TMEP HIGHLIGHTS – OCTOBER 2018

This outline highlights some of the clarifications and changes set forth in the October 2018 version of the TMEP. For a more complete listing, see the “Index to Changes in TMEP October 2018” document, which is posted as part of the TMEP.

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

**SIGNATURE ON CORRESPONDENCE**

***Guidelines on Persons with Legal Authority to Bind Certain Juristic Entities*** (TMEP §611.06)

* When a document must be signed by a person with "legal authority to bind a juristic entity," the **signatory must be someone who has the authority to bind that entity to any obligation and/or agreement** whatsoever, and not solely with regard to trademark matters.

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

# EVIDENCE

***Internet Evidence*** (TMEP §710.01(b))

* For internet evidence, applicants, like examining attorneys, must (1) provide complete information as to the date the evidence was published or accessed from the Internet, and its source (e.g., the complete URL address of the website), and (2) download and attach the evidence to the Office action. If these requirements are not satisfied but an objection is not timely raised, the TTAB may consider the evidence for whatever probative value it may have.
* Evidence from a **“cached” or stored website may be admissible** if properly made of record and there is no evidence indicating that the website is inactive.
* The **TTAB may consider Wikipedia® excerpts submitted with a denial of a request for reconsideration** because an applicant has an opportunity to rebut entry of the excerpts by requesting remand to submit rebutting evidence.

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

**FINAL ACTION**

***Delineating New Issues Requiring Issuance of a Nonfinal Action*** (TMEP §714.05(a))

* A **new nonfinal action is not required** if further amendment to the identification of goods and/or services is needed as to wording previously identified as indefinite in a non-final Office action (e.g., applicant responds to an identification requirement by submitting amended wording that is unacceptable).

***Amendment of Identification of Goods/Services*** (TMEP §714.05(a)(ii))

* A **new nonfinal action is required** if further amendment to the identification of goods and/or services is needed as to issues not previously raised by the examining attorney (e.g., applicant properly responds to an identification requirement in a first non-final Office action and the examining attorney subsequently requires that other goods and/or services in the original identification be amended).

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

# FILING BASIS

***Procedure for Asserting More Than One Basis*** (TMEP §806.02(a))

* **Basis notations are not required** in a multiple-basis, multiple-class application if it has only §1(a) and §1(b) bases, and each class within the application has either a §1(a) or §1(b) basis (i.e., there are no dual bases within any class).

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

# IDENTIFICATION OF GOODS AND SERVICES

***Identification and Classification of Goods/Services*** (TMEP §819.01(g))

* For TEAS Plus applications, **no additional fee is required** if the identification of goods/services has a fill-in-the-blank element and the applicant inserts information that is a reasonable attempt to supply the required information in accordance with the instructions, but requires amendment **because the inserted information includes indefinite wording from the parenthetical guidance** provided for instructional purposes (e.g., “specify,” “indicate,” “etc.”).

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

* The terms **“products” and “equipment” fail, by themselves, to identify recognizable goods/services** for purposes of entitlement to a filing date.

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

**IDENTIFYING THE APPLICANT IN THE APPLICATION**

***Correcting Errors in How the Applicant is Identified*** (TMEP §1201.02(c))

* If an **application owned by joint applicants is filed in the name of one of the owners and another party who is not the joint owner**, this **is a non-correctable error** and the application is void as filed because the listed parties did not own the mark as joint applicants.

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

**DESIGNATION OF A U.S. GOVERNMENT AGENCY OR INSTRUMENTALITY**

***Ownership of Mark*** (TMEP §1201.06(c))

* For a mark that would otherwise be subject to a refusal under §2(a) because it falsely suggests a connection with a designation of a U.S. government agency, instrumentality, or program, such as names, acronyms, titles, terms, and symbols, but the record demonstrates that the **applicant has some affiliation with the agency or program, the examining attorney must issue an information request** under 37 C.F.R. §2.61(b) requiring further information as to ownership of the designation and authorization to register.
* If it appears that the applicant lacks authorization to register the designation in the mark, the examining attorney must refuse to register under §1 of the Trademark Act because the applicant is not the owner of the governmental designation in the mark. The mark must also be refused under §§1 and 45 (absence of lawful use) when such marks are subject to statutory protection.
* Disclaiming the name of, or acronym for, the U.S. government agency or instrumentality to which the mark refers generally will not overcome the refusal under §§1 and 45.

***False Suggestion of a Connection*** (TMEP §1203.03(c)(ii))

* The **§2(a)** false suggestion of a connection refusal and related procedures **also apply to marks containing names of, and acronyms and terms for, United States government programs** (e.g., Medicare or FAFSA), military projects (e.g., BigDog), and quasi-government organizations (e.g., Smithsonian Institution).
* Many statutes protecting designations of government agencies and instrumentalities allow third parties to use the protected matter when authorized by an agency official. This **authorization to use, by itself, should not be construed to extend to authorization to register** marks that include matter the applicant does not own.
* If the test for false suggestion of a connection under §2(a) is not met, the examining attorney must still determine whether the applicant is authorized to register the designation in the mark. If, based on the record, the applicant lacks authorization from the government agency or instrumentality to register the mark, the examining attorney must refuse under §§1 and 45 of the Trademark Act (absence of lawful use).

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

**LIKELIHOOD OF CONFUSION**

***Coexistence of Applicant’s Prior Registration with Conflicting Registration*** (TMEP §1207.01)

* When determining whether the coexistence of the applicant’s prior registration with another party’s registration weighs against citing the latter registration in a §2(d) refusal of the applicant’s applied-for mark, the examining attorney should consider: (1) whether the applicant’s prior registered mark is the same as the applied-for mark or is otherwise not meaningfully different; (2) whether the identifications of goods/services in the application and the applicant’s prior registration are identical or identical in relevant part; and (3) the length of time the applicant’s prior registration has co-existed with the registration being considered as the basis for the §2(d) refusal. The **duration of coexistence is not dispositive as to whether a §2(d) refusal should issue**; instead, this factor should be considered together with all the other relevant du Pont factors.

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

**ACQUIRED DISTINCTIVENESS**

***Unnecessary §2(f) Claims*** (TMEP §1212.02(d))

* The amount of time the **examining attorney must wait** for applicant’s response to an inquiry about an unnecessary §2(f) claim before entering a Note to the File and approving the application without deleting the claim is now **3 business days**.

***Parodies and Copies*** (TMEP §1212.06(e)(vi))

* In rare cases, evidence of the creation of **intentional parodies** of an otherwise nondistinctive mark **may be significant in assessing whether the mark has successfully achieved public recognitio**n as a source indicator.

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

**DISCLAIMERS**

***Voluntary Disclaimer of Registrable or Unregistrable Matter*** (TMEP §1213.01(c))

* The amount of time the **examining attorney must wait** for applicant’s response to an inquiry about an unnecessary voluntary disclaimer before entering a Note to the File and approving the application without deleting the disclaimer is now **3 business days**.

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

**SPECIMENS OF USE FOR SERVICE MARKS**

***Software Applications ("Apps")*** (TMEP §1301.04(h)(iv)(D))

* For service mark specimens, **mere depiction of the mark in an app screenshot without sufficient depiction of the activity identified in the services does not establish service mark use** within the definition of “use in commerce” under Trademark Act Section 45.

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_