

CHANGES: INDEX TO CHANGES IN TMEP April 2016

Attention is directed to the following changes in the April 2016 TMEP.

SECTION	CHANGE
TMEP	Incorporated relevant precedential decisions reported prior to April 1, 2016.
302.02	Added case citation.
503.03(b)	Added instruction that documents can be filed in PDF format.
605.01	Added cross reference.
611.06(g)	Reworded to clarify authorized signatories.
705.06	Updated requirements for signature block on Office actions.
714	Deleted paragraphs (c) and (d) of rule excerpt.
714.05(a)(i)	Clarified statutory citation and updated case citation.
714.05(d)	Clarified that procedures apply why applicant files consent agreement or asserts unity of control “for the first time” in response to final action.
715.01	Updated for consistency with revised Rule 2.63(b).
806.02(f)	Clarified procedure when applicant wishes to add or substitute §44(e) basis after publication.
807.03(b)	Miscellaneous stylistic edit.
807.03(g)	Deleted text regarding §66(a) application and added cross reference.
807.03(h)	Clarified procedure for asserting standard character claim in §66(a) applications.
807.04(a)	Miscellaneous stylistic edit.
807.07(d)	Miscellaneous stylistic edit.
807.13(b)	Miscellaneous stylistic edits. Added exception regarding standard character claim in §66(a) application.
807.14	Updated case citation.
807.14(f)	Updated case citation.
808.02	Clarified prohibition against use of third-party registered marks in descriptions.
813.01(a)	Miscellaneous stylistic edit.
813.01(c)	Miscellaneous stylistic edits.
815.04	Updated appropriate statutory citations.
819.01(m)	Reworded to clarify that TEAS Plus form does not prompt user to enter required translations and transliterations.
903.04	Clarified requirements for acceptable dates of use and added examples that would require amendment and the appropriate procedures for amendment.
903.06(a)	Clarified that applicant must attest to dates of use that are on or before the date an application or allegation of use was signed.
904.03(c)	Added case citation.
904.03(i)(B)(1)	Added introductory sentence stating that examining attorney may consider the prominence of the mark and case citation when determining whether web-page display specimen shows the mark in association with the goods. Updated case citations.
1002.04	Reworded to clarify requirements for establishing country of origin.
1003.01	Updated current title of European Union Intellectual Property Office and reworded to clarify when multiple foreign applications may serve as basis for priority claim.
1003.04(b)	Added cross references.

SECTION	CHANGE
1104.10(b)(iv)	Clarified that date of first use in commerce may not be earlier than date of first use anywhere and that dates of use may not be after the date the amendment to allege use was signed.
1109.09(a)	Clarified that date of first use in commerce may not be earlier than date of first use anywhere and that dates of use may not be after the date the statement of use was signed.
1202	Updated statutory citations. Added cross references.
1202.02(a)(iii)(A)	Updated statutory citations and case citation.
1202.02(b)(i)	Clarified that nondistinctiveness refusal for product design mark is issued for applications based on §§1(b), 44, or 66. Reworded part of section for clarity.
1202.02(b)(ii)	Miscellaneous stylistic edits.
1202.11	Deleted case citation.
1202.17(b)(i)	Miscellaneous stylistic edit.
1202.18	Section rearranged for clarity. Two subsection headings added.
1202.18(a)	Section heading added within current text: Disclaiming HASTAG or Hash Symbol. Added example.
1202.18(b)	Section heading added within current text: Marks Consisting Solely of HASTAG or Has Symbol. Paragraph edited for clarity.
1202.19(e)(i)(A)	Deleted example and case citation.
1203.02(b)	Corrected case citation.
1203.03(b)(i)	Deleted case citation and added different supporting case citations. Updated case citations.
1203.03(b)(ii)	Deleted case citation. Updated case citation.
1203.03(c)(i)	Deleted case citation; added case citation.
1203.03(c)(iii)	Deleted case citation; added case citation.
1206.03	Clarified what comprises a full name. Added example of pseudonym, stage name, or nickname. Miscellaneous stylistic edits.
1207.01(a)(iii)	Added case citation.
1207.01(b)(viii)	Updated case citation.
1207.01(b)(ix)	Updated case citation.
1207.01(c)(ii)	Updated case citation.
1207.01(d)(iii)	Updated case citation.
1207.01(d)(viii)	Added case citation.
1207.01(d)(ix)	Added case citation.
1208.01(d)	Clarified examination procedure when abandoned application is revived or reinstated.
1209.01(c)	Clarified that generic term does not meet the statutory definition of a mark. Added case citation. Added statutory basis for generic refusals.
1209.01(c)(iii)	Added case citation.
1209.02(a)(i)	Added statutory citations.
1209.02(a)(ii)	Clarified statutory basis for refusal.
1209.03(g)	Added case citation.
1211.02(b)(ii)	Clarified use of LexisNexis® database to show surname significance. Moved cross reference.
1212.05(b)	Added case citation.
1212.09(a)	Added case citation.
1213.03(d)	Clarified when disclaimer should not be required. Added case citation and cross reference.

SECTION	CHANGE
1213.05(b)(ii)(A)	Deleted definitions from online sources and added definitions from print source.
1213.05(b)(ii)(B)	Deleted definitions from online sources and added definitions from print source. Corrected misspelling.
1213.05(b)(ii)(C)	Deleted definitions from online sources and added definitions from print source. Corrected misspelling.
1213.08(a)(i)	Miscellaneous stylistic edit.
1214.01	Updated to clarify that when a mark has a significant changeable element, the examining attorney must consider whether drawing would give adequate notice as to the nature of the mark. Added guidance regarding marks with changeable element that may be registrable.
1214.02	Miscellaneous stylistic edits.
1214.03	Moved text within section for clarity.
1214.04	Miscellaneous stylistic edits.
1401.02(a)	Updated to provide information regarding and link to current version of Nice Agreement. Updated class headings and general indications to include version 2016 changes.
1401.02(c)	Updated link to ID Manual.
1401.05(a)	Deleted sentence referencing “hobby craft kit.”
1401.05(b)	Updated to indicate that class includes goods used for surgical, dental, and veterinary purposes. Miscellaneous stylistic edits.
1401.05(d)	Updated to indicate that the primary parts or components should be specified first in the amended identification.
1401.05(e)	Updated to reflect current Class 29 heading.
1401.07	Added cross reference. Miscellaneous stylistic edits.
1401.11	Updated link to ID Manual.
1401.12	Miscellaneous stylistic edits.
1401.13	Miscellaneous stylistic edits.
1402.01	Corrected cross references.
1402.01(c)	Miscellaneous stylistic edit.
1402.03	Miscellaneous stylistic edit.
1402.03(b)	Section partially rewritten to clarify procedures for house marks. Added example.
1402.03(c)	Updated to clarify procedure when applicant cannot establish sufficient use for a “full line.”
1402.03(d)	Updated to clarify when it is not necessary to specify the field of use for software and proper classification for software.
1402.03(e)	Removed reference to “class of purchasers” and deleted current examples of subject matter and added new examples.
1402.04	Corrected title of Administrator and European Union Intellectual Property Office. Deleted reference to downloading ID Manual.
1402.05	Miscellaneous stylistic edit. Added cross reference.
1402.07(b)	Added cross reference.
1402.09	Updated to clarify procedure when identification includes the terms “applicant” or “registrant.”
1402.11(a)(iii)	Revised example of acceptable identification.
1402.11(a)(iv)	Revised example of acceptable identification.

SECTION	CHANGE
1402.11(a)(xii)	New section: Non-Downloadable Computer Software
1402.13	Clarified procedure when examining attorney has not expressly limited requirement to particular indefinite wording, and it is appropriate to do so.
1403.05	Miscellaneous stylistic edit.
1504.03	Clarified procedure when an Office action must be issued after publication and it is too late to withdraw the application from registration.
1604.13	Updated case citation.
1604.20	Clarified that requirements apply when use in commerce is claimed.
1604.20(a)	Clarified that requirements apply when use in commerce is claimed.
1604.20(b)	Clarified that requirements pertain to affidavit or declaration of use.
1604.21	Clarified that requirements apply when use in commerce is claimed.
1604.21(a)	Clarified that requirements pertain to affidavit or declaration of use.
1604.21(b)	Clarified that requirements apply when use in commerce is claimed.
1604.21(c)	Clarified that requirements apply when use in commerce is claimed.
1604.21(d)	Clarified that requirements apply when use in commerce is claimed.
1613.07(b)	Miscellaneous stylistic edit.
1613.13	Updated case citation.
1613.20	Clarified that requirements apply when use in commerce is claimed.
1613.20(a)	Clarified that requirements apply when use in commerce is claimed.
1613.20(b)	Clarified that requirements pertain to affidavit or declaration of use.
1613.21	Clarified that requirements apply when use in commerce is claimed.
1613.21(a)	Clarified that requirements pertain to affidavit or declaration of use.
1613.21(b)	Clarified that requirements apply when use in commerce is claimed.
1613.21(c)	Clarified that requirements apply when use in commerce is claimed.
1613.21(d)	Clarified that requirements apply when use in commerce is claimed.
1705.05	Miscellaneous stylistic edit.
1707	Added case citation and cross reference.
1714.01(a)(ii)	Updated for consistency with current Rule 2.63.
1715.01	Added sentence regarding appropriate subjects for letter of protest.
1715.01(a)	Miscellaneous stylistic edit.
1715.04	Transferred text from current §§1715.04(a) and (b) and clarified what letter of protest should include.
1715.04(a)	Revised section title: Types of Evidence Appropriate for Letter of Protest. Included text from current §1715.04 and clarified what constitutes appropriate evidence.
1715.04(b)	Revised section title: Amount and Format of Evidence for Letter of Protest. Clarified requirements for submitting evidence.
1902.02(a)	Miscellaneous stylistic edit.
1904.02(h)	Clarified when suspension notice and no-call examiner's amendment may be issued as a first Office action.
1904.02(j)	Added examples of impermissible amendments.
1904.03(f)	Miscellaneous stylistic edit.
1904.09(b)	Clarified examination procedure when cancelled extension of protection is transformed into a new application under §1 or §44.

SECTION	CHANGE
Appendix B	Updated to include information regarding renaming of OHIM as the European Union Intellectual Property Office (EUIPO) and the CTM as the European Union trademark (EU trademark) and link to listing of EU members. Section reworded for clarity.
Appendix D	Corrected description of French SAS entity.