

Mandatory electronic filing and TEAS form updates

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UNITED STATES
PATENT AND TRADEMARK OFFICE



What we'll cover today

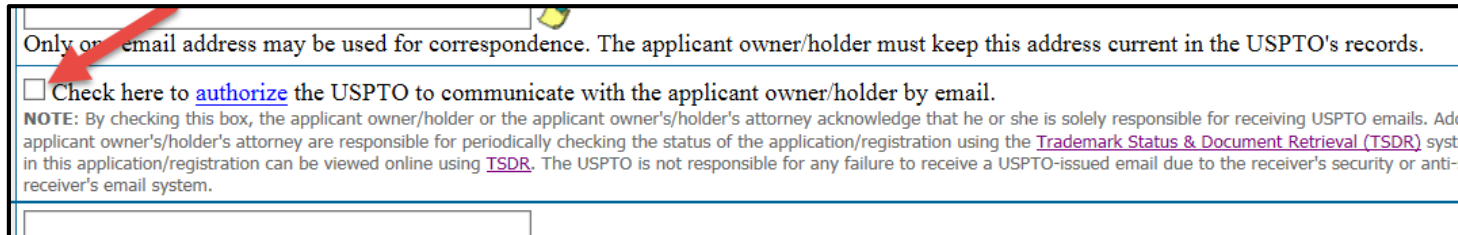
Changes affecting:

- All forms
- Initial application forms
- Petition forms
- Post-registration forms
- Correspondence and attorney/domestic representative forms

Changes affecting all forms

Entering email address

- Owner email address field now mandatory
- Email authorization is presumed. Removed check box for authorizing email communication when you provide an email address for the owner/holder, attorney, or domestic representative



Only one email address may be used for correspondence. The applicant owner/holder must keep this address current in the USPTO's records.

Check here to [authorize](#) the USPTO to communicate with the applicant owner/holder by email.

NOTE: By checking this box, the applicant owner/holder or the applicant owner's/holder's attorney acknowledge that he or she is solely responsible for receiving USPTO emails. Add applicant owner's/holder's attorney are responsible for periodically checking the status of the application/registration using the [Trademark Status & Document Retrieval \(TSDR\)](#) system in this application/registration can be viewed online using [TSDR](#). The USPTO is not responsible for any failure to receive a USPTO-issued email due to the receiver's security or anti-spam receiver's email system.

Revised correspondence information

- Removed postal address, telephone number, and fax number fields
- **Name and primary email address fields for correspondence are not editable.** Populates from attorney's email address, if appointed; otherwise, the owner's email address
- Enter up to four secondary email addresses for courtesy copies of USPTO communication

Correspondence Information	
Watch the TEAS Nuts and Bolts: Correspondence Information video on the USPTO website for instructions on this page. To make changes to the Primary Email Address for Correspondence below, either (1) return to the Applicant Information section (if no attorney has been appointed) and enter the change, or (2) use the Attorney Information section of the form to enter the change (if an attorney has been appointed).	
Name	Pam Martin
Email Address	Primary Email Address for Correspondence: attorney@email.com Secondary Email Address(es) (Courtesy Copies) <input type="text"/> Enter up to 4 addresses, separated by either a semicolon or a comma . Only the Primary Email Address for Correspondence is used for official communication by the USPTO. If an attorney has been appointed, the USPTO will correspond ONLY with the appointed attorney; otherwise the USPTO will correspond with the applicant owner/holder. The applicant owner/holder or the appointed attorney must keep this email address current with the USPTO. <small>NOTE: I understand that (1) a valid email address must be maintained by the applicant owner/holder and the applicant owner's/holder's attorney, if appointed, for correspondence and (2) all official trademark correspondence must be submitted via the Trademark Electronic Application System (TEAS).</small>

Validation page: email addresses

- The “Email for acknowledgement” field has been renamed “Primary Email Address for Correspondence” and there is a new secondary email address field to make it easier to identify the recipients of the filing receipt.
- You **cannot change the email addresses** used to send the TEAS filing receipt **on the validation page**.
- Email addresses prepopulate with the primary email address for correspondence and secondary email address(es), if any.

■ **STEP 2:** If there are no errors and you are ready to file, confirm the **Primary Email Address for Correspondence**, displayed below. To make changes to this email address, use the navigation buttons below to return to the appropriate page in the form and update either the attorney's email address, if appointed, or the applicant owner's/holder's email address. **Courtesy copies** are also permitted and these email address(es) are displayed below. To update these addresses, use the navigation buttons below to return to the Correspondence Information page and enter the changes.

After you submit the form, the USPTO will send an acknowledgment of receipt to the following email address(es):

Primary Email Address for Correspondence:	email@email.com	←
Secondary Email Address(es) (Courtesy Copies):	secondary@email.com	←

These addresses are NOT editable.
Go back in the form to make changes.

Owner and attorney information pages

- Most TEAS forms now contain both pages

Owner Information	
* Owner of Mark	<input type="text"/>
<small>(If an individual, use the following format: Last Name, First Name Middle Initial or Name, if applicable)</small>	
<input type="checkbox"/> DBA (doing business as) <input type="checkbox"/> AKA () <input type="checkbox"/> TA (trading as) <input type="checkbox"/> Formerly	
* Entity Type	
<input type="radio"/> Individual	
<input type="radio"/> Corporation	
<input type="radio"/> Limited Liability Company	
<input type="radio"/> Partnership	
<input type="radio"/> Limited Partnership	
<input type="radio"/> Joint Venture	
<input type="radio"/> Sole Proprietorship	
<input type="radio"/> Trust	
<input type="radio"/> Estate	
<input checked="" type="radio"/> Other	
Internal Address	
* Street Address <small>(Current domicile required for all owners/holders)</small>	
* City	
* State	

Attorney Information	
* Attorney Name	<input type="text"/>
Individual Attorney Docket/Reference Number	<input type="text"/>
	<small>NOTE: You must limit your entry here to no more than 12 characters.</small>
* Bar Membership	* Year of Admission <input type="text" value="Select Year"/>
	* U.S. State/Commonwealth/Territory <input type="text" value="Select State"/>
	* Membership Number <input type="text"/>
	<small>You must enter "N/A" or a membership number if your U.S. state, commonwealth, or territory issues one. This number is not viewable in TSDR. You must limit your entry here to no more than 40 alphanumeric characters.</small>
	* <input type="checkbox"/> The attorney of record is an active member in good standing of the bar of the highest court of a U.S. state, the District of Columbia, or any U.S. Commonwealth or territory.
Other Appointed Attorney(s)	<input type="text"/>
Recognized Canadian Attorney/Agent	<input type="text"/>
Firm Name	<input type="text"/>
Internal Address	<input type="text"/>
* Street Address	<input type="text"/>
	<small>NOTE: You must limit your entry here, and for all remaining fields within this overall section (except City, see below), to no more than 40 characters (the storage limit for the USPTO database). You may need to abbreviate some words, e.g., St. instead of Street. Failure to do so may result in an undeliverable address, due to truncation at the 40 character limit.</small>

[NOTE: You must include as part of the "City" entry any information related to geographical regions (e.g., provinces) not found in the dropdown lists for "States" or "Countries."]

Owner information for Madrid filings

- TEAS forms will include a Madrid version of the owner information page for 79 series files
 - Will permit the addition and/or update of an owner or holder email address
- Changes to the owner's or holder's postal address must continue to be made through the WIPO MM9 form
- Separate domicile address can be provided in the new Change Address or Representation form

Owner Information	
Owner Name	<input type="text"/>
Address (Changes must be made using WIPO Form MM9)	<input type="text"/> London W1D 3SG <input type="text"/> United Kingdom
* Email Address	<input type="text"/> The owner/holder is required to provide an email address and keep that address current. If the owner/holder is represented by a U.S.-licensed attorney, only the attorney's email address will be used for correspondence by the USPTO. NOTE: The owner/holder or the owner's/holder's attorney acknowledges that he or she is solely responsible for receiving USPTO emails. Additionally, the owner/holder or the owner's/holder's attorney is responsible for periodically checking the status of the application/registration using the Trademark Status & Document Retrieval (TSDR) system. USPTO notices and office actions issued in this application/registration can be viewed online using TSDR . The USPTO is not responsible for any failure to receive a USPTO-issued email due to the receiver's security or anti-spam software, or any problems with the receiver's email system.

Representation: recognized Canadian attorneys and agents

- Will have a separate field for entering their name on the attorney information page

* <u>Attorney Name</u>	<input type="text"/>
<u>Individual Attorney Docket/Reference Number</u>	<input type="text"/> <small>NOTE: You must limit your entry here to no more than 12 characters.</small>
* <u>Bar Membership</u>	* Year of Admission <input type="text" value="Select Year"/>
	* U.S. State/Commonwealth/Territory <input type="text" value="Select State"/>
	* Membership Number <input type="text"/> <small>You must enter "N/A" or a membership number if your U.S. state, commonwealth, or territory issues one. This number is not viewable in TSDR. You must limit your entry here to no more than 40 alphanumeric characters.</small>
* <input checked="" type="checkbox"/> The attorney of record is an active member in good standing of the bar of the highest court of a U.S. state, the District of Columbia, or any U.S. Commonwealth or territory.	
<u>Other Appointed Attorney (s)</u>	<input type="text"/>
<u>Recognized Canadian Attorney/Agent</u>	<input type="text"/>

Changes to initial application forms

Initial application forms – enhancements

- **Form options**
 - TEAS RF renamed TEAS Standard
 - TEAS Regular no longer a filing option
 - Single initial application form for TEAS Plus and TEAS Standard
- **Domicile address**
 - Keep domicile address private by using a new field
- **Sole proprietor field**
 - Clearer prompts for required information

TEAS Plus/TEAS Standard initial application form

- Select desired filing option on the wizard page

1. Please select one of the filing options below.

- TEAS Plus:** I am filing a TEAS Plus application, with a reduced fee of **\$225 per class** of goods/services. Failure to comply with [TEAS Plus Requirements](#) will incur an additional processing fee of \$125 per class of goods/services.
- TEAS Standard:** I am filing a TEAS Standard application, with a fee of **\$275 per class** of goods/services.

- Toggle between these filing options while in the form, if needed

New domicile address field

- Enhanced the initial application forms and new Change Address or Representation form to allow owners to provide a separate domicile address
- USPTO presumes owner's street address and owner's domicile address are the same
- If addresses differ, you may enter a separate address in the domicile address field and it is **not publicly viewable** in the USPTO's TSDR database

<p>* Street Address ←</p> <p>(Entered address is viewable in the USPTO's TSDR database. This address must be capable of receiving mail. The USPTO presumes this address is the applicant owner's/holder's domicile. If it is not, enter the Domicile Address below.)</p>	<input type="text"/>	<p>NOTE: You must limit your entry here, and for all remaining fields within this overall section, to no more than 40 characters (the storage limit for the USPTO database). You may need to abbreviate some words, e.g., St. instead of Street. Failure to do so may result in an undeliverable address, due to truncation at the 40 character limit.</p>
<p>* City</p>	<input type="text"/>	<p>NOTE: You must limit your entry here to no more than 22 characters.</p>
<p>* State (Required for U.S. applicant owners/holders)</p>	Select State <input type="text"/>	<p>NOTE: You must include as part of the "City" entry any information related to geographical regions (e.g., provinces) not found in the dropdown lists for "States" or "Countries." Enter the city and then the geographical region, separated by a comma (e.g., Toronto, Ontario). In most instances, you will then also have to select the country within which the region is found, below.</p>
<p>* Country or U.S. Territory</p>	Select Country or U.S. Territory <input type="text"/>	
<p>* Zip/Postal Code (Required for U.S. and certain international addresses)</p>	<input type="text"/>	
<p>* Domicile Address ←</p> <p>(If the domicile and the mailing address above are different, enter the Domicile Address here. Enter the number, street, city, state, country or U.S. territory, and if applicable, zip/postal code.)</p>	<input type="text"/>	<p><input checked="" type="checkbox"/> Uncheck this box if the Domicile Address and mailing address of the applicant owner/holder are NOT the same.</p>
	<input type="text"/>	<p>Indicate place you reside and intend to be your principal home (for individual) or your principal place of business (for entity). The address entered in this field is not publicly viewable in the USPTO's TSDR database unless it is the same as the mailing address entered above.</p>

Domicile of the trademark owner/holder:

- the place an individual person resides and intends to be the person's principal home; or
- the principal place of business (e.g., headquarters) where the entity's senior executives or officers ordinarily direct and control the entity's activities

The address used for the domicile of an individual or entity is rarely a P.O. Box or a "care of" address.

Owner information: new fields for sole proprietors

- Domestic sole proprietors will now enter their name in a text field.
- Sole proprietor's citizenship is separately selected from a dropdown menu.

* Entity Type <input type="radio"/> Individual <input type="radio"/> Corporation <input type="radio"/> Limited Liability Company <input type="radio"/> Partnership <input type="radio"/> Limited Partnership <input type="radio"/> Joint Venture <input checked="" type="radio"/> Sole Proprietorship <input type="radio"/> Trust <input type="radio"/> Estate <input type="radio"/> Other		
	* State or Country Where Legally Organized	If U.S. Entity Select State <input type="text"/>
	<i>For domestic applicants only:</i> Name of Sole Proprietor	OR If non-U.S. Entity Select Country <input type="text"/>
	<i>For domestic applicants only:</i> Country of Citizenship of Sole Proprietor	Select Country <input type="text"/>

Changes to petition forms

Petition forms – enhancements

- Revised petition to the director
 - Dedicated fields instead of open text box
 - Reasons for the petition and necessary updates to the application/registration are clearly identified

Improved Petition to director form

Pre-registration: ←

Enter your Serial Number or Registration Number. On the next screen select the reason for your petition and answer questions to indicate the type of information you want to provide within the petition.

* SELECT THE APPROPRIATE RADIO BUTTON TO INDICATE THE REASON FOR YOUR PETITION.

- Revive partially abandoned goods/services
- Revive application abandoned for more than six months due to extraordinary circumstances
- Reverse holding of abandonment for incomplete response
- Expunge or redact information from public view
- Amend my application after a notice of allowance has issued
- Allow multiple renditions of my mark in a single drawing
- Accept a previously submitted and timely filed paper submission
- Trademark Electronic Application System (TEAS) related issue
- Problem occurred while making a fee payment (FPNG related issue)
- Other (Enter explanation)

↓
Post-registration:

* SELECT THE APPROPRIATE RADIO BUTTON TO INDICATE THE REASON FOR YOUR PETITION.

- Reinstate a cancelled registration and accept a late response to Post Registration office action
- Issue duplicate registration certificate
- Review decision denying Section 8 or 71 declaration
- Review decision denying Section 7 request
- Expunge or redact information from public view
- Accept a previously submitted and timely filed paper submission
- Problem occurred while using Trademark Electronic Application System (TEAS)
- Problem occurred while making a fee payment (FPNG related issue)
- Other (Enter explanation)

Using the Petition to director form

Use this form to update the information above. A current email address must be provided for the trademark owner/holder and the appointed attorney, if any. The **Primary Email Address for Correspondence** is the email address of the attorney, if appointed, if not, the trademark owner/holder. This is the official address for receiving communications from the USPTO. Courtesy email addresses may be provided within this form.

STEP 3: PROVIDE RESPONSE BELOW.

* SELECT THE APPROPRIATE RADIO BUTTON TO INDICATE THE REASON FOR YOUR PETITION.

- Reinstate a cancelled registration and accept a late response to Post Registration office action
- Issue duplicate registration certificate
- Review decision denying Section 8 or 71 declaration
- Review decision denying Section 7 request
- Expunge or redact information from public view
- Accept a previously submitted and timely filed paper submission
- Problem occurred while using Trademark Electronic Application System (TEAS)
- Problem occurred while making a fee payment (FPNG related issue)
- Other (Enter explanation)

REVIEW ALL QUESTIONS BELOW AND SELECT THE APPROPRIATE RADIO BUTTONS TO ANSWER YES OR NO.

1. Is a [newly appearing U.S.-licensed attorney](#) filing this form or do you need to update the bar information, email address, street address, phone or fax number for an already appointed attorney?

Wizard questions build your personalized form—dedicated fields for filing information.

Changes to post-registration forms

Post-registration forms – enhancements

- Post-registration response to office action form
- Select the filing that prompted the office action
- Wizard questions that allow you to build a customized response form
- Dedicated fields instead of open text box for response

Post-registration response to office action

- Dedicated form options for all filing types:

***STEP 3: To respond to an Office action sent in response to any of the following, select the appropriate option:**

- Combined declaration of use & incontestability under Sections 8 & 15
- Declaration of Use and/or Excusable Nonuse of a Mark under Section 8
- Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal under Sections 8 & 9
- Declaration of Incontestability of a Mark under Section 15
- Section 7 Request for Amendment or Correction of Registration Certificate
- Surrender of Registration for cancellation
- Request to Divide Registration
- Section 12(c) Affidavit
- Declaration of Use and Excusable Nonuse under Section 71
- Combined declaration of use & incontestability under Sections 71 & 15

3. Do you need to respond to a [Proof of Use Audit](#)?

Yes No

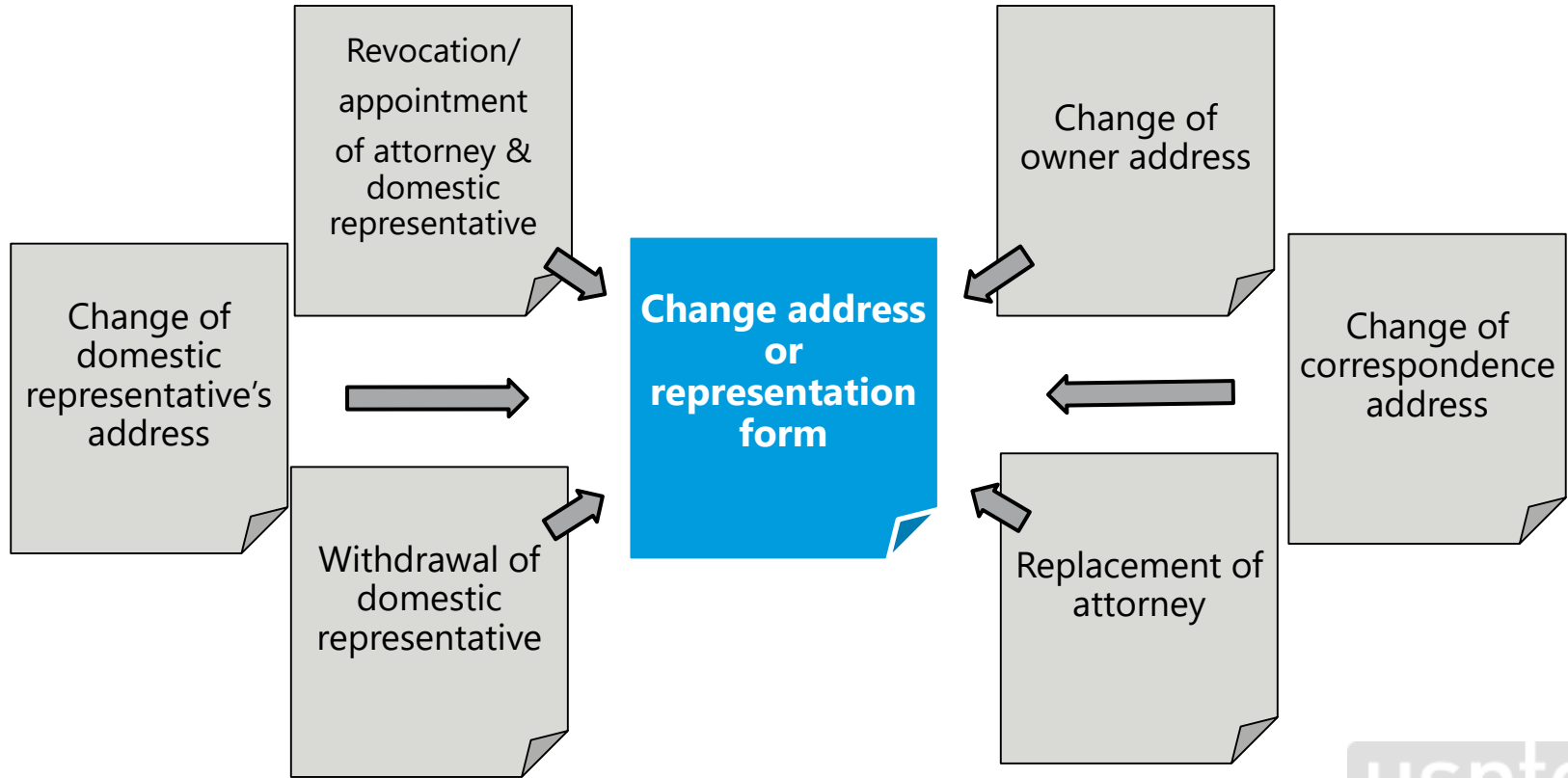
- Choose your option, then complete the form.

Changes to correspondence and attorney/domestic representative forms

Correspondence and attorney/ domestic representative forms - enhancements

- Consolidates six closely related forms into one
- Complete a single form for related actions

New TEAS form



Change address or representation form - 1

- Uses role-based logic
 1. Enter serial or registration number(s)
 2. Identify self as either the owner, attorney, or domestic representative by selecting the appropriate radio button

Use the radio buttons below to indicate the role of the person who is using this form in relation to the Serial/Registration Number(s) entered:

Owner
 Attorney/Law Firm
 Domestic Representative

- Questions appropriate to the identified role appear based on the status of the file(s) in the USPTO's database
- User will indicate what data should be updated

Change address or representation form - 2

Use this form to make updates to different types of data related to your application(s) or registration(s):

- **Update**
 - Contact information for trademark owner/holder, already appointed attorney, or already appointed domestic representative
 - Attorney bar information
- **Appoint** a U.S.-licensed attorney to represent you before the USPTO or Domestic Representative
- **Appear** for the first time as attorney of record on behalf of an owner/holder who is not currently represented
- **Replace** the attorney of record with another already-appointed attorney
- **Revoke** the power of a previously-appointed attorney
- **Remove** a previously-appointed attorney from the record because the power of attorney has ended
- **Withdraw** as domestic representative

Deployment

TEAS deployment information

- TEAS and TEASi will be unavailable on Saturday, December 21 from 12:01 a.m. until 8 a.m. ET to incorporate the mandatory electronic filing changes.
- You must file all saved forms and e-signature forms by **11:59 p.m. ET on Friday, December 20, 2019**, so that your data is not lost.
- If you do not file all of your saved forms by that time, you will have to start the process again with new forms.

Questions during this webinar?

Email: TM_Webinar@uspto.gov





**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Mandatory electronic filing and specimen requirements

Catherine Cain, TMEP editor
Carrie Genovese, senior attorney
Office of Petitions
December 10, 2019

UNITED STATES
PATENT AND TRADEMARK OFFICE



Filing-date requirements

- Requires all applications filed under Sections 1 and/or 44 be filed using TEAS unless:
 - Application is filed by national of an exempt treaty country or
 - Petition to accept paper filing is granted
- Requires email address for each applicant
- Requires practitioner's postal and email address

Changes to filing options

Pre-MEF

- TEAS Plus - \$225
- TEAS RF - \$275
- TEAS Regular - \$400
- Paper - \$600

Post-MEF

- TEAS Plus - \$225
- TEAS Standard - \$275
- Paper – \$600 (treaty country or petition)

TEAS Plus: Processing fee

- Only charged for failure to comply with TEAS Plus initial filing requirements under 37 C.F.R. §2.22(a).
- Submission of subsequent paper filing only granted on petition and incurs paper fee and petition fee.

TEAS Plus: Additional filing requirements

- Domestic partnership must state the names and citizenships of the general partners.
- Domestic joint venture must state the names and citizenships of its active members.
- Sole proprietorship must provide the state of organization and the name and citizenship of the sole proprietor.

Trademark correspondence - 1

- **All filings** relating to applications and registrations must be submitted via TEAS unless:
 - Filed by a national of an exempt treaty country or
 - Petition to accept paper filing is granted

Trademark correspondence - 2

- Paper and TEAS Regular applications and post-registration maintenance documents filed before the effective date are “grandfathered in:”
- They are not required to:
 - provide an email address for correspondence
 - file electronically
- However,...

Trademark correspondence - 3

- Fax transmission is NOT PERMITTED.
 - [37 C.F.R. §§2.62(c), 2.195(c)]
- and...

Trademark correspondence: Non-traditional marks

- It is sometimes not possible to submit a specimen using TEAS because of the nature of the mark:
 - Scent
 - Flavor
- Applicant should indicate in the TEAS filing that the specimen will be mailed in.
- No petition requesting acceptance of the specimen is required.
- The exception does not apply to sound or motion marks. The TEAS form permits attachment of such marks as electronic files.

Trademark correspondence - 4

- All TEAS forms will require applicant's or registrant's:
 - email address
 - the email address of a qualified practitioner, if applicant/registrant is represented

Trademark correspondence - 5

- If an applicant or registrant who is grandfathered in files a TEAS document, the form will not validate without email address(es) being provided.
- Office presumes email communication is authorized when “grandfathered in” party files a submission using TEAS.

Correspondence address

- **Pro se applicants/registrants:**
 - Office will send correspondence only to email address of applicant or registrant [37 C.F.R. §2.18(a)(1)].
- **Represented applicants/registrants:**
 - Office will send correspondence only to email address of attorney of record [37 C.F.R. §2.18(a)(2)] unless:
 - Applicant or registrant files a revocation of and/or new power of attorney;
 - Attorney has been suspended or excluded from practicing in trademark matters;
or
 - Recognition has ended.
- **Courtesy email addresses still permitted**



Correspondence address: Madrid applications

- Exception to requirement for email address – Section 66(a) first-action pubs.
- Section 66(a) applicants must file all subsequent submissions using TEAS and must designate an email address for correspondence.

Correspondence address: Non-traditional marks

- It is sometimes not possible to submit a specimen using TEAS because of the nature of the mark:
 - Scent
 - Flavor
- Applicant should indicate in the TEAS filing that the specimen will be mailed in.
- No petition requesting acceptance of the specimen is required.
- The exception does not apply to sound or motion marks. The TEAS form permits attachment of such marks as electronic files.



When unable to file electronically

- If TEAS or user's system fails:
 - Includes widespread disruptions, natural disasters, and emergencies
- Procedures and requirements depend on whether attempt to file is before or on filing deadline day.

If filing attempt is before filing deadline

- Try again later through TEAS.
- Check systems status and availability page at www.uspto.gov/blog/ebiz/ for widespread outages or scheduled maintenance.
- Contact TEAS staff for technical assistance:
 - TEAS@uspto.gov
 - Call TAC at 1-800-786-9199



If filing attempt is same day as filing deadline - 1

- 1) Desired TEAS form or fee-payment processing is unavailable, but TEAS Petition form is available:
 - File Petition electronically on due date for submission and include:
 - Written verified explanation;
 - Evidence showing that TEAS was unavailable;
 - Document to be filed; and
 - Electronic fees for petition and for document to be filed.

If filing attempt is same day as filing deadline - 2

2) TEAS form is unavailable and TEAS Petition form is unavailable:

- File Petition on paper on due date for submission using the Petition to accept paper cover sheet and include:
 - Proof that TEAS was unavailable on submission due date. May provide printout of a screenshot of error message or statement of this fact;
 - Signed declaration that information provided as proof is accurate;
 - \$200 paper petition fee and paper fee(s) for document submitted;
 - Printout of specific PDF for TEAS form completed by hand; and
 - Signed certificate of mailing



If filing attempt is same day as filing deadline - 3

3) Unable to login to USPTO.gov account:

- See MyUSPTO and USPTO.gov account FAQs at www.uspto.gov/learning-and-resources/account-faqs or contact TAC.
- If still unable to login and deadline is that same day, must file on paper with petition.
- Follow instructions in (2) for filing petition and document on paper.

If filing attempt is same day as filing deadline - 4

- 4) USPTO has declared a widespread service disruption:
- See systems status and availability page at:
www.uspto.gov/blog/ebiz/
 - File via fax or regular paper mail.
 - In general, fax transmission is not permitted UNLESS the USPTO has declared a widespread outage and specifically instructed customers to submit documents via fax.
 - No petition or petition fee required.



If filing attempt is same day as filing deadline - 5

5) Extraordinary situation prevents electronic filing:

- File on paper with petition
- Include explanation as to why situation qualifies as extraordinary.
 - Regional natural disasters that interrupt postal service are usually designated as widespread disasters.
- Follow instructions in (2) for filing petition and document on paper.

Paper submissions: Petition to the director - 1

- 37 C.F.R. §2.147 - Petition to the director to accept a paper submission
- Petitions may be submitted if:
 - TEAS is unavailable on the date of a deadline for submission and the applicant provides proof that TEAS was unavailable; or
 - The applicant/registrant previously timely filed a paper submission that was not processed and is unable to resubmit the document electronically by the statutory deadline.
 - If the applicant/registrant does not qualify under the above and requests acceptance of the paper submission under Rule 2.146(a)(5) due to an extraordinary situation.

Paper submissions:

Petition to the director - 2

- Regularly scheduled TEAS maintenance or user error will generally not qualify for relief under 37 C.F.R. §2.147 or as an extraordinary situation under 37 C.F.R. §2.146(a)(5).
- Rules and policies regarding postal services interruptions and emergencies remain unchanged.

Specimen rule updates

- 37 C.F.R. §2.56 is amended to better conform with existing statutory requirements and precedential case law regarding specimens.

Specimen rule update: Labels and tags - 1

- 37 C.F.R. §2.56(b):
 - “A trademark specimen must show use of the mark on the goods, on containers or packaging for the goods, on labels or tags affixed to the goods, or on a display associated with the goods. To constitute a display associated with the goods, a specimen must show use of the mark directly associated with the goods and such use must be of a point-of-sale nature. The office may accept another document related to the goods or the sale of the goods when it is impracticable to place the mark on the goods, packaging for the goods, or displays associated with the goods.”
- Incorporates language regarding “use in commerce.” 15 U.S.C. §1127

Specimen Rule update:

Labels and tags - 2

- Labels or tags may be accepted if, on their face, they clearly show the mark in actual use in commerce.
- To clearly show actual use in commerce, the tag or label would include informational matter that traditionally appears on a label for those types of goods such as net weight, volume, UPC bar codes, lists of contents or ingredients, or other information about the goods.

Specimen rule update:

Labels and tags - 3

- Labels or tags that do not clearly show actual use in commerce, appear to be merely temporary, or appear to be a mock-up will be refused under Trademark Act Sections 1 and 45 for failure to show the mark in actual use in commerce in connection with the goods.
- In addition to the refusal, the examining attorney will issue an inquiry under Rule 2.61(b) to clarify use of the specimen in commerce. TMEP §904.03(a).

Specimen rule update: Labels and tags - 4

- Examples of acceptable unaffixed labels:



"A PDF of the applicant's product labels which bear the mark."



"Samples of product labels for a variety of paints and coatings products."



Specimen rule update: Labels and tags - 5

OMEN
PINOT NOIR 2017

ATLAS WINE CO.
PRESENTS

ROGUE VALLEY AVA
OREGON

Dark cherry with a touch of cranberry and baking spices.

11 grape clusters per bottle

Serve together with good company, a deck of cards or with the game on.

THIS IS A GOOD SIGN

BODY
★
MEDIUM

Serve at:
53-55° F 12-13° C
(20 min. in the fridge)

Pairs great with pizza.

Ingredients: grapes, yeast, oak, minimum effective sulfites added | omenwine.com | 14.1% alc by VOL pH: 3.75 TA: 5.8
French Oak: 15% New, 85% Neutral

GOVERNMENT WARNING: (1) ACCORDING TO THE SURGEON GENERAL, WOMEN SHOULD NOT DRINK ALCOHOLIC BEVERAGES DURING PREGNANCY BECAUSE OF THE RISK OF BIRTH DEFECTS. (2) CONSUMPTION OF ALCOHOLIC BEVERAGES IMPAIRS YOUR ABILITY TO DRIVE A CAR OR OPERATE MACHINERY, AND MAY CAUSE HEALTH PROBLEMS.

8 66871 00003 3

Cellared and Bottled by Atlas Wine Co., Grants Pass, OR | 750ML | Contains Sulfites



Specimen rule update: Reminder



Even when a label is affixed to the goods, consider the nature and placement of the label because other refusals may apply.

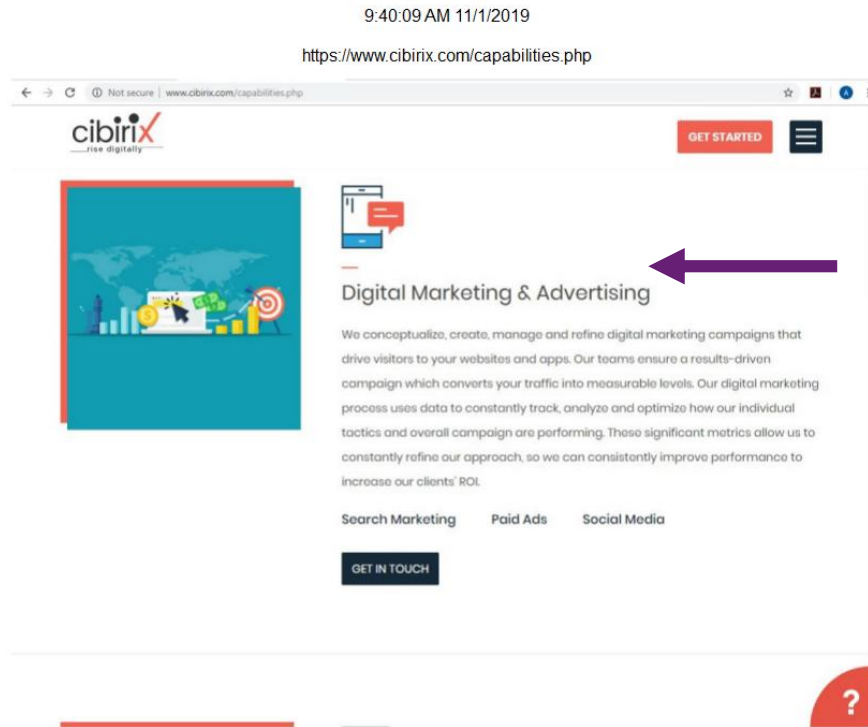


Specimen rule update: Service mark requirements

- 37 C.F.R. §2.56(b)(2):
 - “A service mark specimen must show the mark as used in the sale of the services, including use in the performance or rendering of the services, or in the advertising of the services. The specimen must show a direct association between the mark and the services.”
- Incorporates language consistent with TTAB decisions and examination policy.

Specimen rule update: Service mark direct association

Mark



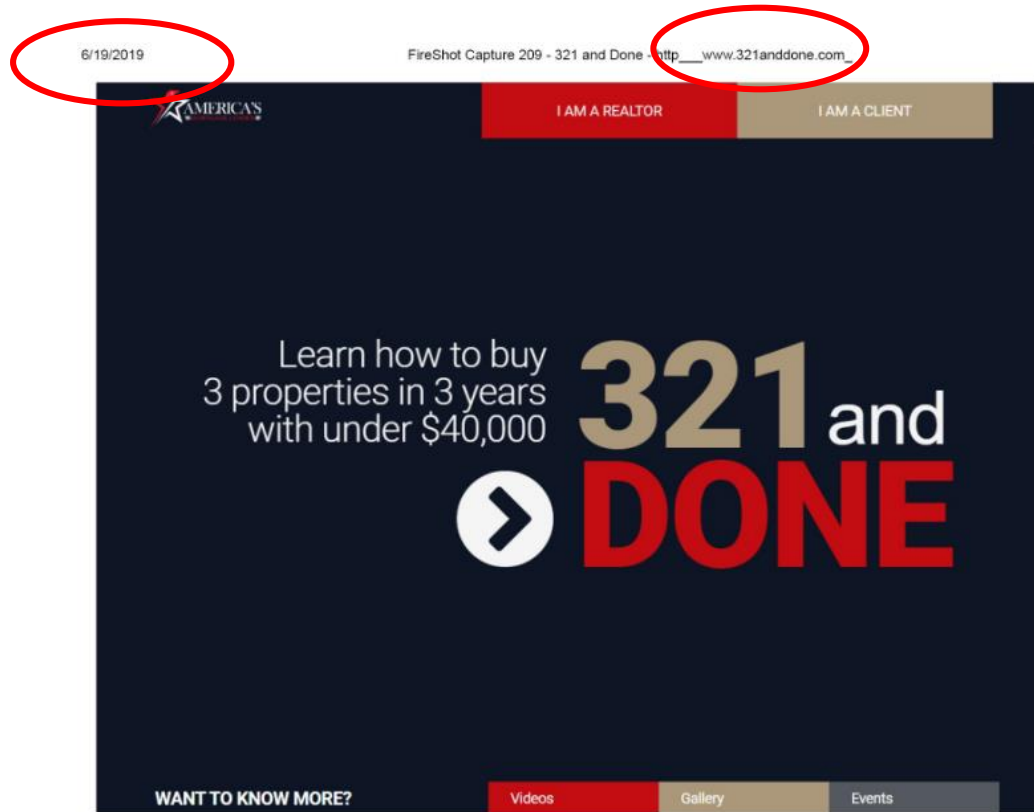
Direct association
with digital
advertising
services.



Specimen rule update: Webpage specimen requires URL and date - 1

- 37 C.F.R. §2.56(c):
 - “A clear and legible photocopy, photograph, website printout, or other similar type of reproduction of an actual specimen that meets the requirements of paragraph (a) and (b) of this section is acceptable. The reproduction must show the entire specimen or enough of the specimen that the nature of the specimen, the mark, and the good or service with which the mark is used are identifiable. **A webpage must include the URL and access or print date.** An artist’s rendering, a printer’s proof, a computer illustration, digital image, or similar mockup of how the mark may be displayed, or a photocopy of the drawing required by § 2.51, are not proper specimens.”

Specimen rule update: Webpage specimen requires URL and date - 2



Questions?

