

TMEP HIGHLIGHTS – JULY 2022

This outline highlights some of the clarifications and changes set forth in the July 2022 version of the TMEP. For a more complete listing, see the “Index to Changes in TMEP July 2022” document, which is posted as part of the TMEP.

DOMICILE ADDRESS

Owners with a U.S. Domicile (TMEP §601.01(b))

- Examples of documents that can support a U.S. street address include the following:
 - (b) *For a juristic entity*, documentation showing that the address is the applicant’s or registrant’s business headquarters, such as one of the following:
 - (i) the most recent final annual or quarterly report or other similar report; or
 - (ii) a current, valid signed rental, lease, or mortgage agreement for office space.

TEAS Plus Applications: Applicant’s Name and Domicile Address (TMEP §819.01(b))

- The application must include the applicant’s name and domicile address. If the application includes this information, no additional fee will be required if the application is amended to clarify the information or to correct an inadvertent error. *For example, if applicant’s domicile address is incorrectly identified as a post-office box or “care of” address, the processing fee will not be required to amend the application to clarify or correct the domicile address.*

DECORUM

Decorum Required in Communications with the Office (TMEP §709.07)

- An applicant, registrant, attorney, or party is required to conduct their business before the Office with decorum and courtesy. The Office will review all oral or written communications received, but may decline to consider or respond to any communication containing abusive, offensive, threatening, or otherwise discourteous remarks directed to the Office or any of its staff. Similarly, Office staff may terminate any communication or other interaction if the person makes abusive, offensive, or threatening statements or engages in threatening or otherwise inappropriate behavior. In addition, documents may not be

submitted to the Office for any improper purpose, such as for harassment or to delay or burden prosecution.

- If a document submitted in a trademark matter contains discourteous remarks, the examining attorney may refer it to the Deputy Commissioner for Trademark Examination Policy for review. If it is determined that the document violates 37 C.F.R. §2.192, the Office will send notice that the document will not be considered and remove the document from the application or registration file. If it is further determined that the document was submitted in violation of 37 C.F.R. § 11.18(b)(2)(i), the Office may take such other actions or sanctions as deemed appropriate. In addition, any threatening communications may be reported to the Federal Protective Service for further investigation.

SUSPENSION

Suspension Pending Receipt of a Correction, Limitation, Assignment, or other Change to the International Record from the International Bureau (TMEP §716.02(g))

- All changes to the international registration (e.g., corrections to the international registration, assignments, cancellations, and changes to the holder's name and mailing address) must be filed directly with the International Bureau (IB). If the applicant states in a timely filed response to an Office action that it has filed a request with the IB that will affect the prosecution of the application, but the USPTO has not been notified by the IB of the change, the applicant should request suspension of the application pending receipt of the filing from the IB. The applicant must support the request to suspend the application with a copy of the filing submitted to the IB.
- In such cases, the USPTO will suspend prosecution of the §66(a) application if the applicant requests suspension in a timely response to an Office action requiring amendment of the identification, or any other matter, and supports the suspension request with a copy of the request for correction or request to record a limitation, a cancellation, a change of ownership, a change in the name or mailing address of the holder, a change to the entity information for a juristic entity, or any other relevant request filed with the IB.

Suspension Pending Disposition of Expungement or Reexamination Proceedings (TMEP §716.02(j))

- The following suspension guidelines apply when an examining attorney has cited, or will cite, a registration under §2(d) of the Trademark Act that is the subject of a petition for expungement or reexamination or an expungement or reexamination proceeding:

- If the examining attorney is **ready to issue a *nonfinal* refusal** of registration under §2(d), and the Trademark database shows that a petition for expungement or reexamination was filed and has not been acted upon, or that an expungement or reexamination proceeding was instituted, the examining attorney must not suspend the application, but must issue the refusal under §2(d). The Office action may include an advisory that, after receipt of a timely response, the application may be suspended pending a determination of whether the expungement or reexamination proceeding will be instituted and/or upon a final determination regarding such a proceeding.
- If the examining attorney is **ready to issue a *final* refusal** of registration under §2(d), and the Trademark database shows that a petition for expungement or reexamination was filed and has not been acted upon, or that an expungement or reexamination proceeding was instituted and has not been terminated, the examining attorney must suspend action pending a determination of whether the expungement or reexamination proceeding will be instituted and/or upon a final determination regarding such a proceeding. If a proceeding is not instituted at the petition stage, or the proceeding was instituted but has been terminated, the examining attorney will remove the application from suspension and issue a final refusal, as appropriate.
- If the examining attorney is ready to issue **a *denial of a request for reconsideration*** of a final refusal of registration under §2(d), and the Trademark database shows that a petition for expungement or reexamination was filed and has not been acted upon, or that an expungement or reexamination proceeding was instituted and has not been terminated, the examining attorney must suspend action pending a determination of whether the expungement or reexamination proceeding will be instituted and/or upon a final determination regarding such a proceeding. If the petition to institute a proceeding is not granted, or the proceeding was instituted but has been terminated, and the applicant has not filed an appeal, the examining attorney will remove the application from suspension and issue an "Examiner's Subsequent Final Refusal," as appropriate, thereby giving the applicant six months in which to file an appeal. If the applicant filed the request for reconsideration in conjunction with a notice of appeal, the examining attorney will remove the application from suspension and issue a "Request for Reconsideration Denied – Return to TTAB," as appropriate. See TMEP §716.06 regarding removing an application from suspension after a final Office action is issued.
- An applicant may, within the proper response period set forth in 37 C.F.R. §2.62(a), inform the examining attorney of the filing of a petition for expungement or reexamination regarding a cited registration, or the

institution of a proceeding resulting from such a petition, and request suspension of the pending application. See 37 C.F.R. §2.67. This request will constitute a proper response to the §2(d) refusal and may also be done by telephone or email if there are no other issues that require a written response. The examining attorney must confirm that the petition or the notice of institution is in the record of the cited registration, and that the petition has not been acted upon or the proceeding is ongoing, prior to suspending the application, if appropriate. However, the mere filing of a petition to institute an expungement or reexamination proceeding with respect to a cited registration does not constitute a response to an outstanding Office action.

LEGAL ENTITY OF APPLICANT

Partnership, Joint Venture, or Other "Firm" (TMEP §803.03(b))

- Domestic partnerships must set forth the names, legal entities, and national citizenship (for individuals), or state of incorporation or organization (for *domestic* businesses), of all general partners or active members that compose the partnership or joint venture.

Joint Applicants (TMEP §803.03(d))

- In a §66(a) application, if the application record includes incomplete joint applicant information, such as showing more than one owner listed in the owner name field, the examining attorney must require the applicant to clarify whether the application is owned by joint applicants or a partnership. However, the USPTO cannot accept any changes to owner name and address information in a §66(a) application from the applicant. The applicant must submit these changes to the International Bureau (IB). The applicant should request suspension of the application pending receipt of the updated information from the IB in a timely filed response to the Office action and must support the request with a copy of the filing submitted to the IB.

Foreign Trusts (TMEP §803.03(e))

- If a foreign trust in a §1 or §44 application is the owner of a mark in an application, the examining attorney must ensure that the trustee(s) is identified as the applicant. However, the name(s) and citizenship(s) of the trustee(s) does not need to be listed because the USPTO does not track the varying legal effects of trustee status in foreign countries.
- In a §66(a) application, if the application record includes complete ownership information for a foreign trust, conservatorship, or estate that does not conform to the standard format, such as omitting "Trustees of" in the owner name field, the examining attorney should

not require the applicant to provide correctly formatted owner name information.

- The USPTO cannot accept any changes to owner name and address information in a §66(a) application from the applicant. The applicant must submit these changes to the International Bureau (IB). The applicant should request suspension of the application pending receipt of the updated information from the IB in a timely filed response to the Office action and must support the request with a copy of the filing submitted to the IB.

REQUESTING ADDITIONAL INFORMATION

Issuing a Request for Information in Functionality Cases (TMEP §§1202.02(a)(v)(A), (C)-(D))

- These sections were updated to indicate that where functionality appears to be an issue, examining attorneys *must* issue a request for information requiring the applicant to provide copies of any active, pending, or expired patent(s), and any pending or abandoned patent application(s) (TMEP §1202.02(a)(v)(A)), to provide information about alternative designs (TMEP §1202.02(a)(v)(C)), and to provide information as to whether the proposed design makes the product simpler or less costly to manufacture (TMEP §1202.02(a)(v)(D)).

MARKS WITH MOTION

Specimens for Marks with Motion (TMEP §904.03(I))

- The mark shown in the specimen must match the mark shown in the freeze frames comprising the drawing.

FAILURE TO FUNCTION

Informational Matter (TMEP §1202.04)

- Designs that would be perceived as the equivalent of a word generally are not legally distinguishable from the word. In informational matter cases, the form in which the term appears is “much less significant than the impression it conveys.” Furthermore, the Trademark Trial and Appeal Board has held that an accurate pictorial representation of a word can be informational and incapable of identifying the source of an applicant’s goods.

Marks Comprised Solely of gTLDs for Domain Registry Operator and Domain Name Registrar Services (TMEP §1215.02(d))

- This section was updated to further clarify that including stylization in a gTLD does not render it registrable on the Principal Register unless the stylization creates a commercial impression separate and apart from the impression made by the wording itself. In addition, a “completely ordinary and nondistinctive” stylized display of a gTLD does not render it registrable on the Supplemental Register. *In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, at *13-14 (citing *In re Anchor Hocking Corp.*, 223 USPQ 85, 88 (TTAB 1984)).
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SECTION 2(a) – FALSE SUGGESTION OF A CONNECTION

Definition of “Persons” (TMEP §1203.03(a)(i))

- In addition to natural persons, §2(a) includes juristic persons, that is, legally created entities such as firms, corporations, unions, associations, or any other organizations capable of suing and being sued in a court of law. Juristic persons do not have to be well known to be protected from the registration of a mark that falsely suggests a connection with them. *However, there must be a legal successor to assert the rights of a defunct juristic person or otherwise those rights are extinguished when the juristic person becomes bankrupt or ceases to exist without an assignment of interest to another.*

Fame or Reputation (TMEP §1203.03(b)(i))

- To establish the fame or reputation of the person or institution under this factor, one is not required to show the fame or reputation of the name “in the entire United States.” *Ass’n Pour la Defense et la Promotion de L’Oeuvre de Marc Chagall Dite Comite Marc Chagall v. Bondarchuk*, 82 USPQ2d 1838, 1843, 1844 (TTAB 2007) (finding the evidence sufficiently showed the fame and reputation of Russian artist Marc Chagall where his work had been featured in exhibits in several major U.S. cities in several regions as well as in permanent public displays, including large stained glass windows installed at the United Nations).
 - Further, the Court of Appeals for the Federal Circuit has stated
[A] party's name may be famous among the particular consumers of those goods and services even if it is not famous among members of the general public. And a party's name may be associated with particular goods such that a false association may be established with goods or services of that type even if it would not have been established with respect to entirely different goods or services.
Piano Factory Grp., Inc., 11 F.4th at 1380, 2021 USPQ2d 913, at *14-15 (citing *In re Nieves & Nieves, LLC*, 113 USPQ2d at 1633).
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DOCTRINE OF FOREIGN EQUIVALENTS

When an Ordinary American Purchaser Would "Stop and Translate" (TMEP §1207.01(b)(vi)(B))

- Additionally, the doctrine typically will not be applied to personal names that would be recognizable as first names to ordinary American consumers and thus, perceived as identifying particular individuals. *Ricardo Media*, 2019 USPQ2d 311355, at *7-9 (holding the doctrine of foreign equivalents did not apply because "consumers would [not] be likely to [stop and] translate RICARDO to RICHARD, or RICHARD to RICARDO, but would instead take each name as it is, in its own language, as identifying the person named, whether real or fictional, known or anonymous."
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SECTION 2(d)

Third-Party Registrations and Evidence of Third Party Use (TMEP §1207.01(d)(iii)) (citations omitted)

- *Third-party registrations used to show inherent or conceptual weakness of a term or mark component.* 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. However, a large number of active third-party registrations including the same or similar term or mark component for the same or similar goods or services may be given some weight to show, in the same way that dictionaries are used, that a mark or a portion of a mark has a normally understood descriptive or suggestive connotation, leading to the conclusion that the term or mark component is relatively weak. However, cancelled or expired third-party registrations for similar marks are not probative evidence of a mark's descriptiveness, suggestiveness, or strength.
- *Third-party use to show commercial weakness.* Evidence of third-party use falls under the sixth *du Pont* factor – the "number and nature of similar marks in use on similar goods." Significant evidence of third-party use of similar marks on similar goods or services can show that consumers have become conditioned by encountering so many similar marks that they distinguish between them based on minute distinctions. If the applicant's evidence is properly submitted and establishes ubiquitous or considerable third-party use of the same or similar marks on the same or similar goods or services, it may be "relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection."
- *Limitations regarding probative value of third-party registration or use evidence to show weakness of mark in cited registration.* The potential

relevance of third-party registrations and uses offered to support registrability over the cited registration depends on the relationship they bear to the application and registration at issue. The third-party marks must generally be as similar to the registered mark as the applied-for mark. Potential relevance also depends on whether the third-party registered marks and uses are for goods or services as similar to those in the cited registration as those identified in the application.

- However, considering a mark's relative strength or weakness is only part of the process of determining whether there is a likelihood of confusion. Even registered marks deemed "weak" are entitled to the presumptions of validity under Section 7(b), and are entitled to protection under Section 2(d) against the registration of confusingly similar marks. Thus, arguments that third-party use has rendered the registered mark so weak as to lack any source-identifying ability may not be raised in examination, but only in cancellation proceedings.

ACQUIRED DISTINCTIVENESS

Survey Evidence, Market Research and Consumer Reaction Studies (TMEP §1212.06(d)) (citations omitted)

- To have any probative value, a survey must be conducted in accordance with accepted principles of survey research.
- Information regarding how a survey was conducted (the entire survey report, including all data and/or statistics gathered regarding participants responses), the complete questionnaire provided to participants, the criteria for selecting participants, the number of participants surveyed, all the individual responses to the questionnaire, the geographic scope of the survey, and an explanation of the survey method and/or design employed may assist the examining attorney in determining the probative weight of such evidence.
- For a survey to be probative, the proper universe of participants must be surveyed.
- The Trademark Trial and Appeal Board has given little weight to surveys that do not include an education or pre-testing portion regarding the difference between a generic term and a trademark or such portion is insufficient to educate respondents.

IDENTIFICATION OF GOODS AND SERVICES

Identification and Classification of Kits, Gift Baskets, and Items Sold as a Unit (TMEP §1401.05(a))

- Identifications must *set forth the particular goods or services* to enable proper classification and to facilitate determination of likelihood of confusion under 15 U.S.C. §1052(d). Thus, identifications for kits, gift

baskets, and items sold as a unit must indicate the particular components of the kits and gift baskets and the particular items sold as a unit *using definite terms that are clear, specific, and accurate to identify the primary components of the kit.*

Dietetic Substances and Meal Replacements (TMEP §1401.13(d))

- The identification “dietetic substances adapted for medical or veterinary use” is indefinite because it does not indicate the particular goods on or in connection with which the applicant uses, or has a bona fide intention to use, the mark in commerce. Identifications for dietetic substances for medical or veterinary use should set forth the common name of the specific “substances,” such as “ground flaxseed fiber for use as a dietary supplement,” in Class 5.

Filing Date of U.S. Application, not Foreign Registration Date, is Used to Determine Whether an Identification is Acceptable (TMEP §§1401.10, 1402.01(b))

- For applications filed under §44(e), the *filing* date, rather than foreign registration date, should be used to determine whether an identification is acceptable and properly classified.

Entitlement to Filing Date With Respect to Identification of Goods and Services (TMEP §1402.02)

- “Parts” has been added as an example for when a filing date will be denied because the application does not identify any recognizable goods or services.

Non-Downloadable Computer Software (TMEP §1402.11(a)(xii))

- The identification “providing downloadable software” is indefinite and encompasses both goods and services. “Providing downloadable software” is ambiguous because it combines the terms “providing,” which suggests a service activity, and “downloadable software,” which are Class 9 goods. The identification must accurately indicate the nature of the goods or services, for example, “online retail store services featuring downloadable software” in Class 35 or “downloadable software for {specify the function of software, e.g., managing bank accounts, editing photos, making restaurant reservations, etc. and, if software is content- or field- specific, the content or field of use}” in Class 9.

REGISTRATION CERTIFICATES

Certificate of Registration (TMEP §1601.01(a))

- On May 24, 2022, the USPTO began issuing electronic registration certificates for all registrations resulting from applications based on §§1, 44, and 66(a) of the Trademark Act, 15 U.S.C. §§1051, 1126, 1141f(a). *See USPTO To Accelerate Transition To Issuance of Electronic Trademark Registration Certificates; Issuing Next Certificates on May 24, 2022* at 87 Fed. Reg. 31533 (May 24, 2022). On that date, the electronic registration certificate became the official registration certificate.
- The registration certificate includes the owner's name and address, the mark, the goods/services/collective membership organization, and the class(es). The certificate is issued under the electronic signature of the Director and with a digital seal, which authenticates the registration. 15 U.S.C. §§1057(a), 1093; 37 C.F.R. §2.151. The USPTO uploads the electronic registration certificate to the Trademark Status and Document Retrieval database. Trademark owners can view, download, and print a complete copy of the registration certificate at no charge at any time.

Presentation Copy of Registration Certificate (TMEP §1601.01(b))

- Trademark owners can order a one-page, condensed, printed copy of the issued registration that is suitable for framing. This document, known as a "presentation" copy, is printed on heavy paper; features a gold foil seal; identifies the owner(s); indicates the trademark; and specifies the classes of goods and/or services, but does not list the goods and services. Presentation copies are not registration certificates or certified copies of the trademark registration. *See USPTO to Begin Issuing Electronic Trademark Registration Certificates* at 87 Fed. Reg. 25623 (May 2, 2022). Trademark owners who filed an initial application on or after May 24, 2022 can order a presentation copy of their registration, for a fee, through the Trademark Electronic Application System (TEAS). Trademark owners who filed an initial application before May 24, 2022 can order one presentation copy for free. *Id.*

UPDATING OF AUTOMATED RECORDS

Updating Automated Records to Show the Status of Registrations (TMEP §1611)

- USPTO records are not updated to show that the registration is cancelled or expired until approximately 10 days after the expiration of the grace period.
- If an examining attorney determines that 10 days have passed since the expiration of the grace period, but the Trademark database does not indicate that the registration is cancelled or expired, the examining attorney should contact the Supervisor of the Post Registration Section and request that the database be updated to show that the registration is cancelled or expired.

APPLICATIONS UNDER §66(a)

Certification and Collective Marks (TMEP §1904.02(d))

- If the §66(a) application does not indicate that the mark is a “Collective, Certificate or Guarantee Mark,” the applicant may not amend the application to seek registration of a collective or certification mark. Similarly, if the §66(a) application indicates that the mark is a “Collective, Certificate or Guarantee Mark,” the applicant may not amend the application to seek registration of a trademark or service mark. If the statement was omitted from or included in the application by mistake, the applicant may request a correction of the record from the IB. The applicant may also request suspension of the application and must include a copy of the request for correction filed with the IB.

Color Claim and Black-and-White Drawing (TMEP §1904.02(k))

- If the international registration contains a color claim, but there is a black-and-white drawing in the international registration, the applicant must: (1) submit a substitute drawing that is a color reproduction of the same mark depicted in the international registration; (2) state for the record that the substitute drawing is a color reproduction of the same mark depicted in the international registration; and (3) submit a color location statement describing where the color(s) appear(s) in the mark. The applicant may not delete the color claim because it is part of the international registration.
- If the color claim was included in the §66(a) application by mistake, the applicant may request a correction of the record from the IB. The applicant may also request suspension of the application and must include a copy of the request for correction filed with the IB.