TMEP HIGHLIGHTS – OCTOBER 2017

This outline highlights some of the clarifications and changes set forth in the October 2017 version of the TMEP. For a more complete listing, see the “Index to Changes in TMEP October 2017” document, which is posted as part of the TMEP.

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**UNAUTHORIZED PRACTICE**

***Individuals Excluded, Suspended, or Unauthorized to Practice Before the USPTO*** (TMEP §608.02)

* A suspended or excluded individual is not a qualified practitioner and may not practice before the USPTO. 37 C.F.R. §§2.17(a), 11.14, 11.58.
* When the Director of the USPTO or Commissioner for Trademarks has suspended or excluded a particular individual from practice before the USPTO, the USPTO will treat any submission signed by such individual as improperly signed and/or non-responsive. 37 C.F.R. §§2.17(a) and 11.14.
* Other submissions that will be treated as improperly signed and/or non-responsive include amendments alleging use, petitions to revive or to the Director, or responses to deficiency or inquiry letters issued by USPTO specialists, paralegals, or staff attorneys.

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**SIGNATURE ON CORRESPONDENCE**

***Proper Person to Sign*** (TMEP §611.03)

* If an application or registration owner who is not represented by a qualified practitioner becomes deceased or legally incapacitated, only a party authorized under the relevant state law regarding wills or intestate succession may sign a document required to be signed by the owner. For example, if the owner’s estate has not been settled, the executor may be an authorized party under the relevant state law.
* In such situations, the document must state that the owner is deceased or legally incapacitated and that the signatory is authorized to sign under the relevant state law.

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# examiner’s amendments

***Examiner’s Amendment Without Prior Authorization*** (TMEP §707.02)

* When **an application under §1 or §44** includes a disclaimer of the entire mark, and the application would otherwise be in condition for approval for publication or registration without the need to contact the applicant or issue an Office action, the examining attorney may issue an examiner’s amendment noting that the entire mark may not be disclaimed and that the disclaimer will be deleted from the record. .
* When **a response to an Office action** includes a disclaimer of the entire mark, and the application would otherwise be in condition for approval for publication or registration, the examining attorney may issue an examiner’s amendment noting that the entire mark may not be disclaimed and that the disclaimer will be deleted from the record.

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**ABANDONMENT OF MULTIPLE-BASIS APPLICATIONS**

***Failure to Respond to an Office Action*** (TMEP §806.02(d)(i))

* When an applicant fails to respond to an Office action in which a refusal or requirement was specifically limited to particular goods/services/classes, the examining attorney will abandon the application in part as to the particular goods/services/classes to which the refusal or requirement is limited.
  + To the extent those goods/services/classes are the only goods/services/classes **supported by one basis of multiple filing bases**, the filing basis corresponding to such goods/services/classes will also be deleted from the application.
  + If **the different bases apply to all goods/services within a class or to all classes, a partial-abandonment advisory must not be given**. The failure to respond will result in abandonment of the entire application.

***Failure to Respond to a Notice of Allowance*** (TMEP §806.02(d)(ii))

* If an applicant fails to respond to a notice of allowance that applies to some or all of the goods and/or services in a multiple-basis application, the failure to respond will result in abandonment of the entire application. The Office will not partially abandon the goods/services to which the §1(b) basis applies, nor will it abandon the §1(b) basis as it applies to any or all goods/services in the application.

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# ELIGIBLE APPLICANTS UNDER §44

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

* Citizens of British overseas territories and Crown Dependencies are also citizens of the United Kingdom.
* Individuals claiming citizenship in Anguilla, Bermuda, British Antarctic Territory, British Indian Ocean Territory, British Virgin Islands, Cayman Islands, Falkland Islands, Gibraltar, Montserrat. Pitcairn Islands, Saint Helena, Ascension and Tristan da Cunha, South Georgia and the South Sandwich Islands, Turks and Caicos Islands, the Bailiwick of Jersey, the Bailiwick of Guernsey, and the Isle of Man will be considered as having the United Kingdom as one of their countries of origin. However, this exception does not apply to juristic persons.
* Accordingly, individuals, but not juristic persons, from one of the British overseas territories or Crown Dependencies, are entitled to priority under §44(d) or registration under §44(e) so long as the relevant foreign registration issued from a country that is party to a treaty or agreement with the United States.

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# USE OF SUBJECT MATTER AS TRADEMARK

***Title of a Single Creative Work*** (TMEP §1202.08)

* When a title, or a portion of a title, of a single creative work appears in a composite mark with registrable matter, the title must be disclaimed, if otherwise appropriate, as an unregistrable component of the mark, unless the evidence shows use of the title on a series of creative works.

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**SECTION 2(a)**

***Refusal on Basis of Matter that May Disparage or Bring into Contempt or Disrepute*** (TMEP §§1203 and 1203.03(b))

* Until June 19, 2017, the USPTO examined applications pursuant to the provision in Section 2(a) of the Trademark Act that prohibits the registration of a mark that consists of or comprises matter that may disparage, or bring into contempt or disrepute, persons, institutions, beliefs, or national symbols.
* In *Matal v. Tam*, 582 U.S. \_\_\_, 122 USPQ2d 1757 (U.S. 2017), the Supreme Court of the United States held that the disparagement provision of 15 U.S.C. §1052(a) violates the Free Speech Clause of the First Amendment.
* Accordingly, that a mark may “disparage . . . or bring . . . into contempt, or disrepute” is no longer a valid ground on which to refuse registration or cancel a registration.

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**SECTION 2(b)**

***Designs That Should Not Be Refused Under §2(b)*** (TMEP §1204.02(c))

* Designs that do not rise to the level of being emblems of national authority, or emblems of state or municipal authority, should not be refused.
* *Exception*: As a result of the enactment of Public Law 98 525 on October 19, 1984, the initials, seal, and emblem of the United States Marine Corps are “deemed to be insignia of the United States.”
* The amendments adding this section do not affect rights that vested before October 19, 1984. Applications claiming use after October 19, 1984 must be refused.

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**DESCRIPTIVENESS**

***Dictionary Listing*** (TMEP §1209.03(b))

* In terms of establishing a term’s likely meaning to consumers, evidence of the current usage may carry more weight than an older dictionary meaning. *See In re Well Living Lab Inc.*, 122 USPQ2d 1777, 1781 (TTAB 2017).

***Historical Figure Names and Fictional Character Names*** (TMEP §1209.03(x))

* The determination of whether a mark comprising the name of an historical figure or a fictional character serves as a source identifier or is merely descriptive turns on:
  + whether consumers link the mark to a particular commercial entity or
  + whether others have a competitive need to use the name to describe their products.
* The case law has drawn a distinction between situations where the applicant owns intellectual property rights in the work(s) from which the character arose and those where the character is a historical figure or is in the public domain

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**SURNAMES**

***Surname Combined with Additional Matter*** (TMEP §§1211.01(b) and (b)(vi))

* The determination of whether a word that, standing by itself, would be primarily merely a surname, would be perceived by the public as a surname when coupled with additional matter involves:
  + assessing the distinctiveness of the additional matter and
  + assessing whether its addition to the surname alters the primary significance of the mark as a whole to the purchasing public.

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**LAWFUL USE**

***Ivory, Bone, Whalebone, Horn, and Tusks*** (TMEP §1401.14(f))

* Identifications that include “ivory,” “bone,” “whalebone,” “horn,” or “tusks” may necessitate an inquiry regarding lawful use in commerce in connection with, for example, the Endangered Species Act (ESA), the African Elephant Conservation Act, and/or the Marine Mammal Protection Act (MMPA).
* ID Manual entries related to those goods were deleted effective January 1, 2017.

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**IDENTIFICATION OF GOODS AND SERVICES**

***Specifying the Goods/Services*** (TMEP §§1402.01 and 1402.06(a))

* An identification that fails to identify the goods and services with specificity is indefinite, either because the nature of the goods or services is not clear or because the wording is so broad that it may include goods or services in more than one class.
* Wording such as “included in this class” is not the common name of particular goods or services. If an identification includes wording such as “included in this class,” “belonging in this class,” or “excluding goods/services in other classes,” or the like, the examining attorney will require the applicant to delete such wording because it does not identify a particular good or service.

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**POST REGISTRATION**

***Amendment of Mark* *in Registration Based on §1 or §44*** (TMEP §1609.02)

* A request to add a standard-character claim to a mark designated as a typed drawing must be submitted pursuant to §7(e) and meet all of the requirements for an amendment to a registration that involves a change in the mark, including a new drawing, supporting specimen per class, and declaration.

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