b)  
“Mutilation” of mark—807.12(d)

### N

NAFTA (see North American Free Trade Agreement)  
Name of applicant, correcting mistake in—1201.02(c)  
Names of artists and authors as marks—1202.09; 1202.09(a); 1206.01; 1301.02(b)  
Name, portrait or signature as mark—813; 1206.01  
National Archives and Records Administration—503.08  
National symbols—1203.03; 1203.03(b); 1203.03(c); 1203.03(d)  
Negative identification language—1402.06(a)  
New certificate of registration, issuance to assignee—502.03  
Non-English wording in mark, translation of—809-809.02(a)  
Non-Latin characters in mark, transliteration of—809-809.02(a)  
Non-lawyers—602; 707.01; 708.02; 712.01  
Non-profit corporation—803.03(c)  
Non-receipt of examining attorney’s Office action—717.02  
Non-responsive communications—719  
Nonuse of registered mark—1604.11  
Non-visual marks—807.09  
North American Free Trade Agreement (NAFTA)—1210; 1210.01(b); 1210.05(a);  
1210.07(a); 1210.07(b); 1211; 1212; 1212.02(a)  
Notice of abandonment—718.04; 718.06  
Notice of allowance—1106-1106.04  
    action after issuance of (but before filing of Statement of use)—806.03(j)(ii);  
    1106.02; 1107  
    cancellation of—1106.03  
    correction of errors in —1106.04  
    information printed on—1106.01  
    issuance of—1106.01  
    non-receipt of—1714.01(c)  
“Notice of incomplete trademark application”—204.01  
Notice of irregularity of international application for registration, issued by the  
    International Bureau—1902.07-1902.07(f)  
Notice of publication—704.01  
Notice, registration (see Registration notice)  
Number of specimens—904.01

### O

Office action (see also Action by examining attorney; Response to Office action;  
    Provisional refusal)  
    non-receipt of—717.02  
    preparation of—705-705.08  
    remailing of—717  
    response period—310; 711-711.02  
    returned as undeliverable —403; 717.01  
“Office Date” label—303.02(b)  
Office personnel

## INDEX

- not to express opinion on validity of registered mark—1801
- not to give legal advice—108.02
- not to testify—1801.01
- Official Gazette (see also Trademark Official Gazette)—106; 1502; 1502.01
- Old drawing, use in new application—807.19
- “Olympic” and other designations protected under Amateur Sports Act of 1978—  
1205.01
- One mark, application limited to—202.01; 807.01
- Operating divisions—803.01
- Opinion, Office personnel not to express—108.02; 1801
- Opposition—1503-1503.06
  - extension of time to file—1503.04
  - to §66(a) application—1503.06
- Order of examination—702.01
- Order of work—702-702.02
- Ordering abandoned application files—109.02; 718.07
- Original document, filing of—302.01; 503.08
- Ornamentation—1202.03-1202.03(g)
- Owner of mark is proper party to apply—803.01; 1201
- Ownership of application or registration—1201-1201.07
  - change of—501-501.06
  - establishing—502-502.03
  - recording change—503-503.05
  - §66(a) application—501.07; 502.02(b); 1904.06
- Ownership of mark (see *also* Assignment; Applicant; Related Company; Ownership  
of application or registration)
  - automatic updating—504-504.05
  - change in, after application filed—501-501.06
  - inquiry by examining attorney with respect to—1201.04
  - refusal on basis of—1201.02(b)
  - related-company use—1201.03-1201.03(f)

## P

- Papers not returnable—404
- Paris Convention—1001; 1002.03; 1002.04; 1205.01
  - article 6<sup>ter</sup>—1205.02
- Partial abandonment—718.02(a); 1402.13; 1403.05; 1904.03(d)
- Partial assignment—501.06; 1110.08; 1615
- Partners, setting forth names and citizenship of—803.03(b)
- Partnership
  - address of—803.05
  - name of—803.02; 803.03(b)
  - signature by—712.01(a)(ii); 804.04
  - state or country of organization—803.02(b); 803.04
- Patent and Trademark Depository Libraries—112
- Payment refused or charged back by financial institution—405.06
- Period for response
  - ending on Saturday, Sunday or federal holiday—308

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- how computed—310
- may run from date of previous action—711.01
- reset in examining attorney's letter correcting error—711.02
- statutory—711
- Petition decisions available to public—110
- Petition from examining attorney's holding of abandonment—1713
- Petition to cancel—1607
- Petition to Director —1702; 1703; 1704; 1705-1705.09; 1706; 1707; 1708
  - after refusal of §8 affidavit—1604.18-1604.18(c);
  - after refusal of renewal—1606.14; 1606.14(c)
  - appeal to federal court from—1705.09
  - delegation of—1709
  - diligence—1705.05
  - evidence and proof of facts—1705.03
  - fee for—1705.02
  - petitionable matter—1704
  - procedure for—1705-1705.09
  - request for reconsideration of denial of—1705.08
  - signature of—1705.07
  - standard of review on—1706
  - standing—1705.01
  - stay of deadlines pending disposition of—1705.06
  - supervisory authority—1707
  - timeliness—1705.04
  - to amend basis after publication—806.03(j)-806.03(j)(ii)
  - to make special (see Petition to make "special")
  - to reinstate abandoned applications—1712.01
  - to reinstate cancelled registrations—1712.02
  - to reverse examining attorney's holding of abandonment—1713
  - to review denial of certification of international application—1902.03(a)
  - to review denial of filing date—1711
  - to revive (see Petition to revive)
  - to waive rules—1708
  - types of—1703
- Petition to make "special"—1710-1710.02
  - basis for granting or denying—1710.01
  - fee for—1710
  - handling of—1710.02
  - must state facts justifying special action—1710.01
  - routing of—1710
- Petition to revive abandoned application (see *a/so* Unintentional delay)
  - basis for granting—1714.01(e)
  - diligence with respect to—1705.05; 1714.01(d)
  - fee for—1710
  - request for reconsideration of denial of—1714.01(g)
  - requirements for filing—1714.01-1714.01(e)
  - time for filing of—1714.01(d)
  - unintentional delay, statement of—1714.01(e)
  - unintentional delay, where unintentional delay applies—1714.01(f)-1714.01(f)(ii)
- Petitionable matter—1704

## INDEX

- “Phantom” elements in marks—807.01; 1214-1214.04
- Photocopies of documents, when acceptable for filing—302.01
- Piecemeal action to be avoided—704.01
- Portrait as mark —813; 1206
- Postal Service, U.S., interruptions of—305.04
- Postcard, acknowledgment—303.02(c)-303.02(c)(i)
- Power of attorney—602.01-602.01(c)
  - associate—602.01(b)
  - change of —602.01(b); 602.04; 603.02(a)
  - filed after registration—602.01(c); 1612
  - relating to multiple application or registration—602.01(a)
  - revocation—602.04
- Practice before Office in trademark matters—602
- Predecessor in title, first use of mark by—903.06
- Preparation of case for publication or registration—817
- President of United States, deceased—1206.02; 1206.03
- Press, inquiries from members of—1804
- Previous examining attorney, examination approach of—713.01
- Principal Register
  - advantages of registration on—801.02(a)
  - applications for registration on—801.02(a)
  - registration on Supplemental Register may not be amended to—1609.09
- Printing of information in *Official Gazette* and on registration certificate—817
- Prior registrations of applicant
  - effect of—1216-1216.02
  - identification of, in application—812
  - “incontestability”—1216.02
  - not controlling—1216.01
  - printing of claim of—812; 817
  - proving ownership of—812.01
  - refusal under §2(d) with respect to—812.01
- Prior trademark acts (see *also* Act of 1881; Act of 1905; Act of 1920)
  - registrations issued under—1601.04; 1601.05; 1602.02; 1602.03
  - repeal of—1601.02
  - reregistration of marks registered under—1601.03
- Priority action
  - combined with examiner’s amendment—708.05
  - defined—708.01
  - elements of—708.01
  - form of—708.03
  - when appropriate—708.02
- Priority, constructive use—201.02
- Priority for publication or issue based on effective filing date—201.01; 1003.05
- Priority claim in application for international registration—1902.05
- Priority claim in request for protection of international registration to the United States—206.02; 1904.01(e)
- Priority claim in §44(d) application
  - abandonment of foreign application—1003.08



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- amendment of basis, priority filing date retained—806.03(h); 806.04(b)
- assignment of §44(d) application—1006
- basis for registration required—1003.03
- bona fide intention to use mark in commerce must be asserted—806.01(c);  
806.02(e); 1003; 1008
- combined with other bases—806.02(f)
- effect of failing to file within six months—1003.02
- effective filing date of—206.02; 1003.05
- eligible applicants—1002.02
- establishing entitlement under a treaty—1002.02; 1002.03; 1002.04
- “first-filed” requirement—1003.01
- identification of goods/services—1012; 1402.01(b)
- may also rely on §44(e)—1003.06
- more than one foreign application—1003.07
- must be filed within six months of foreign filing—806.03(b); 1003.02
- not limited to country of origin—1002.04
- ownership of foreign application—1005
- priority for publication of—201.01; 1003.05
- requirements for §44(d) filing basis—806.01(c)
- retention of priority filing date without perfect §44(e) basis—806.04(b); 806.03(h)
- requirements for receiving a filing date—202
- suspension pending receipt of foreign registration—716.02(b); 1003.04
- use not required—1009
- valid basis for registration in United States required—1003.03
- Process, system or method—1301.02(e)
- Protest, Letter of—1715-1715.07
  - adversarial arguments inappropriate —1715.01
  - appropriate subjects to be raised—1715.01-1715.01(b)
  - approval of application for publication after grant of—1715.05
  - does not extend opposition period—1715.03(b)
  - filed after publication—1715.03
  - filed after registration—1715.03(a)
  - filed before publication—1715.02
  - petition to review denial of—1715.06
  - recourse after denial of—1715.06
  - requests for copies of—1715.07
  - timely filing of—1715.03(a)
- Provisional refusal of 66(a) applications—1904.02(e); 1904.03
- PTDL (see Patent and Trademark Depository Libraries)
- Publication for opposition
  - amendments after—806.03(j)-806.03(j)(ii); 1505-1505.02(d)
  - notice of—704.01
  - of mark in intent-to-use application—1105
- Publications, marks for
  - columns or sections, marks that identify—1202.07-1202.07(b)
  - identification of goods—1402.03(e)
  - specimens for—904.02(d)

## R

## INDEX

- Reasonable time between signing and filing papers—804.03; 1104.09(b);  
1108.02(b); 1109.05(a); 1109.11(c)
- Receipt date placed on all correspondence filed—303.02(b)
- Receipt, filing—401.01
- Receipt, of documents by Office—303-303.02(c)
- Receipt, postcard—303.02(c)
- Reciprocal registration rights—1002.03
- Reconsideration after final action—715.03-715.03(c)
- Reconsideration of Board decision, request for, by examining attorney—1501.07
- Reconsideration of holding of abandonment—718.03(c)
- Reconsideration of decision on petition—1705.08
- Recordation date—503.05
- Recorded documents (see also Assignment, recordation of)
  - correction of errors—503.06-503.06(f)
  - effect of—503.01
  - indexing against, not permitted—503.07
  - original documents should not be submitted for recording—503.03(b)
  - requests for copies of—503.08
  - requirements—503.03-503.04
  - searching—104; 503.08
- Refund of fees—405.04
  - for informal application—204.01
- Refusal, final (see Final refusal)
- Refusal of registration
  - amendment to Supplemental Register after—714.05(a)(i); 816.04; 1209.02
  - as to fewer than all classes in combined application—1403.05
  - based on inadequate response to request for additional information—814
  - deceptive matter—1203.02-1203.02(b); 1210.05(a)-1210.05(b)(ii); 1210.06(b)
  - descriptiveness—1209.02
  - disparagement—1203.03(c); 1203.03(d)
  - duplicate registrations—703
  - false suggestion of a connection—1203.03(e); 1203.03(f)
  - flag, coat of arms or insignia—1204
  - functionality—1202.02(a)-1202.02(a)(v)(C)
  - generic names—1209.01(c)-1209.01(c)(iii)
  - geographic descriptiveness—1210-1210.09
  - geographic misdescriptiveness—1210.01(b); 1210.05(a)-1210.05(b)(ii);  
1210.06(b)
  - immoral or scandalous matter—1203.01
  - in §66(a) application—711.02; 714.05(b); 1904.03; 1904.03(e); 1904.04
  - likelihood of confusion (see *also* Likelihood of confusion)—1207-1207.03
  - matter protected by statute—1205-1205.02
  - name, portrait or signature of living individual or deceased United States  
president without consent—813; 1206-1206.03(b)
  - nondistinctive configuration—1202.02(b)-1202.02(b)(ii)
  - of request for extension of protection of international registration—711.02;  
714.05(b); 1904.03; 1904.03(e); 1904.04
  - ornamentation—1202.03-1202.03(g)

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

ownership (see Ownership of mark)  
res judicata—1217  
surname, primarily merely a—1211-1211.02(b)(vi)  
trade name—1202.01  
use as a service mark—1301.02-1301.02(e)  
use as a trademark—1202-1202.15  
use in commerce—901.04  
Register (see Principal Register; Supplemental Register)  
Register indicated on certificate of registration—1601.07  
Registered extension of protection of international registration to the United States  
(See *also* Extension of protection of international registration to the United States; Section 66(a))  
affidavit of continued use or excusable nonuse—1613; 1904.11  
affidavit of incontestability—1605.01; 1904.11  
amendment of identification of goods/services—1609.01;  
1904.02(b); 1906.01(i)  
amendment of mark not permitted—1609.02; 1904.02(g);  
1906.01(i)  
assignability of—501.01(b)  
assignee, issuance of registration certificate in name of—503  
assignment of—501.01(b); 501.07; 502.01; 502.03; 503.05;  
503.03(a); 1904.06; 1906.01(a)-1906.01(a)(iii)  
cancellation of, by IB—1904.08  
cannot be amended under §7—1609.01(a)  
certificate of registration—1904.05  
certificate of registration, issuance in name of new owner—502.03  
classification of goods and services—1609.04; 1904.02(b)  
constructive use—1904.01(g)  
correction of errors—1906.01(f)  
dividing—1615.02  
establishing right to take action—502.01  
identification of goods and services—1609.01; 1904.02(b);  
1906.01(i)  
incontestability, affidavit of—1605.01; 1904.11  
invalidation of—1904.07  
issuance of registration certificate in name of new owner—502.03  
jurisdiction—1504.04; 1904.02(h)  
mark cannot be amended—1609.02; 1904.02(g); 1906.01(i)  
ownership, in general—501; 502; 1201; 1904.06  
ownership, change of—501.01(b); 501.07; 502.01; 502.03;  
503.05; 503.03(a); 1904.06; 1906.01(a)-1906.01(a)(iii)  
recording change of ownership—503.05; 1904.06; 1906.01(a)-  
1906.01(a)(iii)  
remains part of international registration—1904.05  
renewal of—1602.01; 1606.01(b); 1614; 1905  
replacement—1616; 1904.12  
transformation of—1904.09-1904.09(b)  
Registration, amendment of mark in—1609.02-1609.02(c)  
Registration as correct type of mark—1307  
Registration certificate (see Certificate of registration)

## INDEX

- Registration, division of—1615-1615.02
- Registration notice
  - improper use of—906.02
  - provided for in 15 U.S.C. §1111—906
  - symbolizing foreign registration—906.01
- Registration, reinstatement of registration cancelled or expired due to Office error—1712.02
- Reinstatement of inadvertently abandoned application—1712.01
- Reinstatement of registrations cancelled or expired due to Office error—1712.02
- Related applications (see also Companion applications; Conflicting applications)—702.03-702.03(b)
- Related company
  - common stockholders, directors, officers—1201.03(d)
  - control with respect to use by—1201.03
  - definition of—1201.03
  - first use of mark by—903.06
  - licensees and franchisees—1201.03(f)
  - reference to, in §1(b) applicant—1201.03(a)
  - sister corporations—1201.03(e)
  - use by—903.06; 1201.03-1201.03(f)
  - use solely by—1201.03(a)
  - wholly-owned—1201.03(c)
- Remailing of Office action—717-717.02
- Remand to examining attorney from Trademark Trial and Appeal Board—1504.05; 1504.05(a)
- Renewal (*see also* Renewal, application for)
  - of international registrations—1602.01; 1606.01(b); 1614; 1905
  - of registered extension of protection—1602.01; 1606.01(b); 1614; 1905
  - of registrations issued under Act of 1920—1602.03; 1606-1606.15
  - of registrations issued under Act of 1946—1606-1606.15
  - of registrations issued under Acts of 1881 and 1905—1602.02; 1606-1606.15
- Renewal, application for—1606-1606.15
  - appeal to federal court—1606.15
  - by owner of international registration—1602.01; 1606.01(b); 1614; 1905
  - by registrant not domiciled in United States—1606.10
  - combined with §8 affidavit—1606.16
  - deficiencies, correction of—1606.05(b); 1606.13-1606.13(c)
  - domestic representative, designation of —1606.10
  - execution of—1606.07
  - fee for filing—1606.05-1606.05(c)
  - form for filing—1606.04
  - goods and services set forth in—1606.08-1606.08(d)
  - grace period—1606.05(b); 1606.03
  - Office action upon examination of—1606.11
  - ownership and who may file—1606.06
  - petition to Director—1606.14-1606.14(c)
  - premature filing of—1606.03(a)
  - recourse after refusal—1606.14-1606.14(c)

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- requirements for—1606.04
- signature of—1606.07
- specimen not required—1606.09
- term of—1602-1602.03
- time for filing—1606.03; 1606.03(a)
- untimely filing cannot be cured—1712.02; 1606.13(c)
- use, declaration of use not required—1606.09
- who may file—1606.06
- Repeal of prior trademark acts—1601.02
- Replacement—1616; 1904.12
- Reply brief in *ex parte* appeal—1501.02(a)
- Representation by attorney or other authorized individual—602
- Reproduction of mark (See Drawing)
- Request for extension of protection of international registration to the United States  
(See Extension of protection of international registration to the United States;  
Registered extension of protection of international registration to the United  
States; Section 66(a))
- Request for extension of time to file statement of use—1108-1108.05
  - bona fide intention to use the mark in commerce—1101; 1108.02(e)
  - fee for filing—1108.02(c)
  - filing in conjunction with or after statement of use—1108.03-1108.03(a)
  - form for filing—1108
  - good cause for—1108.02(f)
  - identifying goods/services in—1108.02(d)
  - minimum filing requirements—1108.04
  - ownership—1108.02(a)
  - recourse after denial—1108.04; 1108.05
  - requirements (of 37 C.F.R. §2.89) for—1108.02-1108.02(f)
  - time for filing—1108.01
  - verification—1108.02(b)
- Request for extension of time to oppose—1503.04
- Request for information from applicant—814
- Request to divide —1110-1110.07
  - division of application—1110-1110.07
  - division of application subject to Board proceeding—1110.06
  - division of application under §44—1110.07
  - division of application under §66(a)—1110.08
  - division of multiple class application—1110.05; 1403.03
  - division of registration—1613
  - fee for—1110.02
  - time for filing—1110.01
  - when statement of use is due—1110.04
  - when response to Office action is due—1110.05
- Reregistration of marks registered under prior acts—1601.03
- Res judicata—1217
- Resignation of examining attorney—702.01
- Response to IB notice of irregularity of international application for registration—  
1902.07; 1902.07(f)
- Response to Office action
  - deadline for—310; 711-711.02

## INDEX

persons who can sign—712.01-712.01(a)(vii)  
signature of—712-712.01(a)(vii)  
signed by unauthorized party—602.03; 712.03  
unsigned—712.02  
Restoration of filing date—1711  
Restriction of holder's right to dispose of international registration—1906.01(b)  
Return of application materials not entitled to a filing date—204.01  
Returned correspondence—403; 717.01  
Revival (see Petition to revive abandoned application)  
Revocation of power of attorney—602.04

## S

Scandalous matter (see Immoral or scandalous matter)  
Scent as mark—807.09; 1202.13  
Scope of identification of goods/services for purposes of amendment—1402.07-1402.07(e)  
Search, by examining attorney—704.02; 718.08  
"Search clause"—704.02  
Search library, trademark—104  
Search of trademark applications and registrations—104  
Search room, trademark assignment—104; 503.08  
Secondary meaning (see Acquired distinctiveness (§2(f)) claim)  
Secondary source—1202.03(c)  
Section 2(f) claim (see Acquired distinctiveness (§2(f)) claim)  
Section 8 affidavit (see Affidavit of continued use or excusable nonuse (§8))  
Section 15 affidavit (see Affidavit of incontestability)  
Section 44 (see *also* Foreign registration, application based on ownership of; Priority under §44(d), application claiming)  
    applications for Supplemental Register under—1014  
    assignment of applications under—1006  
    claim of acquired distinctiveness in application under—1010  
    eligible applicants, under—1002-1002.05  
    international trademark agreements implemented by—1001  
    sections of publications, marks that identify—1202.07-1202.07(b)  
Section 66(a) application (see *also* Extension of protection of international registration to the United States; Registered extension of protection of international registration to the United States)  
    amendment to Supplemental Register not permitted—801.02(b); 815; 816.01; 816.04; 1904.02(c)  
    amendment of identification of goods/services—1402.01(c); 1609.01; 1904.02(b); 1906.01(i)  
    amendment of mark not permitted—807.13(b); 1904.02(g); 1906.01(i)  
    assignability of—501.01(b)  
    assignee, issuance of registration certificate in name of—502.02(b)  
    assignment of—501.01(b); 501.07; 502.01; 502.02(b); 503.05; 503.03(a); 1904.06; 1906.01(a)-1906.01(a)(iii)

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

basis—806.01(e); 806.03(k); 1505.01(f); 1904.01(a)  
cancellation of, by IB—1904.08  
cannot be based on USPTO application—1904.01(h)  
certificate of registration—1904.05  
certificate of registration, issuance in name of new owner—  
502.02(b)  
claim of acquired distinctiveness—1212.08  
classification of goods and services—1401.03(d); 1403.02;  
1403.02(b); 1403.02(c); 1505.01(b); 1904.02(b)  
concurrent use registration permitted—1207.04(b)  
constructive use—1904.01(g)  
correction of errors—1906.01(f)  
correspondence address—603.01(a); 1904.02(f)  
declaration of intent to use required—804.06; 1904.01(c)  
dividing—1110.08  
drawing—202.10; 807.03(b); 807.03(g); 807.03(h); 807.07(b);  
807.12(c); 807.13(b)  
establishing right to take action—502.01  
examination of—1904.02-1904.02(h)  
express abandonment of—718.01  
filing basis—806.01(e); 806.03(k); 1505.01(f); 1904.01(a)  
filing date—201; 202; 203; 1904.01(b)  
filing fee—202.03; 810; 810.01; 1401.05(b); 1904.01(f)  
filing receipt—401.01  
identification of goods and services—1402.01(c); 1904.02(b);  
1906.01(i)  
invalidation of—1904.07  
issuance of registration certificate in name of new owner—  
502.02(b)  
jurisdiction—1504.04; 1904.02(h)  
mark cannot be amended—807.13(b); 1904.02(g); 1906.01(i)  
must be filed by holder of international registration—1201  
notice of refusal—1904.03-1904.03(e); 1904.04  
Office actions, issuing—1904.02(e)  
opposition—1503.01; 1503.06; 1504.02; 1504.05(a); 1904.04  
ownership, in general—501; 502; 1201; 1904.06  
ownership, change of—501.01(b); 501.07; 502.01; 502.02(b);  
503.05; 503.03(a); 1904.06; 1906.01(a)-1906.01(a)(iii)  
priority claim—206.02; 1904.01(e)  
recording change of ownership—503.05; 1904.06; 1906.01(a)-  
1906.01(a)(iii)  
remains part of international registration—1904.05  
remand—1504.02; 1504.05(a)  
refusal of—711.02; 714.05(b); 1904.03; 1904.03(e); 1904.04  
renewal of—1602.01; 1606.01(b); 1614; 1905  
replacement—1616; 1904.12  
signature—804.04; 804.06; 1904.01(c)  
Supplemental Register, amendment to not a new issue—  
714.05(a)(i)

## INDEX

- Supplemental Register, not registrable on—801.02(b); 815;  
816.01; 816.04; 1904.02(c)
- transformation of—1904.09-1904.09(b)
- use not required—901; 1904.01(d)
- verification—804; 804.04; 804.06; 1904.01(c)
- Section 71 affidavit—16131; 1904.11
- Security interest agreements, recording of—503.02
- Serial number—401.02
- Series code—401.02
- Service mark
  - character or personal name—1301.02(b)
  - definition of—1301
  - informational matter—1301.02(a)
  - matter that does not function as—1301.02(a)
  - menu item for restaurant—1301.02(a)
  - ornamental matter—1301.02(a)
  - process, system or method—1301.02(e)
  - product used in performing service—1301.02(a)
  - radio and television program, title of—1301.02(d)
  - specimens of use—1301.04-1301.04(d)
  - system, process or method—1301.02(e)
  - three-dimensional—1301.02(c)
  - what is a—1301.02-1301.02(e)
- Service, what is a—1301.01-1301.01(b)(v)
  - contests and promotional activities—1301.01(b)(i)
  - criteria for determining what constitutes—1301.01(a)-1301.01(a)(iii)
  - informational services ancillary to sale of goods—1301.01(b)(v)
  - investment, soliciting—1301.01(b)(iv)
  - promotional services—1215.02(b); 1301.01(b)(i)
  - publishing—1301.01(b)(iii)
  - warranty or guarantee of repair—1301.01(b)(ii)
- Services
  - identification of—1402.11-1402.11(e)
  - classification of—1401.02(a)
- Shape as mark
  - background designs and shapes as mark—1202.11
  - product and container configurations—1202.02(a)-1202.02(b)(ii)
- Signature (see also Verification)
  - as certification—602.02(a)
  - date of—804.03; 1104.09(b); 1108.02(b); 1109.05(a); 1109.11(c)
  - of applicant (see also Verification of application)
  - by association—712.01(a)(vi); 804.04
  - by corporation—712.01(a)(iv); 804.04
  - by foreign corporate-type entity—712.01(a)(v); 804.04
  - by joint applicants—712.01(a)(i); 804.04
  - by joint venture—712.01(a)(iii); 804.04
  - by limited liability company—712.01(a)(vii); 804.04
  - by partnership—712.01(a)(ii); 804.04



## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- by someone other than applicant or applicant's attorney—603.04
- persons who can sign verification on behalf of applicant—804.04
- of application for registration, persons who can sign—804.04
- of electronically-filed documents—804.05
- of petition—1705.07
- of response to Office action—712-712.01(a)(vii)
- of TEAS document—804.05
- original—302.01
- “Single source” (related companies)—1201.07-1201.07(b)(iv)
- Single creative work, title of—1202.08; 1301.02(d)
- Size of mark on drawing —807.06(a)
- Slogans
  - disclaimers with respect to—1213.05(b)
  - registrability of—1202.03(f)(i); 1202.04
- Sole proprietorship as applicant—803.03(a)
- Sound marks—807.09; 904.02(a); 1202.15
- “Special” applications (see *also* Petition to make “special”)—702.02
- Special-form drawing—807.04-807.04(b)
  - also referred to as “ink drawing”—807.04-807.04(b)
  - characteristics of—807.04(a)
  - correction of—807.15; 807.16
  - size limitations for—807.06(a)
  - when required—807.04(b)
- Specimens
  - affidavit of use of—904.09
  - agreement with mark on drawing—807.12(a); 1215.02(c)
  - bulky—904.03
  - catalogs as—904.06(a)
  - certification mark—1306.06(c)
  - collective membership mark—1304.09(c)
  - collective trademark and collective service mark—1303.02(b)
  - deferral of examination in multi-basis application—806.02(c)
  - displays—904.06
    - electronic displays—904.06(b)
  - electronically transmitted—904.02(a); 1104.09(e); 1109.09(b); 1604.12(b)
  - facsimiles—904.08
  - for amendment to allege use—1104.09(e)
  - for color marks—904.02(c); 1202.05(f)
  - for combined application—1403.01
  - for computer programs, movies or videotapes—904.04(d)
  - for downloadable software—904.04(d)
  - labels—904.04(a)
  - multi-class application—904.09; 1403.01; 1403.02(b); 1402.03(c)
  - for publications—904.02(d)
  - for statement of use—1109.09(b)
  - musical score, in TEAS application—904.02(a); 1212.15
  - number of—904.01
  - package inserts—904.07
  - paper—904.02(b)

## INDEX

- parties named on—Office no longer inquires as to relationship with applicant—  
1201.04
- physical form of—904.02
- service mark—1301.04-1301.04(d)
- substitute (see Substitute specimens)
- temporary—904.04(a)
- trademark—904.04-904.04(d)
- translation of matter on—904.10
- use, affidavit of—904.09
- Standard character drawings—807.03-807.03(i)
  - and foreign registration—807.03(f)
  - and specimen of use—807.03(e)
  - changing to or from special form may be material alteration—  
807.03(d)
  - combined with other elements—807.03(c)
  - format unclear—807.03(h)
  - in §44 application—807.03(f)
  - list of—807.03(b)
  - requirements for—807.03(a)
- Standard character list—807.03(b)
- Statement of use
  - approval of—1109.18
  - classification, amendment of—1109.14
  - clear-error standard in examining—1109.08
  - correcting defects—1109.16-1109.16(d)
  - date of execution—1109.11(c)
  - dates of use—1109.09(a)
  - drawing—1109.12
  - examination of, —1109.07; 1109.08
  - execution of —1109.11-1109.11(d)
  - extension of time to file (see Request for extension of time to file statement of  
use)
  - failure to file within time permitted—718.04; 1109.04
  - fee for filing—1109.15; 1109.15(a)
  - form of—1109.05
  - identification of goods/services in—1109.13
  - may not be withdrawn—1109.17
  - minimum requirements for—1109.01
  - minimum requirements, review for compliance with—1109.02
  - necessary elements of—1109.06
  - ownership—1109.10
  - response to Office action—1109.16(d)
  - requirements for—1109.06
  - signature of—804.04; 1109.11-1109.11(d)
  - specimens for—1109.09(b)
  - time for filing—1109.04
  - use on all goods/services required before filing—1109.03
  - use in commerce—1109.09

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- verification of—804.04; 1109.11-1109.11(c)
- withdrawal prohibited—1109.17
- Status inquiries—108
  - Internet information—108.01
  - Personal telephone assistance—108.02
- Statutory authority for examination—701
- Statutory averments in application for registration—804.02
- Stippling on drawing—808.01(d)
- Subpoena received by Office employee—1801.01
- Subsequent designations—1902.08
- Substitute drawing—807.15
- Substitute specimens
  - affidavit supporting—904.09
  - for amendment to allege use—1104.09(e)
  - for statement of use—1109.09(b)
  - may require amendment of dates of use—904.09
  - requirements for substitute specimens and statutory refusals—904.11
- Supervisory authority of Director—1707
- Supplemental Register
  - allegation of use examined before action taken on amendment to—1102.03
  - amendment of application to—816-816.05
  - applications for—815-815.05
  - approval for registration on—815.03
  - intent-to-use applications—1102.03
  - marks eligible for Principal Register not registrable on—815.01
  - not an admission that mark has not acquired distinctiveness—815.04
  - request for extension of protection of international registration, not eligible—  
801.02(b); 815; 816.01; 816.04; 1904.02(c)
- Surname, primarily merely a—1211-1211.02(b)(vi)
  - combined with additional matter—1211.01(b)-1211.01(b)(vii)
  - combined with domain name—1211.01(b)(vii); 1215.03
  - combined with initials—1211.01(b)(iii)
  - combined with title—1211.01(b)(iv)
  - double surname—1211.01(b)(i)
  - evidence supporting refusal—1211.02-1211.02(b)(vi)
  - geographical significance—1211.01(a)(iii)
  - historical place or person—1211.01(a)(iv)
  - “look and feel” of a surname—1211.01(a)(vi)
  - negative dictionary evidence—1211.02(b)(v)
  - non-surname significance—1211.01(a)-1211.01(a)(vi)
  - ordinary language meaning—1211.01(a)(i)
  - phonetic equivalent—1211.01(a)(ii)
  - plural—1211.01(b)(v)
  - possessive—1211.01(b)(v)
  - rare—1211.01(a)(v)
  - stylization—1211.01(b)(ii)
  - telephone directory listings
- Surrender of registration for cancellation—1608
- Suspended cases checked by examining attorney—716.04
- Suspension of action by Office

## INDEX

after final action—716.06  
circumstances where appropriate—716.02-716.02(e)  
letter of inquiry regarding—716.05  
notice of—716.01  
pending cancellation or expiration of cited registration—716.02(e)  
pending decision on petition not permitted—716.02; 1705.06  
pending disposition of earlier-filed application—716.02(c)  
pending receipt of foreign registration—716.02(b); 1003.04  
pending receipt of proof of renewal of foreign registration—716.02(b); 1004.01(a)  
request to remove—716.03  
Suspension, removal of application from—716.03; 716.06

## T

Taiwan, understanding with the United States—App. B  
TAC (Trademark Assistance Center)—108.02  
TARR database—108.01  
Tax-exempt corporation—803.03(c)  
TDR (Trademark Document Retrieval)—109.01; 402  
TEAS (see Electronic filing)  
Telephone numbers—1209.03(l)  
Telescoped words—1213.05(a)(i)  
Temporary specimens—904.04(a)  
“Ten-year proviso” of §5 of Act of 1905—1601.04  
Territorial commerce—901.03  
TESS (Trademark Electronic Search System)—104  
Testimony, requests for, referred to Office of General Counsel—1801.01  
Third parties, inquires from regarding *ex parte* matters—1806  
Third party registrations  
    evidence of—710.03  
    relevance in determining descriptiveness—1209.03(a)  
    relevance in determining likelihood of confusion—1207.01(d)(iii)  
Three-dimensional marks—807.10; 1202.02-1202.02(e); 1301.02(c)  
TICRS—109.02; 402  
Time between execution and filing —804.03; 1104.09(b); 1108.02(b); 1109.05(a);  
    1109.11(c)  
Title of a single creative work—1202.08; 1301.02(d)  
Titles or degrees—1304.08(c); 1306.03; 1306.06(a)  
Trade dress—1202.02; 1202.02(b)-1202.02(f); 1202.03; 1202.03(f)(iii)  
Trade name—1202.01  
Trademark Act of 1946  
    claiming benefits of, under §12(c)—1603-1603.03  
    duration of registrations under—1602.01  
    effective date of—1601.02  
Trademark assignment, searching —503.08  
Trademark Assistance Center—108.02  
Trademark, definition of—1202  
Trademark Document Retrieval (TDR)—109.01; 402  
Trademark Image Capture and Retrieval System (TICRS)—109.02; 402

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- Trademark Law Revision Act of 1988—816.02; 901.02; 1303.01; 1602.01
- Trademark Law Treaty Implementation Act, changes to requirements for maintaining a registration—1602.04
- Trademark Official Gazette
  - contents of—106
  - notification of errors in—1502.01
  - publication in—1502
- Trademark searching—104
- Trademark Trial and Appeal Board
  - appeal to—1501-1501.04
  - jurisdiction of—1504.02
  - opposition proceedings before—1503-1503.05
- Transfer of old drawing to new application—807.19
- Transformation (see Extension of protection of international registration to the United States)
- Translation
  - approval of—809.02(a)
  - equivalency in—809.01
  - of dead languages—809; 1207.01(b)(vi); 1209.03(g)
  - of document submitted for recording in Assignment Division—503.03(c)
  - of foreign registration—1004.01(b)
  - of idiomatic expressions—809; 809.01
  - of matter on specimens—904.10
  - of non-English wording in mark—809-809.02(a)
  - printing of—809.02; 817
- Transliteration of non-Latin characters in mark—809-809.02(a)
- Treaty or convention relating to trademarks—1001; 1002.03; App. B
- TRIPS (Trade Related Intellectual Property portions of General Agreement on Tariffs and Trade)—1210.08; App. B
- Trust as owner of mark—803.03(e); 803.03(e)(i)
- Type of commerce—901.03; 903.03
- Type of mark, registration in correct category—1307
- Types of applications—801-801.02(b)
- Types of marks—1300 introductory text
- Types of registrations—1601-1601.06

## U

- U.S. Postal Service, interruptions of—305.04
- Unintentional delay
  - petition based on—1714.01(e); 1714.01(f)-1714.01(f)(ii)
  - statement of—1714.01(e)
  - where unintentional delay applies—1714.01(f)-1714.01(f)(ii)
- United States Patent and Trademark Office
  - reorganization of—1701
  - World Wide Web Site—102
- Unity of control—1201.07-1201.07(b)(iv)
- Unpublished decisions—705.05
- Unsigned response to Office action—712.02
- Uruguay Round Agreements—1210.08; App. B

## INDEX

- Use in commerce
  - assertion of—901
  - bona fide use in ordinary course of trade—901.02
  - commerce that may be lawfully regulated by Congress—901.03
  - current, asserted in §1(a) application—901
  - date of first—903.02
  - definition of—901.01
  - not required in §44 application—901; 1009
  - not required in §66(a) application—901; 1904.01(d)
  - solely by related company—903.06; 1201.03(a)
- Use of mark
  - bona fide use in ordinary course of trade—901.02
  - by applicant—1201.01
  - by licensee—1201.03(f)
  - by predecessor in title—903.06
  - by related company—903.06; 1201.03-1201.03(f)
  - in commerce (see Use in commerce)
  - solely by related company—1201.03(a)

## V

- Varietal names—1202.12
- Verification of application (see *also* Signature)—804-804.05
  - declaration in lieu of oath—804.01(b)
  - defective—804.01(a); 804.01(b); 804.02
  - electronic—804.05
  - in a foreign country—804.01(a)(i)
  - not required for receipt of filing date—804
  - persons who can sign—804.04
  - of §66(a) application—804; 804.06; 1904.01(c)
  - of TEAS document—804.05
  - under 28 U.S.C. §1746—804.01(b)
  - with oath—804.01(a)

## W

- Waiver of rules, on petition—1708
- Warehouse storage
  - access by public to files in—109.02
  - of registration files—109.02
- Who may practice before Office in trademark matters—602
- Wines/spirits, misleading indication of origin of—1210.08
- Withdrawal of attorney, permissive—602.05
- Withdrawal of authorization to represent—602.04
- Withdrawal of refusal or requirement after appeal—1501.03
- World Intellectual Property Organization—1401.02(a); 1900 (introductory text)
- World Trade Organization—App. B
- Written application, form for filing—802