TMEP HIGHLIGHTS – OCTOBER 2015

This outline highlights some clarifications and changes set forth in the TMEP October 2015 edition. For a more complete listing, see the Change Summary document, which is posted as part of the TMEP. The items below indicate changes or clarifications to examination practice not previously set forth in Examination Guides or other materials.

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# Name/Acronym of Trademark Protection System or Scheme for Geographical Indication in Identification

* Geographical indications are used in connection with wines and spirits, foodstuffs, and agricultural products. They are typically names of geographic places and identify the goods as having characteristics associated with the named places.
* Different countries and governmental organizations have different legal systems or schemes to protect geographical indications of origin. They also have different terminology that has significance in the relevant territories.
* If the identification refers to a protection system or scheme, such wording should not be part of the identification of goods and/or services featuring those goods. This includes not only when the protection system or scheme is indicated by an acronym and/or full name along with reference to a region-specific or particular protection system or scheme, but also when the full name is used in a general or broad sense and without reference to a region-specific or particular protection system or scheme.
* Applicants may not delete the reference to a protection system or scheme entirely from the identification because such an amendment would impermissibly broaden the scope. The amended identification must indicate that the goods are made or produced, or the services feature goods made or produced, in accordance with certain, specific, or adopted standards.

TMEP §1402.03(g)

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# Accreditation- and Certification-Related Services vs. Certification Marks

* Accreditation and certification activities are not considered “services” under the Trademark Act or Nice Classification and should not be included in the identification of services for a service-mark application.
* Activities underlying the accreditation or certification, such as testing goods/services to determine whether they conform to established accreditation/certification standards, may constitute services under the Trademark Act if they are performed for the benefit of others and meet the other criteria for activities that constitute services.
* The development, evaluation, or testing of accreditation or certification standards may also constitute services when those activities are performed for the benefit of or to the order and specification of others.
* Identifications for accreditation- or certification-related services should make clear the nature of the activities performed for the benefit of others and examining attorneys must require clarification where the activity identified does not clearly constitute a service under the Trademark Act.

TMEP §1402.11(k)

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# INCAPABLE product packaging trade dress

* In certain cases, product packaging may be incapable of functioning as an indicator of source.
* Packaging that is common or basic in an industry or that is a mere refinement of packaging commonly used on the relevant goods will not be perceived as indicating source and is not registrable on the Principal Register under §2(f) or on the Supplemental Register.
* The ground for refusal on the Principal Register is that the proposed mark fails to function as a mark under §§1, 2, and 45 (for goods) or under §§1, 2, 3, and 45 (for services). The ground for refusal on the Supplemental Register is that the mark is incapable of functioning as a mark under §§23(c) and 45.

TMEP §1202.02(b)(ii)

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**AMENDMENT TO SUPPLEMENTAL REGISTER – FUNCTIONALITY REFUSAL**

* If registration is refused under Trademark Act §2(a), §2(b), §2c, §2(d), §2(e)(3), or §2(e)(5), an amendment to the Supplemental Register or a claim of distinctiveness under §2(f) does not raise a new issue and does not preclude the examining attorney from issuing a final refusal.
* If an applicant responds to a functionality refusal under §2(e)(5) by submitting an amendment seeking registration on the Supplemental Register *that is not made in the alternative*, the associated nondistinctiveness refusal must be withdrawn and the functionality refusal must be maintained and made final, if appropriate, under §23.

TMEP §§714.05(a)(i), 1202.02(a)(iii)(A)

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# DESCRIPTIVE PICTORIAL REPRESENTATION OF GOODS

* When a mark is comprised of wording that is descriptive under §2(e)(1) and a design element that is a pictorial representation of the goods, *or that reinforces the descriptive meaning of the wording*, the entire mark is merely descriptive.

TMEP §1209.03(f)

# EXAMINATION OF TRANSFORMED APPLICATION

* 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.

TMEP §1904.09(b)

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