TMEP HIGHLIGHTS – OCTOBER 2016

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

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# PRIORITY

§44(d) and §66(a) Applications(TMEP §§206.02, 1003.05, 1715.01(a), 1904.01(e))

* If the priority date is included in the original §44(d) or §66(a) application, the examining attorney must determine, while conducting a search of USPTO records for conflicting marks, whether there are any applications for conflicting marks that would be deemed later filed. The examining attorney must also notify the examining attorney assigned to any later-filed application so that the application may be suspended pending disposition of the §44(d) or §66(a) application with the earlier effective filing date.
* If the priority claim in a §44(d) or §66(a) application is submitted after the examining attorney has conducted a search of USPTO records for conflicting marks, the examining attorney must conduct a new search to determine whether, in view of the new earlier effective filing date, there are any applications for conflicting marks that would now be deemed later filed. The examining attorney must also notify the examining attorney assigned to any now later-filed application so that the application may be suspended pending disposition of the application with the earlier effective filing date.
* In some cases, another U.S. application filed after the §44(d) or §66(a) applicant’s priority date may proceed to publication or registration because the §44(d) applicant had not yet filed in the United States, or the request for extension of protection for the §66(a) application was not yet of record in the United States, when the examining attorney searched USPTO records. The §44(d) or §66(a) applicant may bring the priority-date issue to the USPTO’s attention by submitting a letter of protest that includes the serial number of the §44(d) or §66(a) application in the other pending application.

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# UNAUTHORIZED PRACTICE

Individuals Excluded, Suspended, or Unauthorized(TMEP §608.02)

* When an individual has been suspended or excluded from practice before the USPTO, the USPTO may notify the affected applicants or and registrants.
* Generally, if an Office action was sent to the correspondence address of record before the relevant party’s suspension or exclusion and the action remains outstanding, the USPTO will not send the applicant or registrant a supplemental action restating the refusals or requirements.

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# SUSPENSION

Pending Cancellation or Expiration of Cited Registration (TMEP §716.02(e))

* If the examining attorney is ready to issue a denial of a request for reconsideration of a final refusal of registration under §2(d):
  + If the registrant timely files, and the USPTO accepts, the §8 or §71 affidavit and/or the cited registration is renewed, *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,” 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."

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# LEGAL ENTITY OF APPLICANT

## Common Terms Designating Entity of Foreign Applicants (TMEP §803.03(i)

* The designation Foreign Maritime Entity (FME) is not an acceptable business entity type. A “legal entity” is “[a] body, other than a natural person, that can function legally, sue or be sued, and make decisions through agents.” Black’s Law Dictionary (10th ed. 2014). Here, the capacity to sue or be sued rests with the foreign entity that registers as a FME, as opposed to the FME itself. Therefore, the term FME does not identify a legal entity.

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# REQUESTING ADDITIONAL INFORMATION

Rule 2.61(b) (TMEP §814)

* This rule is designed to encourage high-quality, efficient examination and recognizes that an applicant is often in the best position to provide the facts and information that the USPTO needs to properly examine an application and assess registrability of the applicant’s mark.
* The wording “reasonably necessary” should be interpreted broadly, and applies to information that is “relevant to” registrability or “reasonably calculated” to lead to such relevant information.
* A question is considered “relevant” if an examining attorney has a legitimate reason for asking for the information and if the information is pertinent to the examining attorney’s legal inquiry.
* An examining attorney should ask questions designed to obtain specific information that is factual in nature under Rule 2.61(b).
* The applicant has a duty to participate in the examination process by responding directly and completely to each request for information.
* An applicant’s failure to respond to an information requirement also can result in an adverse evidentiary inference being drawn regarding the issue to which the information requirement was directed.

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# SUPPLEMENTAL REGISTER

Amendment After Refusal(TMEP §816.04)

* An applicant may not “reserve the right” to amend to the Supplemental Register if a final refusal is not withdrawn or is affirmed on appeal.

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# TEAS PLUS

## Prior Registration of the Same Mark (TMEP §819.01(p))

* The additional fee is required if a claim of ownership of registration(s) for the same mark, for which the last listed owner(s) of the prior registration(s) differs from the owner of the application, is omitted *and the failure to claim the prior registration(s) would result in the issuance of a refusal under §2(d)*.

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# SPECIMENS FOR TRADEMARKS

## Labels and Tags (TMEP §904.03(a))

* If a mark is merely informational or incapable of functioning as a mark for some other reason, it would not be seen as an indicator of source, and registration must be refused even if the specimen of record shows what would otherwise be acceptable trademark use, including use on tags or labels.

Digitally Created Specimen (TMEP 904.04(a))

* The specimen may not be an image of the goods or advertising matter for services that has been digitally created or altered to include the mark.
* Such items do not show actual use of the mark on or in connection with the goods or services in commerce and registration must be refused under Sections 1 and 45 of the Act.

Webpages (TMEP §1301.04(h)(iv)(C))

* This type of specimen is acceptable if it shows the mark used in advertising the identified services and creates the required direct association by referring to the services and by showing the mark being used to identify and distinguish the services and their source.

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# APPLICATIONS UNDER §44

## Establishing Entitlement Under a Treaty (TMEP §1002.03)

* Some EU member states maintain special relationships with overseas countries and territories (OCTs), which include Anguilla, Bermuda, the British Virgin Islands, the Cayman Islands, the Falkland Islands, Gibraltar, Montserrat, and the Turks and Caicos Islands.
* Generally, these OCTs are not parties to a relevant treaty or agreement with the United States, nor do they extend reciprocal rights to U.S. nationals by law. Therefore, if the applicant’s country of origin, or the country that issued the foreign registration, is one of these OCTs, the application is not entitled to priority under §44(d) or registration under §44(e).
* There is an exception allowing a United Kingdom territory to rely on a United Kingdom registration if the territory has an address in the United Kingdom or in the Isle of Man.

International Registration as Basis for §44 Application (TMEP §1016)

* If the grant of protection, registration, or certificate of extension issued by the designated trademark office of the applicant’s country of origin does not specify goods/services for which protection has been granted, the applicant should submit both an extract of the International Register issued by WIPO that lists the goods/services of the international registration and the document issued by the designated trademark office to establish the scope of protection of the §44(e) application. A user-generated printout from the WIPO database is not sufficient.

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# AMENDMENT TO ALLEGE USE

## Withdrawal of Amendment to Allege Use (TMEP §1104.11)

* The USPTO will not refund the fee for filing an amendment to allege use that is withdrawn (except as provided in TMEP §1104.04).
* The fee cannot be applied toward another allegation of use filed after the amendment to allege use is withdrawn.
* If the applicant wishes to reassert use prior to publication, the applicant may not rely on the amendment to allege use that was withdrawn. It must file a new amendment to allege use in order to amend the basis to use in commerce.

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# AMENDMENT OF APPLICATION

Amendment After NOA and Before SOU (TMEP §1107)

* An applicant cannot delete a §1(b) basis if the only other basis is §44(d). Section 44(d) provides only a basis for receipt of a priority filing date, not a basis for publication or registration.
* The applicant may request deletion of the §1(b) basis only by filing a petition to allow consideration of an amendment to a §44(e) filing basis.

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# GENERIC MARKS

## Key Aspect of Goods or Services (TMEP §1209.03(v))

* A term may be generic for a genus of goods or services if the relevant public understands the term to refer to a key aspect of that genus, such as a key product that characterizes a particular genus of retail services or identifies a category of goods or services within the genus.

Stylization (TMEP §1209.03(w))

* Adding stylization to descriptive or generic wording does not render the resulting mark registrable on the Principal Register unless the stylization creates a commercial impression separate and apart from the impression made by the wording itself, or the applicant can otherwise show by evidence that the particular stylized display has acquired distinctiveness.
* If descriptive or generic wording is in fact presented in a distinctive display or design, the mark as a whole may be registered with a disclaimer of the unregistrable component.
* If generic wording is stylized to create a display or design that is not inherently distinctive, but is nonetheless capable of functioning as a mark, the mark may be registered on the Supplemental Register with a disclaimer of the generic wording.

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# PRIMARILY GEOGRAPHICALLY DECEPTIVELY MISDESCRIPTIVE AND DECEPTIVE TERMS

## Terms Combined with Additional Matter (TMEP §1210.06(b))

* A §2(e)(3) refusal is not appropriate unless the evidence shows that the mark as a whole would likely be perceived as indicating the geographic origin of the goods or services.
* A mark should not be refused under §2(a) unless the relevant geographic matter, when considered in the context of the mark as a whole, is deceptive.

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# SURNAMES

Primarily Merely a Surname (TMEP §1211.01, 1211.01(a), 1211.01(a)(vi))

* The impact the applied-for term has or would have on the purchasing public must be evaluated in determining whether the primary, and only, significance of the term is a surname significance. *In re Eximius Coffee*, \_\_ USPQ2d \_\_\_ (TTAB 2016).
* Any of the *Benthin* factors – singly or in combination – and any other relevant circumstances may shape the analysis in a particular case.
* Evidence that a term has no recognized meaning other than as a surname further supports a determination that its primary significance is as a surname.
* Examining attorneys may submit evidence that the public would perceive a term to have surname significance due to its *structure or pronunciation*. For example, the examining attorney may compare the mark at issue to other terms with the same structure. In such cases, the examining attorney must provide evidence to show that the public would be likely to perceive the mark as a surname due to the similar structure, such as evidence that the terms to which the mark is being compared are common surnames to which the public has been exposed.

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# IDENTIFICATION OF GOODS AND SERVICES

Moving Goods/Services Between Companion Applications (TMEP 1402.08)

* In applications under §1, the applicant may request to move goods/services under a §1(b) basis to a companion application that includes goods/services in the same class, but which are under a §1(a) basis, or vice versa.
* The examining attorney must ensure that the application to which the goods/services are moved clearly indicates that more than one basis is claimed and separately lists each basis, followed by the goods/services to which that basis applies.

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# DISCLAIMERS

Amendments Adding or Deleting (TMEP 1505.02(e))

* If the notice of allowance has issued, an amendment to *insert* a disclaimer may not be submitted as a post publication amendment. It must be submitted in a petition to the Director under Trademark Rule 2.146.
* A request to *delete* a disclaimer after issuance of the notice of allowance and before the filing of a statement of use is not permitted. Between the issuance of the notice of allowance and the filing of a statement of use, the Office cannot republish the application or issue an Office action regarding the request. The applicant may submit the amendment with the statement of use

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# PETITIONS

Cancelled/Expired Registrations – Standard of Review (TMEP 1712.02(b)(ii))

* If the petition does not include a clear statement that the Office action was not received and either a complete response or request to reissue the Office action, the USPTO will notify the petitioner that this information is required, and grant the petitioner 30 days to submit the information.
* If the petitioner does not submit this information within the time allowed, the petition will be denied because the petitioner did not meet the requirements for filing a petition and the registration will remain cancelled.

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