TMEP HIGHLIGHTS – APRIL 2016

This outline highlights some of the clarifications and changes set forth in the April 2016 version of the TMEP. For a more complete listing, see the “Index to Changes in TMEP April 2016” document, which is posted as part of the TMEP.

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**ACTION AFTER FINAL**

***Proper Response to Final Action*** (TMEP §715.01)

* An applicant may respond to a final action by timely filing (1) a notice of appeal to the Trademark Trial and Appeal Board; (2) a request for reconsideration that seeks to overcome any substantive refusals to register and comply with any outstanding requirements; or (3) a petition to the Director under Trademark Rule 2.146 to review a requirement, if the subject matter of the requirement is procedural and thus appropriate for petition.  37 C.F.R. §2.63(b)(1)-(2).

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**INCAPABLE MATTER**

***Statutory Basis for Refusal of Generic Matter on the Principal Register*** (TMEP §§1209.01(c), 1209.02(a)(ii))

* Generic terms are refused registration on the Principal Register under Trademark Act §§1, 2, and 45, for trademarks, and §§1, 2, 3, and 45, for service marks. *See* 15 U.S.C. §§1051, 1052, 1053, 1127. Previously, the TMEP set forth the statutory basis for refusal of generic terms on the Principal Register as just §2(e)(1).

***Statutory Basis for Refusal of Incapable Matter on the Supplemental Register*** (TMEP §§1202.02(a)(iii)(A), 1202.02(b)(i), 1209.01(c), 1209.02(a)(i))

* The statutory authority to be cited for refusing incapable matter on the Supplemental Register is Trademark Act §§23(c) and 45, 15 U.S.C. §§1091(c), 1127. Previously, the TMEP set forth the statutory basis for refusal of incapable matter on the Supplemental Register as just §23.

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# MARK DESCRIPTION

***Mark Descriptions Must Not Include Third-Party Registered Trademarks Designating Type Fonts*** (TMEP §808.02)

* The prohibition of the use of third-party registered marks in mark descriptions includes the use of registered trademarks that designate type fonts, such as ARIAL (U.S. Registration No. 2270853) or TIMES NEW ROMAN (U.S. Registration No. 1340165).  The use of these type font designations in a description is not critical to an understanding of the mark, and therefore unnecessary for an accurate and complete description.

***Mark Descriptions May Contain Registered Marks Designating Commercial Color Identification Systems*** (TMEP §808.02)

* Registered marks designating commercial color-identification systems, such as PANTONE (e.g., U.S. Registration No. 1003494), may appear in connection with a color identifier in the description of the mark, because greater precision in identifying the color may be critical in accurately describing the mark and such third-party use is an intended use of commercial color identification system terminology.

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# MARK DRAWINGS

## Standard Character Claims in §66(a) Applications (TMEP §807.03(h))

* The applicant may assert a standard character claim in a §66(a) application if the mark drawing complies with the USPTO’s requirements for a standard character drawing under 37 C.F.R. §2.52(a), and the mark in the basic application and/or registration that forms the basis for the international registration is the legal equivalent of a standard character mark under the laws of the country of the basic application and/or registration. Although a mark in a §66(a) application may generally not be amended, submitting a standard character claim under these circumstances is not considered an amendment of the mark.

* When a mark in a §66(a) application appears to be in standard characters but does not include a standard character claim, and an Office action is otherwise necessary, the examining attorney may provide an advisory to the §66(a) applicant that the drawing of the mark meets the requirements for a standard character drawing under 37 C.F.R. §2.52(a), but there is no standard character claim in the U.S. application. The advisory should include an explanation that a standard character claim may be added to the U.S. application if, under the laws of the country of the basic application and/or registration, the basic application and/or registration includes the legal equivalent of a standard character claim.

***Single Application May Seek Registration of Only One Mark*** (TMEP §1214.01)

* If an application seeks registration of a mark with a significant changeable or “phantom” element, the examining attorney must consider whether the element encompasses so many potential combinations that the mark drawing would not give adequate constructive notice to third parties as to the nature of the mark and a thorough and effective search for conflicting marks is not possible. If so, the examining attorney must 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.
* On the other hand, a mark with a changeable element may be registrable if the element is limited in terms of the number of possible variations, such that the mark drawing provides adequate notice as to the nature of the mark and an effective §2(d) search is possible. For example, a “phantom mark” refusal would not be necessary for the mark T.MARKEY TRADEMARK EXHIBITION 2\*\*\*, in which the asterisks represent elements that change to indicate different years.

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# DATES OF USE

Dates of Use May Not Be After Signature Date (TMEP §§903.04, 903.06(a), 1104.10(b)(iv), 1109.09(a))

* Because a §1(a)-based applicationmust properly allege *current* use of the mark, an applicant must attest to dates of use in the application that are on or before the date the application was signed; an applicant may not allege use that has not yet occurred.
* Likewise, the dates of use specified in an allegation of use under §1(c) or §1(d) must be on or before the date the allegation of use was signed.

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# IDENTIFICATION OF GOODS/SERVICES

***House Mark*** (TMEP §1402.03(b))

* The USPTO will register a mark as a house mark only when evidence shows sufficient use as a house mark. Therefore, if an applicant seeks to register a house mark in an application under any basis, including §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 remove the indication “a house mark for” and the remaining wording must comply with the requirements for sufficient specificity as to such goods.
* If an applicant further indicates that its “house mark” is to be used “for a full line” of products, the examining attorney must review both the nature of use of the mark as a house mark as well as the acceptability of the claim of “a full line” by considering the specimens or other evidence of record. If the record does not support use of the “house mark” on a sufficient number or variety of products in its line, the examining attorney may require applicant to provide evidence in support of a “full line” or amend the identification to identify the goods with the requisite specificity.

***Identifying Computer Software*** (TMEP §1402.03(d))

* Generally, an identification for “computer software” will be acceptable as long as both the function/purpose and the field of use are set forth. However, specifying the field of use is not required when the identified software has a clear function and is not field-specific/content-specific.

***Requirement for Amendment of Portion of Identification of Goods/Services*** (TMEP §1402.13)

* 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. If the examining attorney has not expressly limited the requirement to the particular indefinite wording, and it is appropriate to do so, the applicant may request, in a request for reconsideration, filed after a final Office action or with a notice of appeal, that the requirement be limited accordingly.

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# SIGNATURES

## Signature by Limited Liability Company (TMEP §611.06(g))

* Generally, a signatory identified as “manager,” “member,” “principal,” or “owner” may be presumed to have the authority to sign on behalf of a domestic or foreign limited liability company.

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**ELIGIBLE APPLICANTS UNDER §44(d)**

***Establishing Country of Origin*** (TMEP §1002.04)

* An applicant for registration in the United States who is the assignee of a foreign registration, but cannot establish that the country which issued the registration was its country of origin as of the date of the conveyance or is its country of origin as of the date of the filing of the U.S. application, may still claim the benefit of registration under §44(e). In such a case, the requirement that the “applicant” be the owner of a valid registration from its country of origin was perfected by applicant’s predecessor in interest. However, under such circumstances, the applicant must establish that it is otherwise entitled to the benefits of Section 44(b), i.e., 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 must extend reciprocal registration rights to nationals of the United States.

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**TRANSFORMED APPLICATIONS**

***Examination of Transformed Application*** (TMEP §1904.09(b))

* When a cancelled extension of protection is transformed into a new application under §1 or §44, the examining attorney must conduct a new search to determine whether any later-filed applications for conflicting marks were approved for publication or registration and place the search strategy in the record. If a later-filed application has been approved, the examining attorney should inform the examining attorney who approved the later-filed application of the transformed application, so that appropriate action may be taken. If the later-filed application has been published, the examining attorney handling that application should request jurisdiction and suspend the application pending disposition of the transformed application. If a later-filed application for a conflicting mark has matured into registration, the examining attorney must refuse registration of the transformed application under §2(d), even though the application for the registered mark was filed after the transformed application.

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**LETTERS OF PROTEST**

***Types of Evidence Appropriate for Letter of Protest*** (TMEP §1715.04(a))

* Third-party registrations not based on use in commerce have little, if any, persuasive value and generally will not be forwarded to the examining attorney for consideration of the relatedness of the goods and services. In addition, where a protestor wants to establish that its goods or services are related to those in the application(s) for which it is submitting the letter of protest, such evidence must pertain to the goods or services identified in the application. Evidence regarding how the protestor is using its mark for goods or services not identified in the registration or prior-pending application that form the basis for the letter of protest, or information regarding how the applicant is using or may use its mark in commerce in the future that varies from the scope of the identification in the application, is inappropriate and will not be forwarded to the examining attorney.

***Amount and Format of Evidence for Letter of Protest*** (TMEP §1715.04(b))

* Evidence supporting the proposed legal grounds for refusing registration should be succinct and not duplicative. More than fifteen examples generally will be considered duplicative and unnecessary and may result in the letter of protest being denied without further consideration on the merits.
* It should be a rare situation in which more than 75 pages of evidence is necessary to support the proposed legal grounds for refusal. If more than 75 pages of evidence is submitted, the letter of protest must explain in detail why that volume of evidence is necessary and must be accompanied by a separate itemized index, or the letter of protest will be denied without further consideration on the merits. In addition, if any item of evidence attached to the letter or protest consists of multiple pages, the index must specifically identify the page on which the evidence appears and must highlight the relevant portion of the page.

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**MEMBERS OF INTERNATIONAL TRADEMARK AGREEMENTS**

***European Union Trademark*** (TMEP Appendix B)

* Effective March 23, 2016, OHIM was renamed the European Union Intellectual Property Office (“EUIPO”) and the CTM was renamed the European Union trademark (“EU trademark”), and all existing CTMs and CTM applications automatically became EU trademarks and EU trademark applications.