

TMEP HIGHLIGHTS – NOVEMBER 2023

This outline highlights some of the clarifications and changes set forth in the November 2023 version of the TMEP. For a more complete listing, see the “Index to Changes in TMEP November 2023” document, which is posted as part of the TMEP.

INCORPORATION OF EXAMINATION GUIDES 2-22, 2-23, and 3-23

Change in Office Action Response Periods for Section 1 and/or Section 44 Applications

- Incorporated changes in accordance with *Change in Office Action Response Periods for Section 1 and/or Section 44 Applications*, Examination Guide 2-22 (Dec. 2022), including adding the following new sections:
 - **TMEP §711.01** Request for Extension of Time to Respond;
 - **TMEP §711.01(a)** Requirements for Request for Extension of Time to Respond; and
 - **TMEP §711.01(b)** Time for Filing a Request for Extension of Time to Respond.

Electronic Trademark Submissions Signed Using Document-signing Software and Compliance with 37 C.F.R. §2.193

- Incorporated changes in accordance with *Electronic Trademark Submissions Signed Using Document-signing Software and Compliance with 37 C.F.R. §2.193*, Examination Guide 2-23 (July 2023), including adding the following new sections:
 - **TMEP §611.01(c)(i)** Requirements for Electronic Signatures Generated Using Document-signing Software; and
 - **TMEP §611.01(c)(ii)** Requirements for Electronic Signatures Generated Using Document-signing Software.
- From TMEP §611.01(c)(ii):
 - *Electronic signatures generated using document-signing software submitted before July 22, 2023.* Because the USPTO timestamp and USPTO-generated pdf signature page was not available before July 22, 2023, USPTO staff may accept a declaration or verification that contains an electronic signature generated using document-signing software that was submitted before July 22, 2023 that otherwise meets the requirements set forth above. Any electronic signature generated using document-signing software submitted on or after July 22, 2023 must comply with all of the requirements set forth above, including use of the USPTO-generated pdf signature form with the relevant USPTO timestamp.

- *Electronic signatures generated using document-signing software currently only acceptable for verification signatures.* The pdf signature page generated in the USPTO’s forms containing the USPTO timestamp is currently only available for declarations or verifications. Accordingly, only verification signatures, and not submission signatures, can meet the requirements of an acceptable electronic signature generated using document-signing software as set forth immediately above. See TMEP §611.01 for the types of signatures required for filing documents with the USPTO.

Examination Procedures for Reviewing Domicile Addresses

- Incorporated changes in accordance with *Examination Procedures for Reviewing Domicile Addresses*, Examination Guide 3-23 (Aug. 2023), including deleting TMEP §601.01(b)(1) and adding the following new sections:
 - **TMEP §601.01(c)** Examination Procedures for Reviewing Domicile Addresses;
 - **TMEP §601.01(c)(i)** Determining the Acceptability of Domicile Addresses;
 - **TMEP §601.01(c)(ii)** Evaluating a New Domicile Address Provided in Response to a Domicile Address Requirement;
 - **TMEP §601.01(c)(iii)** Reviewing General Arguments or Evidence Provided in Response to a Domicile Address Requirement;
 - **TMEP §601.01(c)(iv)** Reviewing “No Fixed Physical Address” Explanation;
 - **TMEP §601.01(c)(iv)(A)** Response Options for Applicants or Registrants with “No Fixed Physical Address”;
 - **TMEP §601.01(c)(iv)(B)** Reviewing the Name, Title, and Domicile Address of an Individual with Legal Authority to Bind the Juristic Entity;
 - **TMEP §601.01(c)(v)** Checking the Record for a Petition to the Director to Waive the Domicile Address Requirement;
 - **TMEP §716.02(I)** Pending Decision on a Petition to Waive the Domicile Address Requirement; and
 - **TMEP §1708.01** Petition to Waive Domicile Address Requirement.

ISSUANCE OF REGISTRATION CERTIFICATE IN NAME OF ASSIGNEE OR IN APPLICANT’S NEW NAME

Applications Under Trademark Act §1 and §44 (TMEP §502.02(a))

- A request that a registration issue in a new name should be directed to the examining attorney *before an application is approved for publication or registration or during examination of the statement of use and must state that (1) the appropriate document(s) has been filed for recordation, (2) the applicant wants the registration to issue in the name of the new owner or the new name of the applicant, and (3) the application should be suspended pending recordation of the document(s) and updating the Trademark database with the new owner information.*

Applications Under Trademark Act §66(a) (TMEP §502.02(b))

- The request that a registration issue in the name of the new owner must be directed to the examining attorney and must state that (1) the appropriate *IB form* has been *filed* with the IB, (2) the applicant wants the registration to issue in the name of the new owner or the new name of the applicant, *and (3) the application should be suspended pending recordation of the ownership change and updating of the Trademark database with the new owner information. In addition, this request must include a copy of the filing submitted to the International Bureau. TMEP §716.02(g). See below in this section regarding the proper TEAS forms to use to make this request.*
- *Once the USPTO database is updated with the new owner information, the applicant should request the suspension be lifted using the TEAS Response to Suspension Inquiry or Letter of Suspension form and include in the request the new owner's legal entity type and citizenship or state of incorporation or organization (for U.S. assignees), or country of incorporation or organization (for foreign assignees). See 37 C.F.R. §2.32(a)(3); TMEP §§803.03-803.04.*

FRAUD

Fraudulent Filings

- Matters involving fraudulent filings fall under the authority of the Trademark Register Protection Office (RPO).
- Under no circumstances should any USPTO communication pertaining to suspected fraud be made, either orally or in writing, by anyone in the Trademark Examining Operation, unless directed to do so by the RPO.

COMPANION APPLICATIONS

Companion Applications Not Previously Assigned for the Same or Similar Marks (TMEP §702.03(a)(i))

- Any companion applications may only be self-assigned by the examining attorney at the time of initial examination of the new application.
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SUSPENSION

Circumstances Under Which Action May Be Suspended (TMEP §716.02)

- Any request to stay a deadline for responding to an Office action pending disposition of a petition to the Director should be directed to the *Petitions Office, which is part of the Office of the Deputy Commissioner for Trademark Examination Policy*. If such a request is sent to the examining attorney, the examining attorney should forward it to the *Petitions Office*. The examining attorney *must* not suspend action on an application pending a decision on petition to the Director except *upon permission* from the *Petitions Office or when expressly permitted*. See 37 C.F.R. §2.146(g); TMEP §1705.06. See *TMEP §716.02(l)* for *circumstances when an examining attorney may suspend action pending a decision on a petition to the Director requesting waiver of the domicile address requirement without requesting permission*.

NEW SECTION: Pending Disposition of Post Registration Audit (TMEP §716.02(k))

- The following suspension guidelines apply when an examining attorney has cited, or will cite, a registration under §2(d) of the Trademark Act that is the subject of a post registration audit:
 - If the examining attorney is **ready to issue a *nonfinal refusal*** of registration under §2(d), the examining attorney must not suspend the application, but must issue the refusal under §2(d). The applicant may state in a timely filed response to the Office action that the cited registration is the subject of an ongoing post registration audit that may render the §2(d) refusal moot, and may request suspension of the application pending acceptance of the post registration maintenance document or cancellation of the registration in full or in part.
 - If the examining attorney is **ready to issue a *final refusal*** of registration under §2(d), and the Trademark database shows that the cited registration is the subject of an ongoing post registration audit, the examining attorney must suspend action pending acceptance of the post registration maintenance document or cancellation of the registration in full or in part.
 - If the examining attorney is **ready to issue a *denial of a request for reconsideration*** of a final refusal of registration under §2(d), and the Trademark database shows that the cited registration is the subject of an ongoing post registration audit, the examining attorney must suspend action pending acceptance of the post registration maintenance document or cancellation of

the registration in full or in part. If the maintenance document is accepted and the grounds for refusal remain operative, the examining attorney will remove the application from suspension and issue a "Subsequent Final Action," as appropriate, thereby giving the applicant a new response period 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," as appropriate, and the Trademark Trial and Appeal Board will be notified to resume the appeal. See TMEP §716.06 regarding removing an application from suspension after a final Office action is issued.

DRAWING

Requirements for Digitized Images (TMEP §807.05(c))

- When color is not claimed as a feature of the mark, the image must be depicted only in black and white. *Generally, stylized marks with no claim of color are depicted in black on a white background. It is also acceptable to depict the mark in white on a black background when the application indicates that the mark is not in color.* When scanning an image, the applicant should confirm that the settings on the scanner are set to create a black-and-white image file, not a color image file.

MARKS THAT IDENTIFY COLUMNS, SECTIONS, AND SUPPLEMENTS OF PUBLICATIONS

Marks That Identify Columns, Sections, and Supplements of Printed, Downloadable, or Recorded Publications in §1(a) Applications (TMEP §1202.07(a)) (citations omitted)

- Columns, sections, and supplements of a publication that are printed, downloadable, or recorded on electronic media are normally not considered to be separate "goods" or "goods in trade," unless they are sold, syndicated, or offered for syndication separate and apart from the larger publication in which they appear, or are non-syndicated and considered "goods in trade" under the three-part test set forth in *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d 1376, 1382, 103 USPQ2d 1672, 1676 (Fed. Cir. 2012).
- Historically, absent evidence of acquired distinctiveness, non-syndicated columns and sections available in print format or on recorded media were not considered "goods in trade." However, in *In re The New York Times Co.*, the Trademark Trial and Appeal Board held that non-syndicated columns or sections can in fact be goods in trade.

Non-Syndicated Columns and Sections in §1(a) Applications (TMEP §1202.07(a)(ii))

- Whether a column or section of a printed publication, a downloadable publication, or a publication recorded on electronic media that is not separately sold, syndicated, or offered for syndication is separate “goods in trade” is determined by applying the three-part test set forth in *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d 1376, 1382, 103 USPQ2d 1672, 1676 (Fed. Cir. 2012).
 - Prior to *In re The New York Times Co.*, marks that identified non-syndicated columns or sections of printed publications, downloadable publications, or publications recorded on electronic media were registrable under §2(f), 15 U.S.C. §1052(f), with sufficient evidence or, if the mark had not yet acquired distinctiveness, were registrable on the Supplemental Register. Under *In re The New York Times Co.*, if the evidence of record establishes that an applicant’s non-syndicated column or section of a printed publication, downloadable publication, or publication recorded on electronic media comprises “goods in trade” under the *Lens.com* test, the mark is registrable on the Principal Register without resort to §2(f). If the evidence does not establish that it is used on “goods in trade” under the *Lens.com* test, registration may no longer be sought on the Principal Register under §2(f) or on the Supplemental Register.
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TITLE OF A SINGLE CREATIVE WORK

What Constitutes a Single Creative Work (TMEP §1202.08(a))

- A single creative work provided in different formats is still considered a single creative work. See, e.g., *In re MCDM Prods., LLC*, 2022 USPQ2d 227, at *8-9 (TTAB 2022) (holding STRONGHOLDS & FOLLOWERS the title of a single work for role-playing game book manuals offered in print and electronic formats); *Mattel, Inc. v. Brainy Baby, Co.*, 101 USPQ2d 1140, 1141, 1144 (TTAB 2011) (holding LAUGH & LEARN with design the title of a single creative work for educational materials provided in VHS and DVD formats); *In re Appleby*, 159 USPQ 126, 126, 127 n.1 (TTAB 1968) (holding HYNOSMOKE the title of a single creative work for phonograph records and albums provided in English and Spanish).
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CONSENT AGREEMENTS

Consent Agreements (TMEP §1207.01(d)(viii))

- Thus, examining attorneys should give substantial weight to a proper “clothed” consent agreement. When an applicant and registrant have entered into a consent agreement *that shows they have clearly thought*

out their commercial interests, and, on balance, the other factors do not dictate a finding of likelihood of confusion, the parties' consent agreement favors a conclusion that confusion is not likely.

IDENTIFICATION OF GOODS AND SERVICES

Classification and Plurality of Uses (TMEP §1401.05(c))

- Identifications for multipurpose composite goods, such as a “combination hair brush and comb,” must clearly indicate the particular components and purposes of the goods. The identification must not include ambiguous wording regarding the components that comprise the composite goods. For example, an identification for a composite item must not describe the goods as “comprised of one or more of” particular components or aspects because such wording may render the nature of the goods or their classification unclear.

NEW SECTION: Dispensers (TMEP §1401.15(a))

- The 12th edition of the Nice Classification set up a framework for classification of dispensers involving a general rule and exceptions. Generally, under Nice 12-2023, dispensers are considered storage containers for holding items and dispensing them, as needed. Thus, they are classified in Class 6 when made of metal and in Class 20 when they are not made of metal, regardless of whether the dispensers are automatic or non-automatic.
- There are exceptions to the general rule. Certain goods that incorporate dispensing actions are classified in classes other than Class 6 and Class 20 according to the function or purpose of the goods.
- When identifying and classifying dispensers for purposes of trademark registration, the Nice Alphabetical List and the ID Manual should be consulted for examples that follow the general rule and for examples of exceptions to the rule.

NEW SECTION: Downloadable Digital Files Authenticated by Non-fungible Tokens (NFTs) (TMEP §1401.15(b))

- Under the 12th edition of the Nice Classification, the Committee of Experts added the entry “downloadable digital files authenticated by non-fungible tokens [NFTs]” to the Nice Alphabetical List in Class 9. Classification of said goods in Class 9 is based on the wording “recorded and downloadable media, computer software” in the Nice Class Heading for Class 9 and is analogous to the Nice Alphabetical List entries “downloadable image files” and “downloadable music files” in Class 9.
- Although “downloadable digital files authenticated by non-fungible tokens [NFTs]” are clearly *classified* in Class 9 pursuant to Nice 12-2023, that wording is not acceptable to *identify* the goods. See TMEP

§1402.01. Generally, identifications for downloadable digital files authenticated by non-fungible tokens must indicate the type (e.g., audio files or image files) and subject matter of the files.

General Guidelines for Acceptable Identifications of Goods or Services
(TMEP §1402.01(a))

- Commas, semicolons, and apostrophes are the only punctuation that should be included in an identification. Other punctuation, such as colons, question marks, exclamation points, and periods should not be used in an identification. In addition, symbols, such as asterisks (*), at symbols (@), *the percentage sign (%)*, or carets (^), should not be included in the identification. *The word "percent" must be used in identifications in lieu of the percentage sign.*

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

- A filing date will be denied if the identification of goods or services is blank or recites only the following:
 - (1) the mark itself;
 - (2) a class number;
 - (3) wording such as "company name," "corporate name," or "company logo;"
 - (4) "Internet services" or "e-commerce services;"
 - (5) "business" or "business services;"
 - (6) "miscellaneous" or "miscellaneous services;"
 - (7) "personal services;"
 - (8) "parts;"
 - (9) "products;"
 - (10) "equipment;"
 - (11) "NFTs," "nonfungible tokens," or "non-fungible tokens;"
 - (12) "charitable services;"
 - (13) "information services;"
 - (14) "educational information;" or
 - (15) "consulting services."

Identifying Printed, Downloadable, or Recorded Publications with Specificity (TMEP §1402.03(e))

- Even if the mark itself indicates the subject of a publication, the identification must specify the subject matter of the goods. Generally, the identification should include a particular subject matter, e.g., biology or history. However, “general human interest” and “general interest” are acceptable subject matters *if they are recognized as terms of art in particular industries, such as the magazine and newsletter industries*. See TMEP §1402.03(f) regarding recognition of industry terms *evidenced by dictionary definitions or other authoritative references*.

Computer Retail Services (TMEP §1402.11(a)(vi))

- “Retail services” is an indefinite identification because it encompasses a wide array of services related to retailing, including marketing and advertising services. Identifications for “retail services” must indicate the nature of the retail activity (e.g., retail outlets or online retail stores), regardless of whether the services are provided by electronic or other means. Additionally, identifications for retail store, catalog, or ordering services and identifications for retail services by direct solicitation by sales agents must indicate the type or field of goods offered by the services (e.g., retail clothing stores), regardless of whether the services are provided in person, online, or by other means.

§66(a) APPLICATIONS/REGISTRATIONS

Correspondence in Section 66(a) Applications and Registrations (TMEP §609.01(a))

- The USPTO will send the first Office action in an application under Trademark Act §66(a) to the International Bureau (IB). The IB will then send it to the representative designated in the international registration, or if no such representative is designated, the IB will send the first Office action directly to the applicant.
- Appointing an attorney authorized to practice before the USPTO to represent the applicant does not change the designated representative before the IB. To change the representative designated in the international registration, a request to record a change of the name or address of the representative designated in the international registration must be filed with the IB; it cannot be filed through the USPTO.

Notice Must Be Sent Within 18 Months (TMEP §1904.03(a))

- If upon re-examination the examining attorney determines a new ground of refusal exists *that should have been raised in the first Office*

action, a second Office action raising this new ground may be issued only if time remains in the 18-month period. In such a case, the examining attorney must *ensure* that a notification of the new ground of refusal *is* sent to the IB.

Limitations to Goods/Services - §66(a) Applications (TMEP §1904.03(g)(i)) (citations omitted)

- This section has been revised to update and clarify procedures relating to reviewing limitations filed separately from the §66(a) application.