This Practice Tip addresses when an 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 respective records.

**Practice Tip**

**Section 2(d) & Foreign Entity Designations:**

**When Different Entity Terminology Identifies the Same Owner**

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**Examining Attorney’s Search for Conflicting Marks**

When examining a trademark 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, it must be cited against the applied-for mark under Trademark Act §2(d), 15 U.S.C. §1052(d), unless the applicant asserts ownership of it or USPTO records otherwise indicate that it is owned by the applicant. TMEP §812.01. Likewise, any pending conflicting applications will also be cited as a potential bar to registration. *See id.*

**Determining Ownership**

The examining attorney will compare the applicant’s owner name and the 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 in the respective records differs, 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 §2(d) analysis.

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

However, when the owners named in the application and prior registration or application are foreign entities, it is possible that different entity 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 the prior registration.

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

When the terminology used to identify 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 §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](#Ex1).

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](#Ex2).

1. **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**](http://tess2.uspto.gov/tmdb/tmep/appendix_d.htm)**.**

[Appendix D](http://tess2.uspto.gov/tmdb/tmep/appendix_d.htm) 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.

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

If 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](#Ex3).

**Applicant May Respond to §2(d) Refusal by Verifying Ownership**

If an examining attorney refuses registration under §2(d) because all three of the conditions listed above are not met, the applicant may respond to the refusal by verifying its ownership claim 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.

The foregoing 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 §7 correction of the registration. *See* TMEP §§713, 1609.10(b).

**Examples**

The following examples illustrate the concepts discussed above:

*Example 1 – No §2(d) Refusal*

|  |  |  |  |
| --- | --- | --- | --- |
|  | Owner Name | Entity Designation | Country  |
| Application | Acme Industries | Aktiengesellschaft | Switzerland |
| Registration | 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](http://tess2.uspto.gov/tmdb/tmep/appendix_d.htm) 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 §2(d) refusal should issue.

*Example 2 – Issue §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 §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 §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](http://tess2.uspto.gov/tmdb/tmep/appendix_d.htm). 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 §2(d) refusal.

*Example 4 – No §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 registrant has used “Corporation” to describe the nature of its entity, and applicant has used “Joint Stock Company,” [Appendix D](http://tess2.uspto.gov/tmdb/tmep/appendix_d.htm) 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 §2(d) refusal should issue.

*Example 5* *- No §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](http://tess2.uspto.gov/tmdb/tmep/appendix_d.htm) 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 §2(d) refusal should issue.