

## **Practice Tip**

### **Section 2(d) & Foreign Entity Designations: When Different Entity Terminology Identifies the Same Owner**

This Practice Tip addresses when a trademark examining attorney may presume that an applicant owns a conflicting prior registration or application, despite differences in the terminology used to identify the owner's entity type in the application and the prior registration/application.

#### **Examining Attorney's Search for Conflicting Marks**

Upon initial examination of an application, the examining attorney will search the USPTO records for conflicting marks in prior registrations and applications. See *Trademark Manual of Examining Procedure* (TMEP) §704.01. If the examining attorney finds a conflicting registration, the examining attorney must cite it against the applied-for mark under Trademark Act Section 2(d), [15 U.S.C. §1052\(d\)](#), unless the applicant has claimed ownership of it or USPTO records otherwise indicate that the applicant owns it. TMEP §812.01. Likewise, the examining attorney will also cite any pending conflicting applications as a potential bar to registration. See *id.*

#### **Determining Ownership**

The examining attorney will compare the application's owner name and entity information to the corresponding information in the conflicting prior registration or application to determine if the owner is the same. Generally, if the owner's designated entity type differs in the respective records, the examining attorney will treat the entities as different owners, even if the owner name is the same. For example, Acme Plumbing, a Delaware corporation, and Acme Plumbing, a Delaware limited liability company, are considered to be different entities, and thus different owners, for purposes of the Section 2(d) analysis.

#### **Foreign Entity Types and U.S. Equivalents**

However, when the owners named in the application and prior registration/application are foreign entities, it is possible that different entity type terminology in the records actually identifies the same entity and, thus, the same owner. That is, the same owner may have set forth a foreign entity designation (e.g., GmbH) in the application, but used the equivalent U.S. entity designation (e.g., limited liability company) in a prior registration. In other cases, the application and registration may each use different U.S. terminology to describe the nature of the same foreign entity.

#### **When Examining Attorneys May Presume Marks Have the Same Owner**

When the terminology identifying the entity type in the respective records differs, an examining attorney nonetheless may presume that marks have the same owner,

and need not issue a Section 2(d) refusal, if *all* of the following conditions are satisfied:

**(1) The owner name in the application is identical to the owner name set forth in the prior registration or application.**

Generally, the examining attorney will not consider the owner names to be identical if they contain different matter. However, when the only difference between the names is that one contains an entity designation and the other does not (e.g., “Acme” and “Acme, GmbH”), the parties may be treated as identical if conditions (2) and (3) below are satisfied. See [Example 1](#).

If, on the other hand, the owner names each contain different entity designations (e.g., “Acme, KG” and “Acme, GmbH”), the examining attorney may not presume that they identify the same owner, even if the owner entity information is otherwise the same. See [Example 2](#).

**(2) The entity designation in the application translates to, or is otherwise the equivalent of, the entity designation set forth in the prior registration or application, based on the information in the TMEP’s [Appendix D](#) or another competent source.**

[Appendix D](#) lists common abbreviations for entity designations used in various foreign countries to identify legal commercial entities, aiding examining attorneys in determining the acceptability of foreign entity designations. The appendix includes a description of the foreign designation and, in some cases, the equivalent U.S. entity type. Suggestions for additions or other changes to the appendix may be emailed to [TMTMEP@uspto.gov](mailto:TMTMEP@uspto.gov).

Examining attorneys may also base their determination regarding the equivalence of entity designations on competent sources other than [Appendix D](#), such as legal reference materials that explain or describe juristic entity formation in foreign jurisdictions.

If the owner names are identical and each contain the *same entity designation* (e.g., GmbH), the examining attorney may presume that they identify the same owner, even if the owner entity types are described using different U.S. terminology (e.g., “limited liability company” and “corporation”). See [Example 5](#).

**(3) The entity’s country of citizenship, incorporation, or organization is the same.**

If, on the other hand, the designated country of citizenship, incorporation, or organization differs in the respective records, the examining attorney may *not* presume that the marks have the same

owner, even if the owner name, entity type, and other ownership information is otherwise the same or equivalent. See [Example 3](#).

### **Applicant May Respond to a Section 2(d) Refusal by Verifying Ownership**

If an examining attorney refuses registration under Section 2(d) because all three of the conditions listed above are not met, the applicant may respond to the refusal by verifying a claim of ownership of the cited registration in any of the following ways:

- (1) Submitting a statement, supported by an affidavit or declaration under [37 C.F.R. §2.20](#), that the applicant is the owner of the cited registration;
- (2) Submitting evidence of the chain of title; or
- (3) Recording an assignment with the USPTO's Assignment Recordation Branch for registrations based on §1 or §44, or with the International Bureau of the World Intellectual Property Organization for registrations based on §66(a), and notifying the trademark examining attorney that the assignment has been duly recorded.

These response options also apply when a pending conflicting application is cited as a potential bar to registration. See TMEP [§812.01](#). In addition, an applicant may also provide evidence showing that the designated entity types are in fact equivalent, even if Appendix D does not list the relevant entity types as equivalent, and thus the owners in the respective records are the same. And, if appropriate, an owner may resolve an inconsistency in the ownership information by clarifying indefinite or incorrect entity terminology or information through an amendment to the application or a Section 7 correction of the registration. See TMEP §§[713](#), [1609.10\(b\)](#).

### **Examples**

The following examples illustrate the concepts discussed above:

#### *Example 1 – No Section 2(d) Refusal*

	<b>Owner Name</b>	<b>Entity Designation</b>	<b>Country</b>
<b>Application</b>	Acme Industries	Aktiengesellschaft	Switzerland
<b>Registration</b>	Acme Industries, AG	Joint Stock Company	Switzerland

Here, the registrant's name includes the entity designation AG, but the applicant's name does not. However, the owner names may be treated as identical, because the country of organization is the same and the specified entity types are equivalent. Specifically, the TMEP's [Appendix D](#) indicates that the term *Aktiengesellschaft*, abbreviated as AG, refers to a "joint stock company." Thus, the owner is presumed to be the same and no Section 2(d) refusal should issue.

*Example 2 – Issue Section 2(d) Refusal*

	Owner Name	Entity Designation	Country
Application	Oakstreet SRC	Sociedad Anonima	Spain
Registration	Oakstreet SA	Sociedad Anonima	Spain

Here, the application and registration specify the same entity designation and country of organization. However, the owner names differ because the applicant's owner name includes "SRC," the abbreviation for the *Sociedad Regular Colectiva* entity type, while the registrant's owner name includes "SA," the abbreviation for the *Sociedad Anonima* entity type. Thus, the examining attorney must treat the applicant and registrant as different owners and issue a Section 2(d) refusal. In addition, because the entity type referenced in the applicant's owner name (SRC) does not agree with the entity designation specified in the application (*Sociedad Anonima*), the examining attorney must require the applicant to resolve this discrepancy.

*Example 3 – Issue Section 2(d) Refusal*

	Owner Name	Entity Designation	Country
Application	Redwood	Joint Stock Company	Switzerland
Registration	Redwood	Aktiebolag	Sweden

Here, the owner names are identical and the entity designations, joint stock company and *Aktiebolag*, are equivalent according to [Appendix D](#). However, the application identifies the country of organization as Switzerland, while the registration identifies the country of organization as Sweden. Thus, the examining attorney must treat the applicant and registrant as different owners and issue a Section 2(d) refusal.

*Example 4 – No Section 2(d) Refusal*

	Owner Name	Entity Designation	Country
Application	Space Labs, AB	Joint Stock Company	Sweden
Registration	Space Labs, AB	Corporation	Sweden

Here, the owner names, which include the entity designation "AB," are identical and the country of organization, Sweden, is the same. Although the registration describes the entity as a "Corporation" and the application describes the entity as a "Joint Stock Company," [Appendix D](#) indicates that, in Sweden, an AB, or *Aktiebolag*, is a joint stock company, which is equivalent to a corporation. Thus, the owner is presumed to be the same and no Section 2(d) refusal should issue.

*Example 5 – No Section 2(d) Refusal*

	Owner Name	Entity Designation	Country
Application	Skyline, GmbH	Limited Liability Company	Germany
Registration	Skyline, GmbH	Corporation	Germany

Here, the owner names, which include the entity designation “GmbH,” are identical, but the registration describes the entity as a “Corporation,” and the application describes the entity as a “Limited Liability Company.” [Appendix D](#) describes a GmbH as the equivalent of a limited liability company, which, under U.S. law, is not considered to be equivalent to a corporation. However, because both the registrant’s and applicant’s owner name contain the same entity abbreviation, “GmbH,” and both identify Germany as the country of organization, it may be presumed that the owner simply used different U.S. terminology in the respective records to identify the nature of the GmbH. Thus, no Section 2(d) refusal should issue.

*Example 6 – Issue Section 2(d) Refusal*

	Owner Name	Entity Designation	Country
Application	Greenleaf	Partnership	Australia
Registration	Greenleaf	Corporation	Australia

Here, the owner names and country of organization are identical, but the registration describes the entity as a “Corporation,” and the application describes the entity as a “Partnership.” These entity types are not equivalents and, unlike the owner names in [Example 5](#), the owner names here do not include an entity abbreviation indicating that the entity type is, in fact, the same. Thus, the examining attorney must treat the applicant and registrant as different owners and issue a Section 2(d) refusal.