UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP)

Chapter 800 Application Requirements

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801 Types of Applications

The wording "type of application" refers to the kind of application by which registration is requested, e.g., whether the application is a single-class application or a multiple-class application, or whether registrationis sought on the Principal Register or on the Supplemental Register.

See TMEP Chapter 700 regarding the examination of applications in general, and Chapter 1300 regarding the examination of applications for service marks, collective marks, and certification marks.

801.01 Single or Combined Application

801.01(a) Single (Single-Class) Application

A single-class application limits the goods or services for which registration is sought to goods or services in only one of the classes in the classification schedules. The application may recite more than one item, if the items recited are all classified in one class. See TMEP §§1401 et seq. for additional information about classification.

801.01(b) Combined (Multiple-Class) Application

A combined or multiple-class application is an application to register the mark for items classified in two or more classes. The applicant must pay a filing fee for each class. The class numbers and corresponding goods or services must be listed separately, from the lowest to the highest number.

See TMEP §§1403 et seq. for further information about combined applications.

801.02 Principal Register or Supplemental Register

801.02(a) Act of 1946, Principal Register

The primary provision for registration in the Trademark Act of 1946 is for registration on the Principal Register (15 U.S.C. §1051 through 1072). When a mark has been registered on the Principal Register, the mark is entitled to all the rights provided by the Act. The advantages of owning a registration on the Principal Register include the following:

- Constructive notice to the public of the registrant's claim of ownership of the mark (15 U.S.C. §1072);
- A legal presumption of the registrant's ownership of the mark and the registrant's exclusive right to use the mark nationwide on or

in connection with the goods/services listed in the registration (15 U.S.C. §1057(b) and 1115(a));
- A date of constructive use of the mark as of the filing date of the application (15 U.S.C. §1057(c); TMEP §201.02);
- The ability to bring an action concerning the mark in federal court (15 U.S.C. §1121);
- The ability to file the United States registration with the United States Customs Service to prevent importation of infringing foreign goods (15 U.S.C. §1124);
- The registrant's exclusive right to use a mark in commerce on or in connection with the goods or services covered by the registration can become "incontestable," subject to certain statutory defenses (15 U.S.C. §1065 and 1115(b)); and
- The use of the United States registration as a basis to obtain registration in foreign countries.

If the applicant seeks registration on the Principal Register, the application should state that registration is requested on the Principal Register. However, if the applicant does not specify a register, the United States Patent and Trademark Office ("USPTO") will presume that the applicant seeks registration on the Principal Register.

801.02(b) Act of 1946, Supplemental Register

Certain marks that are not eligible for registration on the Principal Register, but are capable of distinguishing an applicant's goods or services, may be registered on the Supplemental Register. Sections 23 through 28 of the Trademark Act, 15 U.S.C. §1091 through 1096, provide for registration on the Supplemental Register.

This is a continuation of the register provided for in the Act of March 19, 1920. Marks registered on the Supplemental Register are excluded from receiving the advantages of certain sections of the Act of 1946.

The excluded sections are listed in §26 of the Act, 15 U.S.C. §1094. See Otter Products LLC v. BaseOneLabs LLC, 105 USPQ2d 1252, 1256 (TTAB 2012) (finding that while ownership of a registration on the Supplemental Register established opposer's standing to oppose registration of applicant's mark, it did not establish that opposer owned a proprietary interest in a mark).

If the applicant seeks registration on the Supplemental Register, the application should state that registration is requested on the Supplemental Register. If no register is specified, the USPTO will

presume that the applicant seeks registration on the Principal Register.

See TMEP §815 and 816 et seq. regarding examination procedure relating to the Supplemental Register.

An applicant may not seek registration on both the Principal and the Supplemental Register in the same application. If an applicant requests registration on both the Principal and the Supplemental Register in the same application, the examining attorney must require that the applicant amend to specify only one register, or file a request to divide under 37 C.F.R. §2.87.

A mark in an application under §66(a) of the Trademark Act, 15 U.S.C. §1141f(a), based on a request for extension of protection of an international registration to the United States, cannot be registered on the Supplemental Register. 15 U.S.C. §1141h(a)(4); 37 C.F.R. §2.47(c) and 2.75(c).

802 Application Form

Applications under §66(a) of the Trademark Act are sent to the USPTO electronically by the International Bureau of the World Intellectual Property Organization ("IB").

The USPTO prefers that applicants file applications under §1 or §44 of the Trademark Act through the Trademark Electronic Application System ("TEAS"), available at http://www.uspto.gov (using either a TEAS or TEAS Plus application form), or on the USPTO's pre-printed scannable form. The applicant may obtain the USPTO's pre-printed scannable form by calling the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199.

The amount of the trademark application filing fee varies, depending upon whether the application (or the amendment adding classes to an existing application) is filed through TEAS or on paper. See TMEP §810. An applicant has three choices. The applicant can file:

- A paper application at the higher fee per class, set forth in 37 C.F.R. §2.6(a)(1)(i);
- A regular TEAS application at a lower fee per class, set forth in 37 C.F.R. §2.6(a)(1)(ii); or
- A TEAS Plus application (see TMEP §819 et seq.) at the lowest fee per class, set forth in 37 C.F.R. §2.6(a)(1)(iii).

The current fee schedule is available on the USPTO website at http://www.uspto.gov.

Note: Applications that are downloaded from TEAS or TEAS Plus, printed, and mailed to the USPTO are considered paper applications and are subject to the paper application filing fee.

Trademark applications may not be filed by facsimile ("fax") transmission. 37 C.F.R. §2.195(d)(1); TMEP §306.01.

The USPTO strongly discourages self-created forms, but will accept them if they meet the requirements for receipt of a filing date set forth in 37 C.F.R. §2.21(a) (see TMEP §202). If a self-created form is used, the application should be on letter size (i.e., 8. inches (21.6 cm.) by 11 inches (27.9 cm.)) paper, typewritten, double spaced, with margins of at least 1. inches (3.8 cm.) at the left and top of the pages. The application should be written on only one side of the paper.

The application must be in the English language. 37 C.F.R. §§2.21(a) and 2.32(a).

The USPTO does not generally require the submission of original documents, so the applicant may file a copy of a signed application.

37 C.F.R. §2.193(a) and (b); TMEP §302.01.

See TMEP §819 et seq. regarding TEAS Plus applications.

803 Applicant

803.01 Who May Apply

An application to register a mark must be filed by the owner of the mark or, in the case of an intent-to-use application under 15 U.S.C. §1051(b), by the person who is entitled to use the mark in commerce. Normally the owner of a mark is the person who applies the mark to goods that he or she produces, or uses the mark in the sale or advertising of services that he or she performs. See TMEP §1201 et seq. regarding ownership, and TMEP §501 and 502 et seq. regarding assignment of marks and changes of ownership.

If an applicant is not the owner of (or entitled to use) the mark at the time the application is filed, the application is void and cannot be amended to specify the correct party as the applicant, because the applicant did not have a right that could be assigned. 37 C.F.R. §2.71(d). See TMEP §803.06 and cases cited therein.

Applicants may be natural persons or juristic persons. Juristic persons include corporations, partnerships, joint ventures, unions, associations, and other organizations capable of suing and being sued in a court of law. 15 U.S.C. §1127. An operating division, or the like, that is merely an organizational unit of a company and not a legal entity that can sue and be sued, may not own or apply to register a mark. See TMEP §1201.02(d).

Nations, states, municipalities, and other related types of bodies operating with governmental authorization may apply to register marks that they own. See National Aeronautics & Space Admin. v. Record Chemical Co. Inc., 185 USPQ 563 (TTAB 1975); In re U.S. Department of the Interior, 142 USPQ 506 (TTAB 1964).

The question of whether an application can be filed in the name of a minor depends on state law. If the minor can validly enter into binding legal obligations, and can sue or be sued, in the state in which he or she is domiciled, the application may be filed in the name of the minor. Otherwise, the application should be filed in the name of a parent or legal guardian, clearly setting forth his or her status as a parent or legal guardian. An example of the manner in which the applicant should be identified in such cases is:

John Smith, United States citizen, (parent/legal guardian) of Mary Smith.

If the record indicates that the named applicant is a minor, the examining attorney must inquire as to whether the person can validly enter into binding legal obligations under the law of the state in

which he or she is domiciled. If the minor cannot enter into binding legal obligations, the examining attorney must require correction of the applicant-identifying information in the manner shown above, if necessary.

If a minor comes of age during the prosecution of an application in which his or her parent/legal guardian is identified as the applicant, the application may be amended to change the applicant's name. No assignment is required in such cases. However, the minor must also state his or her citizenship. See also TMEP Chapter 500 regarding assignments, name changes, and issuance of a registration in the name of an assignee or in an applicant's new name.

See also TMEP §§1002 et seq. regarding eligibility to file an application under §44 of the Trademark Act, 15 U.S.C. §1126, and TMEP §1901 regarding eligibility to file a request for an extension of protection of an international registration to the United States under §66(a) of the Act, 15 U.S.C. §1141f(a).

803.02 Name of Applicant

The name of the applicant should be set out in its correct legal form. For example, a corporate applicant should be identified by the name set forth in the articles of incorporation. If a trust is the owner of a mark in an application, the examining attorney must ensure that the trustee(s) is identified as the applicant and indicate the name of the trust, if any. See TMEP §803.03(e) regarding the proper format for identifying trusts, conservatorships, and estates.

If the applicant's legal name includes the assumed name under which it does business, an assumed name designation should be used to connect the actual name with the assumed name. Assumed name designations include "d.b.a." (doing business as), "a.k.a." (also known as), and "t.a." (trading as). The particular assumed name designation used is optional. Only the abbreviation of the assumed name designation will be printed in the Official Gazette and on the certificate of registration. If an applicant gives the assumed name designation in full, the abbreviation will automatically be used for printing purposes.

803.02(a) Individual

If the applicant is an individual person who is doing business under an assumed business name, the individual's name should be set forth, followed by an assumed name designation (e.g., d.b.a., a.k.a., or t.a.) and by the assumed business name.

If an individual indicates that he or she is doing business under a corporate designation (e.g., Corporation, Corp., Incorporated, Inc., Limited, Ltd.), the USPTO will presume that relevant state law permits such a practice. The assumed name will be printed on the registration certificate.

If the application reflects an inconsistency between the owner name and the entity type as to whether a corporation or an individual owns the mark, the examining attorney must require the applicant to clarify the record regarding ownership (e.g., if the name of an individual appears as the applicant, but the entity is listed as a corporation, or if a business is named as the applicant but the entity is listed as an individual). However, in view of the broad definition of a "person properly authorized to sign on behalf of the applicant" in 37 C.F.R. §2.193(e)(1) (see TMEP §§611.03(a) and 804.04), the fact that the title of the person signing an application refers to a different entity is not in itself considered an inconsistency between owner and entity type that would warrant an inquiry as to who owns the mark.

See TMEP §803.03(a) for information about identifying an individual applicant's entity, and TMEP §§803.06 and 1201.02(c) regarding USPTO policies regarding correction of an applicant's name and entity.

803.02(b) Partnership, Joint Venture, or Other "Firm"

If a partnership, joint venture, or other "firm" has been organized under a particular business name, the application should be filed in that name. If the partnership or firm has not been organized under a business name, the names of the members should be listed as though they composed a company name. If a partnership or joint venture is doing business under an assumed name, this may be indicated, using an assumed name designation. See TMEP §803.02 regarding assumed name designations, and TMEP §803.03(b) for information about identifying a partnership or joint venture as a legal entity.

803.02(c) Corporation and Association

If the applicant is a corporation, the official corporate name must be set out as the applicant's name. Listing an assumed business name is optional. The name of a division of the applicant should not be included in or along with the applicant's name. If the applicant wishes to indicate in the application that actual use of the mark is being made by a division of the applicant, the applicant may provide a statement that "the applicant, through its division [specify name of division], is using the mark in commerce." This statement should not

appear in conjunction with the listing of the applicant's name, and will not be printed on the registration certificate.

In unusual situations, one corporation may also be doing business under another name, even another corporate name. This sometimes happens, for example, when one corporation buys out another. In the unusual situation where a corporate applicant provides a DBA ("doing business as") that includes a corporate designation (e.g., Corporation, Corp., Incorporated, Inc., Limited, Ltd.) in addition to its official corporate name, the USPTO will presume that relevant state law permits such a practice. The DBA will be printed on the registration certificate.

Associations should be identified by the full, official name of the association.

See TMEP §803.03(c) for information about identifying a corporation or association as a legal entity.

803.03 Legal Entity of Applicant

Immediately after the applicant's name, the application should set out the applicant's form of business, or legal entity, such as partnership, joint venture, corporation, or association. The words "company" and "firm" are indefinite for purposes of designating a domestic applicant's legal entity, because those words do not identify a particular type of legal entity in the United States. (However, the word "company" is acceptable to identify entities organized under the laws of foreign countries that are equivalent or analogous to United States corporations or associations. See TMEP §803.03(i).)

Whether the USPTO will accept the identification of an applicant's entity depends on whether that entity is recognized by the applicant's state of domicile.

If other material in the record indicates that the applicant is a different type of entity than is set out in the written application, the examining attorney must ask for an explanation, and require amendment if necessary.

However, in view of the broad definition of a "person properly authorized to sign on behalf of the applicant" in 37 C.F.R. §2.193(e)(1) (see TMEP §§611.03(a) and 804.04), no explanation is usually required merely because the person signing a declaration has a title that refers to a different type of entity. See TMEP §§803.06 and 1201.02(c) regarding USPTO policies governing correction of an applicant's name.

803.03(a) Individual or Sole Proprietorship

Individual. For an individual, it is not necessary to specify "individual," but it is acceptable to do so. The applicant may state that he or she is doing business under a specified assumed company name. TMEP §803.02.

In an application for international registration, if the applicant is a natural person, he or she must indicate his or her name and may include the country of which he or she is a national. Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to That Agreement ("Common Regs."), Rule 9(4)(b)(i) (2008). The international application does not require this information, but when the information is included, the IB will forward the nationality of the applicant to the USPTO. In a §66(a) application, if the "Nationality of Applicant" field appears in the Trademark Image Capture and Retrieval System ("TICRS") (which is available to the public through the Trademark Status and Document Retrieval ("TSDR") portal on the USPTO website at http://tsdr.uspto.gov/), this means that the applicant is an individual rather than a juristic entity, and that applicant's citizenship is the country corresponding to the two-letter code set forth in this field. The list of country codes appears in the MM2 International Re gistration application form at http://www.wipo. int/export/sites/www/madrid/en/forms/docs/form_mm2.pdf. A separate statement that applicant is an individual will not appear in TICRS, and the "Legal Nature" and "Legal Nature: Place Incorporated" fields will state "Not Provided."

If the "Nationality of Applicant" field appears in TICRS, the examining attorney may enter the relevant information into the Trademark database, or ask the LIE to enter it. No inquiry as to the applicant's entity or citizenship is necessary. If the "Nationality of Applicant" field does not appear in TICRS, the examining attorney must require that the applicant indicate its entity and citizenship. Examining attorneys cannot rely on the "Entitlement Nationality," "Entitlement Establishment," or "Entitlement Domiciled" fields for the applicant's citizenship because these fields merely indicate the basis for the applicant's entitlement to file an application through the Madrid system, not the national citizenship of the individual applicant.

Sole Proprietorship. An applicant may identify itself as a sole proprietorship. If an applicant does so, the applicant must also indicate the state where the sole proprietorship is organized, in addition to the name and national citizenship of the sole proprietor.

If the application specifically identifies the applicant as a sole proprietorship and indicates the state of organization of the sole proprietorship and the name and citizenship of the sole proprietor, the USPTO will accept the characterization of the entity. On the other hand, if the application refers to a sole proprietorship but lacks some of the necessary information or is ambiguous as to whether the applicant should be identified as a sole proprietorship or as an individual, the examining attorney must require appropriate clarification of the entity type.

A sole proprietorship generally means a business which has only one owner. Therefore, if an application identifies two persons or two different entities as a "sole proprietorship," this is an ambiguity that requires clarification of the entity type. Note, however, that in California a husband and wife can be classified as a sole proprietorship.

803.03(b) Partnership, Joint Venture, or Other "Firm"

After setting forth the applicant's name and entity, the application of a partnership or a joint venture should specify the state or country under whose laws the partnership or joint venture is organized. 37 C.F.R. §2.32(a)(3)(ii). In addition, domestic partnerships must set forth the names, legal entities, and national citizenship (for individuals), or state or country of organization (for businesses), of all general partners or active members that compose the partnership or joint venture. 37 C.F.R. §2.32(a)(3)(iii) and (iv). These requirements apply to both general and limited partnerships. They also apply to a partnership that is a general partner in a larger partnership. Limited partners or silent or inactive partners need not be listed.

The following format should be used:

"_____, a (partnership, joint venture) organized under the laws of _____, composed of _____ (name, legal entity, and citizenship of individual partner; or name, legal entity, and state or country of incorporation or organization of juristic partner)."

In the case of a domestic partnership consisting of ten or more general partners, if the partnership agreement provides for the continuing existence of the partnership in the event of the addition or departure

of specific partners, the USPTO will require that the applicant provide the names, legal entities, and national citizenship (or the state or country of organization) of the principal partners only. If there are more than ten principal partners, the applicant need list only the first ten principal partners. If there is no class of principal partners, the applicant may list any ten general partners.

Upon the death or dissolution of a partner or other change in the members that compose a domestic partnership, that legal entity ceases to exist and any subsequent arrangement constitutes a new entity, unless the partnership agreement provides for continuation of the partnership in the event of changes in partners.

This same principle also applies to joint ventures. See TMEP Chapter 500 regarding changes of ownership.

The rule requiring names and citizenships of general partners seeks to provide relevant information in the record, given the legal effects of partnership status in the United States. Because the USPTO does not track the varying legal effects of partnership status in foreign countries, and the relevance of the additional information has not been established, the same requirement for additional information does not apply to foreign partnerships.

The term "firm" is not an acceptable designation of the applicant's entity, because it does not have a universally understood meaning. The examining attorney must require a definite term such as "partnership" or "joint venture" when it is necessary to identify these entities.

See TMEP §803.03(k) regarding limited liability partnerships.

803.03(c) Corporation, Association, Organization, and Company

Corporation. In the United States, the term "corporation" is proper for juristic entities incorporated under the laws of the various states or under special federal statutes. In addition to specifying that an applicant is a corporation, the application must specify the applicant's state (for United States corporations) or country of incorporation (for foreign corporations). It is customary to follow the applicant's name by the words "a corporation of the state (or country) of . . . ."

This also applies to a nonprofit or tax-exempt corporation. If no state or country of incorporation, or the incorrect state or country of incorporation, is given for an applicant corporation, this defect may be corrected by amendment. The amendment does not have to be verified. If a corporation exists by virtue of a specific state or federal statute, this should be stated.

Association. "Association" and "nonprofit association" are acceptable terms to identify juristic entities organized under state laws or federal statutes that govern this form of organization. A domestic association must specify the state under whose laws the applicant is organized or exists, and indicate whether the association is incorporated or unincorporated. A foreign association must specify the country under whose laws the applicant is organized or exists and indicate whether the association is incorporated or unincorporated, unless the country and the designation or description "association/associazione" appear in Appendix D. This also applies to a domestic or foreign nonprofit or tax-exempt association. If an association exists by virtue of a specific state or federal statute, this should be stated. Verification is not required.

Company. The term "company" is indefinite for describing a United States entity because it does not identify a particular juristic entity, but is acceptable to identify entities organized under the laws of foreign countries that are equivalent or analogous to United States corporations or associations. See TMEP §803.03(i) and TMEP Appendix D regarding foreign companies.

Organization. "Organization" and "nonprofit organization" are indefinite to identify juristic entities. If an applicant's entity type is identified as a "nonprofit organization," the examining attorney must require amendment of the entity, or proof that such a legal entity exists under the appropriate state statute or foreign country law.

803.03(d) Joint Applicants

An application may be filed in the names of joint applicants or joint owners. Ex parte Pacific Intermountain Express Co., 111 USPQ 187 (Comm'r Pats. 1956); Ex parte Edward Taylor and Isabelle Stone Taylor doing business as Baby's Spray-Tray Co., 18 USPQ 292 (Comm'r Pats. 1933). The terms "joint applicant(s)" or "joint owner(s)" reflects the relationship of multiple applicants as to a particular mark, but does not identify a particular type of legal entity in the United States. Therefore, the application must name each of the joint applicants, and must set forth the citizenship (or the state or nation of organization for a juristic applicant) of each of the joint applicants. 37 C.F.R. §2.32(a)(2) and (3); TMEP §803.02 and 803.03.

The application may also state the joint applicant relationship; however, where an application identifies two or more individuals or entities as the applicant, and separately sets forth the citizenship

or state of organization of each, the USPTO will presume that the entity is that of joint applicants, if the record is not otherwise contradictory. If, however, the legal entity is set out as "joint applicant(s)" or "joint owner(s)," the examining attorney must require each applicant to clarify the nature of its legal entity as an individual or juristic person.

An application by joint applicants must be verified by all the applicants, since they are individual parties and not a single entity. However, if only one of the joint applicants signs the verification, the USPTO will presume that he or she is signing on behalf of all the joint applicants, and will not require an additional verification or declaration, unless there is evidence in the record indicating that the party who signed the application was not in fact authorized to sign on behalf of all the joint applicants under 37 C.F.R. §2.193(e)(1). This does not apply to a response to an Office action submitted by joint applicants who are not represented by a practitioner authorized under 37 C.F.R. §11.14 to practice in trademark cases ("qualified practitioner").

Such a response must be signed personally by each of the joint applicants. 37 C.F.R. §§2.62(b) and 2.193(e)(2); TMEP §611.06(a). See TMEP §611.03(a) and 804.04 regarding persons authorized to sign a verification on behalf of an applicant.

Joint applicants are not the same as a joint venture. A joint venture is a single applicant, in the same way that a partnership is a single applicant. See TMEP §803.03(b) regarding joint ventures.

803.03(e) Trusts, Conservatorships, and Estates

If a trust is the owner of a mark in an application, the examining attorney must ensure that the trustee(s) is identified as the applicant. Thus, the examining attorney should require that the trust's application be captioned as follows:

The Trustees of the XYZ Trust, a California trust, the trustees comprising John Doe, a United States citizen, and the ABC Corporation, a Delaware corporation.

The application must first refer to the trustee(s) as the applicant and indicate the name of the trust, if any.

Then the state under whose laws the trust exists must be set forth. Finally, the names and citizenship of the individual trustees must be listed. If there are more than ten individual trustees, the applicant need list only the first ten trustees.

The same format generally applies to conservatorships and estates as follows:

The Conservator of Mary Jones, a New York conservatorship, the conservator comprising James Abel, a United States citizen.

The Executors of the John Smith estate, a New York estate, the executors comprising Mary Smith and James Smith, United States citizens.

803.03(e)(i) Business Trusts

Most states recognize an entity commonly identified as a "business trust,"

"Massachusetts trust," or "common-law trust."

A business trust has attributes of both a corporation and a partnership. Many states have codified laws recognizing and regulating business trusts; other states apply common law. The USPTO will accept the entity designation "business trust," or any appropriate variation provided for under relevant state law.

The business trust is created under the instructions of the instrument of trust. Generally, the "trustee" has authority equivalent to an officer in a corporation. Laws vary to some extent as to the authority conferred on various individuals associated with the business trust.

The application must first refer to the trustee(s) as the applicant and indicate the name of the trust, if any.

The state under whose laws the trust exists, and the names and citizenship (or state of incorporation or organization) of the individual trustees, must also be set forth. Accordingly, the examining attorney should require that the business trust's application be captioned as follows:

The Trustees of the DDT Trust, a California business trust, the trustees comprising Sue Smith, a United States citizen, and the PDQ Corporation, a Delaware corporation.

For the purpose of service of process, the business trust is essentially like a corporation. Therefore, it is not necessary to identify the beneficiaries or equitable owners of the business trust in identifying the entity.

803.03(f) Governmental Bodies and Universities

It is difficult to establish any rigid guidelines for designating the entity of a governmental body. Due to the variety in the form of these entities, the examining attorney must consider each case on an individual basis.

The following are just a few examples of acceptable governmental entities:

Department of the Air Force, an agency of the United States.

Maryland State Lottery Agency, an agency of the State of Maryland.

City of Richmond, Virginia, a municipal corporation organized under the laws of the Commonwealth of Virginia.

These examples are not exhaustive of the entity designations that are acceptable.

The structure of educational institutions varies significantly. The following are examples of acceptable university entities:

Board of Regents, University of Texas System, a Texas governing body.

University of New Hampshire, a nonprofit corporation of New Hampshire.

Auburn University, State University, Alabama.

These examples are not exhaustive of the entity designations that are acceptable.

The designations "education institution" and "educational organization" are not acceptable. If the applicant uses either of these designations to identify the entity, the examining attorney must require the applicant to amend the entity designation to a legally recognized juristic entity.

803.03(g) Banking Institutions

The nature of banking institutions is strictly regulated and, thus, there are a limited number of types of banking entities. Some banking institutions are federally chartered while others are organized under state law. The following are examples of acceptable descriptions of banking institutions:

First American Bank of Virginia, a Virginia corporation.

Pathway Financial, a federally chartered savings and loan association.

This is not an exhaustive listing of acceptable entity designations.

803.03(h) Limited Liability Companies

Most states recognize an entity commonly identified as a "limited liability company" or "LLC." The entity has attributes of both a corporation and a partnership. Therefore, the USPTO must accept the entity designation "limited liability company." The examining attorney may accept appropriate variations of this entity, with proof that the entity exists under the law of the relevant state. For example, some states recognize an entity identified as a "low-profit-limited-liability company" or "L3C," which combines the features of a for-profit LLC and a nonprofit organization.

If “LLC” or “L3C” appears in the applicant’s name, but the entity is listed as a corporation, the examining attorney must inquire as to whether the applicant is a limited liability company or a corporation. The applicant must indicate the state under whose laws the limited liability company is established. It is not necessary to list the “members” or owners of the limited liability company when identifying the entity.

See TMEP §611.06(g) regarding the proper party to sign a response to an Office action filed by a limited liability company that is not represented by an attorney.

Limited Liability Corporation. A business organization known as a “limited liability corporation” is currently not recognized. If an applicant’s entity type is identified as a limited liability corporation, the examining attorney must inquire as to whether the applicant is a limited liability company or a corporation. If the applicant believes that it is a limited liability corporation, then the applicant must provide proof that such a legal entity exists under the appropriate state statute.

See TMEP §803.03(k) regarding limited liability partnerships.

803.03(i) Common Terms Designating Entity of Foreign Applicants

In designating the legal entity of foreign applicants, acceptable terminology is not always the same as for United States applicants. The word “corporation” as used in the United States is not necessarily equivalent to juristic entities of foreign countries; the word “company” is sometimes more accurate. If the applicant is from the United Kingdom or another commonwealth country (e.g., Canada or Australia) and the term “company” (or the abbreviation “co.”) is used, no inquiry is needed. “Limited company” is also acceptable, for example, in China, the Republic of Korea, and commonwealth countries. There is a list of commonwealth countries on the commonwealth website at http://www.Thecommonwealth.org/Internal/142227/members/.

“Limited corporation” is also an acceptable entity designation for a foreign applicant.

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.

Appendix D of this manual lists common foreign designations, and their abbreviations, used by various foreign countries to identify legal commercial entities. The appendix also includes a description (Joint Stock Company, Cooperative Society, Trading Partnership, etc.) of the foreign designation and, in some cases, the equivalent United States entity. If a foreign designation, its abbreviation, or a description appears in the appendix, the examining attorney may accept any of those terms as the entity designation without further inquiry. The applicant may also choose to specify the legal entity by indicating the entity that would be its equivalent in the United States. However, if an applicant identifies itself by a name that includes a foreign entity designation in Appendix D (e.g., "Business SpA"), but provides a characterization of the entity that does not match the description (e.g., General Partnership), the examining attorney must clarify the nature of the applicant's entity.

If a foreign entity designation, its abbreviation, or its description does not appear in Appendix D, the examining attorney must inquire further into the specific nature of the entity. The examining attorney may request a description of the nature of the foreign entity, if necessary.

The applicant must also specify the foreign country under the laws of which it is organized, but no additional information is required, even if additional information would be required for a United States entity of the same name. For example, it is not necessary to set forth the names and citizenship of the partners of a foreign partnership. The rule requiring names and citizenships of general partners (37 C.F.R. §2.32(a)(3)(iii)) seeks to provide relevant information in the record, given the legal effects of partnership status in the United States. Because the USPTO does not track the varying legal effects of partnership status in foreign countries, and the relevance of the additional information has not been established, the same requirement for additional information does not apply to foreign partnerships.

Foreign entities may be organized under either national or provincial laws. However, the TEAS formrequires an applicant to specify the state or foreign country under which it is legally organized, but does notpermit an applicant to specify a foreign province or geographical region in this field. Therefore, if the applicant is organized under the laws of a foreign province or geographical region, the applicant should select the entity type "Other" (rather than "Corporation," "Limited Liability Company," "Partnership," etc.),which will allow

entry within the free-text field provided at “Specify Entity Type” of both the type of entityand the foreign province or geographical region under which it is organized (e.g., enter “corporation of Ontario” in the box labeled "If not listed above, please specify here:"). In the next section, “State or CountryWhere Legally Organized,” the country (e.g., “Canada”) should then be selected from the pull-down menu.

803.03(j) Federally Recognized Indian Tribe

A federally recognized Indian tribe, organized under the laws of the United States, is an acceptable designation of an applicant’s entity.

803.03(k) Limited Liability Partnerships

Most states recognize an entity commonly identified as a “limited liability partnership” (“LLP”). An LLP is separate and distinct from a limited partnership, and is more closely associated with a limited liability company in that it has attributes of both a corporation and a partnership. Therefore, the USPTO will accept the entity designation “limited liability partnership.” The examining attorney may accept appropriate variations of this entity (e.g., "limited liability limited partnership” or “LLLP”), with proof that the entity exists under the law of the relevant state.

The applicant must indicate the state under whose laws the limited liability partnership is established. It is not necessary to list the partners of the limited liability partnership when identifying the entity.

See TMEP §611.06(h) regarding the proper party to sign a response to an Office action filed by a limited liability partnership that is not represented by a qualified practitioner.

See also TMEP §803.03(h) regarding limited liability companies.

803.04 Citizenship of Applicant

An application for registration must specify the applicant’s citizenship or the state or nation under whose laws the applicant is organized. 37 C.F.R. §2.32(a)(3). If ambiguous terms are used, the examining attorney must require the applicant to clarify the record by setting forth the citizenship with greater specificity. For example, the term “American” is ambiguous because it could refer to a citizen of North, South, or Central America. Therefore, “United States” or “U.S.A.” is the appropriate citizenship designation for applicants who are citizens of the United States of America. However, terms such as “Brazilian,” Colombian,” and “Welsh” are acceptable citizenship

designations because each refers to a specific country.

An individual applicant should set forth the country of which he or she is a citizen. Current citizenship information must be provided; a statement indicating that the applicant has applied for citizenship in any country is not relevant or acceptable. If an individual is not a citizen of any country, a statement to this effect is acceptable.

In an application for international registration, if the applicant is a natural person, he or she must indicate his or her name and may include the country of which he or she is a national. Common Regs, Rule 9(4)(b)(i).

The international application does not require this information, but when the information is included, the IB will forward the nationality of the applicant to the USPTO. In a §66(a) application, if the "Nationality
of Applicant" field appears in TICRS, this means that the applicant is an individual rather than a juristic entity, and that applicant's citizenship is the country corresponding to the two-letter code set forth in this field. The list of country codes appears in the MM2 International Registration application form, which can be found at http://www.wipo.int/pct/en/appguide/. A separate statement that applicant is an individual will not appear in TICRS, and the "Legal Nature" and Legal Nature: Place Incorporated" fields will state "Not Provided."

If the "Nationality of Applicant" field appears in TICRS, the examining attorney may enter the relevant information into the Trademark database, or ask the LIE to enter it. No inquiry as to the applicant's entity or citizenship is necessary. If the "Nationality of Applicant" field does not appear in TICRS, the examining attorney must require that the applicant indicate its entity and citizenship. Examining attorneys cannot rely on the "Entitlement Nationality," "Entitlement Establishment," or "Entitlement Domiciled" fields for the applicant's citizenship because these fields merely indicate the basis for the applicant's entitlement to file an application through the Madrid system, not the national citizenship of the individual applicant.

If an applicant asserts dual citizenship, the applicant must choose which citizenship will be printed in the Official Gazette and on the registration certificate. The USPTO will print only one country of citizenship for each person in the Official Gazette and on the registration certificate, and the automated records of the USPTO will indicate only one country of citizenship for each person.

For a corporation, the application must set forth the United States

state or foreign country of incorporation. 37 C.F.R. §2.32(a)(3)(ii). Foreign entities may be organized under either national or provincial laws. However, the TEAS form requires an applicant to specify the state or foreign country under which it is legally organized, but does not permit an applicant to specify a foreign province or geographical region in this field. Therefore, if the applicant is organized under the laws of a foreign province or geographical region, the applicant should select as the entity type the choice of "Other," which will allow entry within the free-text field provided at "Specify Entity Type" of both the type of entity and the foreign province or geographical region under which it is organized (e.g., "corporation of Ontario"). In the next section, "State or Country Where Legally Organized," the country (e.g., "Canada") should then be selected from the pull-down menu.

For an association, the application must set forth the United States state or foreign country under whose laws the association is organized or incorporated. 37 C.F.R. §2.32(a)(3)(ii). See TMEP §803.03(c).

A partnership or other firm must set forth the United States state or foreign country under the laws of which the partnership is organized. Domestic partnerships must also provide citizenship information for each general partner in the partnership. 37 C.F.R. §2.32(a)(3)(iii). This requirement also applies to a partnership that is a general partner in a larger partnership. See TMEP §803.03(b) for the proper format for identifying a partnership. Given the varying legal effects of partnership status in foreign countries, the relevance of the name and citizenship information for each partner has not been established. Therefore, for foreign partnerships, it is not necessary to provide the names and citizenship of the partners. See TMEP §803.03(i) for further information about foreign applicant entities.

For joint applicants or a joint venture, the application should set forth the citizenship or United States state or foreign country of organization of each party. Domestic joint ventures must also provide citizenship information for all active members of the joint venture. 37 C.F.R. §2.32(a)(3)(iv). See TMEP §803.03(b) for the proper format for identifying a joint venture.

803.05 Address of Applicant

The written application must specify the applicant's mailing address. 37 C.F.R. §2.32(a)(4). Addresses should include the United States Postal Service ZIP code or its equivalent for addresses outside the United States. The applicant's address may consist of a post office

box.

For an individual, the application must set forth either the business address or the residence address.

If the application sets out more than one address, the applicant should designate the address to be included on the registration certificate.

For a partnership or other firm, only the address of the business need be set forth -- not the addresses of the partners or members.

For a corporation or association, the business address should be set forth. If the corporation's business address is not in its state of incorporation, the applicant should set out the address where the applicant is domiciled.

For joint applicants, the application should include addresses for each party.

The application must also include an address for correspondence concerning the application. See 37 C.F.R. §§2.18 and 2.21(a)(2). This is referred to as the correspondence address. See TMEP §§609 et seq.

803.06 Applicant May Not Be Changed

While an application can be amended to correct an inadvertent error in the manner in which an applicant's name is set forth (see TMEP §1201.02(c)), an application cannot be amended to substitute another entity as the applicant. If the application was filed in the name of a party who had no basis for his or her assertion of ownership of (or entitlement to use) the mark as of the filing date, the application is void, and registration must be refused. 37 C.F.R. §2.71(d); TMEP §1201.02(b). Huang v. Tzu Wei Chen Food Co. Ltd., 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988); Great Seats, Ltd. v. Great Seats, Inc., 84 USPQ2d 1235 (TTAB 2007); American Forests v. Sanders, 54 USPQ2d 1860 (TTAB 1999), aff 'd, 232 F.3d 907 (Fed. Cir. 2000); In re Tong Yang Cement Corp., 19 USPQ2d 1689 (TTAB 1991); In re Lettmann, 183 USPQ 369 (TTAB 1974); Dunleavy v. Koeppel Steel Products, Inc., 114 USPQ 43 (Comm'r Pats. 1957), aff 'd, 328 F.2d 939, 140 USPQ 582 (C.C.P.A. 1964); Richardson Corp. v. Richardson, 51 USPQ 144 (Comm'r Pats. 1941); Celanese Corp. of America v. Edwin Crutcher, 35 USPQ 98 (Comm'r Pats. 1937). The USPTO will not refund the application filing fee in such a case.

A void application cannot be cured by amendment or assignment. The true owner may file another application (with a new filing fee) in its name or, if the applicant who is refused later becomes the owner of the mark, he or she may file another application (with a new filing fee) at that time.

See TMEP §1201.02(c) for examples of correctable and non-correctable errors in identifying the applicant, TMEP §803.01 regarding minor applicants, and TMEP §1201.02(e) and TMEP Chapter 500 regarding the situation in which the true owner of a mark files an application and transfers ownership to another party after the filing date.

804 Verification and Signature

An application must include a statement that is verified by the applicant or by someone who is authorized to verify facts on behalf of an applicant. 15 U.S.C. §1051(a)(3) and 1051(b)(3); 37 C.F.R. §§2.32(b), 2.33(a), and 2.193(e)(1).

In an application under §1 or §44 of the Trademark Act, a signed verification is not required for receipt of an application filing date under 37 C.F.R. §2.21(a). If the initial application does not include a proper verified statement, the examining attorney must require the applicant to submit a verified statement that relates back to the original filing date. See TMEP §§804.01 et seq. regarding the form of the oath or declaration, TMEP §804.02 regarding the essential allegations required to verify an application for registration of a mark, and TMEP §804.04 regarding persons properly authorized to sign a verification on behalf of an applicant.

In §66(a) applications, the verified statement is part of the international registration on file at the IB. 37 C.F.R. §2.33(e). See TMEP §804.05 and 1904.01(c).

804.01 Form and Wording of Verification in §1 or §44 Application

The format of the verification in an application under §1 or §44 of the Trademark Act may be: (1) the classical form for verifying, which includes an oath (jurat) (see TMEP §804.01(a)); or (2) a declaration under 37 C.F.R. §2.20 or 28 U.S.C. §1746 instead of an oath (see TMEP §804.01(b)).

804.01(a) Verification with Oath

The verification is placed at the end of the application. It should first set forth the venue; followed by the signer's name (or the words "the undersigned"); then the necessary statements (TMEP §804.02); concluding with the signature. After the signature, there should be the jurat for the officer administering the oath, and an indication of the officer's authority (such as notarial seal).

The form of the verification depends on the law of the jurisdiction where the document is executed, so variations of the above form are acceptable. If there is a question as to the validity of the verification, the examining attorney should ask the applicant if the verification complies with the laws of the applicant's jurisdiction. See TMEP §804.01(a)(i) regarding verifications made in a foreign country.

If the verification is notarized but does not include the notarial seal, the examining attorney must require a substitute affidavit or declaration under 37 C.F.R. §2.20.

If the verification is notarized but has not been dated, the applicant must submit either a statement from the notary public attesting to the date of signature and notarization, or a substitute affidavit or declaration under 37 C.F.R. §2.20.

804.01(a)(i) Verification Made in Foreign Country

Verification (with oath) made in a foreign country may be made: (1) before any diplomatic or consular officer of the United States; or (2) before any official authorized to administer oaths in the foreign country.

In those foreign countries that are members of The Hague Convention Abolishing the Requirement of Legislation for Foreign Public Documents, a document verified before a foreign official should bear or have appended to it an apostille (i.e., a certificate issued by an official of the member country).

Member countries, territories, and Departments in Europe participating in this Convention are: Anqulla, Antigua & Barbuda, Argentina, Armenia, Australia, Austria, Bahamas, Bailiwick of Guernsey, Barbados, Belarus, Belgium, Belize, Bermuda, Bosnia & Herzegovina, Botswana, British Antarctic, British Guiana (Guyana), British Soloman Islands, Cayman, Croatia, Cyprus, Dominica, El Salvador, Falkland Islands, Figi, Finland, France, French Guiana, Germany, Gibraltar, Gilbert & Ellice Islands (Kiribati), Greece, Grenada, Guadeloupe, Hong Kong, Hungary, Isle of Man, Jersey, Israel, Italy, Japan, Latvia, Lesotho, Liechtenstein, Lithuania, Luxembourg, Macedonia, Malawi, Malta, Marshall Islands, Martinique, Mauritius, Mexico, Montserrat, Netherlands, New Hebrides (Vanuatu), Norway, Panama, Portugal, Reunion, Saint Christopher & Nevis, Saint Helena, Saint Lucia, Saint Vincent, San Marino, Seychelles, Slovenia, South Africa, Southern Rhodesia (Zimbabwe), Spain, Suriname, Swaziland, Switzerland, Tonga, Turkey, Turks & Caicos, United Kingdom & Northern Ireland, and the Virgin Islands.

An apostille must be square shaped with sides at least 9 centimeters long. The following is the prescribed form for an apostille:

[Figure is omitted]

See notice at 1013 TMOG 3 (December 1, 1981).

If a verification is made before a foreign official in a country that is not a member of the Hague Convention, the foreign official’s

authority must be proved by a certificate of a diplomatic or consular officer of the United States. 15 U.S.C. §1061.

Declarations under 37 C.F.R. §2.20 and 28 U.S.C. §1746 by foreign persons do not have to be made before a United States diplomatic or consular officer, or before a foreign official authorized to administer oaths.

A declaration under 28 U.S.C. §1746 that is executed outside the United States must allege that "I declare (or certify, verify, or state) under penalty of perjury under the laws of the United States of America that the foregoing is true and correct." See TMEP §804.01(b).

See http://www.state.gov/www/authenticate/index.html for updated information about the Hague Convention.

804.01(b) Declaration in Lieu of Oath

Under 35 U.S.C. §25, the USPTO is authorized to accept a declaration under 37 C.F.R. §2.20 or 28 U.S.C. §1746 instead of an oath. These declarations can be used whenever the Act or rules require that a document be verified or under oath.

When the language of 37 C.F.R. §2.20 or 28 U.S.C. §1746 is used with a document, the document is said to have been subscribed to (signed) by a written declaration rather than verified by oath (jurat).

When a declaration is used in lieu of an oath, the party must include in place of the oath (jurat) the statement that "all statements made of his or her own knowledge are true and all statements made on information and belief are believed to be true." Preferably, this language is placed at the end of the document.

In addition, the declaration must warn the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. §1001). 35 U.S.C. §25(b). Trademark Rule 2.20 requires that the warning contain the additional language that such statements may jeopardize the validity of the application (or document) or any registration resulting therefrom. A declaration under 37 C.F.R. §2.20 should read as follows:

[Figure is omitted]

Instead of using the language of 37 C.F.R. §2.20, an applicant may use the language of 28 U.S.C. §1746, which provides as follows:

Wherever, under any law of the United States or under any rule, regulation, order, or requirement made pursuant to law, any matter is required or permitted to be supported, evidenced, established, or proved by the sworn declaration, verification, certificate, statement, oath, or affidavit, in writing of the person making the same (other

than a deposition, or an oath of office, or an oath required to be taken before a specific official other than a notary public), such matter may, with like force and effect, be supported, evidenced, established, or proved by the unsworn declaration, certificate, verification, or statement, in writing of such person which is subscribed by him, as true under penalty of perjury, and dated, in substantially the following form:

1 If executed outside the United States, its territories, possessions, or commonwealths: "I declare (or certify, verify, or state) under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on (date).(Signature)".

2 If executed within the United States, its territories, possessions, or commonwealths: "I declare (or certify, verify, or state) under penalty of perjury that the foregoing is true and correct. Executed on (date).(Signature)".

NOTE: Title 35 of the United States Code pertains specifically to the USPTO and, therefore, is preferred to 28 U.S.C. §1746, which is a statute of general application relating to verification on penalty of perjury.

A declaration that does not attest to an awareness of the penalty for perjury is unacceptable. 35 U.S.C. §25.

In re Hoffmann-La Roche Inc., 25 USPQ2d 1539 (Comm'r Pats. 1992) (failure to include a statement attesting to an awareness of the penalty for perjury, which is the very essence of an oath, is not a "minor defect" that can be provisionally accepted under 35 U.S.C. §26), overruled on other grounds, In re Moisture Jamzz Inc., 47 USPQ2d 1762, 1764 (1997); In re Stromsholmens Mekaniska Verkstad AB, 228 USPQ 968 (TTAB 1986); In re Laboratories Goupil, S.A., 197 USPQ 689 (Comm'r Pats. 1977).

The signatory must personally sign his or her name. It is unacceptable for a person to sign another person's name to a declaration pursuant to a general power of attorney. See In re Dermahose Inc., 82 USPQ2d 1793 (TTAB 2007); In re Cowan, 18 USPQ2d 1407 (Comm'r Pats. 1990). In a TEAS submission, the person(s) identified as the signer(s) must manually enter the elements of the electronic signature. The rules do not provide authority for an attorney to sign another person's declaration. Dermahose, 82 USPQ2d at 1795. See TMEP §611.01(c) regarding signature of documents filed through TEAS.

If a declaration under 37 C.F.R. §2.20 or 28 U.S.C. §1746 is not dated, the examining attorney must require the applicant to state the date on which the declaration was signed. This statement does not have to

be verified, and may be entered through a Note to the File in the record.

See TMEP §804.02 regarding the essential allegations required to verify an application for registration of a mark.

804.02 Averments Required in Verification of Application for Registration - §1 or §44 Application

The requirements for the verified statement in applications under §1 or §44 of the Trademark Act are set forth in §1(a)(3), 1(b)(3), and 44 of the Trademark Act, 15 U.S.C. §1051(a)(3), 1051(b)(3), and 1126, and 37 C.F.R. §2.33, 2.34, and 2.193(e)(1). These allegations are required regardless of whether the verification is in the form of an oath (TMEP §804.01(a)) or a declaration (TMEP §804.01(b)). See TMEP §804.05 regarding the requirements for verification of a §66(a) application.

Truth of Facts Recited. Under 15 U.S.C. §1051(a)(3)(B) and 1051(b)(3)(C), the verification of an application for registration must include an allegation that "to the best of the verifier's knowledge and belief, the facts recited in the application are accurate." 37 C.F.R. §§2.33(b)(1) and (2). The language in 37 C.F.R. §2.20 that "all statements made of [the verifier's] own knowledge are true, and all statements made on information and belief are believed to be true" satisfies this requirement.

Use in Commerce. If the filing basis is §1(a), the applicant must submit a verified statement that the mark is in use in commerce on or in connection with the goods or services listed in the application. If the verification is not filed with the original application, the verified statement must also allege that the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date. 37 C.F.R. §2.34(a)(1)(i).

Bona Fide Intention to Use in Commerce. If the filing basis is §1(b), §44(d), or §44(e), the applicant must submit a verified statement that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. 15 U.S.C. §1051(b)(3)(B), 1126(d)(2), and 1126(e). If the verification is not filed with the original application, the verified statement must also allege that the applicant has had a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application as of the application filing date. 37 C.F.R. §2.34(a)(2), 2.34(a)(3)(i), and 2.34(a)(4)(ii).

Ownership or Entitlement to Use. In an application based on §1(a), the verified statement must allege that the verifier believes the applicant to be the owner of the mark and that no one else, to the best of his or her knowledge and belief, has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of the other person, to cause confusion or mistake, or to deceive. 15 U.S.C. §1051(a)(3)(A), (D); 37 C.F.R. §2.33(b)(1).

In an application based on §1(b) or §44, the verified statement must allege that the verifier believes the applicant to be entitled to use the mark in commerce and that no one else, to the best of his or her knowledge and belief, has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of the other person, to cause confusion or mistake, or to deceive. See 15 U.S.C. §1051(b)(3)(A); 37 C.F.R. §2.33(b)(2).

While the correct language for an application filed under §1(b) or §44 is "entitled to use," if a §1(b) or §44 applicant files a verification stating that the applicant is the owner of the mark, the USPTO will accept the verification, and will not require a substitute verification stating that the applicant is entitled to use the mark.

Concurrent Use. The verification for concurrent use should be modified to indicate an exception, i.e., that no one else except as specified in the application has the right to use the mark. 15 U.S.C. §1051(a)(3)(D).

See TMEP §1207.04 et seq. regarding concurrent use registration.

Related-company use does not require stating an exception, because the statement that no one else has the right to use the mark refers only to adverse users and not to licensed or permitted use. See TMEP §1201.03 et seq. regarding use by related companies.

Affirmative, Unequivocal Averments Based on Personal Knowledge Required. The verification must include affirmative, unequivocal averments that meet the requirements of the Act and the rules. Statements such as "the undersigned [person signing the declaration] has been informed that the applicant is using [or has a bona fide intention to use] the mark in commerce...," or wording that disavows the substance of the declaration, are unacceptable.

Substitute Verification. If the verified statement does not include all the necessary averments, the examining attorney will require a substitute or supplemental affidavit or declaration under 37 C.F.R.

§2.20.

804.03 Time Between Execution and Filing of Documents - §1 or §44 Application

Documents Must Be Filed Within a Reasonable Time After Execution

All applications and documents must be filed within a reasonable time after their execution. Under 37 C.F.R. §2.33(c), if the verified statement supporting an application for registration is not filed within a reasonable time after it is signed, the USPTO will require the applicant to submit a substitute affidavit or declaration under 37 C.F.R. §2.20 of the applicant's continued use or bona fide intention to use the mark in commerce. Re-execution is also required where an allegation of use (i.e., either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d)) or request for extensions of time to file a statement of use is not filed within a reasonable time after the date of execution. 37 C.F.R. §§2.76(i), 2.88(k), and 2.89(h); TMEP §§1104.09, 1108.02(b), and 1109.11(c).

The USPTO considers one year between execution and filing as reasonable for all applications and all documents. No new verification should be required if the document is filed within one year of execution.

If an application, allegation of use, or request for extension of time to file a statement of use is filed more than one year after its execution, the examining attorney will require that the applicant submit re-executed documents, or a statement that is verified or includes a declaration under 37 C.F.R. §2.20, of the applicant's continued use or bona fide intent to use the mark in commerce, as appropriate.

Documents Cannot Be Filed Before They Are Executed

If an applicant files an application that is signed and lists a date of execution that is subsequent to the application filing date, the examining attorney will inquire as to the actual date on which the application was signed. However, where an application is executed in a foreign country located across the international date line, the fact that an application shows a date of execution as of the day after the application filing date is not inconsistent with its having been executed before filing. No inquiry is required in this limited situation.

804.04 Persons Authorized to Sign Verification or Declaration

37 CFR §2.33(a)

The application must include a statement that is signed in accordance with the requirements of §2.193 and verified (sworn to) or supported by a declaration under §2.20 by a person properly authorized to sign on behalf of the applicant under §2.193(e)(1).

37 CFR §2.193(e)(1) Verification of facts.

A verification in support of an application for registration, amendment to an application for registration, allegation of use under §2.76 or §2.88, request for extension of time to file a statement of use under §2.89, or an affidavit under section 8, 12(c), 15, or 71 of the Trademark Act must be sworn to or supported by a declaration under §2.20, signed by the owner or a person properly authorized to sign on behalf of the owner. A person who is properly authorized to verify facts on behalf of an owner is:

(i) A person with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership);

(ii) A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or

(iii) An attorney as defined in §11.1 of this chapter who has an actual written or verbal power of attorney or an implied power of attorney from the owner.

The Trademark Act does not specify the appropriate person to verify facts on behalf of an applicant. The definition of a "person properly authorized to sign on behalf of the applicant" is set forth in 37 C.F.R. §2.193(e)(1). This definition applies to applications for registration, amendments to allege use, statements of use, requests for extensions of time to file statements of use, affidavits of continued use or excusable nonuse under 15 U.S.C. §1058, affidavits of incontestability under 15 U.S.C. §1065, and combined filings under 15 U.S.C. §1058 and 1059. 37 C.F.R. §2.76(b)(1), 2.88(b)(1), 2.89(b)(3), and 2.161(b). It also applies to declarations supporting amendments to dates of use, use of substitute specimens, claims of acquired distinctiveness under 15 U.S.C. §1052(f), amendments changing the basis for filing, and requests for amendment or correction of registrations under 15 U.S.C. §1057. 37 C.F.R. §2.193(e)(1).

Generally, the USPTO does not question the authority of the person who signs a verification, unless there is an inconsistency in the record as to the signatory's authority to sign. The USPTO presumes that the verification or declaration is properly signed. In view of the broad definition of a "person properly authorized to sign on behalf of the

applicant" in 37 C.F.R. §2.193(e)(1), the fact that an application is signed by someone whose title refers to a different entity is not considered an inconsistency that warrants an inquiry as to whether the verification was properly signed.

Example: If an application is filed by "ABC Company, Inc.," and the verification is signed by an officer of "XYZ Company, Inc.," the USPTO will presume that XYZ Company, Inc. is a related company properly authorized to sign on behalf of ABC Company, Inc.

The signatory should set forth his or her name and title, or state the relationship between the applicant and the person who signed the verification.

If the person signing the verification is identified as a different person than the individual named as the applicant, or as representing a different legal entity than the juristic applicant, the USPTO generally will not question whether the proper party is listed as the applicant.

Example: If the applicant is identified as Mary Smith, an individual citizen of the U.S., and the application is signed by John Smith, the USPTO will not question whether the proper party is listed as applicant.

Example: If the applicant is John Smith, an individual citizen of the U.S., and the application is signed by John Smith, President, XYZ, Inc., the USPTO will not question whether the proper party is listed as applicant.

If a qualified practitioner signs a verification on behalf of an applicant, the USPTO will not require a power of attorney or other documentation stating that the practitioner is authorized to sign.

This policy applies to both individual applicants and juristic applicants.

The broad definition of a "person properly authorized to sign on behalf of the applicant" in 37 C.F.R. §2.193(e)(1) applies only to verifications of facts by the applicant. It does not apply to powers of attorney, revocations of powers of attorney, responses to Office actions, letters of express abandonment, or changes to the correspondence address. 37 C.F.R. §2.193(e)(2), (3), and (9).

A non-attorney who is authorized to verify facts on behalf of an applicant under 37 C.F.R. §2.193(e)(1) is not necessarily entitled to sign responses to Office actions, or to authorize examiner's amendments and priority actions. Preparing a document, authorizing an amendment to an application, and submitting legalarguments in response to an examining attorney's requirement or refusal of registration all constitute examples of representation of the applicant in a trademark

matter. 37 C.F.R. §11.5(b)(2). Under 5 U.S.C. §500(d) and 37 C.F.R. §11.14(e), non-attorneys may not represent a party in a trademark proceeding before the USPTO. See TMEP §611.03(b), 611.06 et seq., and 712 et seq. regarding signature on responses to Office actions.

The signatory must personally sign his or her name. 37 C.F.R. §2.193(a)(1) and (c)(1). It is unacceptable for a person to sign another person's name to a verification pursuant to a general power of attorney. See In re Dermahose Inc., 82 USPQ2d 1793 (TTAB 2007); In re Cowan, 18 USPQ2d 1407 (Comm'r Pats. 1990). In a TEAS submission, the person whose name is affixed to the verification must manually enter the elements of the electronic signature. The rules do not provide authority for an attorney to sign another person's declaration. Dermahose, 82 USPQ2d at 1795.

The name of the person who signs a document submitted in connection with an application must be set forth in printed or typed form immediately below or adjacent to the signature, or identified elsewhere in the filing (e.g., in a cover letter or other document that accompanies the filing). 37 C.F.R. §2.193(d). If the signatory's name is not set forth in a document, the USPTO may require that it be stated for the record. This information can be entered through a Note to the File.

In applications under §66(a) of the Act, the verified statement is part of the international registration on file at the IB. 37 C.F.R. §2.33(e). The IB establishes that an international registration includes a signed declaration before it sends the request for extension of protection to the USPTO. Generally, the examining attorney should not issue any inquiry regarding the authority of the signatory to verify the application. If the applicant needs to file a request for correction of the declaration, the request should be filed with the IB.

However, if the applicant voluntarily files a substitute declaration with the USPTO, it will be examined according to the same standards used for examining any other declaration. See TMEP §804.05 regarding verification of §66(a) applications.

804.05 Verification of §66(a) Application

In applications under §66(a) of the Act, the request for extension of protection to the United States must include a declaration that the applicant has a bona fide intention to use the mark in commerce that can be controlled by the United States Congress. The declaration must include a statement that the person making the declaration believes

applicant to be entitled to use the mark in commerce, and that to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive. 15 U.S.C. §1141(f)(a). The declaration must be signed by: (1) a person with legal authority to bind the applicant; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant; or (3) a qualified practitioner who has an actual written or verbal power of attorney or an implied power of attorney from the applicant.

The verified statement in a §66(a) application is part of the international registration on file at the IB.

37 C.F.R. §2.33(e). The IB will have established that the international registration includes this declaration before it sends the request for extension of protection to the USPTO. The examining attorney should generally not issue any inquiry regarding the verification of the application. If the applicant needs to file a request for correction of the declaration, the request should be filed with the IB. However, if the applicant voluntarily files a substitute declaration with the USPTO, it will be examined according to the same standards used for examining any other declaration.

805 Identification and Classification of Goods and Services

An application must include a list of the particular goods or services on or in connection with which the applicant uses or intends to use the mark. 37 C.F.R. §2.32(a)(6). See TMEP §1402 et seq. for further information about identifying goods and services in an application.

The applicant should designate the international class number(s) that are appropriate for the identified goods or services, if this information is known. 37 C.F.R. §2.32(a)(7). See TMEP §1401 et seq. for more information about classification.

806 Filing Basis

A filing basis is the statutory basis for filing an application for registration of a mark in the United States. An applicant must specify and meet the requirements of one or more bases. 37 C.F.R. §2.32(a)(5). There are five filing bases:

(1) use of a mark in commerce under §1(a) of the Trademark Act, 15 U.S.C. §1051(a);

(2) bona fide intention to use a mark in commerce under §1(b) of the Act, 15 U.S.C. §1051(b);

(3) a claim of priority, based on an earlier-filed foreign application under §44(d) of the Act, 15 U.S.C. §1126(d);

(4) ownership of a registration of the mark in the applicant's country of origin under §44(e) of the Act, 15 U.S.C. §1126(e); and (5) extension of protection of an international registration to the United States, under §66(a) of the Act, 15 U.S.C. §1141f(a). 37 C.F.R. §2.34.

An applicant is not required to specify the basis for filing to receive a filing date. Kraft Group LLC v. Harpole, 90 USPQ2d 1837 (TTAB 2009). If a §1 or §44 application does not specify a basis, the examining attorney must require in the first Office action that the applicant specify the basis for filing and submit all the elements required for that basis. If the applicant timely responds to the first Office action, but fails to specify a basis for filing, or fails to submit all the elements required for a particular basis, the examining attorney will issue a final Office action, if the application is otherwise in condition for final action.

In a §66(a) application, the basis for filing will have been established in the international registration on file at the IB.

See 37 C.F.R. §2.34 and TMEP §806.01 et seq. for a list of the requirements for each basis.

806.01 Requirements for Establishing a Basis

The requirements for establishing a basis are set forth in TMEP §806.01(a) through 806.01(e). If these requirements are not met in the original application, the examining attorney will require the applicant to comply with them in the first Office action.

806.01(a) Use in Commerce - §1(a)

Under 15 U.S.C. §1051(a) and 37 C.F.R. §2.34(a)(1), to establish a basis under §1(a) of the Trademark Act, the applicant must:

(1) Submit a verified statement that the mark is in use in commerce on or in connection with the goods or services listed in the

application. 15 U.S.C. §1051(a)(3)(C). If this verified statement is not filed with the initial application, the verified statement must also allege that the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date (37 C.F.R. §2.34(a)(1)(i));

(2) Specify the date of the applicant's first use of the mark anywhere on or in connection with the goods or services (37 C.F.R. §2.34(a)(1)(ii); TMEP §903.01);

(3) Specify the date of the applicant's first use of the mark in commerce as a trademark or service mark (37 C.F.R. §2.34(a)(1)(iii); TMEP §903.02); and

(4) Submit one specimen for each class, showing how the applicant actually uses the mark in commerce (37 C.F.R. §2.34(a)(1)(iv) and 2.56; TMEP §904 et seq.).

The Trademark Act defines "commerce" as commerce which may lawfully be regulated by Congress, and "use in commerce" as the bona fide use of a mark in the ordinary course of trade. 15 U.S.C. §1127; 37 C.F.R. §2.34(c). See TMEP §901 et seq.

An applicant may claim both use in commerce under §1(a) of the Act and intent-to-use under §1(b) of the Act as a filing basis in the same application, but may not assert both §1(a) and §1(b) for the identical goods or services. 37 C.F.R. §2.34(b)(1); TMEP §806.02(b).

An applicant may not claim a §1(a) basis unless the mark was in use in commerce on or in connection with all the goods or services covered by the §1(a) basis as of the application filing date. 37 C.F.R. §2.34(a)(1)(i).

Cf. E.I. du Pont de Nemours & Co. v. Sunlyra Int'l, Inc., 35 USPQ2d 1787, 1791 (TTAB 1995).

If the applicant claims use in commerce in addition to another filing basis, but does not specify which goods or services are covered by which basis, the USPTO may defer examination of the specimen(s) until the applicant identifies the goods or services for which use is claimed. TMEP §806.02(c).

806.01(b) Intent-to-Use - §1(b)

In an application based on 15 U.S.C. §1051(b), the applicant must submit a verified statement that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. 15 U.S.C. §1051(b)(3)(B). If the verified statement is not filed with the initial application, the verified statement must also allege that the applicant had a bona

fide intention to use the mark in commerce on or in connection with the goods or services as of the filing date of the application.37 C.F.R. §2.34(a)(2).

Prior to registration, the applicant must file an allegation of use (i.e., either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d)) that states that the applicant is using the mark in commerce on or in connection with the goods or services, includes dates of use and a filing fee for each class, and includes one specimen evidencing such use for each class. See 37 C.F.R. §2.76 and TMEP §1104 et seq. regarding amendments to allege use, and 37 C.F.R. §2.88 and TMEP §1109 et seq. regarding statements of use.

Once an applicant claims a §1(b) basis for any or all of the goods or services, the applicant may not amend the application to seek registration under §1(a) of the Act for those goods or services unless the applicant files an allegation of use under §1(c) or §1(d) of the Act. 37 C.F.R. §2.35(b)(8).

See TMEP Chapter 1100 for additional information about intent-to-use applications.

806.01(c) Foreign Priority - §44(d)

Section 44(d) of the Act provides a basis for receipt of a priority filing date, but not a basis for publication or registration. Before the application can be approved for publication, or for registration on the Supplemental Register, the applicant must establish a basis under §1(a), §1(b), or §44(e) of the Act. 37 C.F.R. §2.34(a)(4)(iii); TMEP §1003.03. If the applicant claims a §1(b) basis, the applicant must file an allegation of use before the mark can be registered. See TMEP §806.01(b) regarding the requirements for a §1(b) basis.

Under 15 U.S.C. §1126(d) and 37 C.F.R. §2.34(a)(4), the requirements for receipt of a priority filing date based on a previously filed foreign application are:

(1) The applicant must file a claim of priority within six months of the filing date of the foreign application. 37 C.F.R. §2.34(a)(4)(i) and 2.35(b)(5);

(2) The applicant must: (a) specify the filing date, serial number, and country of the first regularly filed foreign application; or (b) state that the application is based upon a subsequent regularly filed application in the same foreign country, and that any prior-filed application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without having

any rights outstanding, and has not served as a basis for claiming a right of priority. 37 C.F.R. §2.34(a)(4)(i)(A) and (B). See also Paris Convention Article 4(D); and

(3) The applicant must verify that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods and/or services listed in the application. 15 U.S.C. §1126(d)(2). This allegation is required even if use in commerce is asserted in the application. TMEP §806.02(e). If the verified statement is not filed with the initial application, the verified statement must also allege that the applicant had a bona fide intention to use the mark in commerce as of the filing date of the application. 37 C.F.R. §2.34(a)(4)(ii).

The scope of the goods/services covered by the §44 basis in the United States application cannot exceed the scope of the goods/services in the foreign application or registration. 37 C.F.R. §2.32(a)(6); TMEP §1402.01(b).

If an applicant properly claims a §44(d) basis in addition to another basis, the applicant may retain the priority filing date without perfecting the §44(e) basis. 37 C.F.R. §2.35(b)(3) and (4). See TMEP §806.04(b) regarding processing an amendment electing not to perfect a §44(e) basis, and TMEP §806.02(f) regarding the examination of applications that claim §44(d) in addition to another basis.

See TMEP §1003 et seq. for further information about §44(d) applications.

806.01(d) Foreign Registration. §44(e)

Under 15 U.S.C. §1126(e) and 37 C.F.R. §2.34(a)(3), the requirements for establishing a basis for registration under §44(e), relying on a registration granted by the applicant's country of origin, are:

(1) The applicant must submit a true copy, a photocopy, a certification, or a certified copy of the registration in the applicant's country of origin. 37 C.F.R. §2.34(a)(3)(ii); TMEP §1004.01 and 1004.01(b);

(2) The application must include the applicant's verified statement that it has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services. 15 U.S.C. §1126(e). This allegation is required even if use in commerce is asserted in the application. TMEP §806.02(e). If the verified statement is not filed with the initial application, the verified statement must also allege that the applicant had a bona fide intention to use the mark in commerce as of the application filing date. 37 C.F.R. §2.34(a)(3)(i); and

(3) The applicant's country of origin must either be a party to a convention or treaty relating to trademarks to which the United States is also a party, or extend reciprocal registration rights to nationals of the United States by law. See TMEP §1002 et seq.

If the applicant does not submit a certification or a certified copy of the registration from the country of origin, the applicant must submit a true copy or photocopy of a document that has been issued to the applicant by, or certified by, the intellectual property office in the applicant's country of origin. A photocopy of an entry in the intellectual property office's gazette (or other official publication) or a printout from the intellectual property office's web site is not, by itself, sufficient to establish that the mark has been registered in that country and that the registration is in full force and effect. See TMEP §1004.01.

The scope of the goods/services covered by the §44 basis in the United States application cannot exceed the scope of the goods/services in the foreign registration. 37 C.F.R. §2.32(a)(6); TMEP §1402.01(b).

An application may be based on more than one foreign registration. If the applicant amends an application to rely on a different foreign registration, this is not considered a change in basis; however, the application must be republished. TMEP §1004.02. See TMEP §806.03 et seq. regarding amendments to add or substitute a basis.

See TMEP §1004 et seq. for further information about §44(e) applications.

806.01(e) Extension of Protection of International Registration - §66(a)

Section 66(a) of the Act, 15 U.S.C. §1141f(a), provides for a request for extension of protection of an international registration to the United States. See 37 C.F.R. §2.34(a)(5). The request must include a declaration of a bona fide intention to use the mark in commerce that is verified by the applicant for, or holder of, the international registration. The verified statement is part of the international registration on file at the IB. 37 C.F.R. §2.33(e). The IB will have established that the international registration includes this declaration before it sends the request for extension of protection to the USPTO. Generally, the examining attorney need not review the international registration to determine whether there is a proper declaration of intent to use, or issue any inquiry regarding the initial verification of the application. However, if the applicant voluntarily files a substitute declaration with the USPTO, it will be

examined according to the same standards used for examining any other declaration. See TMEP §804.05.

A §66(a) applicant cannot change the basis or claim more than one basis. 37 C.F.R. §2.34(b)(3) and 2.35(a). See TMEP §1904.09 regarding the limited circumstances under which a §66(a) application can be transformed into an application under §1 or §44.

Section 66(a) requires transmission of a request for extension of protection by the IB to the USPTO. It cannot be added or substituted as a basis in an application originally filed under §1 or §44.

Under 15 U.S.C. §1141g and Madrid Protocol Article 4(2), the §66(a) applicant may claim a right of priority within the meaning of Article 4 of the Paris Convention if:

(1) The request for extension of protection contains a claim of priority;

(2) The request for extension of protection specifies the filing date, serial number, and the country of the application that forms the basis for the claim of priority; and

(3) The date of international registration or the date of the recordal of the subsequent designation

requesting an extension of protection to the United States is not later than six months after the date of the first regular national filing (within the meaning of Article 4(A)(3) of the Paris Convention) or a subsequent application (within the meaning of Article 4(C)(4) of the Paris Convention).

See Common Regs., Rule 9(4)(a)(iv); Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol (2009) ("Guide to International Registration"), Para. B.II.07.32.

806.02 Multiple Bases

806.02(a) Procedure for Asserting More Than One Basis

In a §66(a) application, the applicant may not claim more than one basis. 37 C.F.R. §2.34(b).

In an application under §1 or §44 of the Trademark Act, the applicant may claim more than one basis, if the applicant satisfies all requirements for each basis claimed. However, the applicant may not claim both §1(a) and §1(b) for identical goods or services in the same application. 37 C.F.R. §2.34(b). The applicant must clearly indicate that more than one basis is claimed, and must separately list each basis, followed by the goods, services, or classes to which that basis

applies. If some or all of the goods or services are covered by more than one basis, this must be stated. 37 C.F.R. §2.34(b), 2.35(b)(6).

Example: Based on use - SHIRTS AND COATS, in Class 25; Based on intent to use - DRESSES, in Class 25.

The applicant may assert different bases for different classes, and may also assert different bases as to different goods or services within a class.

When a single class has different bases for goods or services within that class, the USPTO uses parentheses to indicate the particular basis for specific goods or services. When entering this information into the Trademark database for goods and services under §1(a) or §1(b), the examining attorney or legal instruments examiner ("LIE") must refer to "use in commerce" or "intent to use" rather than referring to the statutory citation. However, for goods and services under §44, the statutory citation must be identified.

Example: Class 025: (Based on Use in Commerce) Pants; (Based on Intent to Use) Shirts

Example: Class 025: (Based on 44(e)) Pants

When all bases do not apply to all classes in a multiple-basis, multiple-class application, each class must include a basis notation.

Example:

Class 016: (Based on 44(e)) Greeting cards and postcards

Class 025: (Based on Use in Commerce) Shoes; (Based on Intent to Use) Shirts

Class 041: (Based on 44(e)) Entertainment, namely, live performances by a musical band

The applicant may claim a §44 basis in addition to either a §1(a) or a §1(b) basis for the same goods or services. When an application has a §44 and §1(b) dual basis for the same goods or services, the §1(b) basis information must always appear after the §44 basis information. Further, when only some of the goods/services in a class share a dual basis under §44 and §1(b), the basis information must appear with respect to those goods/services that share the dual bases and those that do not.

Example: Class 005: (Based on 44(e)) (Based on Intent to Use) Gene the rapy products, namely, pharmaceutical preparation vectors for use in gene therapy; (Based on Intent to Use) Pharmaceutical preparations containing nucleic acids for use in the treatment of viral and bacterial infections

806.02(b) Applicant May File Under Both §1(a) and §1(b) in the Same Application

An applicant may rely on both §1(a) and §1(b) in the same application. The applicant may not assert both a §1(a) and §1(b) basis for the identical goods or services in the same application, but the applicant may assert a §1(a) basis for some of the goods or services and a §1(b) basis for other goods or services. This can occur in either a single or multiple-class application. 37 C.F.R. §2.34(b)(1).

When the applicant asserts both §1(a) and §1(b) as bases for registration in the same application, the USPTO will publish the mark for opposition and will issue a notice of allowance (see TMEP §§1106 et seq.) if there is no successful opposition. The goods/services for which a §1(a) basis is asserted will remain in the application pending the filing and approval of a statement of use for the goods/services based on §1(b), unless the applicant files a request to divide. See TMEP §§1110 et seq. regarding requests to divide. If the applicant fails to timely file a statement of use or request for an extension of time to file a statement of use in response to a notice of allowance, the entire application will be abandoned, unless the applicant files a request to divide before the expiration of the deadline for filing the statement of use. TMEP §806.02(d).

806.02(c) Examination of Specimens of Use in a Multiple-Basis Application

If the applicant claims use in commerce in addition to another basis, but does not specify which goods/services are covered by which basis, the USPTO may defer examination of the specimens until the applicant identifies the goods/services for which use is claimed. A proper examination of specimens requires consideration of the particular goods/services on or in connection with which the mark is used.

806.02(d) Abandonment of Multiple-Basis Applications

If an applicant fails to respond to an Office action or notice of allowance pertaining to only one basis of a multiple-basis application, the failure to respond will result in abandonment of the entire application, unless the applicant files a request to divide under 37 C.F.R. §2.87 and notifies the examining attorney that the request has been filed. See TMEP §§1110 et seq. regarding requests to divide. If the failure to respond was unintentional, the applicant may file a petition to revive. See TMEP §§1714 et seq. regarding petitions to revive.

806.02(e) Allegation of Bona Fide Intention to Use Mark in Commerce Required Even if Application Is Based on Both §44 and §1(a)

Any application filed under §44(d) or §44(e) must include a verified statement that the applicant has a bona fide intention to use the mark in commerce even if §1(a) (use in commerce) is asserted as an additional filing basis. Cf. In re Paul Wurth S.A., 21 USPQ2d 1631 (Comm'r Pats. 1991).

If an application is based on both §1(b) and §44, it is not necessary to repeat the allegation that the applicant has a bona fide intention to use the mark in commerce.

806.02(f) Section 44(d) Combined With Other Bases

If an applicant properly claims priority under §44(d), 15 U.S.C. §1126(d), in addition to a §1 basis, the applicant may elect not to perfect the §44(e) basis (based on the foreign registration that will issue from the application on which the applicant relies for priority) and still retain the priority filing date. 37 C.F.R. §2.35(b)(3) and (4).

The examining attorney must advise the applicant that it may retain the priority filing date even if it does not perfect the §44(e) basis, and inquire whether the applicant wishes to retain §44(e) as a second basis for registration. See TMEP §806.04(b) regarding the processing of an application in which an applicant elects not to perfect a §44(e) basis, and TMEP §1003.04(b) regarding the procedures to follow when an applicant claims priority under §44(d) in addition to another basis.

806.02(g) Not Necessary to Repeat Allegation of Bona Fide Intention to Use Mark in Commerce in Multiple-Basis Application

If an application is based on both §1(b) and §44, it is not necessary to repeat the allegation that the applicant has a bona fide intention to use the mark in commerce. Therefore, when an applicant adds or substitutes §1(b) or §44 as a filing basis, it is not necessary to submit a new verification of the applicant's bona fide intention to use the mark in commerce if there is already one in the record with respect to the goods or services covered by the new basis.

806.03 Amendments to Add or Substitute a Basis

806.03(a) When Basis Can be Changed

Section 1 or §44 Application - Before Publication. The applicant may

add or substitute a basis before publication, provided that the applicant meets all requirements for the new basis. 37 C.F.R. §2.35(b)(1).

Section 1 or §44 Application - After Publication. In an application that is not the subject of an inter partes proceeding before the Trademark Trial and Appeal Board, if an applicant wants to add or substitute a basis after a mark has been published for opposition, the applicant must first petition the Director to allow the examining attorney to consider the amendment. If the Director grants the petition, and the examining attorney accepts the added or substituted basis, the mark must be republished. 37 C.F.R. §2.35(b)(2). See TMEP §§806.03(j) et seq. for further information.

Amendment of an application that is the subject of an inter partes proceeding before the Trademark Trial and Appeal Board is governed by 37 C.F.R. §2.133(a). See Trademark Trial and Appeal Board Manual of Procedure ("TBMP") §514.

Section 66(a) Application. In a §66(a) application, the applicant cannot change the basis, unless the applicant meets the requirements for transformation under §70(c) of the Trademark Act, 15 U.S.C. §1141j(c), and 37 C.F.R. §7.31. 37 C.F.R. §2.35(a); TMEP §806.03(k).

806.03(b) Applicant May Add or Substitute a §44(d) Basis Only Within Six-Month Priority Period

An applicant may add or substitute a §44(d) basis only during the six-month priority period following the filing date of the foreign application. 37 C.F.R. §2.35(b)(5). See TMEP §806.02(f) regarding §44(d) combined with another basis.

806.03(c) Amendment From §1(a) to §1(b)

In an application filed under §1(a), if the §1(a) basis fails, either because the specimens are unacceptable or because the mark was not in use in commerce when the application was filed, the applicant may substitute §1(b) as a basis. The USPTO will presume that the applicant had a continuing valid basis. 37 C.F.R. §2.35(b)(3).

Although there is a presumption of a continuing valid basis, when amending from §1(a) to §1(b), the applicant must confirm the presumption by submitting a verified statement that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods/services, and that the applicant had a bona fide intention to use the mark in commerce on or in connection with the goods/services as of the application filing date. 15 U.S.C.

§1051(b)(3)(B); 37 C.F.R. §2.34(a)(2).

If the applicant wishes to substitute §1(b) as a basis after publication of an application filed under §1(a), the applicant must petition the Director to allow the examining attorney to consider the amendment. 37 C.F.R. §2.35(b)(2). In a multiple-basis application, if a notice of allowance has issued for those goods/services based on §1(b), the petition will not be granted unless a request to divide the application is submitted with the petition. The goods/services to be amended from §1(a) to §1(b) must be divided out in order to process the amendment because republication is required. (37 C.F.R. §2.35(b)(2)). The petitioner may include all the goods/services based on §1(a) in the child application or only those to which the amendment to §1(b) applies. If dividing within a class, in addition to the fee for filing a request to divide, an application filing fee is required. See 37 C.F.R. §2.87 and TMEP §1110 et seq. regarding requests to divide.

Note that in a §1(b) application, once an applicant has filed a statement of use, the applicant may not withdraw the statement of use. 37 C.F.R. §2.88(g); TMEP §1109.17. Thus, an applicant may not amend the basis from §1(a) to §1(b) after a statement of use has been filed. See TMEP §1104.10 regarding withdrawing an amendment to allege use.

See TMEP §806.03(j) et seq. regarding amendment of the basis after publication.

806.03(d) Amendment From §44 to §1(b)

An applicant may amend the basis from §44 to §1(b). The USPTO will presume that the applicant had a continuing valid basis, because the applicant had a bona fide intention to use the mark in commerce as of the application filing date. 37 C.F.R. §2.35(b)(3). Karsten Mfg. Corp. v. Editoy AG, 79 USPQ2d 1783 (TTAB 2006). It is not necessary to submit a new verification of the applicant's bona fide intention to use the mark in commerce if such a verification is already in the record with respect to the goods/services covered by the new basis. See TMEP §806.03(i).

Applicant must clearly indicate whether it wants to:

(1) add the §1(b) basis and maintain the §44 basis; or

(2) replace the §44 basis with the §1(b) basis.

In a §44(d) application, the applicant may substitute §1(b) as a basis and still retain the priority filing date. 37 C.F.R. §2.35(b)(3) and (4); TMEP §806.03(h). If the applicant chooses to add the §1(b) basis and maintain the §44 basis, the examining attorney cannot approve the mark for publication until the applicant files a copy of the foreign

registration. See TMEP §806.02(f).
See TMEP §806.03(j) regarding amendment of the basis after publication.

806.03(e) Allegation of Use Required to Amend From §1(b) to §1(a)

An applicant who claims a §1(b) basis for any or all of the goods or services may not amend the application to seek registration under §1(a) of the Act for those goods or services, unless the applicant files an allegation of use. 37 C.F.R. §2.35(b)(8). See TMEP §§1103, 1104 et seq., and 1109 et seq. regarding allegations of use.

806.03(f) Use in Commerce as of Application Filing Date Required to Add or Substitute §1(a) as a Basis in §44 Application

An applicant can add or substitute a basis only if the applicant meets all the requirements for the new basis.
37 C.F.R. §2.35(b)(1). Therefore, an applicant may not amend a §44 application to claim a §1(a) basis unless the applicant: (1) verifies that the mark is in use in commerce on or in connection with the goods or services listed in the application, and that the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date; (2) provides a specimen, with a verified statement that the specimen was in use in commerce as of the application filing date; and (3) supplies the date of first use anywhere and the date of first use in commerce of the mark. 15 U.S.C. §1051(a)(1); 37 C.F.R. §2.34(a)(1), 2.59(a), and 2.71(c)(1); TMEP §806.01(a), 806.03(i), 903.01, 903.02, 903.04, and 904.05.
If an applicant began using the mark in commerce after the application filing date, the applicant cannot add or substitute §1(a) as a basis. However, the applicant may add or substitute §1(b) as a basis, and concurrently file an amendment to allege use. See TMEP §806.03(d) regarding amendment of the basis from §44 to §1(b), and TMEP §1104 et seq. regarding amendments to allege use.

806.03(g) Amendment From §1(b) to §44

An applicant may amend the basis from §1(b) to §44, if the applicant meets the requirements of §44 as of the filing date of the amendment. It is not necessary to submit a new verification of the applicant's bona fide intention to use the mark in commerce if such a verification is already in the record with respect to the goods/services covered by the new basis. See TMEP §806.03(i).
When an applicant adds §44(e) as a basis, the applicant must submit a

copy of the foreign registration (and a translation, if necessary) with the amendment. 37 C.F.R. §2.34(a)(3)(ii); TMEP §§1004.01 and 1004.01(b).

The applicant may add a claim of priority under §44(d) only within the six-month priority period following the filing date of the foreign application. 37 C.F.R. §2.35(b)(5). See TMEP §806.02(f) regarding §44(d) combined with another basis.

If the amendment is filed before publication, the applicant must clearly indicate whether it wants to:

(1) add the §44 basis and maintain the §1(b) basis; or

(2) replace the §1(b) basis with the §44 basis.

If the applicant chooses to add §44 and maintain the §1(b) basis, the application will proceed to publication with a dual basis. See TMEP §806.03(j) et seq. regarding amendment of the basis after publication.

806.03(h) Effect of Substitution of Basis on Application Filing Date

When the applicant substitutes one basis for another, the applicant must meet the requirements for the new basis. The applicant will retain the original filing date, provided that the applicant has had a continuing valid basis for registration since the application filing date. Unless there is contradictory evidence in the record, the USPTO will presume that there was a continuing valid basis for registration. See 37 C.F.R. §2.35(b)(3); Kraft Group LLC v. Harpole, 90 USPQ2d 1837 (TTAB 2009); Karsten Mfg. Corp. v. Editoy AG, 79 USPQ2d 1783 (TTAB 2006).

If the applicant properly asserts a claim of priority under §44(d) during the six-month priority period, the applicant will retain the priority filing date, no matter which basis for registration is ultimately established, provided that the applicant has had a continuing valid basis for registration. See 37 C.F.R. §2.35(b)(3) and (4); TMEP §806.02(f) and 1003.

If there is no continuing valid basis, the application is void, and registration will be refused. In this situation, the applicant cannot amend the filing date, and the USPTO will not refund the filing fee. See TMEP §205.

806.03(i) Verification of Amendment Required

An applicant who adds or substitutes use in commerce under §1(a) as a basis must verify that the mark is in use in commerce on or in connection with the goods/services covered by the §1(a) basis, and that the mark was in use in commerce on or in connection with these

goods/services as of the filing date of the application. 37 C.F.R. §2.34(a)(1)(i).

An applicant who adds or substitutes §1(b), §44(d), or §44(e) as a basis must verify that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods/services covered by the amendment, and that the applicant had a bona fide intention to use the mark in commerce on or in connection with these goods/services as of the filing date of the application, unless a verified statement of the applicant's bona fide intention to use the mark in commerce has already been filed with respect to all the goods/services covered by the new basis. 37 C.F.R. §2.34(a)(2), 2.34(a)(3)(i), and 2.34(a)(4)(ii).

Example: If a §44 application originally included a verified statement that the applicant had a bona fide intention to use the mark in commerce, it is not necessary to repeat this statement if the applicant later adds or substitutes a §1(b) basis for the goods/services covered by the §44 basis.

See TMEP §804.04 regarding persons who may sign a verification on behalf of an applicant under 37 C.F.R. §2.193(e)(1).

806.03(j) Petition to Amend Basis After Publication - §1 or §44 Application

37 CFR §2.35(b)(2)

After publication, an applicant may add or substitute a basis in an application that is not the subject of an inter partes proceeding before the Trademark Trial and Appeal Board, but only with the express permission of the Director, after consideration on petition. Republication will be required. The amendment of an application that is the subject of an inter partes proceeding before the Board is governed by §2.133(a).

In an application that is not the subject of an inter partes proceeding before the Trademark Trial and Appeal Board, if an applicant wants to add or substitute a basis after a mark has been published for opposition, the applicant must petition the Director to allow the examining attorney to consider the amendment. 37 C.F.R. §2.35(b)(2). Amendment of an application that is the subject of an inter partes proceeding before the Trademark Trial and Appeal Board is governed by 37 C.F.R. §2.133(a) (see TBMP §514).

When granting a petition to amend the basis, the Director will restore jurisdiction to the examining attorney to consider the amendment, except in a §1(b) application in which the notice of allowance has

issued. See TMEP §806.03(j)(ii) regarding amendment of the basis after issuance of a notice of allowance.

If the examining attorney accepts the new basis, the mark must be republished to provide notice to third parties who may wish to oppose registration based on issues that arise in connection with the new basis.

37 C.F.R. §2.35(b)(2).

If the examining attorney does not accept the new basis, he or she will issue an Office action using standard examination procedures except in a §1(b) application in which a notice of allowance has issued and no statement of use has been filed. See TMEP §806.03(j)(ii) regarding amendment of the basis after issuance of a notice of allowance.

Any petition to change the basis must be filed before issuance of the registration. To avoid the possible issuance of a registration without consideration of the petition, an applicant should submit the petition no later than six weeks after publication.

The Director will not grant a petition to amend the basis after publication if the amendment could substantially delay prosecution of the application. For example, the Director will deny petitions to amend the basis after publication in the following situations:

- Once the Director has granted a petition to amend the basis after publication, the Director will not thereafter grant a second petition to amend the basis with respect to the same application.
- f an applicant had previously deleted a §1(b) basis after a notice of allowance had issued, the Director will not grant a petition to re-assert §1(b) as a basis for registration. This would require issuance of a new notice of allowance and could result in filing of a statement of use more than 36 months after issuance of the first notice of allowance, which is not permitted under §1(d) of the Act, 15 U.S.C. §1051(d).

See TMEP §806.03(j)(i) regarding amendment of the basis in a §1(b) application between publication and issuance of a notice of allowance, and TMEP §806.03(j)(ii) regarding amendment of the basis after issuance of a notice of allowance.

Petitions to amend the basis after publication are processed by the Office of Petitions, which is part of the Office of the Deputy Commissioner for Trademark Examination Policy.

806.03(j)(i) Amending the Basis of a §1(b) Application After Publication But Before Issuance of Notice of Allowance

An applicant who wants to add or substitute a §44(e) basis to a §1(b) application after publication must petition the Director to allow the examining attorney to consider the amendment. 37 C.F.R. §2.35(b)(2); TMEP §806.03(j). The applicant must submit a copy of the foreign registration (and a translation, if necessary) with the petition. 37 C.F.R. §2.34(a)(3)(ii); TMEP § 1004.01 and 1004.01(b). If the petition is granted, the mark must be republished. 37 C.F.R. §2.35(b)(2); TMEP § 806.03(j).

The petition must indicate whether applicant wants to delete or retain the §1(b) basis. The applicant has two options:

(1) Applicant may request to delete the §1(b) basis and substitute §44(e) if the examining attorney accepts the §44(e) basis. If the petition is granted, the examining attorney will be instructed to examine the §44(e) basis in accordance with standard examination procedures and to delete the §1(b) basis if the §44(e) basis is accepted. If the examining attorney accepts the §44(e) basis, the examining attorney must ensure that: (a) the §1(b) basis is deleted, (b) the foreign registration information is entered into the Trademark database, and (c) the application is scheduled for republication. If registration of the mark is not successfully opposed, a registration will issue. If the examining attorney does not accept the §44(e) basis, the examining attorney will issue an Office action notifying the applicant of the reason(s). The applicant may elect to withdraw the amendment adding the §44(e) basis and proceed under §1(b) as the sole basis without republication; or

(2) Applicant may request to add §44(e) and retain the §1(b) basis. If the petition is granted, the examining attorney will be instructed to examine the §44(e) basis in accordance with standard examination procedures. If the examining attorney accepts the §44(e) basis, the examining attorney must ensure that: (a) the foreign registration information is entered into the Trademark database and (b) the application is scheduled for republication with a dual basis. If registration of the mark is not successfully opposed, a notice of allowance will issue. If the examining attorney does not accept the §44(e) basis, the examining attorney will issue an Office action notifying the applicant of the reason(s). The applicant may elect to withdraw the amendment adding the §44(e) basis and proceed under §1(b) as the sole basis without republication.

806.03(j)(ii) Amending the Basis of a §1(b) Application Between Issuance of Notice of Allowance and Filing of Statement of Use

An applicant who wants to add or substitute a §44(e) basis in a §1(b) application after issuance of the notice of allowance and before filing a statement of use must petition the Director to allow the examining attorney to consider the amendment. The applicant must submit a copy of the foreign registration (and a translation, if necessary) with the petition. 37 C.F.R. §2.34(a)(3)(ii); TMEP §§ 1004.01 and 1004.01(b). If the petition is granted, the mark must be republished. 37 C.F.R. §2.35(b)(2); TMEP §806.03(j).

The petition must indicate whether applicant wants to delete or retain the §1(b) basis. The applicant has three options:

(1) The applicant may request to delete the §1(b) basis and substitute §44(e). If the petition is granted, the Office of Petitions will have the notice of allowance cancelled and instruct the examining attorney to examine the §44(e) basis in accordance with standard examination procedures. If the examining attorney accepts the §44(e) basis, the examining attorney must ensure that: (a) the §1(b) basis is deleted, (b) the foreign registration information is entered into the Trademark database, and (c) the application is scheduled for republication. If registration of the mark is not successfully opposed, a registration will issue. If the examining attorney does not accept the new basis, the examining attorney will issue an Office action advising the applicant of the reasons. The applicant cannot re-assert the §1(b) basis;

(2) The applicant may request to add §44(e) and perfect the §1(b) basis by filing a statement of use with the petition. The Director will not grant a petition to add §44(e) and retain the §1(b) basis after issuance of the notice of allowance unless a statement of use is filed with the petition because examination of the §44(e) basis could substantially delay prosecution of the application. If the petition is granted, the examining attorney will examine the §44(e) basis during examination of the statement of use. If the examining attorney accepts the §44(e) basis and the statement use, the examining attorney must ensure that: (a) the foreign registration information is entered into the Trademark database and (b) the application is scheduled for republication with a dual basis. If registration of the mark is not successfully opposed, a registration will issue. If the examining attorney does not accept the §44(e) basis or the statement of use, the examining attorney will issue an Office action notifying the applicant of the reason(s). The applicant may elect to withdraw

the amendment adding the §44(e) basis and, if the statement of use is acceptable, proceed to registration without republication; or

(3) The applicant may request to add a §44(e) basis and request that the §1(b) basis be deleted only if the examining attorney accepts the §44(e) basis. Applicants who request to maintain the §1(b) basis pending acceptance of the §44(e) basis must also file a request for extension of time to file a statement of use when due (or a statement of use) or the application will be abandoned. 37 C.F.R. §2.89. If the petition is granted, the examining attorney will be instructed to examine the §44(e) basis in accordance with standard examination procedures. If the examining attorney accepts the §44(e) basis, the examining attorney must ensure that: (a) the notice of allowance is cancelled, (b) the §1(b) basis is deleted, (c) the foreign registration information is entered into the Trademark database, and (d) the application is scheduled for republication. If the mark is not successfully opposed, a registration will issue. If the examining attorney does not accept the §44(e) basis, the examining attorney is unable to issue an Office action since the notice of allowance is still pending. Therefore, the examining attorney will notify the applicant by telephone or e-mail of the reasons why the amendment is unacceptable. The applicant may then (1) agree to delete the §1(b) basis so that the notice of allowance can be cancelled and an examiner's amendment and/or appropriate Office action regarding the requested basis amendment can be issued, (2) withdraw the request to amend the basis to §44(e), or (3) request that the amendment remain pending until a statement of use is filed. The examining attorney should also enter an appropriate Note to the File in the record.

See also 37 C.F.R. §2.77 and TMEP §1107 et seq.

Amendments That Apply to Less Than All the Goods/Services

The Director will not grant a petition to amend the basis to §44(e) after issuance of the notice of allowance and before the filing of a statement of use, if the foreign registration does not include all of the goods/services covered by the §1(b) basis, unless the applicant concurrently files: (1) a request to divide out the goods/services to which the amendment applies; or (2) an amendment deleting the goods/services not covered by the amendment. See 37 C.F.R. §2.87 and TMEP §§1110 et seq. regarding requests to divide.

806.03(j)(iii) Amending the Basis of a §1(b) Application After Filing of Statement of Use But Before Approval for Registration

An applicant who wants to add or substitute a §44(e) basis after filing

a statement of use must petition the Director to allow the examining attorney to consider the amendment. The applicant must submit a copy of the foreign registration (and a translation, if necessary) with the petition. 37 C.F.R. §2.34(a)(3)(ii); TMEP §1004.01 and 1004.01(b). If the petition is granted, the mark must be republished. 37 C.F.R. §2.35(b)(2); TMEP §806.03(j).

While an applicant may not withdraw the statement of use (37 C.F.R. §2.88(g); TMEP §1109.17), the applicant may elect not to perfect the use basis and substitute §44(e). The statement of use, specimen(s), and any materials submitted with the statement of use will remain part of the record even if the §1(b) basis is deleted. See 37 C.F.R. §2.25. If the examining attorney accepts the §44(e) basis and the applicant is not perfecting the statement of use, the examining attorney must ensure that: (a) the §1(b) basis is deleted, (b) the dates of use are deleted, (c) the foreign registration information is entered into the Trademark database, and (d) the mark is scheduled for republication. If the mark is not successfully opposed, a registration will issue.

If the examining attorney does not accept the §44(e) basis, the examining attorney will issue an Office action notifying the applicant of the reason(s) and address any additional issue(s) that arise during examination of the statement of use. If an Office action has already been issued, the examining attorney must issue a supplemental action, with a new six-month response period, notifying the applicant that the §44 basis is unacceptable. The examining attorney must indicate that the action is supplemental to the previous action and incorporate all outstanding issues by reference to the previous action. The applicant may choose to withdraw the request to amend the §44(e) basis.

Filing a petition to add or substitute a §44(e) basis does not relieve the applicant of the duty to file a response to an outstanding Office action or to take any other action required in an application. See TMEP §§711 et seq. regarding the deadline for response to an Office action. If the applicant has filed a petition to delete the §1(b) basis and substitute §44(e), but the petition has not yet been acted on, the applicant may respond to an outstanding refusal or requirement by informing the examining attorney that a petition has been filed to substitute §44(e). The applicant must also respond to any outstanding issues regarding the statement of use unless the applicant no longer intends to perfect the statement of use.

806.03(k) Basis Cannot be Changed in §66(a) Application

In a §66(a) application, the applicant cannot change the basis, unless

the applicant meets the requirements for transformation under §70(c) of the Trademark Act, 15 U.S.C. §1141j(c), and 37 C.F.R. §7.31. 37 C.F.R. §2.35(a). See TMEP §1904.09 et seq. regarding transformation.

806.03(l) §66(a) Basis Cannot be Added to §1 or §44 Application

Section 66(a) requires transmission of a request for extension of protection by the IB to the USPTO. It cannot be added or substituted as a basis in an application originally filed under §1 or §44.

806.04 Deleting a Basis

If an applicant claims more than one basis, the applicant may delete a basis at any time, before or after publication. 37 C.F.R. §2.35(b)(1). No petition to the Director is required to delete a basis from a multiple-basis application after publication. When the applicant deletes a basis, the applicant must also delete any goods or services covered solely by that basis. 37 C.F.R. §2.35(b)(7).

To expedite processing, the USPTO recommends that a request to delete a §1(b) basis from a multiple-basis application be filed through TEAS, at http://www.uspto.gov.

806.04(a) Deletion of §1(b) Basis After Publication or Issuance of the Notice of Allowance

If all of the goods/services/classes in an application are based on §1(b) and §44(e), the applicant may file a request to delete the §1(b) basis by amendment at any time, except as set forth below. 37 C.F.R. §2.35(b)(1).

No petition to the Director is required to delete a §1(b) basis from a multiple-basis application after publication. To expedite processing, the USPTO recommends that any request to delete a §1(b) basis be filed through TEAS, at http://www.uspto.gov, using the "Request to Delete §1(b) Basis" form.

If the application has some goods/services/classes based solely on §1(b) and some goods/services/classes based solely on §1(a) or §44(e) and the applicant wants to delete the §1(b)goods/services/classes after publication or issuance of the notice of allowance, the applicant must submit a post-publication amendment requesting the deletion and that the application proceed to registration for the other goods/services/classes that are not based on §1(b). To expedite processing, the USPTO recommends that any request to delete the §1(b) goods/services/classes be filed through TEAS, at www.uspto.gov, using the "Post-Publication Amendment" form. For further information on

filing post-publication amendments, see TMEP §1505.

If a notice of allowance has issued, the request must be filed: (1) within six months of the issuance date of the notice of allowance, or within a previously granted extension of time to file a statement of use; or (2) between the filing date of the statement of use and the date on which the examining attorney approves the mark for registration.

If filed on paper, the request should be directed to the ITU Unit. The ITU Unit will cancel the notice of allowance, and take the necessary steps to delete the §1(b) basis and schedule the issuance of the registration.

If filed on paper before issuance of the notice of allowance, the request should be faxed to Post Publication Amendments/Corrections at 571-270-9007. The request will be reviewed by paralegal specialists in the Office of Petitions, who will delete the §1(b) basis and schedule the issuance of the registration.

806.04(b) Retention of §44(d) Priority Filing Date Without Perfecting §44(e) Basis

If an applicant properly claims §44(d) in addition to another basis, the applicant may elect not to perfect a §44(e) basis and still retain the §44(d) priority filing date. 37 C.F.R. §2.35(b)(3) and (4); TMEP §806.01(c) and 806.02(f).

When a §44(d) applicant elects not to proceed to registration under §44(e), the USPTO does not delete the §44(d) priority claim from the Trademark database. Both the §44(d) priority claim and the other basis will remain in the Trademark database.

Sometimes, a §44(d) applicant who elects not to perfect a §44(e) basis will file an amendment "deleting" the §44 basis. In this situation, the USPTO will presume that the applicant wants to retain the priority claim, unless the applicant specifically states that it wants to delete the priority claim and instead rely on the actual filing date of the application in the United States.

If the applicant is not entitled to priority (e.g., because the United States application was not filed within six months of the foreign filing), the examining attorney should ensure that the priority claim is deleted from the Trademark database, and should conduct a new search of USPTO records for conflicting marks.

806.05 Review of Basis Prior to Publication or Issue

If an application claims more than one basis, the examining attorney must ensure that the record clearly and accurately shows which goods

are covered by which basis before approving the application for publication for opposition or registration on the Supplemental Register. If there are any errors, the examining attorney must ensure that the Trademark database is corrected.

See TMEP § 806.02(a) for information regarding entering multiple bases in the Trademark database when the applicant asserts different bases for different classes, or different bases as to different goods or services within a class.

807 Drawing

The drawing shows the mark sought to be registered. 37 C.F.R. §2.52. An applicant must submit a clear drawing with the original application in order to receive a filing date in any application for registration of a mark, except in applications for registration of sound, scent, and other non-visual marks. See 37 C.F.R. §2.21(a)(3) and 37 C.F.R. 2.52(e); see also TMEP §807.09 regarding "drawings" in applications for registration of non-visual marks. Submitting a specimen showing how the mark is or may be used (e.g., the overall packaging, a photograph of the goods, or an advertisement) does not satisfy the requirement for a clear drawing of the mark. See TMEP §202.01.

The drawing is used to reproduce the mark in the Trademark Official Gazette and on the registration certificate.

The main purpose of the drawing is to provide notice of the nature of the mark sought to be registered. The drawing of a mark is promptly entered into the automated records of the USPTO and is available to the public through the Trademark Electronic Search System ("TESS") and the Trademark Status and Document Retrieval ("TSDR") database on the USPTO website at http://tsdr.uspto.gov/. Timely public notification of the filing of applications is important, because granting a filing date to an application potentially establishes a date of constructive use of the mark (see TMEP §201.02). Therefore, an application must include a clear drawing of the mark to receive a filing date. 37 C.F.R. §2.21(a)(3); TMEP §202.01.

Examining attorneys must require applicants to comply promptly with the drawing rules. Requests to defer drawing corrections until the application is approved for publication or registration should be denied.

There are two forms of drawings: "special form drawings" and "standard character drawings." See 37 C.F.R. 2.52(a) and (b); see also TMEP §§807.03 et seq. for information about standard character drawings, and TMEP §807.04 et seq. for information about special form drawings. (Note: "Typed" drawings are acceptable for applications filed before November 2, 2003. See TMEP §807.03(i).)

The mark in the drawing must agree with the mark as used on the specimen in an application under §1 of the Trademark Act, 15 U.S.C. §1051; as applied for or registered in a foreign country in an application under §44, 15 U.S.C. §1126; or as it appears in the international registration in an application under §66(a), 15 U.S.C. §1141f (a). 37 C.F.R. §2.51; TMEP §807.12 et seq. and 1011.01.

In a TEAS application, the drawing must be submitted electronically

through TEAS, and must meet the requirements of 37 C.F.R. §2.52 and 2.53 (see TMEP §807.05 et seq.). In a paper application, the drawing must be submitted on paper and must meet the requirements of 37 C.F.R. §2.52 and 2.54 (see TMEP §807.06 et seq.).

807.01 Drawing Must Show Only One Mark

An application must be limited to only one mark. 15 U.S.C. §1051(a)(1); 37 C.F.R. §2.52. See In re International Flavors & Fragrances Inc., 183 F.3d 1361, 1366, 51 USPQ2d 1513, 1516 (Fed. Cir. 1999) Under 37 C.F.R. §2.21(a)(3), an applicant must submit "a clear drawing of the mark" to receive a filing date. An application that includes two or more drawings displaying materially different marks does not meet this requirement. Two marks are considered to be materially different if the substitution of one for the other would be a material alteration of the mark, within the meaning of 37 C.F.R. §2.72 (see TMEP §807.14 et seq.).

Accordingly, if an applicant submits two or more drawing pages, the application is denied a filing date, because the applicant has not met the requirement for a clear drawing of the mark. See TMEP §202.01 for further information. See also Humanoids Group v. Rogan, 375 F.3d 301, 71 USPQ2d 1745 (4th Cir. 2004).

However, if an applicant submits a separate drawing page in a paper application showing a mark, and a different mark appears in the written application, the application will receive a filing date, and the drawing page will control for purposes of determining what the mark is. The USPTO will disregard the mark in the written application. In re L.G. Lavorazioni Grafite S.r.l., 61 USPQ2d 1063 (Dir USPTO 2001). Similarly, if an applicant enters a standard character mark, or attaches a digitized image of a mark, in the "Mark" field of a TEAS application, and a different mark appears in another field, the application will receive a filing date, and the mark entered in the "Mark" field will control for purposes of determining what the mark is.

The USPTO will not deny a filing date if the drawing shows spatially separate elements. If the applicant submits an application where the "drawing" is composed of multiple elements on a separate page, multiple elements on a single digitized image, or multiple elements in a separate area of the body of the application, the applicant has met the requirement of 37 C.F.R. §2.21(a)(3) for a clear drawing of the mark. The examining attorney must determine whether the matter presented for registration is a single mark projecting a unitary

commercial impression. See TMEP §807.12(d) regarding "mutilation" or incomplete representation of the mark.

If the examining attorney determines that spatially separate elements constitute two or more different marks, the examining attorney should refuse registration under §§1 and 45 of the Trademark Act, 15 U.S.C. §§1051 and 1127, on the ground that the applicant seeks registration of more than one mark. See In re Hayes, 62 USPQ2d 1443 (TTAB 2002); In re Elvis Presley Enterprises, Inc., 50 USPQ2d 1632 (TTAB 1999); In re Walker-Home Petroleum, Inc., 229 USPQ 773 (TTAB 1985); In re Jordan Industries, Inc., 210 USPQ 158 (TTAB 1980); In re Audi NSU Auto Union AG, 197 USPQ 649 (TTAB 1977); In re Magic Muffler Service, Inc., 184 USPQ 125 (TTAB 1974); In re Robertson Photo-Mechanix, Inc., 163 USPQ 298 (TTAB 1969).

This refusal may apply in any application, regardless of the filing basis.

When registration is refused because the matter presented on the drawing does not constitute a single mark, the application filing fee will not be refunded. The applicant may amend the drawing if the amendment does not materially alter the mark, or may submit arguments that the matter on the drawing does in fact constitute a single mark. See TMEP §807.14 et seq. regarding material alteration, and TMEP §807.14(a) regarding deletion of matter from the drawing.

Under 37 C.F.R. §2.52(b)(2), even if registration is sought for a three-dimensional mark, the applicant must submit a drawing depicting a single rendition of the mark. See TMEP §807.10. If the applicant submits a drawing that depicts a three-dimensional mark in multiple renditions, the examining attorney will require a substitute drawing depicting the mark in a single rendition. If the applicant believes that its mark cannot be adequately depicted in a single rendition, the applicant may file a petition under 37 C.F.R. §2.146 requesting that the rule be waived. See TMEP Chapter 1700 regarding petitions.

If the mark is duplicated in some form on the drawing (e.g., a typed word and a stylized display of the same word), this is generally not considered to be two materially different marks, and deletion of one of the marks is permitted.

See TMEP §1214 et seq. regarding the refusal of registration of a mark with a "phantom" element on the ground that it includes more than one mark in a single application.

See also In re Upper Deck Co., 59 USPQ2d 1688 (TTAB 2001) (hologram used on trading cards in varying shapes, sizes, contents, and positions constitutes more than one "device" as contemplated by §45 of the

Trademark Act).

807.02 Drawing Must Be Limited to Mark

The drawing allows the USPTO to properly code and index the mark for search purposes, indicates what the mark is, and provides a means for reproducing the mark in the Official Gazette and on the certificate of registration. Therefore, matter that appears on the specimen that is not part of the mark should not be placed on the drawing. Purely informational matter such as net weight, contents, or business addresses are generally not considered part of the mark.

Quotation marks and hyphens should not be included in the mark on a drawing, unless they are a part of the mark. See TMEP §807.12(a)(i) through (a)(iii) and 807.14(c) regarding the role of punctuation in determining whether the mark on the drawing agrees with the mark on the specimen. The drawing may not include extraneous matter such as the letters "TM," "SM," the copyright notice c, or the federal registration notice R. See TMEP §§906 et seq. regarding use of the federal registration notice.

See TMEP §807.14(a) regarding requirements for removal of matter from the drawing.

807.03 Standard Character Drawings

37 CFR §2.52(a) Standard character (typed) drawing.

Applicants who seek to register words, letters, numbers, or any combination thereof without claim to any particular font style, size, or color must submit a standard character drawing that shows the mark in black on a white background. An applicant may submit a standard character drawing if:

(1) The application includes a statement that the mark is in standard characters and no claim is made to any particular font style, size, or color;

(2) The mark does not include a design element;

(3) All letters and words in the mark are depicted in Latin characters;

(4) All numerals in the mark are depicted in Roman or Arabic numerals; and

(5) The mark includes only common punctuation or diacritical marks.

Effective November 2, 2003, Trademark Rule 2.52, 37 C.F.R. §2.52, was amended to replace the term "typed" drawing with "standard character" drawing. Applicants who seek to register a mark without any claim as to the manner of display must submit a standard character drawing that complies with the requirements of 37 C.F.R. §2.52(a).

807.03(a) Requirements for Standard Character Drawings

A standard character drawing must show the mark in black on a white background. An applicant may submit a standard character drawing if:

· The mark does not include a design element;

· All letters and words in the mark are depicted in Latin characters;

· All numerals in the mark are depicted in Roman or Arabic numerals;

· The mark includes only common punctuation or diacritical marks; and

· No stylization of lettering and/or numbers is claimed in the mark.

37 C.F.R. §2.52(a).

If the applicant files an application on paper, the applicant may depict the mark in any font style; may use bold or italicized letters; and may use both uppercase and lowercase letters, all uppercase letters, or all lowercase letters, since no claim is made to any particular font style, size, or color. The applicant does not have to display the mark in all uppercase letters. If filing electronically via the Trademark Electronic Application System ("TEAS"), the applicant may neither depict the mark in any particular font style nor use bold or italicized letters. TEAS will automatically convert any wording typed into the standard-character field to a standardized typeface.

Superscripts, subscripts, exponents, or other characters that are not in the USPTO's standard character set (see TMEP §807.03(b)) are not permitted in standard character drawings. In re AFG Industries Inc., 17 USPQ2d 1162 (TTAB 1990) (special form drawing required for raised numeral). The degree symbol is permitted.

Underlining is not permitted in a standard character drawing.

Standard Character Claim Required. An applicant who submits a standard character drawing must also submit the following standard character claim:

The mark consists of standard characters without claim to any particular font style, size, or color.

This statement will appear in the Official Gazette and on the certificate of registration.

807.03(b) List of Standard Characters

The USPTO has created a standard character set that lists letters, numerals, punctuation marks, and diacritical marks that may be used in a standard character drawing. The standard character set is available on the USPTO website at http://www.uspto.gov/teas/standard CharacterSet.html.

If the applicant has claimed standard character format and the drawing

includes elements that are not in the set, then the examining attorney must treat the drawing as a special form drawing, ensure that the mark drawing code is changed, and require the applicant to delete the standard character claim. See TMEP §807.18 concerning mark drawing codes.

In a §66(a) application, if the drawing includes elements that are not in the standard character set, the examining attorney must require deletion of the standard character claim even if the international registration indicates that the mark is in standard characters. See the IB's Guide to International Registration, Para. B.II.07.44.

807.03(c) Drawings Containing Both a Standard Character Claim and Designs or Other Elements

If the application contains a standard character claim, but the mark includes a design element, or color, or a claim of a particular style or size of lettering, or other elements such that the mark does not meet the requirements of 37 C.F.R. §2.52(a), then the examining attorney must: (1) treat the drawing as a special form drawing;

(2) require that the applicant delete the standard character claim from the record;

(3) ensure that the appropriate mark drawing code is entered into the Trademark database; and

(4) if appropriate, add design search codes. See TMEP §807.18 concerning mark drawing codes and TMEP §104 regarding design codes.

Similarly, a standard character claim is not acceptable where the characters form shapes or designs, such as emoticons.

807.03(d) Changing From Special Form Elements to Standard Characters, or the Reverse, May be a Material Alteration

A special form drawing containing a design element, color, a claim to a particular style or size of lettering, or other distinctive elements cannot be amended to a standard character drawing, unless the examining attorney determines that the amendment is not material. 37 C.F.R. §2.72.

Conversely, a standard character drawing cannot be amended to a special form drawing containing a design element, color, or a claim to a distinctive style or size of lettering, unless the examining attorney determines that the amendment is not material. 37 C.F.R. §2.72. See TMEP §807.14 et seq. regarding material alteration.

807.03(e) Standard Character Drawing and Specimen of Use

When the applicant submits a standard character, the mark shown in the drawing does not necessarily have to appear in the same font style, size, or color as the mark shown on the specimen of use. However, the examining attorney must review the mark depicted on the specimen to determine whether a standard character claim is appropriate, or whether a special form drawing is required.

If the examining attorney determines that the standard characters are displayed in a distinctive manner that changes the meaning or overall commercial impression of the mark, the examining attorney must process the drawing as a special form drawing, and require the applicant to delete the standard character claim. As with all drawings, the mark on the drawing must be a substantially exact representation of the mark used on the specimen in an application under §1 of the Trademark Act. 37 C.F.R. §2.51(a) and (b); TMEP §807.12(a) et seq.

The examining attorney may delete the standard character claim by examiner's amendment after obtaining approval from the applicant or the applicant's qualified practitioner. When deleting a standard character claim, the examining attorney must ensure that the mark drawing code is changed. See TMEP §807.18 concerning mark drawing codes.

See TMEP §807.04(b) for further information as to when a special form drawing is required.

807.03(f) Standard Character Drawing and Foreign Registration

In a §44 application, if the applicant claims standard characters, the examining attorney must ensure that the foreign registration also claims standard characters. See 37 C.F.R. §2.51(c); TMEP §807.12(b).

If the foreign registration certificate does not indicate that the mark is in standard characters (or the equivalent), the examining attorney must inquire whether the foreign registration includes a claim that the mark is in standard characters (or the legal equivalent). The applicant must either submit an affirmative statement that the foreign registration includes a claim that the mark is in standard characters (or the legal equivalent), or delete the standard character claim in the United States application. A statement that the foreign registration includes a claim that the mark is in standard characters may be entered in the record through a Note to the File if there are no other outstanding issues.

Appendix E of this manual lists countries that register marks in standard characters or the equivalent. For countries on this list, if

all letters and words in the mark are in block capital or capital and lowercase Latin characters, all numerals are Roman or Arabic numerals, the mark includes only common punctuation or diacritical marks, and no stylization of lettering and/or numbers is claimed, the examining attorney need not inquire whether the registered mark in the foreign registration is in standard characters or the equivalent, unless the applicant has indicated that the mark is not standard characters or the equivalent. If the applicant has indicated that the mark is not in standard characters or the equivalent, but the foreign registration is from a country on the list and the mark meets the standards set forth above, the examining attorney must inquire about the discrepancy. In response to the inquiry, the applicant must either amend the application to claim standard characters, or confirm that the mark is not in standard characters or the equivalent. If a particular country is not on this list, the examiner must inquire as to whether the mark in the foreign registration is for a mark in standard characters or the equivalent.

The examining attorney may delete the standard character claim by examiner's amendment after obtaining approval from the applicant or applicant's qualified practitioner. When deleting a standard character claim, the examining attorney must ensure that the mark drawing code is changed. See TMEP §807.18 concerning mark drawing codes.

807.03(g) Drawings in "Typed" Format With No Standard Character Claim

Section 1 Applications. If the application does not include a standard character claim, but the mark is shown in a format that would have been considered "typed" prior to November 2, 2003 (i.e., the mark is shown in capital letters, or the mark is specified as "typed" in the body of the application, on a separate drawing page, or on a cover letter filed with the application), the drawing will initially be coded and entered into the automated records of the USPTO as a special form drawing. However, the examining attorney must treat the drawing of the mark as a standard character drawing, and ensure that a standard character claim is entered into the record.

If the application is ready to be published for opposition, the examining attorney should enter the standard character claim by a no-call examiner's amendment. In this situation, no prior authorization from the applicant is required to add a claim by an examiner's amendment. See TMEP §707.02. If an Office action is necessary, it must include a requirement that the applicant submit a standard character claim.

Once the applicant submits a standard character statement, the examining attorney should ensure that the mark drawing code is changed to 4 (see TMEP §807.18).

Section 44 Applications. In a §44 application, the applicant cannot claim standard characters unless the foreign registration also claims standard characters. See TMEP §807.03(f).

Section 66(a) Applications. In a §66(a) application, the request for extension of protection forwarded by the IB normally indicates whether there is a standard character claim in the international registration. However, due to differences in requirements for standard character claims in different countries, there may be situations where the mark in the international registration meets the USPTO's requirements for a standard character claim, but no standard character claim is set forth in the international registration. If the international registration does not indicate that the mark is in standard characters, and the applicant seeks to amend the §66(a) application to add a standard character claim, the examining attorney must contact the Supervisor of the Madrid Processing Unit ("MPU") via e-mail for instructions on how to proceed. The applicant may not add a standard character claim unless the mark meets the United States requirements for a standard character claim, as set forth in 37 C.F.R. §2.52(a) (see TMEP §807.03(a) and (b)).

807.03(h) Drawings Where the Format Is Unclear

Section 1 Applications. When it is unclear from the record whether the submitted drawing was intended to be a standard character drawing, the examining attorney must contact the applicant for clarification. For example, clarification is needed if the font style used in the mark on the drawing does not match the font style used on the specimen and there is no standard character claim in the application, or if the applicant files a paper application in which the mark is printed or written by hand. If the mark is intended to be in standard characters, then the examining attorney must require that the applicant amend the application to include the standard character claim. This may be done by examiner's amendment. Once the applicant submits this statement, the examining attorney should ensure that the mark drawing code is changed to 4 (see TMEP §807.18).

Section 44 Applications. In a §44 application, the applicant cannot claim standard characters unless the foreign registration also claims standard characters. See TMEP §807.03(f).

Section 66(a) Applications. In a §66(a) application, the request for

extension of protection forwarded by the IB normally indicates whether there is a standard character claim in the international registration. However, due to differences in requirements for standard character claims in different countries, there may be situations where the mark in the international registration meets the USPTO's requirements for a standard character claim, but no standard character claim is set forth in the international registration. If the international registration does not indicate the mark is in standard characters, and the applicant seeks to amend the §66(a) application to add a standard character claim, the examining attorney must contact the MPU Supervisor via e-mail for instructions on how to proceed. The applicant may not add a standard character claim unless the mark meets the United States requirements for a standard character claim, as set forth in 37 C.F.R. §2.52(a) (see TMEP §807.03(a) and (b)).

Alternatively, if the international registration indicates that the mark is in standard characters, but the drawing includes elements that are not in the standard character set, the examining attorney must require deletion of the standard character claim even if the international registration indicates that the mark is in standard characters. See the IB's Guide to International Registration, Para. B.II.07.44.

The Guide to the International Registration provides that if an Office "considers that the mark is not in standard characters, it may issue a refusal, for example, on the ground that the international registration covers two marks (one in standard characters and one in special characters) or that it is simply not clear for what protection is sought." Para. B.II.14.09. See TMEP §807.01 regarding multiple marks and §1214 et seq. regarding phantom marks.

807.03(i) Typed Drawings

Prior to November 2, 2003, "standard character" drawings were known as "typed" drawings. The mark on a typed drawing had to be typed entirely in capital letters. A typed mark is the legal equivalent of a standard character mark.

807.04 Special Form Drawings

37 CFR §2.52(b) (Extract) Special form drawing.

Applicants who seek to register a mark that includes a two or three-dimensional design; color; and/or words, letters, or numbers or the combination thereof in a particular font style or size must submit a special form drawing. The drawing should show the mark in black on a

white background, unless the mark includes color.

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807.04(a) Characteristics of Special Form Drawings

A "special form drawing" is a drawing that presents a mark comprised, in whole or in part, of special characteristics such as elements of design or color, style(s) of lettering, or unusual form(s) of punctuation.

All special form drawings must be of a quality that will reproduce satisfactorily for scanning into the USPTO's database. If the drawing is not of a quality that will reproduce satisfactorily for scanning and printing in the Official Gazette and on the certificate of registration, the examining attorney must require a new drawing.

If there is any doubt as to whether the drawing is acceptable, the examining attorney should contact the Office of Trademark Quality Review.

Pasted material, taped material, and correction fluid are not acceptable because they do not reproduce satisfactorily.

See TMEP §807.18 concerning mark drawing codes.

807.04(b) When Special Form Drawing Is Required

A special form drawing is required if words, letters, or numerals are presented in a distinctive form that engenders an uncommon or "special" commercial impression that would be altered or lost were registration to issue based on a standard character drawing. In re Morton Norwich Prods., Inc., 221 USPQ 1023, 1023 (TTAB 1983) (holding LABID not registrable without a special form drawing because the specimen showed the letter "a" in smaller lettering with a diacritical accent that set off the "BID" portion of the mark, when the word "BID" had an accepted meaning as applied to drug prescriptions, i.e., "twice a day"); see In re United Servs. Life Ins. Co., 181 USPQ 655, 656 (TTAB 1973) (holding FOR LIFE INSURANCE SEE US not registrable without a special form drawing because the specimen showed the "US" portion of the mark in significantly larger lettering and underlined, suggesting a double entendre because "US" could stand for applicant's name "United Services" or for the pronoun "us"); In re Dartmouth Mktg. Co., 154 USPQ 557, 558 (TTAB 1967) (finding "luncheon time" presented "in an uncommon manner to the extent that a prospective purchaser's initial impression of the mark might well be other than that which applicant may intend to convey by the well understood term 'luncheon time'") .

A special form drawing is required for marks that contain superscripts, subscripts, exponents, or other characters that are not in the USPTO's standard character set. In re AFG Indus. Inc., 17 USPQ2d 1162, 1164 (TTAB 1990) (requiring special form drawing for raised numeral). See TMEP §807.03(b) regarding the USPTO's standard character set.

The USPTO encourages the use of standard character drawings. As a general rule, an applicant may submit a standard character drawing when a word, letter, numeral, or combination thereof creates a distinct commercial impression apart from any stylization or design element appearing on the specimen. If a mark remains the same in essence and is recognizable regardless of the form or manner of display that is presented, displaying the mark in standard character format affords a quick and efficient way of showing the essence of the mark. In re wTe Corp., 87 USPQ2d 1536, 1539-40 (TTAB 2008) (reversing refusal on the ground that the standard character mark on the drawing was not a substantially exact representation of the mark as actually used, finding that SPECTRAMET creates a distinct commercial impression apart from any stylization or design element appearing on the specimens, on which the letter "C" was displayed with an arrow design);

see In re Oroweat Baking Co., 171 USPQ 168 (TTAB 1971) (holding requirement for special form drawing to register OROWEAT displayed with wheat designs in the letter "O" improper); In re Elec. Reps. Ass'n, 150 USPQ 476 (TTAB 1966) (finding special form drawing not required when acronym makes an impression apart from design).

When an application is for a mark in standard characters, the examining attorney must consider the manner in which the mark is used on the specimen, and decide whether the mark includes an essential element or feature that cannot be produced by the use of standard characters. See TMEP §807.12(a).807.12(a)(iii) regarding agreement between the mark on the drawing and the mark used on the specimen.

If the examining attorney determines that the mark in a standard character drawing should have been presented in special form, the applicant may submit a special form drawing if the amendment would not result in a material alteration of the mark. See 37 C.F.R. §2.72; TMEP §807.14.807.14(f). If a standard character drawing is amended to a special form drawing, the examining attorney must ensure that the mark drawing code is changed. See TMEP §807.18 concerning mark drawing codes.

807.05 Electronically Submitted Drawings

The drawing in a TEAS application must meet the requirements of 37

C.F.R. §2.52 and 2.53.

The USPTO has waived the requirement of 37 C.F.R. §2.53(c) that drawings have a length and width of no less than 250 pixels and no more than 944 pixels. See notice at 69 Fed. Reg. 59809 (Oct. 6, 2004). However, applicants are encouraged to continue to submit drawings with a length and width of no less than 250 pixels and no more than 944 pixels.

807.05(a) Standard Character Drawings Submitted Electronically

If an applicant is filing a standard character drawing, the applicant must enter the mark in the appropriate data field. The applicant must also submit a standard character claim, which is automatically generated once the applicant selects the standard character option. 37 C.F.R. §2.52(a)(1).

When an application for a standard character mark is filed through TEAS, the characters entered in the appropriate data field in the TEAS application or TEAS response form are automatically checked against the USPTO's standard character set. See TMEP §807.03(b) regarding the standard character set.

If all the characters in the mark are in the standard character set, the USPTO will create a digitized image that meets the requirements of 37 C.F.R. §2.53(c), and automatically generate the standard character statement.

The application record will indicate that standard characters have been claimed and that the USPTO has created the image. The examining attorney need not check the standard character mark against the standard character set during examination.

807.05(a)(i) Long Marks in Standard Character Drawings

As noted in TMEP §807.05(a), when an applicant files an application for a standard character mark through TEAS, the applicant must enter the mark in the appropriate data field.

A single line can consist of no more than 26 characters, including spaces. If the applicant enters a mark that exceeds 26 characters into the standard character word mark field, the USPTO's automated system will break the mark, so that it fits into the Official Gazette. After 26 characters, the mark will automatically continue onto the next line. The online TEAS instructions provide further information about breaks in long standard character marks. If a standard character mark exceeds 26 characters, and the applicant has a preference as to where the mark will be broken, the applicant should use the special form option, and

attach a digitized image that meets the requirements of 37 C.F.R. §2.53(c). See TMEP §807.05(c) regarding the requirements for digitized images. If the applicant selects the special form option, the applicant may not include a standard character claim.

807.05(b) Special Form Drawings Submitted Electronically

If the mark is in special form, the applicant must attach a digitized image of the mark that meets the requirements of 37 C.F.R. §2.53(c) to the "Mark" field on the electronic application. See TMEP §807.05(c).

807.05(c) Requirements for Digitized Images

The mark image must be in .jpg format, and should be scanned at no less than 300 dots per inch and no more than 350 dots per inch, to produce the highest quality image. All lines must be clean, sharp, and solid, must not be fine or crowded, and must produce a high-quality image. 37 C.F.R §2.53(c). It is recommended that mark images have a length of no less than 250 pixels and no more than 944 pixels, and a width of no less than 250 pixels and no more than 944 pixels.

Mark images should have little or no white space appearing around the design of the mark. If scanning from a paper image of the mark, it may be necessary to cut out the mark and scan it with little or no surrounding white space. Failure to do this may cause the mark to appear very small in the USPTO's automated records, such that it may be difficult to recognize all words or design features of the mark. To ensure that there is a clear image of the mark in the automated records of the USPTO, examining attorneys and LIEs should view the mark on the Publication Review program available on the USPTO's internal computer network. If the mark is not clear, the examining attorney must require a new drawing that meets the requirements of 37 C.F.R. §2.52 and 2.54.

When color is not claimed as a feature of the mark, the image must be depicted only in black and white. 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.

Mark images may not include extraneous matter such as the symbols TM or SM, or the registration notice R. The image should be limited to the mark. See TMEP §807.02.

807.06 Paper Drawings

37 CFR §2.52(d) Paper drawings.

A paper drawing must meet the requirements of §2.54.

37 CFR §2.54 Requirements for drawings submitted on paper.

The drawing must meet the requirements of §2.52. In addition, in a paper submission, the drawing should:

(a) Be on non-shiny white paper that is separate from the application;

(b) Be on paper that is 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long. One of the shorter sides of the sheet should be regarded as its top edge. The image must be no larger than 3.15 inches (8 cm) high by 3.15 inches (8 cm) wide;

(c) Include the caption "DRAWING PAGE" at the top of the drawing beginning one inch (2.5 cm.) from the top edge; and

(d) Depict the mark in black ink, or in color if color is claimed as a feature of the mark.

(e) Drawings must be typed or made with a pen or by a process that will provide high definition when copied. A photolithographic, printer's proof copy, or other high quality reproduction of the mark may be used. All lines must be clean, sharp and solid, and must not be fine or crowded.

Paper drawings may be filed by mail or hand delivery. Drawings may not be submitted by facsimile transmission. 37 C.F.R. §2.195(d)(2).

The drawing must meet the requirements of 37 C.F.R. §2.52 and 2.54.

807.06(a) Type of Paper and Size of Mark

Size of Mark. The mark on the drawing should be no larger than 3.15 inches high by 3.15 inches wide (8 cm high by 8 cm wide). 37 C.F.R. §2.54(b).

The USPTO will create a digitized image of all drawings submitted on paper. The examining attorney must view the mark on the Publication Review program, available on the USPTO's internal computer network. If the display of the mark appears to be clear and accurate, the examining attorney will presume that the drawing meets the size requirements of the rule.

Type of Paper and Recommended Format. The drawing should:

· Be on non-shiny white paper that is separate from the application;

· Be on paper that is 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long. One of the shorter sides of the sheet should be regarded as its top edge;

- Include the caption "DRAWING PAGE" at the top of the drawing beginning one inch (2.5 cm.) from the top edge; and
- Depict the mark in black ink, or in color if color is claimed as a feature of the mark.

37 C.F.R. §2.54(a) through (d).

The drawing must be typed or made with ink or by a process that will provide high definition when scanned.

A photolithographic, printer's proof copy, or other high-quality reproduction of the mark may be used. All lines must be clean, sharp, and solid, and must not be fine or crowded. 37 C.F.R. §2.54(e).

807.06(b) Long Marks in Standard Character Drawings

Because all standard character drawings are stored in USPTO systems as an image, a standard character drawing must meet the 3.15 inch (8 cm) by 3.15 inch (8 cm) requirement of 37 C.F.R. §2.54(b). If the mark is too long to meet this requirement, applicant must submit an image on which the mark is broken in an appropriate place. It is suggested that the applicant use 14-point type to ensure that the mark will be legible in the Official Gazette and on the certificate of registration.

If an applicant submits an image on which the mark exceeds the size requirements of 37 C.F.R. §2.54(b), the USPTO will reduce the image so that it will meet these requirements. See TMEP §807.06(a). This could cause the mark to appear very small. To ensure that the mark will be legible in the Official Gazette and on the certificate of registration, the examining attorney should view the mark on the Publication Review program available on the USPTO's internal computer network. If the mark is not legible, the examining attorney must require a new drawing that meets the requirements of 37 C.F.R. §2.52 and 2.54.

807.06(c) Separate Drawing Page Preferred

The USPTO recommends that an applicant submit a drawing of the mark on a separate page from the written application. 37 C.F.R. §2.54(a). However, a separate drawing page is not mandatory. Instead of a drawing page, an applicant may include a drawing of the mark embedded in the application, in either the heading or the body of the application.

If the applicant identifies a separate page as a drawing (e.g., by labeling it as a drawing, or providing a heading with the applicant's name, address and the subject goods/services), this will be the only drawing considered.

A mark depicted on the specimen or in the foreign registration certificate will not be considered a drawing.

If there is no separate drawing page, the examining attorney must review the application to determine what the mark is. If an embedded drawing meets the requirements of 37 C.F.R. §§2.51, 2.52, and 2.54, the examining attorney should accept it and not require a substitute

drawing.

Effective October 30, 1999, a separate drawing page is considered part of the written application, not a separate element. Dates of use, disclaimers, descriptions of the mark, identifications of goods / services, and other information that appears on the drawing are also considered part of the written application. This applies to substitute drawings as well as original drawings. If there is an inconsistency between the information on the drawing page and the information in the body of the application, the examining attorney must require clarification.

If an applicant submits a separate drawing page showing a mark, and a different mark appears in the written application, the drawing page controls for purposes of determining what the mark is. See TMEP §807.01.

807.07 Color in the Mark

37 CFR §2.52(b)(1) Marks that include color.

If the mark includes color, the drawing must show the mark in color, and the applicant must name the color(s), describe where the color(s) appear on the mark, and submit a claim that the color(s) is a feature of the mark.

If the applicant wishes to register the mark in color, the applicant must submit a color drawing and meet the requirements of 37 C.F.R. §2.52(b)(1). See TMEP §807.07(a) et seq. regarding the requirements for color drawings. If the applicant does not claim color as a feature of the mark, the applicant must submit a black-and-white drawing.

Generally, if the applicant has not made a color claim, the description of the mark should not mention color(s), because reference to color in the description of a non-color mark creates a misleading impression. TMEP §808.02. However, in some cases, it may be appropriate to submit a black-and-white drawing and a description of the mark that refers to black, white, and/or gray, if the applicant states that color is not claimed as a feature of the mark. This occurs where the black, white, or gray is used as a means to indicate areas that are not part of the mark, such as background or transparent areas; to depict a certain aspect of the mark that is not a feature of the mark, such as dotted or broken-line outlining to show placement of the mark; to represent shading or stippling; or to depict depth or three-dimensional shape. See TMEP §807.07(f) et seq. regarding applications with black-and-white drawings and mark descriptions that refer to black, white, or gray with no corresponding color claim; TMEP §807.07(d) et seq. regarding color drawings that contain black, white,

or gray, and TMEP §807.07(e) regarding black-and-white drawings and color claims.

See TMEP §1202.05 et seq. regarding the registration of marks that consist solely of one or more colors used on particular objects.

807.07(a) Requirements for Color Drawings

For applications filed on or after November 2, 2003, the USPTO does not accept black-and-white drawings with a color claim, or drawings that show color by use of lining patterns. 37 C.F.R. §2.52(b)(1).

If the mark includes color, the drawing must show the mark in color. In addition, the application must include: (1) a claim that the color(s) is/are a feature of the mark; and (2) a color location statement in the

"Description of the Mark" field naming the color(s) and describing where the color(s) appear(s) on the mark.

37 C.F.R. §2.52(b)(1). A color drawing will not publish without both of these statements. See TMEP §807.07(a)(i) regarding the color claim, and TMEP §807.07(a)(ii) regarding the color location statement.

807.07(a)(i) Color Must Be Claimed as a Feature of the Mark

If an applicant submits a color drawing, or a description of the mark that indicates the use of color on the mark, the applicant must claim color as a feature of the mark. 37 C.F.R. §2.52(b)(1). If the color claim is unclear or ambiguous, the examining attorney must require clarification. If the color claim or mark description references changeable colors, the examining attorney must require an amended mark description that deletes the reference to the color in the mark varying or being changeable and restricts the description to only those colors shown on the drawing. See TMEP §807.01. Alternatively, the applicant may amend to a black-and-white drawing, if the amendment would not constitute a material alteration. A properly worded color claim would read as follows:

The color(s) <name the color(s)> is/are claimed as a feature of the mark.

The color claim must include the generic name of the color(s) claimed. The color claim may also include a reference to a commercial color identification system. The USPTO does not endorse or recommend any one commercial color identification system.

In an application filed on or after November 2, 2003, an applicant cannot file a color drawing with a statement that "no claim is made to color" or "color is not a feature of the mark." If this occurs, the

examining attorney must require the applicant to claim color as a feature of the mark. The applicant may not substitute a black-and-white drawing, unless the examining attorney determines that color is non-material.

807.07(a)(ii) Applicant Must Specify the Location of the Colors Claimed

If an applicant submits a color drawing, in addition to claiming the color(s), the applicant must include a separate statement specifying where the color(s) appear(s) on the mark. 37 C.F.R. §2.52(b)(1). This statement is often referred to as a "color location statement." In a TEAS application, the color location statement should be set forth in the "Description of the Mark" field. A properly worded color location statement would read as follows:

The mark consists of <specify the color(s) and literal or design element(s) on which the color(s) appear, e.g., a red bird sitting on a green leaf>.

If the color location statement is unclear or ambiguous, the examining attorney must require clarification. If the statement references changeable colors, the examining attorney must require an amended mark description that deletes the reference to the color in the mark varying or being changeable and restricts the description to only those colors shown on the drawing. See TMEP §807.01. However, if the record contains an accurate and properly worded color claim listing all the colors, and an informal description of where the colors appear, but one of the colors is omitted from the formal description of the colors in the mark, the examining attorney may enter an amendment of the color description that accurately reflects the location of all colors in the mark without prior approval by the applicant or the applicant's qualified practitioner. See TMEP §707.02.

Example. A TEAS applicant includes a statement in the "Miscellaneous" field that refers to the mark as a blue, red, and yellow ball and includes an accurate and properly worded color claim listing all colors in the mark, but omits the color yellow from the description of the mark. The examining attorney may enter an amendment of the description to accurately reflect all colors in the mark;

The color location statement must include the generic name of the color claimed. The statement may also include a reference to a commercial color identification system. The USPTO does not endorse or recommend any one commercial color identification system.

It is usually not necessary to indicate shades of a color, but the

examining attorney has the discretion to require that the applicant indicate shades of a color, if necessary to accurately describe the mark.

See TMEP §1202.05(e) for additional information regarding the requirement for a written explanation of a mark consisting solely of color.

807.07(b) Color Drawings Filed Without a Color Claim

If the applicant submits a color drawing but does not include a color claim in the written application, and if the color is a material element of the mark, the examining attorney must require the applicant to submit a claim that color(s) is a feature of the mark, and a separate color location statement in the "Description of the Mark" field naming the color(s) and specifying where the color(s) appear(s) on the mark.

In an application under §1, if the examining attorney determines that color is a non-material element of the drawing, the applicant may be given the option of submitting a black-and-white drawing.

In an application under §44, the drawing of the mark must be a substantially exact representation of the mark in the foreign registration. 37 C.F.R. §2.51(c). If a §44 application is based on a foreign registration that depicts the mark in color, but no claim of color is made in the registration document, the examining attorney must inquire whether the foreign registration includes the color(s) shown as claimed features of the mark. The applicant must either: (1) submit an affirmative statement that color is a feature of the mark, and comply with the United States requirements for drawings in color; or (2) submit a statement that although the mark is registered in its country of origin featuring a color depiction of the mark, no claim of color is made in that registration. If the examining attorney determines that color is a non-material element of the drawing, the applicant may be given the option of submitting a black-and-white drawing. See TMEP §807.12(b) and 1011.01.

In an application under §66(a), the drawing of the mark must be a substantially exact representation of the mark as it appears in the international registration. 37 C.F.R. §2.51(d); TMEP §807.12(c). The IB will include a reproduction that is identical to the reproduction in the international registration when it forwards the request for extension of protection of the international registration to the United States. The mark in a §66(a) application cannot be amended. TMEP §807.13(b).

Generally, when a mark is depicted in color, the §66(a) application will contain a claim of the colors featured in the mark. However, because some countries accept color drawings of marks that do not include a color claim, there may be cases where no claim of color has been made in the international registration, but the reproduction of the mark contains color. In these cases, the examining attorney should require the applicant to submit either: (1) a claim of the color(s) featured in the mark and a separate statement in the "Description of the Mark" field describing where the color(s) appear(s) in the mark; or (2) a statement that no claim of color is made with respect to the international registration, and a black-and-white reproduction of the same mark depicted in the international registration to comply with United States drawing requirements. 37 C.F.R. §2.52(b).

807.07(c) Color Drawings Filed With an Incorrect Color Claim

When the color shown in the drawing page in a paper application, or in the digitized image of the drawing in a TEAS application, is inconsistent with the color claimed in the written application (e.g., the mark is shown in blue in the drawing, but the color claimed is orange), the drawing controls. The color claim may be corrected to conform to the drawing. The drawing may not be corrected to conform to the color claim, unless the examining attorney determines that the amendment is non-material.

807.07(d) Color Drawings that Contain Black, White, or Gray

When color is claimed as a feature of the mark, the applicant must submit a color claim that identifies each color and a separate color location statement describing where each color appears in the mark. 37 C.F.R §2.52(b)(1); TMEP §807.07(a). The applicant must claim all colors shown in the mark; the applicant cannot claim color for some elements of the mark and not others. See id. For example, when the drawing includes

solid black lettering as well as elements in other colors, the applicant must claim the color black as a feature of the mark and include reference to the black lettering in the color location statement. The applicant may not state that solid black lettering represents all colors, or that it represents the particular color of the label, product, packaging, advertisement, website, or other specimen on which the mark appears at any given time.

If color is claimed as a feature of the mark, the drawing may include black, white, and/or gray used in two ways: (1) as claimed features

of the mark; and/or (2) as a means to depict a certain aspect of the mark that is not a feature of the mark, such as dotted or broken-line outlining to show placement of the mark on a product or package; to represent shading or stippling; to depict depth or three-dimensional shape; or to indicate areas that are not part of the mark, such as background or transparent areas. See TMEP §807.08 and 808.01(b).

The terms "background" and "transparent areas" refer to the white or black portions of the drawing which are not part of the mark, but appear or will appear in the particular color of the label, product, packaging, advertisement, website, or other acceptable specimen on which the mark is or will be displayed. The applicant may not claim that the background or transparent areas represent all colors or that they represent the particular color of the label, product, packaging, advertisement, website, or other specimen on which the mark appears at any given time.

If the applicant claims color as a feature of the mark, the examining attorney must require the applicant to:

- state that the color(s) black, white, and/or gray (and all other colors in the drawing) are claimed as a feature of the mark, and describe where the colors appear on the mark; or
- if appropriate, state that the black, white, and/or gray in the drawing represents background, outlining, shading, and/or transparent areas and is not part of the mark.

These statement(s) may be submitted in either a written amendment to the application or by an examiner's amendment. The examining attorney must ensure that the statement(s) is entered into the database. The statement(s) will be printed on the registration certificate.

The only exception to the requirement to claim or explain any black, white, and/or gray shown on the drawing is that, if the background of the drawing is white and it is clear that the white background is not part of the mark, no explanation of the white background is required. For example, if the drawing depicts the letters "ABC" in solid blue on a white background, or depicts a solid purple and green flower on a white background, no statement about the white background is required. On the other hand, if the shape of each of the letters "ABC" is outlined in blue with an enclosed white interior, or if the purple and green flower is enclosed in a green or black rectangle, square, or circle with a white interior, the applicant must explain the purpose of the interior white areas on the drawing.

807.07(d)(i) Applications Under §1

If the drawing includes black, white, gray tones, gray shading, and/or gray stippling, and also includes other colors (e.g., red, turquoise, and beige), and the color claim does not include the black/white/gray, the examining attorney must require the applicant to either: (1) add the black/white/gray to the color claim and to the color location statement; or (2) if appropriate, add a statement that "The <black/white/gray> in the drawing represents background, outlining, shading, and/or transparent areas and is not part of the mark."

Drawing must match the specimen of use. The drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods or services, as shown by the specimen.

37 C.F.R. §2.51 and 2.72(a)(1). See TMEP §807.12(a) et seq.

For example, if the drawing shows a red flower and the letters XYZ in the color black, the specimen must show the mark in the same colors. If the specimen depicts the lettering in a color other than solid black (e.g., green), the applicant must: (1) submit an amended drawing that depicts the lettering in the color shown on the specimen, if the amendment would not materially alter the mark; and (2) amend the color claim and the color location statement to match the new drawing, e.g., replace the word "black" with the word "green."

Alternatively, the applicant may submit a substitute specimen showing use of the mark in the colors depicted on the drawing, or, if deleting the colors from the drawing would not materially alter the mark, the applicant may delete the color claim and substitute a black-and-white drawing for the color drawing. 37 C.F.R. §2.72.

807.07(d)(ii) Applications Under §44

If the applicant claims any color as a feature of the mark in the foreign registration, the applicant must claim the same color(s) in the United States application. If the foreign registration includes a color claim and also includes black, white, and/or gray that is not claimed as a feature of the mark, the applicant must state that the black/white/gray in the drawing represents background, outlining, shading, and/or transparent areas and is not part of the mark. See 37 C.F.R. §2.51(c) and 2.72(c)(1); TMEP §807.12(b) and 1011.01.

In applications under §44, the drawing of the mark, including any color claim, must match the mark in the foreign registration. See 37 C.F.R. 2.51(c). An applicant under §44 who is claiming color in the United States application must state for the record that the foreign registration includes a claim of color, unless the foreign

registration clearly indicates that color is a feature of the registered mark. The statement that the foreign registration includes a claim of color will not be printed on the United States registration certificate.

807.07(d)(iii) Applications Under §66(a)

If the applicant claims color as a feature of the mark, and the drawing also includes black, white, and/or gray that is not mentioned in the international registration color claim, the applicant must either: (1) claim the black / white/ gray as color(s) in the United States application and describe the location of the black / white / gray; or (2) state that the black / white / gray in the drawing represents background, outlining, shading, and/or transparent areas and is not part of the mark.

807.07(e) Black-and-White Drawings and Color Claims

If an applicant submits a black-and-white drawing that is lined for color (see TMEP §808.01(b)), or if the applicant submits a black-and-white drawing with an application that includes a color claim, the examining attorney must require the applicant to submit a color drawing, a claim that color(s) are a feature of the mark, and a separate statement naming the color(s) and describing where they appear on the mark. If, however, the examining attorney determines that the color is a non-material element of the drawing, the applicant may instead be given the option of submitting a black-and-white drawing that is not lined for color, or deleting the color claim in the written application, whichever is applicable.

If an applicant submits a black-and-white drawing that is not lined for color, and there is no color claim in the written application, generally the applicant cannot substitute a color drawing and claim color, unless the examining attorney determines that the color is a non-material element of the drawing.

807.07(f) Black-and-White Drawings that Contain Gray or Black-and-White Drawings with a Mark Description that Refers to Black, White, or Gray

807.07(f)(i) TEAS, TEAS Plus, and §66(a) Applications

If the applicant submits a black-and-white drawing that contains gray or stippling that produces gray tones, and the application states that color is not claimed as a feature of the mark, no further inquiry is

required.
Similarly, if an applicant submits a black-and-white drawing and a description of the mark that references black, white, and/or gray, and the applicant states that color is not claimed as a feature of the mark, no further inquiry is required and no change to the description of the mark is required.
The word "No" in the "Color Mark" field on a TEAS or TEAS Plus application, or in the "Mark in Color" field on a §66(a) application, is sufficient to indicate that color is not claimed as a feature of the mark, even if the application contains the notation "grayscale" in reference to the drawing.
When a mark contains stippling, it is generally not necessary to require a statement that the stippling represents shading or is a feature of the mark, unless the examining attorney believes such a statement is necessary to accurately describe the mark. See TMEP §808.01(b) regarding stippling statements.

807.07(f)(ii) Applications Filed on Paper

If the applicant submits a black-and-white drawing on paper and the application is silent about whether color is claimed as a feature of the mark, the presence of any gray in the drawing creates an ambiguity as to whether black, white, and/or gray are claimed as a feature of the mark. Similarly, if an applicant submits a black-and-white drawing on paper and the application is silent about whether color is claimed as a feature of the mark, the inclusion of a description of the mark that refers to black / white / gray creates an ambiguity as to whether black/white/gray is claimed as a feature of the mark. In these cases, the examining attorney must require that the applicant submit one of the following:
(1) A statement that the mark is not in color. The applicant may submit the statement, or the examining attorney may obtain the information in a telephone interview or e-mail exchange with the applicant or the applicant's qualified practitioner, and enter a Note to the File in the record that the mark is not in color; or
(2) A statement that the color(s) black, white, and/or gray is a feature of the mark, and a separate statement naming the color(s) and describing where the color(s) appear(s) on the mark.

807.07(g) Drawings in Applications Filed Before November 2, 2003

Prior to November 2, 2003, the USPTO did not accept color drawings. An applicant who wanted to show color in a mark was required to submit

a black-and-white drawing, with a statement describing the color(s) and where they appeared on the mark. Alternatively, the applicant could use a color lining system that previously appeared in 37 C.F.R. §2.52 but was deleted from the rule effective October 30, 1999. See notice at 64 Fed. Reg. 48900, 48903 (Sept. 8, 1999) and 1226 TMOG 103, 106 (Sept. 28, 1999).

In applications filed prior to November 2, 2003, it was presumed that color was claimed as a feature of the mark, unless the applicant specifically stated that no claim was made to color, or that color was not claimed as a feature of the mark.

For applications filed before November 2, 2003, unless the application included a statement that color was not claimed as a feature of the mark (or that no claim was made to color), the applicant may voluntarily submit a color drawing under the current rules, with the requisite color claim and a separate description of the color(s) in the mark.

A registrant may substitute a color drawing for a black-and-white drawing in a registration where color is claimed, by filing a §7 request to amend the registration certificate. The request must include: (1) a color drawing; (2) a color claim; (3) a description of where the color appears in the mark; and (4) the fee required by 37 C.F.R. §2.6. See TMEP §1609.02(e).

807.08 Broken Lines to Show Placement

37 CFR §2.52(b)(4) Broken lines to show placement.

If necessary to adequately depict the commercial impression of the mark, the applicant may be required to submit a drawing that shows the placement of the mark by surrounding the mark with a proportionately accurate broken-line representation of the particular goods, packaging, or advertising on which the mark appears. The applicant must also use broken lines to show any other matter not claimed as part of the mark. For any drawing using broken lines to indicate placement of the mark, or matter not claimed as part of the mark, the applicant must describe the mark and explain the purpose of the broken lines.

Occasionally, the position of the mark on the goods, or on a label or container, may be a feature of the mark.

If necessary to adequately depict the commercial impression of the mark, the examining attorney may require the applicant to submit a drawing that shows the placement of the mark by surrounding the mark with a proportionately accurate broken-line representation of the particular goods, packaging, or advertising on which the mark appears.

The applicant must also use broken lines to show any other matter not claimed as part of the mark. For any drawing using broken lines to indicate placement of the mark, or matter not claimed as part of the mark, the applicant must include a written description of the mark and explain the purpose of the broken lines, e.g., by indicating that the matter shown by the broken lines is not a part of the mark and that it serves only to show the position of the mark. 37 C.F.R. §2.52(b)(4). The drawing should clearly define the matter the applicant claims as its mark. See In re Water Gremlin Co., 635 F.2d 841, 208 USPQ 89 (C.C.P.A. 1980); In re Famous Foods, Inc., 217 USPQ 177 (TTAB 1983). Because the matter depicted in broken lines is not part of the mark, it should not be considered in determining likelihood of confusion. In re Homeland Vinyl Products, Inc., 81 USPQ2d 1378 (TTAB 2006). See TMEP §1202.02(c)(i) regarding drawings in trade dress applications.

807.09 "Drawing" of Sound, Scent, or Non-Visual Mark

37 CFR §2.52(e) Sound, scent, and non-visual marks.

An applicant is not required to submit a drawing if the mark consists only of a sound, a scent, or other completely non-visual matter. For these types of marks, the applicant must submit a detailed description of the mark.

The applicant is not required to submit a drawing if the mark consists solely of a sound (e.g., music or words and music), a scent, or other completely non-visual matter. In a paper application, the applicant should clearly indicate in the application that the mark is a "NON-VISUAL MARK." If the applicant is submitting a TEAS application for a sound mark, the applicant should select "Sound Mark" as the mark type. If the applicant is submitting a TEAS application for a scent mark, the applicant should indicate that the mark type is "Standard Character" and should type "Scent Mark" in the "Standard Character" field. The USPTO will enter the proper mark drawing code when the application is processed. Non-visual marks are coded under mark drawing code 6 in the automated search system. See TMEP §807.18 regarding mark drawing codes. If the applicant selects "Sound Mark" as the mark type, the applicant will be required to indicate whether it is attaching an audio file. The applicant should submit an audio reproduction of any sound mark. See 37 C.F.R. §2.61(b). The purpose of this reproduction is to supplement and clarify the description of the mark.

The reproduction should contain only the mark itself; it is not meant to be a specimen. The reproduction must be in an electronic file in .wav, .wmv, .wma, .mp3, .mpg, or .avi format and should not exceed

5 MB in size because TEAS cannot accommodate larger files.
Audio files can only be attached to TEAS application forms. To submit an electronic file in connection with any other TEAS form (e.g., Response to Office Action or Statement of Use/Amendment to Allege Use), the file must be sent after the TEAS document is transmitted, as an attachment to an e-mail message directed to TEAS@uspto.gov, with clear instructions that the electronic file should be associated with "the application filed under Serial No. <specify>." See In re Powermat Inc., 105 USPQ2d 1789, 1791 (TTAB 2013). Note, however, that audio files attached to an e-mail currently cannot exceed 9 MB.
For paper filings, reproductions of sound marks must be submitted on compact discs ("CDs"), digital video discs ("DVDs"), videotapes, or audiotapes. See id. The applicant should clearly and explicitly indicate that the reproduction of the mark contained on the disc or tape is meant to supplement the mark description and that it should be placed in the paper file jacket and not be discarded.
If the mark is a composite comprising both visual and non-visual matter, the applicant must submit a drawing depicting the visual matter, and include a description of the non-visual matter in the "Description of the Mark" field.
The applicant must also submit a detailed description of the mark for all non-visual marks. 37 C.F.R. 2.52(e).
If the mark comprises music or words set to music, the applicant should generally submit the musical score sheet music to supplement or clarify the description of the mark. See 37 C.F.R. §2.61(b). In a TEAS application or response, the score should be attached as a .jpeg or .pdf file in the "Additional Statements" section of the form, under "Miscellaneous Statements."
See TMEP §904.03(f) and 1202.15 regarding specimens for sound marks, and TMEP §904.03(m) regarding specimens for scent and flavor marks.

807.10 Three-Dimensional Marks

37 CFR §2.52(b)(2) Three dimensional marks.

If the mark has three-dimensional features, the drawing must depict a single rendition of the mark, and the applicant must indicate that the mark is three-dimensional.
If the mark is three-dimensional, the drawing should present a single rendition of the mark in three dimensions.
In re Schaefer Marine, Inc., 223 USPQ 170, 171 n.1 (TTAB 1984). The applicant must include a description of the mark indicating that the mark is three-dimensional.

Under 37 C.F.R. §2.52(b)(2), the applicant is required to submit a drawing that depicts a single rendition of the mark. If the applicant believes that its mark cannot be adequately depicted in a single rendition, the applicant may file a petition under 37 C.F.R. §2.146 requesting that the rule be waived. See TMEP Chapter 1700 regarding petitions.

See TMEP §1202.02(c)(i) regarding drawings in trade dress applications and 1202.02(c)(ii) regarding information required in descriptions for trade dress marks comprising product design or product packaging, or trade dress for services.

807.11 Marks With Motion

37 CFR §2.52(b)(3) Motion marks.

If the mark has motion, the drawing may depict a single point in the movement, or the drawing may depict up to five freeze frames showing various points in the movement, whichever best depicts the commercial impression of the mark. The applicant must also describe the mark.

If the mark includes motion (i.e., a repetitive motion of short duration) as a feature, the applicant may submit a drawing that depicts a single point in the movement, or the applicant may submit a square drawing that contains up to five freeze frames showing various points in the movement, whichever best depicts the commercial impression of the mark. The applicant must also submit a detailed written description of the mark. 37 C.F.R. §2.52(b)(3).

See TMEP §904.03(l) regarding specimens for motion marks.

807.12 Mark on Drawing Must Agree with Mark on Specimen or Foreign Registration

37 CFR §2.51 Drawing required.

(a) In an application under section 1(a) of the Act, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.

(b) In an application under section 1(b) of the Act, the drawing of the mark must be a substantially exact representation of the mark as intended to be used on or in connection with the goods and/or services specified in the application, and once an amendment to allege use under §2.76 or a statement of use under §2.88 has been filed, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.

(c) In an application under section 44 of the Act, the drawing of the mark must be a substantially exact representation of the mark as it

appears in the drawing in the registration certificate of a mark duly registered in the applicant's country of origin.

(d) In an application under section 66(a) of the Act, the drawing of the mark must be a substantially exact representation of the mark as it appears in the international registration.

807.12(a) Applications Under §1 of the Trademark Act

For applications under §1 of the Trademark Act, the drawing must always be compared to the specimen of record to determine whether they match. 37 C.F.R. §2.51(a) and (b). The first step is to analyze whether the mark in the drawing is a substantially exact representation of the mark shown on the specimen.

In an application filed under §1(a) of the Trademark Act, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods/services, as shown by the specimen. 37 C.F.R. §2.51(a) and 2.72(a)(1).

In an application filed under §1(b) of the Act, the drawing of the mark must be a substantially exact representation of the mark as intended to be used on or in connection with the goods/services, and as actually used as shown by the specimen filed with the amendment to allege use or statement of use. 37 C.F.R. §2.51(b) and 2.72(b)(1).

If the mark in the drawing is not a substantially exact representation of the mark shown in the specimen, the second step is to determine whether an amendment to the drawing to agree with the mark shown on the specimen would be a material alteration of the mark in the original drawing. If the answer is "no," the applicant must submit either an amended drawing or a substitute specimen. If the answer is "yes," the applicant must submit a substitute specimen and no amendment to the drawing is allowed. 37 C.F.R. §2.72(a) and (b); see TMEP §807.14 et seq. for more information about material alteration.

Extraneous matter shown on the specimen that is not part of the mark (e.g., the symbols "TM" or "SM," the registration notice R, the copyright notice c, or informational matter such as net weight or contents) may not be shown on the drawing. See TMEP §807.14(a) regarding deletion of non-distinctive matter.

See TMEP §1214.02 regarding the agreement of the mark on the drawing with the mark on the specimen in an application that seeks registration of a mark with a "phantom" or changeable element, and TMEP §1215.02(c) regarding the agreement of the mark on the drawing with the mark on the specimen in an application that seeks registration of a domain name mark.

807.12(a)(i) Role of Punctuation in Determining Whether Mark on Drawing Agrees with Mark on Specimen

In assessing discrepancies in punctuation between the mark on the drawing and the mark shown on the specimen, the general rule is that:

(1) Extraneous, non-distinctive punctuation that appears on the specimen may be omitted from the mark on the drawing, because an acceptable specimen may contain additional matter used with the mark on the drawing, so long as the mark on the drawing makes a separate and distinct commercial impression apart from the other matter. See TMEP §807.12(d) and cases cited therein regarding "mutilation" of the mark.

(2) Punctuation in the mark on the drawing must also appear on the specimen because a mark sought to be registered under §1 must be "used in commerce," and if the punctuation on the drawing does not appear on the specimen, the mark on the drawing is not used in commerce.

See TMEP §1215.08(c) regarding the addition or deletion of a "." in marks for domain name registry or registration services.

807.12(a)(ii) Punctuation on the Drawing but Not on the Specimen

If a drawing contains punctuation, the elements of punctuation are presumed to be part of the mark. Thus, if there is punctuation in the mark on the drawing, the punctuation must also appear on the specimen or the drawing is not considered to be a substantially exact representation of the mark as used in commerce. If deletion of the punctuation from the drawing does not alter the commercial impression, the drawing may be amended to match the specimen. If deletion of the punctuation changes the commercial impression, i.e., constitutes a material alteration, the applicant must submit a substitute specimen to match the original drawing. See TMEP §807.14 et seq. regarding material alteration.

For example, if the mark on the drawing is "ALL THE KING'S MEN," and the mark on the specimen is ALL THE KING'S MEN, the mark on the drawing is not a substantially exact representation of the mark as used in commerce. Since the deletion of the quotation marks from the drawing would not change the commercial impression of the mark, the drawing may be amended to match the specimen. The applicant has the option to either: (1) amend the drawing to delete the punctuation; or (2) submit a new specimen showing use of the mark with the punctuation.

However, if the mark on the drawing is GOT MILK?, and the mark on the specimen is GOT MILK, the deletion of the punctuation from the drawing

would constitute a material alteration because it changes the commercial impression from a question to a statement. Therefore, the drawing may not be amended and the applicant must submit a substitute specimen that includes punctuation in order for the drawing to be a substantially exact representation. See TMEP §§807.14 et seq.

807.12(a)(iii) Punctuation on the Specimen but Not on the Drawing

Generally, extraneous, non-distinctive punctuation marks that appear on the specimen may be omitted from the drawing, if the matter on the drawing makes an impression separate and apart from the punctuation marks that appear on the specimen. See TMEP §807.12(d). For example, if the mark on the drawing is HOME RUN, and the mark on the specimen is "HOME RUN," the drawing is considered a substantially exact representation of the mark as used on the specimen. The quotation marks on the specimen are nondistinctive and do not change the commercial impression of the mark, so it is unnecessary to amend the drawing or require a substitute specimen.

However, in rare instances, the punctuation marks on the specimen result in a mark with a different commercial impression than the mark shown on the drawing. For example, if the mark on the specimen is PREGNANT ?, and the mark on the drawing is PREGNANT, the mark on the drawing is not a substantially exact representation of the mark as actually used. The question mark on the specimen transforms the word PREGNANT from a mere statement to a question, and, therefore, changes the commercial impression of the mark. Moreover, the drawing cannot be amended to add the punctuation because it would result in a material alteration. Therefore, the applicant must submit a new specimen showing the mark without the punctuation. In re Guitar Straps Online, LLC, 103 USPQ2d 1745, 1751-52 (TTAB 2012) (finding the mark GOT STRAPS on the drawing not a substantially exact representation of the mark GOT STRAPS? on the specimen). See TMEP §807.14 et seq.

807.12(b) Applications Under §44 of the Trademark Act

In a §44 application, the drawing of the mark must be "a substantially exact representation of the mark as it appears in the drawing in the registration certificate of the mark registered in the applicant's country of origin." 37 C.F.R. §2.51(c) and 2.72(c)(1). The standard for determining whether the mark in the drawing agrees with the mark in the foreign registration is stricter than the standard used to determine whether a specimen supports use of a mark in an application under §1 of the Trademark Act. See TMEP §1011.01.

The drawing in the United States application must display the entire mark as registered in the foreign country. The applicant may not limit the mark to part of the mark shown in the foreign registration, even if it creates a separate and distinct commercial impression.

Exception: Non-material informational matter that appears on the foreign registration, such as net weight or contents, or the federal registration notice, may be omitted or deleted from the drawing.

When the mark on the drawing does not agree with the mark on the foreign registration, the applicant cannot amend the drawing of the mark if the amendment would materially alter the mark on the original drawing.

37 C.F.R. §2.72(c); TMEP §807.14 et seq. and 1011.01.

If the United States application has a black-and-white drawing, and color appears in the foreign registration, or color is claimed or described as a feature of the mark in the foreign registration, the mark in the United States drawing does not agree with the mark in the foreign registration. In general, the black-and-white drawing in the United States application should be amended to agree with the colored mark in the foreign registration, unless the proposed amendment would be a material alteration.

If the United States application has a color drawing, the same colors must be part of the mark in the foreign registration. Whether the drawing in the United States application can be amended depends upon whether the amendment would be a material alteration of the mark. If the United States application has a color drawing but the drawing in the foreign registration is in black and white with no color claim, the applicant must either: (1) amend the drawing in the United States application to a black-and-white drawing, if the amendment would not be a material alteration; or (2) delete the §44 basis and proceed under §1.

See TMEP §1214.02 regarding the agreement of the mark on the drawing with the mark on the foreign registration in an application that seeks registration of a mark with a "phantom" or changeable element.

807.12(c) Applications Under §66(a) of the Trademark Act

In an application under §66(a) of the Trademark Act, the drawing of the mark must be a substantially exact representation of the mark as it appears in the international registration. 37 C.F.R. §2.51(d). The IB will include a reproduction that is identical to the reproduction in the international registration when it forwards the request for extension of protection of the international registration to the

United States. It is, therefore, unnecessary for the examining attorney to compare the drawing in the §66(a) application with the reproduction in the international registration. See TMEP §1904 et seq. for further information about §66(a) applications.

The mark in a §66(a) application cannot be amended. TMEP §807.13(b).

Exception: Non-material informational matter that appears on the international registration, such as net weight or contents, or the federal registration notice, may be omitted or deleted from the drawing.

Because the drawing requirements in other countries often differ from those in the United States, an ambiguity may arise when the international registration contains no color claim, but the reproduction of the mark in the international registration is in color. In such cases, the §66(a) applicant must either: (1) make a color claim to clarify that the depicted color(s) is a feature of the mark and submit a description of the location of the color(s); or (2) submit a black-and-white reproduction of the mark. See 37 C.F.R. §2.52(b) and 2.52(b)(1). This is not considered to be an amendment to the mark, but rather a clarification of the ambiguity.

If the USPTO receives a notification of correction to a mark in the International Register from the IB, the examining attorney must conduct a new search of the mark as corrected and, if appropriate, issue a provisional refusal of the request for extension of protection as corrected on all applicable grounds. The USPTO must notify the IB of the provisional refusal within 18 months of notification of the correction. See TMEP §1904.03(f) regarding notifications of corrections to the International Register. If the reproduction of the corrected mark features color, the applicant will be required to comply with the requirements for a color drawing (see TMEP §807.07(a) et seq.). 37 C.F.R. §2.52(b)(1).

807.12(d) Mutilation or Incomplete Representation of Mark

In an application under §1 of the Trademark Act, the mark on the drawing must be a complete mark, as evidenced by the specimen. When the representation on a drawing does not constitute a complete mark, it is sometimes referred to as a "mutilation" of the mark. This term indicates that essential and integral subject matter is missing from the drawing. An incomplete mark may not be registered. See In re Chemical Dynamics Inc., 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988); In re Miller Sports Inc., 51 USPQ2d 1059 (TTAB 1999); In re Boyd Coffee Co., 25 USPQ2d 2052 (TTAB 1993); In re Semans, 193 USPQ 727 (TTAB 1976).

However, in a §1 application, an applicant has some latitude in selecting the mark it wants to register. The mere fact that two or more elements form a composite mark does not necessarily mean that those elements are inseparable for registration purposes. An applicant may apply to register any element of a composite mark if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen.

In a §44 application, the standard is stricter. TMEP §1011.01. The drawing in the United States application must display the entire mark as registered in the country of origin. The applicant may not register part of the mark in the foreign registration, even if it creates a distinct commercial impression.

In any application, if registration is refused on the ground that the mark on the drawing does not agree with the mark as shown on the specimen or foreign registration, the applicant may not amend the drawing if the amendment would materially alter the mark on the original drawing. 37 C.F.R. §2.72; TMEP §807.14 et seq. and 1011.01.

This issue will not arise in a §66(a) application, because the IB includes a reproduction that is identical to the reproduction in the international registration when it forwards the request for extension of protection of the international registration to the United States. The mark in a §66(a) application cannot be amended. TMEP §807.13(b).

In the following cases, an element of a composite mark was found not to present a separate and distinct commercial impression apart from any other matter with which the mark was or would be used on the specimen: See Chemical Dynamics, 839 F.2d at 1569, 5 USPQ2d at 1828 (registration of design of medicine dropper and droplet properly refused, where the proposed mark is actually used as an integral part of a unified mark that includes a design of a watering can, and does not create a separate commercial impression); In re Lorillard Licensing Co., 99 USPQ2d 1312 (TTAB 2011) (finding that the drawing was not a substantially exact representation of the proposed mark, an orange-and-green color combination for the packaging of cigarettes, as appearing on the specimen); In re Pharmavite LLC, 91 USPQ2d 1778 (TTAB 2009) (Board affirmed refusal to register a mark comprised of the design of two bottles, finding that it does not create a separate and distinct commercial impression apart from the mark shown on the specimen and further that it is not a substantially exact representation of the mark shown on the specimen); In re Yale Sportswear Corp., 88 USPQ2d 1121 (TTAB 2008) (Board affirmed refusal

to register "UPPER 90," finding that it does not form a separate and distinct commercial impression apart from the degree symbol that appears on the specimen); Miller Sports, 51 USPQ2d at 1059 (proposed mark comprising the letter "M" and skater design properly refused, where the "M" portion of applicant's "Miller" logo is so merged in presentation with remainder of logo that it does not create a separate commercial impression); Boyd Coffee, 25 USPQ2d 2052 (proposed mark comprising cup and saucer design properly refused as mutilation of mark actually used, which includes the cup and saucer design as well as a sunburst design, since the cup and saucer design does not create a separate and distinct commercial impression apart from the sunburst design); In re Sperouleas, 227 USPQ 166 (TTAB 1985) (design unregistrable apart from wording that appears on specimen, where the words are not only prominent but are also physically merged with the design, such that the design does not make a separate commercial impression); In re Volante Int'l Holdings, 196 USPQ 188 (TTAB 1977) (mark consisting of a design of a double-headed girl, a dragon, and a tree is not a substantially exact representation of the mark actually used, which incorporates the visually inseparable and intertwined term "VIRGIN"); In re Library Restaurant, Inc., 194 USPQ 446 (TTAB 1977) (the words "THE LIBRARY" are so intimately related in appearance to other elements of the mark actually used that it is not possible to conclude that the pictorial features by themselves create a separate commercial impression); Semans, 193 USPQ at 727 (the term "KRAZY," displayed on the specimen on the same line and in the same script as the expression "MIXED-UP," does not in itself function as a registrable trademark apart from the unitary phrase "KRAZY MIXED-UP"); In re Mango Records, 189 USPQ 126 (TTAB 1975) (the typed mark "MANGO" is so uniquely juxtaposed with the pictorial elements of the composite that it is not a substantially exact representation of the mark as used on the specimen and does not show the mark in the unique manner used thereon).

An element of a proposed mark was found to create a separate commercial impression in the following cases: In re Servel, Inc., 181 F.2d 192, 85 USPQ 257 (C.C.P.A. 1950) (refusal to register the term "SERVEL" as a mutilation of the mark "SERVEL INKLINGS" reversed, where the specimen displays an insignia between the words "SERVEL" and "INKLINGS," and "INKLINGS" is printed in a large and different kind of type); In re Royal BodyCare Inc., 83 USPQ2d 1564 (TTAB 2007) (Board reversed refusal to register the term "NANOCEUTICAL," finding that the term is actually used in a manner that creates a commercial impression separate and

apart from the house mark or trade name "RBC's"); In re Big Pig, Inc., 81 USPQ2d 1436 (TTAB 2006) ("PSYCHO" creates a separate commercial impression apart from additional wording and background design that appears on the specimen, where the word "PSYCHO" is displayed in a different color, type style and size, such that it stands out); In re 1175856 Ontario Ltd., 81 USPQ2d 1446 (TTAB 2006) (refusal to register "WSI" and globe design reversed, since the letters "WSI" and globe design create a separate commercial impression apart from a curved design element that appears on the specimen); In re Raychem Corp., 12 USPQ2d 1399, 1400 (TTAB 1989) (Board reversed refusal to register "TINEL-LOCK" as mutilation of mark "TRO6AI-TINEL-LOCK-RING," noting that part or stock number does not usually function as a source identifier, and that the "fact that hyphens connect both the part number and the generic term to the mark does not, under the circumstances presented in this case, create a unitary expression such that 'TINEL-LOCK' has no significance by itself as a trademark."); In re National Institute for Automotive Service Excellence, 218 USPQ 745 (TTAB 1983) (design of meshed gears "is distinctive in nature" and "creates a commercial impression separate and apart from the words superimposed thereon"); In re Schecter Bros. Modular Corp., 182 USPQ 694 (TTAB 1974) (where specimens show mark consisting in part of RAINAIRE together with its shadow image, it is not a mutilation of mark to delete shadow image from drawing since RAINAIRE creates the essential impression); In re Emco, Inc., 158 USPQ 622 (TTAB 1968) (Board concluded that the law and the record supported applicant's position that RESPONSER is registrable without addition of the surname MEYER).

See TMEP §807.14(c) regarding the effect of the addition or deletion of punctuation on the commercial impression of the mark.

807.12(e) Compound Word Marks and Telescoped Marks

Like any other drawing, a drawing of a compound word mark or telescoped mark must be a substantially exact representation of the mark as it appears on the specimen in a §1 application or on the foreign registration in a §44 application.

A compound word mark is comprised of two or more distinct words, or words and syllables, that are represented as one word (e.g., BOOKCHOICE, PROSHOT, MAXIMACHINE, PULSAIR). Often, each word or syllable in a compound word mark is displayed or highlighted by: (1) capitalizing the first letter of each word or syllable (e.g., TimeMaster); or (2) presenting the words or syllables in a different color, script, or

size (e.g., RIBtype).

If the drawing depicts the mark as a compound word mark, but the specimen shows the mark as two separate words, or vice versa, the examining attorney must determine whether the specimen is a substantially exact representation of the mark on the drawing and/or whether an amendment to the drawing would be a material alteration of the mark. See In re Innovative Companies, LLC, 88 USPQ2d 1095 (TTAB 2008) (FREEDOMSTONE not a substantially exact representation of FREEDOM STONE, but amendment of FREEDOMSTONE to FREEDOM STONE not deemed a material alteration). For example, if the drawing depicts the mark as BOOKCHOICE, but the specimen shows it as BOOK CHOICE, the mark on the specimen is not a substantially exact representation of the mark on the drawing. An amendment to the drawing would not be a material alteration. However, depending upon the nature of the goods/services, a disclaimer might be required. Note that a specimen showing the mark as BookChoice would be a substantially exact representation.

A telescoped mark is comprised of two or more words that share letters (e.g., SUPERINSE). A telescoped word must be presented as a unitary term with the letters shared. The telescoped element may not be represented as two words, because the shared letter is an aspect of the commercial impression, (e.g., SUPERINSE, not SUPE RINSE or SUPER RINSE).

See TMEP §1213.05(a) et seq. regarding disclaimers in telescoped and compound word marks.

807.13 Amendment of Mark

37 CFR §2.72 Amendments to description or drawing of the mark.

(a) In an application based on use in commerce under section 1(a) of the Act, the applicant may amend the description or drawing of the mark only if:

(1) The specimens originally filed, or substitute specimens filed under §2.59(a), support the proposed amendment; and

(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.

(b) In an application based on a bona fide intention to use a mark in commerce under section 1(b) of the Act, the applicant may amend the description or drawing of the mark only if:

(1) The specimens filed with an amendment to allege use or statement

of use, or substitute specimens filed under §2.59(b), support the proposed amendment; and

(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.

(c) In an application based on a claim of priority under section 44(d) of the Act, or on a mark duly registered in the country of origin of the foreign applicant under section 44(e) of the Act, the applicant may amend the description or drawing of the mark only if:

(1) The description or drawing of the mark in the foreign registration certificate supports the amendment; and

(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.

807.13(a) Amendment of Mark in Applications Under §1 and 44

Section 1(a) Application. The mark in an application under §1(a) of the Trademark Act can be amended if the specimen supports the amendment and the amendment does not materially alter the mark. 37 C.F.R. §2.72(a). See TMEP §904 et seq. regarding specimens, and TMEP §807.14 et seq. regarding material alteration.

Section 1(b) Application. The mark in an application under §1(b) of the Trademark Act can be amended if the specimen filed with an amendment to allege use or statement of use supports the amendment, and the amendment does not materially alter the mark. 37 C.F.R. §2.72(b). See TMEP §904 et seq. regarding specimens, TMEP §1104 et seq. regarding amendments to allege use, TMEP §§1109 et seq. regarding statements of use, and TMEP §807.14 et seq. regarding material alteration.

Section 44 Application. The mark in an application under §44 of the Trademark Act can be amended if the mark in the foreign registration certificate supports the amendment, and the amendment does not materially alter the mark. 37 C.F.R. §2.72(c). See TMEP §1011.01 regarding the requirement that the mark on the drawing in a §44 application be a substantially exact representation of the mark as it appears in the foreign registration certificate, and TMEP §807.14 et seq. regarding material alteration.

807.13(b) Mark in §66(a) Application Cannot be Amended

The Madrid Protocol and the Common Regs. do not permit amendment of the mark in an international registration. If the holder of the international registration wants to change the mark in any way, even slightly, the holder must file a new international application. The IB's Guide to International Registration, Para. B.II.72.02, provides as follows:

There is no provision for a mark that is recorded in the International Register to be amended in any way, either on renewal or at any other time. If the holder wishes to protect the mark in a form which differs, even slightly, from the mark as recorded, he must file a new international application. This is true even if the mark has been allowed to be changed in the basic application, the registration resulting from the basic application or the basic registration, as the case may be....

Accordingly, because an application under §66(a) of the Trademark Act is a part of the international registration, 37 C.F.R. §2.72 makes no provision for amendment of the mark in a §66(a) application, and the USPTO will not permit any such amendments. See notice at 68 FR 55748, 55756 (Sept. 26, 2003). See TMEP §1904.02(j).

Exception: Non-material informational matter that appears on the international registration, such as net weight or contents, or the federal registration notice, may be omitted or deleted from the drawing. However, the applicant must comply with United States requirements regarding drawings and descriptions of the mark. See TMEP §1904.02(k).

Similarly, after registration, a registrant generally cannot amend under §7 of the Trademark Act a mark in a registered extension of protection under §7 of the Trademark Act, except to add a standard character claim if the registered mark complies with the requirements of 37 C.F.R. §2.52(a)(1)-(5). TMEP §1609.01(a) and 1609.02.

See TMEP §1904.03(f) and 1904.14 regarding notifications of corrections in the International Register with respect to pending §66(a) applications and registered extensions of protection.

807.14 Material Alteration of Mark

Trademark Rule 2.72, 37 C.F.R. §2.72, prohibits any amendment of the mark in an application under §1 or §44 of the Trademark Act that materially alters the mark on the drawing filed with the original application.

The test for determining whether an amendment is a material alteration is as follows:

The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark. The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it would be tantamount to a new mark appropriate for a new application.

In re Hacot-Colombier, 105 F.3d 616, 620, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997), quoting Visa Int'l Service Ass'n v. Life-Code Systems, Inc., 220 USPQ 740,743-44 (TTAB 1983). This test applies to both an amendment of the description of a mark and an amendment of the mark on a drawing. In re Thrifty, Inc., 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001).

Although the test refers to republication, it also applies to amendments to marks proposed before publication.

Material alteration is the standard used for evaluating amendments to marks in all phases of prosecution, i.e., before publication, after publication, and after registration. See TMEP §1609.02 et seq. regarding amendment of registered marks.

As a general rule, the addition of any element that would require a further search will constitute a material alteration. In re Pierce Foods Corp., 230 USPQ 307 (TTAB 1986). However, while the question of whether a new search would be required is a factor to be considered in deciding whether an amendment would materially alter a mark, it is not necessarily the determining factor. In re Who? Vision Systems, Inc., 57 USPQ2d 1211 (TTAB 2000); In re Vienna Sausage Mfg. Co., 16 USPQ2d 2044 (TTAB 1990).

Each case must be decided on its own facts, and these general rules are subject to exceptions. The controlling question is always whether the old and new forms of the mark create essentially the same commercial impression.

See TMEP §807.14(a) regarding amendments to delete matter from a drawing, TMEP §807.14(b) regarding the addition or deletion of previously registered matter, TMEP §807.14(c) regarding the addition or deletion of punctuation, TMEP §1202.02-1202.02(e) regarding registration of trade dress marks and 1202.02(c)(i) regarding drawings in trade dress applications, and TMEP §1215.08 et seq. regarding material alteration in marks comprised, in whole or in part, of domain names.

807.14(a) Removal or Deletion of Matter from Drawing

An applicant may request deletions from the mark on the drawing, and the examining attorney may approve the request if he or she believes the deletions are appropriate and would not materially alter the mark. 37 C.F.R. §2.72.

Deletion of matter from the mark can result in a material alteration. See In re Dillard Department Stores, Inc., 33 USPQ2d 1052 (Comm'r Pats. 1993) (proposed deletion of highly stylized display features of mark "IN.VEST.MENTS" held to be a material alteration of a registered mark). However, nondistinctive matter may be deleted, if it does not constitute a material alteration. For example, the deletion of the generic name of the goods or services would not generally be considered a material alteration, unless it was so integrated into the mark that the deletion would alter the commercial impression. In some circumstances, nondistinctive matter may be deleted if the overall commercial impression is not altered. Also, deletions of matter determined to be unregistrable under §2(a) or 2(b) of the Act, 15 U.S.C. §1052(a) or (b) (see TMEP §1203 and 1204), are sometimes permissible.

If a specimen shows that matter included on a drawing is not part of the mark, the examining attorney may require that such matter be deleted from the mark on the drawing, if the deletion would not materially alter the mark. See In re Sazerac Co., Inc., 136 USPQ 607 (TTAB 1963) and cases cited therein.

The symbols "TM," "SM," and the registration notice R must be deleted from the drawing.

Informational matter, such as net weight and volume statements, lists of contents, addresses, and similar matter, should also be deleted from the mark, unless it is truly part of a composite mark and the removal of this matter would alter the overall commercial impression. If unregistrable matter, including informational matter and the name of the goods, is incorporated in a composite mark in such a way that its removal would change the commercial impression of the mark or make it unlikely to be recognized, the matter may remain on the drawing and be disclaimed. See TMEP §1213.03(b) regarding disclaimer of such matter. However, this type of matter rarely is part of a composite mark.

Functional matter that is part of an otherwise registrable trade dress mark may also be removed or deleted from the drawing by depicting that matter in broken or dotted lines. Since functionality is an absolute bar to registration on the Principal Register or the Supplemental

Register, features of a trade dress mark that are deemed functional under trademark law are never capable of acquiring trademark significance and are not registrable. Therefore, such removal or deletion of the functional features generally will not be considered a material alteration of the mark, regardless of the filing basis of the application. See TMEP §1202.02(a). (a)(viii) regarding functionality and 1202.02(c)(i) regarding drawings in trade dress applications.

See TMEP §807.14(b) regarding deletion of previously registered matter.

807.14(b) Addition or Deletion of Previously Registered Matter

Addition. An amendment adding an element that the applicant has previously registered for the same goods or services may be permitted. The rationale is that "the addition of applicant's well-known registered mark to the mark sought to be registered ... is not a material change which would require republication of the mark." Florasynth Laboratories Inc. v. Mulhens, 122 USPQ 284 (Comm'r Pats. 1959) (addition of applicant's previously registered mark "4711" to the mark "ELAN" held not a material alteration). However, the addition of matter that the applicant has previously registered for different goods or services is not permissible. In re Hacot-Colombier, 105 F.3d 616, 620, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997); In re Nationwide Industries Inc., 6 USPQ2d 1882, 1886 (TTAB 1988). An amendment adding previously registered matter is also unacceptable if it substantially alters the original mark. In re John LaBatt Ltd., 26 USPQ2d 1077, 1078 (Comm'r Pats. 1992) ("Here, the applicant does not seek to merely add an element from one registration to another. Rather, the applicant seeks to eliminate its original mark, and substitute another. The exception to the material alteration rule clearly does not encompass cases where the original mark disappears.").

Deletion. The question of whether a proposed amendment to delete previously registered matter from a mark is a material alteration should be determined without regard to whether the matter to be deleted is the subject of an existing registration.

807.14(c) Addition or Deletion of Punctuation

Punctuation, such as quotation marks, hyphens, periods, commas, and exclamation marks generally does not significantly alter the commercial impression of the mark. See, e.g., In re Litehouse, Inc., 82 USPQ2d 1471 (TTAB 2007) and cases cited therein. See also In re Promo Ink, 78 USPQ2d 1301, 1305 (TTAB 2006) (the Board found the mark

PARTY AT A DISCOUNT! to be merely descriptive, specifically noting that "this punctuation mark does not significantly change the commercial impression of the mark. It would simply emphasize the descriptive nature of the mark to prospective purchasers...").

However, punctuation may be incorporated into a mark in such a way that the commercial impression of the mark would be changed by the addition or deletion of such punctuation. See In re Guitar Straps Online, LLC, 103 USPQ2d 1745, 1748 (TTAB 2012) (finding "the proposed addition of a question mark to the mark 'GOT STRAPS' constitutes a material alteration because it changes the commercial impression of the original mark from a declaratory statement to an interrogative phrase"); Richards-Wilcox Mfg. Co., 181 USPQ 735 (Comm'r Pats. 1974), overruled on other grounds, In re Umax Data System, Inc., 40 USPQ2d 1539 (Comm'r Pats. 1996) (proposed change of FYE[R-W]ALL and design to FYER-WALL in block letters denied as material alteration, in part, because brackets changed commercial impression of mark as the initial letters of applicant's name, "R" and "W," were no longer emphasized). For example, unlike most cases where the addition of an exclamation point does not affect the commercial impression of a mark, the addition of an exclamation point to the mark MOVE IT transforms the words from a mere command to relocate an object to an exclamatory statement . MOVE IT!. often used to order a person out of the way, and, therefore, changes the commercial impression of the mark.

Some other examples, though not exhaustive, are:

- the addition or deletion of a question mark, which changes a statement into a question or vice versa (See In re Guitar Straps Online, 103 USPQ2d at 1748);
- the addition or deletion of spaces between the syllables of a term, which may change the commercial impression created by the separate syllables or the unitary word; and
- the addition or deletion of a period before the term ".com," which can change wording to or from a website address.

See also TMEP §807.12(a)(i).(iii) regarding the role of punctuation in determining whether the mark on the drawing agrees with the mark on the specimen(s).

807.14(d) Amendments to Correct "Internal Inconsistencies"

The USPTO will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application. 37 C.F.R. §§2.72(a)(2), 2.72(b)(2), and 2.72(c)(2).

Prior to October 30, 1999, in certain limited circumstances, the USPTO would accept an amendment that corrected an "internal inconsistency" in an application as originally filed, without regard to the issue of material alteration. Because 37 C.F.R. §§2.72(b), (c), and (d) did not expressly prohibit an amendment that materially altered the mark on the original drawing, the USPTO would accept an amendment to correct an "internal inconsistency," even if the amendment materially altered the mark on the original drawing. An application was considered "internally inconsistent" if the mark on the original drawing did not agree with the mark on the specimen in an application based on use, or with the mark on the foreign registration in an application based on §44 of the Act. See In re ECCS Inc., 94 F.3d 1578, 39 USPQ2d 2001 (Fed. Cir. 1996); In re Dekra e.V., 44 USPQ2d 1693 (TTAB 1997).

Effective October 30, 1999, 37 C.F.R. §2.72 was amended to prohibit amendments that materially alter the mark on the drawing filed with the original application. Furthermore, 37 C.F.R. §2.52 was amended to state that the "drawing depicts the mark sought to be registered."

Accordingly, the USPTO no longer accepts amendments to cure "internal inconsistencies," if these amendments materially alter the mark on the original drawing. In re Who? Vision Systems, Inc., 57 USPQ2d 1211 (TTAB 2000). See also In re Tetrafluor Inc., 17 USPQ2d 1160 (Comm'r Pats. 1990) (examining attorney properly refused to accept amendment to "correct a typographical error" that materially altered mark on original drawing page).

If a paper application includes a separate drawing page showing a mark, and a different mark appears in the written application, the drawing controls for purposes of determining what the mark is. See TMEP §§202.01 and 807.01. In re L.G. Lavorazioni Grafite S.r.l., 61 USPQ2d 1063 (Dir USPTO 2001). Similarly, if an applicant enters a standard character mark, or attaches a digitized image of a mark, in the "Mark" field on a TEAS application, and a different mark appears in another field, the mark entered in the "Mark" field will control for purposes of determining what the mark is. The applicant may not amend the mark if the amendment is a material alteration of the mark on the drawing. For example, if the applicant submits a drawing page showing the word mark "ABC and design," the applicant may not amend the application to delete the wording "and design," and add a design feature to the letters "ABC." However, the applicant may amend the drawing to "ABC." In re Meditech Int'l Corp., 25 USPQ2d 1159 (TTAB 1990) (mark comprised of a design of blue star found to be a material alteration of the typed words "DESIGN OF BLUE STAR").

807.14(e) Amendments to Color Features of Marks

If a proposed amendment to a color feature of a mark does not change the commercial impression of the mark, the amendment is unlikely to have an adverse impact on public notice. In such cases, the mark need not be republished, and the proposed amendment would not be deemed a material alteration.

Whenever a proposed color amendment is refused as a material alteration, the examining attorney must clearly explain why the proposed amendment changes the meaning or overall impression of the mark, or impacts the likelihood of confusion analysis.

807.14(e)(i) Black-and-White Drawings

The amendment of a black-and-white special form drawing to one claiming a color(s) as a feature of the mark generally does not constitute a material alteration.

If a mark is initially depicted in a black-and-white special form drawing in which no color is claimed, the drawing is presumed to contemplate the use of the mark in any color, without limitation. See, e.g., In re Data Packaging Corp., 453 F.2d 1300, 1302, 172 USPQ 396, 397 (C.C.P.A. 1972). The amendment of the black-and-white drawing to one claiming a particular color as a feature of the mark is, therefore, a restriction or limitation of the applicant’s rights.

807.14(e)(ii) Marks that Include Color and Other Elements

The extent to which color contributes to the commercial impression created by a mark is often determined by the type of mark in question (i.e., word mark, design mark, or trade dress). In some cases, color may play only an incidental or insignificant part in creating the commercial impression of a mark, such as the color lettering of a word mark. In other cases, color is the only feature of the mark that creates a commercial impression, such as where the mark consists only of color(s) applied to goods or their packaging, or to articles used in the sale or advertising services.

Word Marks

In general, the addition, deletion, or amendment of color lettering in a word mark does not result in a material alteration of the mark. Word marks may appear as stylized marks in color lettering. With the possible exception of generic wording, as discussed below, the literal portions of word marks are likely to be the dominant portions that create the greatest commercial impression. Inter-State Oil Co., Inc.

v. Questor Corp., 209 USPQ 583, 586 (TTAB 1980). In most cases, the color in the lettering is unlikely to have a significant impact on the commercial impression created by the mark.

Exception. Generic Terms. Generic terms are incapable of functioning as marks denoting source, and are not registrable on the Principal Register under §2(f) or on the Supplemental Register. However, if the generic wording appears in color lettering, the color portion may be capable of functioning as a source indicator. See, e.g., Courtenay Communications Corp., v. Hall, 334 F.3d 210, 216, 67 USPQ2d 1210, 1214 (2nd Cir. 2003) and cases cited therein ("There are many examples of legally protected marks that combine generic wording with distinctive lettering, coloring, or other design elements."). With respect to such generic word marks, the color element of the wording is likely to be the more dominant portion in creating the commercial impression of the mark. Therefore, in cases where the entire literal portion is generic, a proposed amendment to the color portion of the word mark generally would be a material alteration.

Design Marks

In general, the addition, deletion, or amendment of color features in a design mark does not result in a material alteration of the mark. In a color design mark, the design portion is likely to be the most dominant portion of the mark in creating a commercial impression. Although the color portion is part of the mark, it only appears in the context of the design and is not a separable element. The color portion is, therefore, less likely than the design portion to play a significant role in likelihood of confusion or trademark selection considerations. For example, the fact that two different designs, such as a red hat design and a red boat design, may appear in identical colors is unlikely to result in a finding of likelihood of confusion. In contrast, if two boat designs are identical in stylization, it is likely that the designs would be held to be confusingly similar regardless of any differences in their respective colors.

Exception - Color Impacts the Meaning or Significance of the Mark. An amendment that causes the mark to have a new meaning or significance in the context of the goods or services is likely to be a material alteration. For example, the amendment of a blue colored drop for "spring water," which looks like a rain drop, to a red drop, which looks like blood, would probably be a material alteration because the change in the color of the drop has altered the meaning or commercial impression of the mark. An amendment of a rainbow design, consisting of an arc with a spectrum of colors, to a black or solid-colored arc,

would be a material alteration, regardless of the goods or services, because the amended mark is just an arc and is no longer identifiable as a rainbow.

Exception - Color is the Dominant Portion of the Mark. Generally, if the color portion to be amended constitutes the dominant or most significant part of the entire mark, it becomes more likely that the proposed color amendment is a material alteration. For example, if the design mark consists solely of a common geometric shape, the color element is likely to be the dominant element of the mark. As a result, amending the color of a common geometric shape is likely to be a material alteration.

Another factor to consider in assessing the dominance of the color element of the mark is the size or prominence of the color design or graphic element to be amended in proportion to the rest of the mark. For example, if it is clear that the mark consists of the overall color scheme of a product's trade dress, such as the product package or container, an amendment to a particular color element that is small or insignificant in proportion to the entire mark is unlikely to be a material alteration. Conversely, an amendment to a color element that is large in proportion to the entire mark, or is a dominant element of the overall color scheme, is more likely to be a material alteration. For example, if a mark consists solely of the color scheme or pattern of a package or container that is equally divided into two colors, amending one or both colors is more likely to be a material alteration.

807.14(e)(iii) Color Marks

The amendment of any color in a color mark is a prohibited material alteration.

Color marks are marks that consist solely of one or more colors used on particular objects or substances as a source identifier (as opposed to marks that include color in addition to other elements). See TMEP §1202.05 et seq. Color marks generally appear in a drawing with the outline or configuration of the goods on which they appear to show the placement of the color mark. However, the shape or configuration of the goods is not part of the mark. The mark is comprised solely of the color as applied to the object or substance, in the manner depicted and described, so that changing or amending the color of the mark would always change the entire commercial impression created by the mark.

An amendment of the mark to show the same color on a different object is also generally a material alteration (e.g., an amendment of a

drawing of a blue hammer to a blue saw). A color takes on the characteristics of the object to which it is applied, and the commercial impression of a color may change depending on the object to which it is applied. See In re Thrifty, Inc., 274 F.3d 1349, 1353, 61 USPQ2d 1121, 1124 (Fed. Cir. 2001) ("A word mark retains its same appearance when used on different objects, but color is not immediately distinguishable as a service mark when used in similar circumstances"); In re Hayes, 62 USPQ2d 1443 (TTAB 2002); TMEP §1202.05(c).

See TMEP §807.07(e) regarding black-and-white drawings in an application that includes a color claim, and TMEP §807.07(c) regarding incorrect color claims.

807.14(f) Material Alteration: Case References

Proposed amendments to marks were held to be material alterations in the following decisions: In re Thrifty, Inc., 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001) (amendment describing a mark as the color blue applied to an unlimited variety of objects found to be a material alteration of the mark on the original drawing, which depicted the color blue applied to a building); In re Hacot-Colombier, 105 F.3d 616, 41 USPQ2d 1523 (Fed. Cir. 1997) (proposed addition of house mark to conform to mark on foreign registration found to be material alteration of mark on drawing filed with original application); In re Guitar Straps Online, LLC, 103 USPQ2d 1745 (TTAB 2012) (proposed amendment from "GOT STRAPS" to "GOT STRAPS?" found to be a material alteration); In re Who? Vision Systems, Inc., 57 USPQ2d 1211 (TTAB 2000) (proposed amendment from "TACILESENSE" to "TACTILESENSE" found to be material alteration); In re Meditech Int'l Corp., 25 USPQ2d 1159, 1160 (TTAB 1990) ("a drawing consisting of a single blue star, as well as a drawing consisting of a number of blue stars, would both be considered material alterations vis-a-vis a drawing consisting of the typed words 'DESIGN OF A BLUE STAR'"); In re Vienna Sausage Mfg. Co., 16 USPQ2d 2044 (TTAB 1990) (addition of wording "MR. SEYMOUR" to design mark held to be a material alteration); In re The Wine Society of America Inc., 12 USPQ2d 1139 (TTAB 1989) (proposed amendment to replace typed drawing of "THE WINE SOCIETY OF AMERICA" with a special form drawing including those words with a crown design and a banner design bearing the words "IN VINO VERITAS" held to be a material alteration); In re Nationwide Industries, Inc., 6 USPQ2d 1882 (TTAB 1988) (addition of house mark "SNAP" to product mark "RUST BUSTER" held a material alteration); In re Pierce Foods Corp., 230 USPQ 307 (TTAB 1986)

(addition of house mark "PIERCE" to "CHIK'N-BAKE" held a material alteration).

Proposed amendments to marks were found not to constitute a material alteration in the following cases:

In re Innovative Companies, LLC, 88 USPQ2d 1095 (TTAB 2008) (amendment from "FREEDOMSTONE" to "FREEDOM STONE" held not a material alteration); Paris Glove of Canada, Ltd. v. SBC/Sportco Corp., 84 USPQ2d 1856, 1862 (TTAB 2007) ("AQUASTOP" depicted on one line in semicircular form not material alteration of "AQUA STOP" depicted on two lines in rectangular form; the Board found that "the commercial impression of the mark is dependent upon the literal terms AQUA STOP and not on the rectangular, semicircular or linear forms of display"); In re Finlay Fine Jewelry Corp., 41 USPQ2d 1152 (TTAB 1996) ("NEW YORK JEWELRY OUTLET" not material alteration of "NY JEWELRY OUTLET"); In re Larios S.A., 35 USPQ2d 1214 (TTAB 1995) ("VINO DE MALAGA LARIOS" and design not material alteration of "GRAN VINO MALAGA LARIOS" with similar design); Visa Int'l Service Ass'n v. Life-Code Systems, Inc., 220 USPQ 740 (TTAB 1983) (amendment inverting the design portion of the mark held not a material alteration).

807.15 Substitute Drawings

When requiring a substitute drawing, the examining attorney must inform the applicant of the specific reason for rejecting the existing drawing and explain what type of amendment is needed to comply with the rules.

If the examining attorney requires a change in the drawing, the applicant must submit a substitute drawing, except in the limited circumstances discussed in TMEP §807.16 in which the USPTO will amend or correct a drawing. The USPTO will not return the original drawing to the applicant. 37 C.F.R. §2.25.

If the examining attorney requires correction of a standard character drawing, the applicant may select "Standard Characters" in the Mark Information section of the TEAS Response to Office Action form and enter the proposed amended mark. If the required change is to a special-form drawing, the applicant may select "Special Form" in the Mark Information section of the TEAS Response to Office Action form and attach a digitized image of the substitute drawing to the form or submit a separate drawing page if the response is filed on paper. The USPTO will accept a substitute drawing embedded in a paper response to an Office action if the substitute drawing meets the requirements of 37 C.F.R. §2.51 and 2.52.

When the applicant voluntarily submits a substitute drawing, the examining attorney must determine whether the substitute drawing is acceptable. See TMEP §807.17 regarding the procedures for processing unacceptable amendments to drawings.

When a substitute drawing is submitted and accepted, the original drawing is replaced by the substitute drawing. The examining attorney must ensure that the automated records of the USPTO reflect the amended mark, and have the Trademark database corrected, if necessary. The original drawing remains in the record.

The examining attorney must also ensure that the mark drawing code is changed, if necessary. See TMEP §807.18 concerning mark drawing codes.

807.16 Amendment of Drawings by the USPTO

If the examining attorney requires correction of a standard character drawing, the applicant may submit a substitute drawing (see TMEP §807.15), or may request that the USPTO amend the drawing. If only a minor correction to a standard character drawing (such as deletion of the letters "TM") is required, the examining attorney may correct the drawing on his or her own initiative, or may require the applicant to submit a substitute drawing.

When correcting a standard character drawing, the examining attorney must create a new drawing page, and have the new drawing page scanned. The examining attorney must also ensure that the "Word Mark" field in the Trademark database is corrected.

When the correction involves a special form drawing, the examining attorney will delete matter from the drawing only if the matter to be deleted is sufficiently separate from the matter that is to remain. If the matter to be deleted is not sufficiently separate from the matter that is to remain, the applicant must submit a substitute drawing. If the examining attorney deletes matter from the drawing, the examining attorney must ensure that the corrected drawing is scanned, and that it appears in the Trademark database, before the mark is approved for publication or registration.

The examining attorney must also ensure that the mark drawing code is changed, if necessary. See TMEP §807.18 concerning mark drawing codes.

807.17 Procedures for Processing Unacceptable Amendments to Drawings

If an applicant submits an amendment to the drawing and the examining attorney determines that the amendment is unacceptable, the examining attorney must issue an action refusing to accept the amendment and advising the applicant that the amendment will not be entered, and

that the previous drawing remains the operative drawing. If the unacceptable amended drawing has been entered into the automated records of the USPTO, the examining attorney must ensure that the automated records are modified to reflect that the previous drawing is operative.

The applicant must respond to the Office action to avoid abandonment. If the applicant submits arguments in support of acceptance of the amendment and the examining attorney determines that the amendment is still unacceptable, the examining attorney must issue a final refusal of the amendment, if the application is otherwise in condition for final action.

807.18 Mark Drawing Code

Standard Character Drawings. Standard character drawings are coded in the USPTO's automated system as mark drawing code 4. Prior to November 2, 2003, typed drawings (see TMEP §807.03(i)) were coded as mark drawing code 1. Mark drawing code 1 is not available for applications filed on or after November 2, 2003. Applications that were filed before November 2, 2003, may be amended to mark drawing code 1, if appropriate for that drawing. Only mark drawing code 4 should be used for standard character drawings.

Special Form Drawings. Marks comprising only a design are coded as mark drawing code 2; marks comprising words plus a design are coded as mark drawing code 3; and marks comprising stylized letters and/or numerals with no design feature are coded as mark drawing code 5. All marks consisting of words, numerals, and/or diacritical symbols for which no standard character claim (see TMEP §807.03(a)) has been submitted are coded as mark drawing code 5.

Non-Visual Marks. "Drawings" of non-visual marks (see TMEP §807.09) are coded as mark drawing code 6.

808 Description of Mark

37 CFR §2.37

A description of the mark must be included if the mark is not in standard characters. In an application where the mark is in standard characters, a description may be included and must be included if required by the trademark examining attorney.

37 CFR §2.52(b)(5) Description of mark.

A description of the mark must be included.

808.01 Guidelines for Requiring Description

For applications filed on or after May 13, 2008, a description of the mark is required for any mark not in standard characters.

Therefore, the examining attorney must require a description of the mark if:

- the applicant is claiming a particular font style, size, or color of words, letters, or numbers (37 C.F.R. §2.52(a));
- the mark contains a design element;
- the mark includes non-Latin characters;
- the mark includes non-Roman or non-Arabic numerals;
- the mark includes uncommon punctuation or diacritical marks;
- the mark is three-dimensional, or is a configuration of the goods or packaging (TMEP §807.10 and 1202.02(c)(ii));
- the drawing includes broken lines to show placement or to indicate a portion of the product or packaging that is not part of the mark (TMEP §807.08 and 1202.02(c)(ii));
- the mark includes color (TMEP §807.07(a) and 1202.05(e));
- the mark includes motion (TMEP §807.11);
- the mark is a sound, scent, or non-visual mark (TMEP §807.09);
- the mark appears in standard characters, but an element of the mark is unclear or ambiguous; or
- the mark consists of characters from the standard character set (TMEP §807.03(b)), but the characters are displayed in a manner that affects the meaning or significantly contributes to the overall commercial impression of the mark, such as using standard characters that create emoticons (TMEP §807.03(c)).

37 C.F.R. §§2.37 and 2.52.

808.01(a) Meaning of Term in Mark

A statement that a term has no meaning in the relevant industry should not be entered as a description of the mark, nor should it be printed. If such a statement is entered as a description of the mark, the

examining attorney must ensure that the statement is deleted from the "Description of the Mark" field in the Trademark database and enter an appropriate Note to the File in the record. The document containing the information deleted from the Trademark database will remain of record for informational purposes. See TMEP §808.03 regarding printing of descriptions of the mark.

See TMEP §809 et seq. regarding translation and transliteration of non-English wording and non-Latin characters.

808.01(b) Lining and Stippling Statements for Drawings

Current Practice. For applications filed on or after November 2, 2003, the USPTO does not accept black-and-white drawings lined for color. 37 C.F.R. §2.52(b)(1); TMEP §807.07(a). Thus, the examining attorney should not require the applicant to enter a statement that the lining or stippling represents shading or is a feature of the mark, unless the examining attorney believes such a statement is necessary to accurately describe the mark.

See TMEP §808.03 et seq. and 817 regarding printing of lining and stippling statements and other descriptions of the mark.

Previous Practice. Prior to October 30, 1999, an applicant who wanted to show color in a mark was required to use the USPTO's color lining system. The color lining system required applicants to line their drawings using certain patterns designated for certain colors, and to provide a color lining statement describing where the colors appeared. The color lining system was deleted from the rule effective October 30, 1999; however, during a transitional period between October 30, 1999 and November 2, 2003, the USPTO continued to accept drawings that showed color by using this lining system. See notice at 64 Fed. Reg. 48900, 48903 (Sept. 8, 1999) and 1226 TMOG 103, 106 (Sept. 28, 1999). When an applicant submitted a drawing that included lining that was a feature of the mark and was not intended to indicate color, the applicant was required to submit a statement to that effect, so the record would be clear as to what applicant was claiming as the mark. Similarly, when an applicant submitted a drawing that included stippling for shading purposes, the applicant was required to submit a statement to that effect.

808.02 Description Must Be Accurate and Concise

If a description of a mark is placed in the record, the description should state clearly and accurately what the mark comprises, and should not create a misleading impression by either positive statement or

omission.

Statements regarding how a mark is used (e.g., that the mark is not used in a particular color) are not appropriate and, if submitted, must not be printed on the registration certificate. See TMEP § 808.03(g).

The description should describe all significant aspects of the mark, including both literal elements and design elements. Insignificant features need not be included in a description.

When a mark includes a large number of elements, they are not all necessarily significant. For example, background design elements can sometimes be considered insignificant if they do not change the overall commercial impression of the mark. In addition, it may be unnecessary to describe the placement of repetitive literal or design elements within a mark, as long as the description generally characterizes them and explains that the elements are repeated. Similarly, when a mark contains a substantial number of design elements, it may only be necessary to generally state in the description those elements that capture the essence of the mark. Please note that because of the requirement to describe where colors appear in the mark, marks that include color will generally have a more detailed description. 37 C.F.R. §2.52(b)(1). See TMEP §807.07(a) et seq. regarding requirements for color drawings.

If a mark contains both wording and design features, the description should describe both aspects of the mark in order to be complete. The rare exception is for wording that is

(1) not significant to the mark; and

(2) would not be searched (e.g., purely informational matter such as product weight, lists of contents, and business addresses). The better - but not mandatory - practice with descriptions of non-standard character marks that include wording is to indicate that the wording is "in stylized font."

Generally, if the applicant has not made a color claim, the description of the mark should not mention color, because a reference to color in the description of a non-colored mark creates a misleading impression. See TMEP §807.07 et seq. regarding color. However, in some cases, it may be appropriate to submit a black-and-white drawing and a description of the mark that refers to black, white, and/or gray if the applicant states that color is not claimed as a feature of the mark. See TMEP §807.07(f) et seq. regarding applications that include mark descriptions that refer to black, white, or gray when there is no corresponding color claim.

If a trademark or a service mark that is registered to an entity other than the applicant is used in the description of the mark, the examining attorney must require that it be deleted and that generic wording be substituted.

It is inappropriate to use a registered mark in a description because such a mark indicates origin in only one party and cannot be used to describe a mark used in connection with goods or services that originate in a party other than the registrant. Cf. Camloc Fastener Corp. v. Grant, 119 USPQ 264, 265, n.1 (TTAB 1958) (noting that if applicant prevailed in opposition proceeding, it would be required to delete registered mark from the identification of goods set forth in the application).

A description cannot be used to restrict the likely public perception of a mark. A mark's meaning is based on the impression actually created by the mark in the minds of consumers, not on the impression that the applicant states the mark is intended to convey. However, an examining attorney may defer to the applicant's phrasing of a description, so long as the description is accurate and complete. For example, if an element in a mark could reasonably be characterized in more than one way, the examining attorney should accept the applicant's selection of one characterization over the other in the description.

The following are examples of descriptions containing an appropriate level of detail:

[Figure is omitted]

The mark consists of a group of children holding hands.

Note: The description would be incomplete if it merely stated that the mark consisted of children; however, it is not necessary to describe the individual details of each child.

[Figure is omitted]

The mark consists of a red background; the stylized word "HOSPITAL" in white letters outlined in black with the letter "S" in the form of a dollar sign and letter "L" in the form of a cast; a man with red hair in a green gown with an orange and silver stethoscope and silver headband mirror; man wearing a blue cap, gown and mask with silver scissors; silver medical tree with white, pink, and gold intravenous pouch, fluid and tube; gray and gold crutch; nurse with yellow hair wearing pink clothing and brown clip board; orange and black scale with an orange man wearing purple pants and orange robe; nurse with yellow hair and white clothing pushing a wheelchair with a man in green clothing with white cast and gold cane; white and blue bed pan; yellow and black buildings and white signs with stylized words

“EMERGENCY HOSPITAL” in black, and green vegetation; white and pink emergency vehicle with purple tires; a green air tank, orange stretcher, green golf club bag with white balls and pink clubs; nurse with yellow hair and blue clothing holding a white syringe with pink fluid; and an orange man dressed in blue with a white and red thermometer.

Note: This level of detail is necessary because the description must incorporate the color location statement (see TMEP §807.07(a)(ii).

[Figure is omitted]

The mark consists of the stylized word “HOSPITAL” with the letter “S” in the form of a dollar sign and letter “L” in the form of a cast surrounded by a border containing a variety of images relating to a hospital including highly stylized images of doctors, nurses, patients, hospital equipment, an ambulance and building design containing the wording “EMERGENCY HOSPITAL”.

Note: Since the mark is not in color, it is not necessary to describe every element of the mark. Instead, due to the large number of elements in the mark, it is only necessary to describe the wording in the mark and generally characterize the background elements.

[Figure is omitted]

The mark consists of a group of stylized people each in the shape of a lowercase letter "E" and a fanciful dog also in the shape of a lowercase letter "E".

Note: The description would be incomplete if it did not indicate that the figures are in the shape of a lowercase letter “E”; however, it is not necessary to describe the individual details or placement of each figure.

[Figure is omitted]

The mark consists of the stylized wording “BETSTONE” on a background design.

Note: The description would be incomplete if it did not indicate that the mark consists of more than wording; however, it is not necessary to specifically identify a nondescript common geometric carrier.

[Figure is omitted]

The mark consists of Chinese characters and the stylized wording “M ITCHELL”.

Note: It is not necessary to include in the description of the mark the translation or transliteration of the Chinese characters. Though these elements would be searched, they are provided in the translation/transliteration statement.

[Figure is omitted]

The mark consists of an oval design with the stylized wording “OUTWIT

OUTPLAY" and "OUTLAST", the design of a stylized jungle containing a gorilla, elephants, and snakes and the stylized wording "SURVIVOR GABON EARTH'S LAST EDEN" within the oval.

Note: The description would be incomplete if it did not describe both the wording and design elements of the mark; however, it is not necessary to describe the placement of the elements within the oval. See TMEP §808.03 regarding the examination procedure for descriptions.

808.03 Examination Procedure for Descriptions

After having determined that a description of the mark is required because the mark is not in standard characters, the examining attorney must then consider whether the description should be printed in the Official Gazette and on the registration certificate. Accurate and complete descriptions may always be printed. In other situations, the decision to print. and to modify the description so that it is appropriate for printing. depends on whether, in view of the nature or drawing of the particular mark in question, a description is necessary to clarify the mark for the public.

For example, pursuant to longstanding policy, a description must always be printed if:

(1) The mark is three-dimensional, or a configuration of the goods or packaging (TMEP §807.10 and 1202.02(c)(ii));

(2) The drawing includes broken lines to show position or placement or to indicate a portion of the product or packaging that is not part of the mark (TMEP §807.08 and 1202.02(c)(ii));

(3) The mark includes color (TMEP §807.07(a) and 1202.05(e));

(4) The mark includes motion (TMEP §807.11); or

(5) The mark is a sound, scent, or other non-visual mark (37 C.F.R. §2.37, 2.52(e); TMEP §807.09 and 808.01).

In rare instances, a description must be printed when the mark consists of characters from the standard character set, but the characters are displayed in a manner that affects the meaning or significantly contributes to the overall commercial impression of the mark, for example, emoticons such as :) or :(. Note that a standard character claim is not acceptable where the characters form shapes or designs, such as emoticons (TMEP §807.03(c)).

If the examining attorney determines that a description provided by the applicant will not be printed, notice to the applicant is not required. The examining attorney must either enter a Note to the File in the record stating that the description should not be printed or issue an examiner's amendment stating that the description will not

be printed. Generally, the examining attorney may use either option, but a Note to the File should be used where the examining attorney will issue an Office action regarding other matters. An examiner's amendment without the prior approval of the applicant (see TMEP §707.02) may be used where it is unnecessary to issue an Office action or a regular examiner's amendment regarding other matters.

The examining attorney must then either:

(1) delete the mark description from the "Description" field in the relevant Trademark database; or

(2) send the examiner's amendment or an e-mail instruction (where only a Note to the File was entered) to the LIE for appropriate action.

The foregoing procedures ensure that a description not intended for printing will not be printed. They further ensure that at the publication review stage, the Note to the File or examiner's amendment reflects the determination not to print.

The following sections explain how to handle various scenarios relating to the description requirement.

Regarding TEAS applications, please note that although TEAS Plus applications for non-standard character marks cannot be validated and filed unless an entry is made in the "Description" field, "regular" TEAS applications can be filed without entry of a description. The "regular" TEAS application will, however, display a warning message in non-standard character mark applications where no entry has been made in the "Description of the Mark" field. The warning message will indicate that although the description is not a filing date requirement, it must be provided at some point in the prosecution, or the application will not proceed to registration (assuming, of course, that all other requirements have been satisfied).

808.03(a) Accurate and Complete Descriptions

If the application contains an accurate and complete description of the mark, no further action regarding the description is necessary and it will be printed in the Official Gazette and on the certificate of registration.

Obvious misspellings, typographical errors and redundancies in an otherwise accurate and complete description may be corrected by examiner's amendment without the prior approval of the applicant (see TMEP §707.02).

The following are examples of accurate and complete descriptions:

[Figure is omitted]

The mark consists of the words "SUSHI SUSHI" represented in stylized

font.
Note: If an application containing this mark was submitted without a description, the description could be added by examiner's amendment without the prior approval of the applicant (see TMEP §§707.02, 808.03(b)).
[Figure is omitted]
The mark consists of the wording "HEIDI.COM" in stylized font appearing below a stylized design of a girl's head.
[Figure is omitted]
The mark consists of the word "LULU" in stylized font having a backwards second "L" adjacent to an abstract symbol of a sun and the word "COMPANY" in stylized font positioned underneath the second "U" and the sun.
[Figure is omitted]
The mark consists of an image of a building with a window with four panes with the words "JUST SMILES" in a large, stylized font with lines above the dot in the letter "I" representing shine or glow and the words "DENTISTRY FOR FAMILIES ON THE GO" in smaller, block-letter font.
[Figure is omitted]
The mark consists of a series of circles stylistically representing a group of bubbles, such series being located on the handle of a water bottle. The outline of the bottle depicted in broken lines in the drawing is intended to show the placement of the mark when used and is not part of the mark.
Note: Any mark whose drawing includes broken lines must have a printed description.
[Figure is omitted]
The mark consists of the three-dimensional configuration of a recessed window portion of a thermostat. The portion of the thermostat that comprises the mark is shown in solid lines in the drawing. The matter shown in broken lines in the drawing is not part of the mark. The dotted lines merely show the position of the mark in the configuration of the goods.
Note: Any mark whose drawing includes broken lines must have a printed description.
[Figure is omitted]
The mark consists of the color kelly green applied to the vehicles used in performing pest-control services.
The matter shown in broken lines serves to show the placement of the mark on the vehicle and is not part of the mark.

Note: Any mark whose drawing includes broken lines must have a printed description.

808.03(b) No Description in Application

If the description is not submitted with the initial application, the examining attorney must ensure that a description is included in the record. Applications that include vague statements such as "the mark contains wording and a design," "the mark contains a miscellaneous design," and "the mark consists of words" should be treated as the equivalent of accurate but incomplete descriptions.

For TEAS applications for marks that consist only of wording in stylized font, with no design element, the applicant's completion of the "Literal Element" field may be accepted for purposes of compliance with the rule, even if an unacceptably vague statement or no information is entered in the "Description of the Mark" field. In these cases, where the description need not be printed, the "Literal Element" information need not be copied into the "Description of the Mark" field in the relevant Trademark database.

Likewise, for §66(a) applications for marks that consist only of wording in stylized font, with no design element, the applicant's completion of the "Textual Elements of Mark" field may be accepted for purposes of compliance with the rule. In these cases, where the description need not be printed, the "Textual Elements of Mark" information need not be copied into the "Description" field in the relevant Trademark database.

Similarly, in any application for a mark that includes color, the applicant's provision of a color location statement (either in the original application or in response to a requirement) may be accepted for purposes of compliance with the rule. For TEAS applications, a color location statement provided in the initial application will automatically appear in the "Description" field in the relevant Trademark database and should remain there for printing. For paper applications, the color location statement is placed in the "Description" field in the relevant Trademark database and should remain there for printing.

Where an Office action or regular examiner's amendment is otherwise unnecessary, in the following situations the examining attorney may enter a description by examiner's amendment without the prior approval of the applicant (as with any examiner's amendment, the examining attorney is thereby providing the applicant with notice and an opportunity to disagree):

- The mark consists only of wording in stylized font, with no color claim and with no design element (note that an examiner's amendment would only be necessary where the applicant also failed to provide the "Literal Element," which can serve as a description for this type of mark);
- The mark includes no color claim and consists only of wording in combination with underlining or a common geometric shape used as a vehicle for the display of the wording; or
- The record already contains an informal indication of what the mark comprises, such as where the cover letter of a paper application refers to the mark as "a stylized golf ball design."

See TMEP §707.02.

The following are examples of descriptions that may be entered by examiner's amendment without prior approval of the applicant:

[Figure is omitted]

The mark consists of the stylized wording "GROB" within a rectangle.

[Figure is omitted]

The mark consists of the stylized wording "LIGHTYEAR ALLIANCE" with a curved line to the right of the wording.

[Figure is omitted]

The mark consists of the stylized wording "GSC PARTNERS" with a curved line between "GSC" and "PARTNERS".

[Figure is omitted]

The mark consists of the stylized letters "P" "A" "C" "T" each within a shaded circle and the stylized wording "PURE ADVANCED COSMETIC TECHNOLOGY" underneath.

[Figure is omitted]

The mark consists of the stylized wording "H BLOCK" within a square with a horizontal line between "H"
and "BLOCK".

[Figure is omitted]

The mark consists of the stylized wording "REECE & NICHOLS" with the ampersand within a square.

In the foregoing examples, a description is necessary to comply with the requirements of the rule, but need not be printed in the Official Gazette or on the registration. In such cases, the "no-call" examiner's amendment (TMEP §707.02) should neither be sent to the LIE nor entered for printing by the examining attorney.

Where printing of the description is unnecessary, the examiner's amendment must indicate that the description will not be printed in the Official Gazette or on the registration certificate. This

indication in the examiner's amendment ensures that at the publication review stage, the description is not mistakenly entered for printing. On the other hand, where an Office action or examiner's amendment regarding other matters is necessary, a description should be required in the Office action or entered by examiner's amendment. If a response to an Office action requiring the description fails to include a description but resolves all other issues, and one of the special situations set out above applies, the examining attorney may do a "no-call" examiner's amendment (TMEP §707.02) at that time. If all other issues have not been resolved, the requirement for a description must be maintained or made final, as appropriate.

For marks that include a design element of any kind that are not covered by the special situations set out above, the examining attorney must either issue a requirement for the description, or enter a description by examiner's amendment, with the prior approval of the applicant. Once a description of the mark is received in response to an Office action or through an examiner's amendment, the examining attorney must follow the procedures set forth in the other parts of TMEP §808.03(c)-(d) (i.e., determine whether the description is accurate and complete, accurate and incomplete, or inaccurate, and proceed accordingly).

808.03(c) Accurate But Incomplete Description in Application or Amendment

If the description accurately describes some elements of the proposed mark but does not describe other elements, the USPTO will require amendment to complete the description only if the description will be printed in the Official Gazette and on the certificate of registration.

808.03(c)(i) Accurate But Incomplete Descriptions in Cases Where a Description is Needed to Clarify the Mark and Must be Printed

If the examining attorney determines that a description must be printed in the Official Gazette and on the registration certificate because it is necessary to clarify the proposed mark, the examining attorney needs to ensure that the description accurately addresses all significant elements of the mark. If the description is incomplete, the examining attorney must require amendment to ensure that the description is complete and accurate. The amendment may be done by examiner's amendment, with the prior approval of the applicant.

The following is an example of an accurate but incomplete description where a corrected description must be printed:

[Figure is omitted]
The mark consists of a hot dog in a bun with face, hands and feet wearing a grass skirt and grass hat.
Note: This description is incomplete because it does not reference the two beach umbrellas and palm trees behind the hot dog. It must be completed and printed because it is necessary to clarify the mark.

808.03(c)(ii) Accurate But Incomplete Descriptions in Cases Where a Description Need Not Be Printed

Alternatively, if the examining attorney determines that the description need not be printed, the examining attorney need not require the applicant to amend or withdraw an incomplete or inartfully worded description, so long as the description does not misdescribe those elements of the mark addressed in the description. In such a case, although the incomplete description remains part of the application record, it must not be printed in the Official Gazette and on the certificate of registration. The examining attorney must follow the procedure described in §808.03 for descriptions provided by the applicant that need not be printed.
The following are examples of accurate but incomplete descriptions where a description need not be printed:
[Figure is omitted]
The mark consists of a dog design.
Note: This description is incomplete because it does not include the wording in the mark. Unless it is amended to be complete, the description must not be printed in the Official Gazette and certificate of registration because it is not necessary to clarify the proposed mark.
[Figure is omitted]
The mark consists of the word "SUSHI" represented in stylized font.
Note: This description is incomplete because it does not include the second "SUSHI". Unless it is amended
to be complete, the description must not be printed.

808.03(d) Inaccurate Description in Application or Amendment

If the examining attorney determines that the description misdescribes some element of the mark, such that the description is inconsistent with the mark shown on the drawing, the examining attorney must require the applicant to amend the description, even if the description will not be printed. An inaccurate description must be corrected to accurately reflect the mark regardless of whether the description will

be printed. The amendment of the description may be done by examiner's amendment, with the prior approval of the applicant.

The following are examples of inaccurate descriptions:

[Figure is omitted]

The mark consists of two overlapping triangles with two stars positioned below.

Note: This description is inaccurate because there are three stars in the mark.

[Figure is omitted]

The mark consists of the design of a single grape leaf with an attached vine in front of a full moon design.

Note: This description is inaccurate because the mark contains a crescent moon design.

[Figure is omitted]

The mark consists of the stylized wording "FLORIDA'S FOOD SERVICE" to the left of a stylized chef design.

Note: This description is inaccurate because the term "FLORIDA" includes an "'S" in the description. The change in the spelling of "FLORIDA" would not be considered an obvious misspelling because it is unclear whether the applicant intended for the mark to include the "'S". Either the mark or the description must be amended.

[Figure is omitted]

The mark consists of the stylized wording "FLOODS FOR LESS" with a pool of water under the wording.

Note: This description is inaccurate because the mark includes the numeral "4" rather than the word "FOR".

[Figure is omitted]

The mark consists of the stylized wording "C THREE REDUCT".

Note: This description is inaccurate because the mark includes the superscript number "3" following the letter "C" rather than the word "THREE". A proper description could refer to the numeral as "3" or "CUBED".

808.03(e) Amending Descriptions

Generally, amending the description of the mark is liberally permitted, so long as the drawing supports the description. In rare cases where the amendment of the description constitutes a material alteration of the mark on the drawing or of the description filed with the original application, amendment will not be permitted.

See 37 C.F.R. §2.72; In re Thrifty, Inc., 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001). See TMEP §807.14 et seq. regarding material

alteration.

808.03(f) Updating Design Coding

Particularly when a description is not included in the initial application, the examining attorney should ensure that the design coding is updated in accordance with the description, where appropriate and necessary.

The examining attorney should ensure the design coding of all significant elements of the mark, specifically those that the examining attorney used in conducting a search. The examining attorney may update the "Design Code" field by making the appropriate entries in the Trademark database or by sending an e-mail message to the internal TM Design Code Correct mailbox that contains instructions regarding the changes to be made.

If additional codes beyond those searched have been coded for a particular design, deleting the extra codes is unnecessary.

808.03(g) Unacceptable Statements in Mark Descriptions

A statement that purports to limit a mark by excluding color(s) or other features that do not appear in a mark is not appropriate for inclusion in a description of a mark. Statements regarding any purported "exclusion" usually feature a limitation on the mark, often in an attempt to satisfy third parties that have infringement concerns. In some cases, the applicant has a written agreement with a potential opposer that addresses this issue. However, descriptions are solely to be used to describe the mark shown in the drawing and are not to be used to describe how the mark does not and will not appear. See TMEP §808.02.

Although these additional restrictive statements are uncommon, when they do appear the facts are generally as follows. The mark features a design and color is not claimed as a feature of the mark. The description of the mark is amended by the applicant to include a reference to a color or colors that the mark will not comprise. This type of statement is inappropriate and must be deleted from the description. For example, the following type of statement must not be included in a description of a mark: "The application and any registration resulting from the application exclude the color purple within or as part of the (design element) in the mark."

Thus, when the applicant has not made a color claim, the description of the mark must not mention color(s), because reference to color in the description of a non-color mark creates a misleading impression.

TMEP §807.07 and 808.02.

Accordingly, the description may not be used to state any limitations as to how a mark does not and will not appear. Any such statements must be deleted from the description if it is determined that the description needs to be printed. TMEP §§808.02, 808.03. Although applicants may include such restrictive statements in the application record, they are not appropriate for the registration certificate. If it is determined that the description does not need to be printed, the description does not need to be amended to delete the restrictive statement unless some part of the description is inaccurate, in which case the restrictive statement must be deleted. TMEP §808.03(d).

809 Translation and Transliteration of Non-English Wording in Mark

An application to register a mark that includes non-English wording must include an English translation of that wording. 37 C.F.R. §2.32(a)(9). This requirement also applies to compound word marks comprised of two or more distinct words (or words and syllables) that are represented as one word, in which one or more of the words in the mark appears to be non-English wording that would clearly be perceived as a distinct word(s) within the compound. For example, if the mark is GRINCANTCOMPUTERS, the commercial impression is that the mark is comprised of the words GRINCANT and COMPUTERS. In such a case, the application must include a translation of the French word GRINCANT, which means "creaking" in English.

If, however, the combination either suggests a single word or conveys a commercial impression other than a mark comprised of two separate words, no translation of the non-English portion should be required. Thus, if the mark is FELIZCITY, the commercial impression is that the mark is a play on the word "felicity" and no translation of the term "feliz" (which means "happy" in English) is required. See TMEP §809.01 regarding the procedure for examining applications for marks with non-English wording that do not include an accurate translation.

Similarly, an application for a mark that comprises non-Latin characters must include a transliteration of those characters, and either an English translation or a statement that this portion of the mark has no meaning in a foreign language. 37 C.F.R. §2.32(a)(10). A transliteration is the phonetic spelling, in corresponding Latin characters, of the word(s) in the mark that are in non-Latin characters.

Examples of statements translating and transliterating a word in non-Latin characters are as follows:

The non-Latin characters in the mark transliterate to "Asahi" and this means "Rising Sun" in English.

Or The non-Latin characters in the mark transliterate to "Weidamei" and this has no meaning in a foreign language.

If an application for a mark comprising non-English wording or non-Latin characters does not include an accurate translation and/or transliteration, the examining attorney must require the applicant to submit a statement of translation/transliteration.

37 C.F.R. §2.32(a)(9) and (10).

When an application or certificate of registration includes a translation, both the non-English wording and the English translation will appear in the records of the USPTO. See TMEP §809.03 regarding the printing of the translation/transliteration statement in the

Official Gazette and on the registration certificate.

In a TEAS Plus application, if the mark includes non-English wording, the initial application must include an English translation of that wording. 37 C.F.R. §2.22(a)(16). If the mark includes non-Latin characters, the application must include a transliteration of those characters. 37 C.F.R. §2.22(a)(17). If the applicant does not meet these requirements, the applicant must pay a processing fee per class to have the application examined as a regular TEAS application. See TMEP §819.01(m) for further information on translation and transliteration statements in TEAS Plus applications.

See TMEP §809.01(b) regarding the limited exceptions to the requirement to provide a translation of foreign wording in the mark.

809.01 Examining Applications for Marks Comprising Non-English Wording that Do Not Include an Accurate Translation or Transliteration

In order to properly examine applications with non-English wording, the translation and transliteration of the non-English wording must be determined prior to performing a search of the mark. This is critical because the foreign equivalent of an English term may be regarded in the same way as the English term for purposes of determining descriptiveness, requiring disclaimer, and citing marks under §2(d) of the Act (see, e.g., TMEP §1207.01(b)(vi) and 1209.03(g)). Therefore, if there is no translation and/or transliteration in the initial application, the examining attorney should ascertain the meaning of non-English wording before searching the mark.

The examining attorney may obtain the meaning of non-English wording through sources such as foreign language dictionaries and search engines. The examining attorney may also consult the Trademark Librarian or the Translations Branch, as appropriate.

If research by the examining attorney, the Trademark Library, and/or the Translations Branch indicates that the term has no meaning or no clear and exact equivalent in a foreign language, although no inquiry regarding the meaning in a foreign language is necessary, the examining attorney has the discretion under 37 C.F.R. §2.61(b) to make such an inquiry. The examining attorney should enter a Note to the File in the record indicating that the term has no meaning in a foreign language. In such cases, a statement regarding meaning should not be entered for printing in the Official Gazette.

If the examining attorney determines the meaning of the non-English term(s), he or she must search the terms as they appear in the application, the transliterated terms, and the English translation(s)

for the terms, as applicable. The examining attorney must also require (under 37 C.F.R. §2.61(b)) that an accurate translation be made of record by the applicant using the researched translation or other accurate translation provided by applicant. If the applicant disputes a translation obtained through online resources, the examining attorney should supplement the record with evidence from the Trademark Librarian and/or the Translations Branch.

If the translation is provided or supplemented after the examining attorney has conducted a search for conflicting marks, the examining attorney must conduct a new search of the transliterated terms and/or the English translation(s) for the terms, as applicable.

809.01(a) Inquiry/Applicant's Response Regarding Meaning in a Foreign Language

If it is necessary to make a separate inquiry regarding the meaning of non-English wording, the examining attorney should provide the applicant with the correct format for a translation or transliteration statement.

See TMEP §809.03. If a general inquiry is made regarding meaning under 37 C.F.R. §2.61(b) (i.e., whether the term has significance in the relevant trade, any geographical significance, or any meaning in a foreign language), the applicant's response may not be in the correct format for the translation or transliteration statement. If necessary, the examining attorney should ensure that the translation or transliteration is entered in the relevant Trademark database, using the appropriate format. See TMEP §809.03. It is not necessary to issue an examiner's amendment in such cases.

If the applicant responds to an inquiry regarding the meaning of non-English wording by stating that "the term has no significance in the relevant trade, no geographical significance, and no meaning in a foreign language," the statement should not be entered into the relevant Trademark database. Similarly, if the applicant responds that "the mark has only trademark significance," or in some similar manner, the examining attorney should not enter the statement in the Trademark database.

809.01(b) Limited Exceptions to Rules for Translations

There are three limited exceptions to the general rule requiring that all foreign wording be translated. See TMEP §809.01(b)(i) through (iii).

809.01(b)(i) Foreign Terms Appearing in English Dictionary

It is generally unnecessary to provide a translation of a foreign term if the term appears in an English dictionary (e.g., croissant, fiesta or flambe). However, if a term that appears in the English dictionary appears in a mark as part of a foreign idiomatic phrase or other unitary expression, a translation of the idiomatic phrase or unitary expression is required. It would be illogical to break the phrase into its individual word elements and to translate only the individual words that do not appear in the English dictionary. Such a translation would serve no useful purpose because it would not convey the true commercial impression of the phrase.

Example: If the mark included the phrase "la fiesta grande," an appropriate translation would be "the great celebration" or possibly "the great fiesta." It would be inappropriate to translate only "la" and "grande." The ultimate goal is to provide a translation that reflects the true meaning of the non-English wording in the mark and the commercial impression made by the entire phrase. See TMEP §809.01 regarding equivalency in translation.

809.01(b)(ii) Foreign Articles or Prepositions Combined with English Terms

It is generally unnecessary to provide a translation of foreign articles or prepositions, such as "de," "le," "la," or "il," when combined with English terms, because their meaning is generally understood and, in this context, they are being used to convey an impression different from their foreign meaning. For example, in the mark "LE CASE," it is unnecessary to translate "LE."

809.01(b)(iii) Words From Dead or Obscure Languages

It is generally not necessary to translate words from dead or obscure languages. Cf. Gen. Cigar Co.v. G.D.M. Inc., 988 F. Supp. 647, 45 USPQ2d 1481 (S.D.N.Y. 1997) (applicant had no obligation to disclose that the term COHIBA for cigars means "tobacco" in the language of the Taino Indians in the Dominican Republic, because cigar smokers in the United States would not be aware of such a meaning). See TMEP §1207.01(b)(vi) and 1209.03(g) regarding the applicability of the doctrine of foreign equivalents to words from dead or obscure languages. The determination of whether a language is "dead" must be made on a case by case basis, based upon the meaning that the term would have to the relevant purchasing public.

Example: Latin is generally considered a dead language. However, if

there is evidence that a Latin term is still in use by the relevant purchasing public (e.g., if the term appears in news articles), then a Latin term is not considered dead. The same analysis should be applied to other uncommon languages.

809.02 Equivalency in Translation

The translation that should be relied upon in examination is the English meaning that has significance in the United States as the equivalent of the meaning in the non-English language. The following are examples of equivalency in translation:

(1) "Chat Noir" - The exact equivalent in English is "black cat," and this translation would undoubtedly be recognized by the purchasing public in this country. Ex parte Odol-Werke Wien Gesellschaft M.B.H., 111 USPQ 286 (Comm'r Pats. 1956) (mark "Chat Noir" refused registration because the words "Black Cat" were already registered for related goods).

(2) "Mais Oui" - The English equivalent of the phrase "mais oui" is "why, certainly," or "why, of course," and not the literal translation "but yes." In re Societe Des Parfums Schiaparelli, S.A., 122 USPQ 349 (TTAB 1959). A satisfactory translation must be some normal English expression that will be the equivalent in meaning of the term "mais oui" in French.

(3) "Schwarzkopf" - The term can be literally translated as "black head," but, even to German-speaking persons, the primary significance of "Schwarzkopf" is most likely that of a surname. Neither English nor foreign surnames should be translated. See TMEP §1211 regarding surnames.

If any question arises as to the proper translation of a mark, the examining attorney may consult the Trademark Library or Translations Branch of the USPTO. The determination of the appropriate translation often requires consideration of the meaning in relation to the goods and/or services. See TMEP §1207.01(b)(vi) regarding the use of the doctrine of foreign equivalents in determining likelihood of confusion under 15 U.S.C. §1052(d), TMEP §1209.03(g) regarding the doctrine of foreign equivalents in determining questions of descriptiveness under 15 U.S.C. §1052(e)(1), and TMEP §1211.01(a)(vii) regarding the doctrine of foreign equivalents in determining whether a term is primarily merely a surname under 15 U.S.C. §1052(e)(4).

809.03 Printing of Translations and Transliterations

Generally, non-English wording in a mark must be translated into

English and the translation (and transliteration, if applicable) must be printed in the Official Gazette and on the registration certificate. A statement that a term has no meaning in a foreign language also should be printed.

Sometimes, translations that are not precise, or that give a variety of meanings, are placed in the record. While all possible translations, and discussions relative to meaning, are useful for informational purposes, not all such matter is appropriate for printing in the Official Gazette or on the certificate of registration. Only a translation that is the clear and exact equivalent (see TMEP §809.02) should be printed. This normally means only one translation, because the existence of a variety of alternative translations, or the necessity of including explanatory context, usually indicates lack of a clearly recognized equivalent meaning.

If an applicant submits a translation that is too verbose or vague to be appropriate for printing, the examining attorney must require a clear, concise translation. The transliteration of non-Latin characters, if any, must be included in the statement to be printed. If necessary, the examining attorney should rewrite the statement via an examiner's amendment and ensure that the Trademark database is updated accordingly.

Example: The translation statement contains the proper translation, but the statement is not suitable for printing because it is too wordy. If the examining attorney is only "reformatting" the applicant's statement without changing the substance, the examining attorney should rewrite the translation statement into a simple, clear statement as to meaning, issue a "no-call" examiner's amendment (see TMEP §707.02), and ensure that the Trademark database is updated accordingly.

Example: The translation statement is vague or is otherwise in need of clarification in order for the statement to be clear and concise. The examining attorney should contact the applicant and suggest a simple, clear statement. If the applicant agrees to amend the translation statement as suggested, the examining attorney should issue a regular examiner's amendment, and ensure that the Trademark database is updated accordingly. If the applicant and examining attorney cannot agree on wording, the examining attorney must issue an Office action to resolve the issue.

One of the following statement formats should be used, as appropriate:

The English translation of the word "_____ " in the mark is "_____"

The English translation of the _____ word "_____" in the mark is "_____”

The English translation of "_____" is "_____”

The wording "_____" has no meaning in a foreign language

The non-Latin characters in the mark transliterate to "_____" and this means "_____" in English

The _____ characters in the mark transliterate to "_____" and this means "_____" in English

The non-Latin characters in the mark transliterate to "_____" and this has no meaning in a foreign language

All information in the “Translation” and “Transliteration” fields in the application record will automatically be printed in the Official Gazette and on the certificate of registration. Accordingly, the examining attorney must ensure that the translation or transliteration is entered into the Trademark database. When an examining attorney determines that a translation should not be printed because it is unnecessary, the examining attorney must ensure that the translation is deleted from the Trademark database, and enter a Note to the File in the record indicating that the translation has been deleted. The document containing the information deleted from the Trademark database will remain of record for informational purposes. See TMEP §817 regarding preparation of an application for publication or issuance.

810 Filing Fee

An application under §1 or §44 of the Trademark Act must include a filing fee for each class of goods or services. 15 U.S.C. §1051(a)(1), 1051(b)(1), and 1126.

The required filing fee for at least one class of goods or services must be received before an application can be given a filing date. 37 C.F.R. §2.21(a)(5).

The amount of the trademark application filing fee varies, depending upon whether the application (or the amendment adding classes to an existing application) is filed through TEAS or on paper. An applicant has three choices. The applicant can file:

- A paper application at the highest fee per class, set forth in 37 C.F.R. §2.6(a)(1)(i);
- A regular TEAS application at the lower fee per class, set forth in 37 C.F.R. §2.6(a)(1)(ii); or
- A TEAS Plus application (see TMEP §819 et seq.) at the lowest fee per class, set forth in 37 C.F.R. §2.6(a)(1)(iii).

See notices at 70 Fed. Reg. 2952 (Jan. 19, 2005) and 70 Fed. Reg. 38768 (July 6, 2005). The current fee schedule is available on the USPTO website at http://www.uspto.gov.

Note: Applications that are downloaded from TEAS or TEAS Plus, printed, and mailed to the USPTO are considered paper applications and are subject to the paper application filing fee.

An applicant who amends an application to add classes is entitled to the lower fee if the applicant files the amendment through TEAS (either as a voluntary amendment or a response to an examining attorney's Office action), or through an examiner's amendment. The applicant must pay the higher fee if the applicant files an amendment adding class (es) on paper. See TMEP §1403.02(c) and 1403.06 for further information about fees in multiple-class applications.

See also TMEP §405 et seq. regarding payment of fees to the USPTO, and TMEP §202.03(a) and 202.03(a)(i) regarding the processing of applications in which a check submitted as the application filing fee is returned unpaid, or an electronic funds transfer or credit card payment is refused or charged back by a financial institution.

The filing fee for a §66(a) application will be sent to the USPTO by the IB, pursuant to the provisions of the Madrid Protocol and the Common Regulations. The examining attorney should not require additional fees during examination.

810.01 Collection of Fees for Multiple Classes

A filing fee is required for each class in a multiple-class application under §1 or §44 of the Trademark Act. 37 C.F.R. §2.86(a)(2). The USPTO has established the following policy to ensure the collection of application filing fees from all applicants on an equitable basis.

In an application under §1 or §44, if the applicant has specifically authorized the USPTO to charge any additional fees to a deposit account, the examining attorney should ask the LIE to charge the fees, and proceed with examination of the application on the merits. If the applicant has not provided a specific authorization to charge an account, the examining attorney should attempt to contact the applicant to secure a written authorization to charge fees to a credit card or deposit account by fax or-e-mail.

An authorization to charge a fee to a deposit account must be made in a written document signed and submitted by an authorized person. It cannot be entered by examiner's amendment unless the record already contains a written authorization, signed and submitted by someone who is authorized to charge fees to the account. See TMEP §405.03 regarding deposit accounts.

If the examining attorney is able to secure a written authorization to charge fees to a credit card or deposit account, the examining attorney should have the LIE charge the necessary fees to the credit card or deposit account and proceed with examination. See TMEP §810, 1403.02(c), and 1403.06 regarding the amount of the fee for adding classes to an application.

If an authorization to charge fees has not been provided and the examining attorney is unable to secure one, the examining attorney must issue a written Office action noting the deficiency and requiring either payment of the fees or deletion of classes. This policy applies to any application under §1 or §44 of the Trademark Act in which the applicant specifically delineates more than one class of goods or services and the applicant has paid the fee(s) for less than all the classes. The delineation may be by indicating class numbers or any other means demonstrating a clear intention to seek registration in multiple classes.

In limited circumstances, the examining attorney should advise the applicant that action on the merits of the application is deferred pending receipt of the applicant's response to the Office action requiring payment of missing fees or deletion of classes. In most cases, the examining attorney should simply act on the merits of the application and require the additional fees. For example, it would be

inappropriate to defer action in a pro se application or in other cases where the applicant has in good faith attempted to pay the appropriate fees. Before issuing a letter deferring action until additional fees are paid, the examining attorney should consult with the managing attorney or senior attorney.

The filing fee for a §66(a) application will be sent to the USPTO by the IB, pursuant to the provisions of the Madrid Protocol and the Common Regulations. The examining attorney should not require additional fees during examination. The classification in a §66(a) application cannot be changed and additional classes cannot be added. See TMEP §1401.03(d) for further information.

810.02 Refunds

Only money paid by mistake or in excess (when a fee is not required by the statute or rules, or is not required in the amount paid) may be refunded. A mere change of purpose after the payment of money does not entitle a party to a refund. For example, if an applicant deletes a class from an application, or withdraws an application, the applicant is not entitled to a refund. 37 C.F.R. §2.209.

The filing fee for an application that is denied a filing date will be refunded. After an application has been given a filing date and processed, the filing fee will normally not be returned. However, if an examining attorney erroneously requires a fee, the USPTO will refund any fee submitted in response to the erroneous requirement.

If the examining attorney determines that an applicant is entitled to a refund, he or she should submit the request to the TMFinance @uspto.gov e-mail box with the information necessary for processing the refund.

If the examining attorney is uncertain as to whether a refund is appropriate, he or she should discuss the situation with the managing attorney or senior attorney.

See TMEP §405.04 for additional information about processing refunds.

811 Designation of Domestic Representative

Under 15 U.S.C. §1051(e) and 1141h(d) and 37 C.F.R. §2.24, an applicant not domiciled in the United States may file a document designating the name and address of a person residing in the United States on whom may be served notices or process in proceedings affecting the mark. See TMEP §610 for further information. The USPTO encourages applicants who do not reside in the United States to designate domestic representatives. To expedite processing, the USPTO recommends that designations of domestic representative be filed through TEAS, at http://www.uspto.gov.

812 Identification of Prior Registrations of Applicant

37 CFR §2.36 Identification of prior registrations.

Prior registrations of the same or similar marks owned by the applicant should be identified in the application.

Trademark Rule 2.36, 37 C.F.R. §2.36, states that prior registrations of the same or similar marks owned by the applicant should be identified in the application. The rule does not precisely define when an applicant should claim ownership of prior registration(s), and the examining attorney may exercise discretion in invoking the rule. The main purpose of the rule is to provide the examining attorney with information necessary for proper examination. The information does not have to be given in any specific form. The applicant's claim of ownership of prior registrations will be printed in the Official Gazette and on the registration certificate.

Normally, identification of a registration is necessary because the registration would, if not owned by the applicant, be a basis for refusal under §2(d) of the Act, 15 U.S.C. §1052(d). Occasionally, it is desirable to ask an applicant to identify a particular registration as being owned by the applicant merely to provide relevant information. It is not necessary to assert ownership of expired or cancelled registrations. If the applicant wants to include a reference to a cancelled or expired registration, the applicant should indicate that the applicant owns the mark disclosed in the cancelled or expired registration, because technically one does not "own" a registration that is not in force and effect. Claims of ownership of pending applications, expired or cancelled registrations, and registrations that are unrelated to an application will not be printed.

Before approving an application that includes a claim of ownership of prior registrations for publication or registration, the examining attorney must ensure that the registrations are active. If a registration is not active, the claim of ownership should not be printed.

All information in the "Prior Registration" field in the application record in the Trademark database will automatically be printed in the Official Gazette and on the certificate of registration. Accordingly, when an examining attorney determines that a claim of ownership of a prior registration should not be printed (e.g., because the registration is no longer active or is irrelevant to the registrability of the mark in the subject application), the examining attorney must ensure that the claim of ownership is deleted from the Trademark database, and enter a Note to the File in the record indicating that

the claim has been deleted. The document containing the information deleted from the Trademark database will remain of record for informational purposes. See TMEP §817 regarding preparation of an application for publication or issuance.

If the applicant owns numerous prior registrations, it is not necessary to list them all. The applicant should specifically identify the two or three registration numbers that are most relevant (due to the similarity of the marks and/or relatedness of the goods or services), and then indicate that it owns other registrations as well, e.g., "the applicant is the owner of Reg. Nos. <specify the numbers> and others." If the applicant lists numerous prior registrations, the database will only show the first three registration numbers entered in the claim of ownership field and will automatically indicate "and others" as to any additional registration numbers. Therefore, the examining attorney must ensure that the claim of ownership identifies the two or three most relevant registration numbers.

In a TEAS Plus application, if the applicant owns one or more registrations for the same mark, the initial application must include a claim of ownership of the registration(s). If this information is not included in the initial application, the applicant must pay a processing fee per class to have the application examined as a regular TEAS application. 37 C.F.R. §2.22(a)(19). See TMEP §819.01(p) for further information.

812.01 Proving Ownership of Prior Registrations

If an applicant includes a claim of ownership of a prior registration, or a pending application, in the application as filed, the examining attorney must accept the claim without further proof of ownership and must not cite the registration for likelihood of confusion under §2(d) of the Act or advise the applicant that there may be a conflict with the earlier-filed application.

If the applicant does not assert ownership of a pertinent registration in the application when it is filed, but the Trademark database indicates that an assignment was filed as to the registration, the examining attorney must check the database of the USPTO's Assignment Recordation Branch to determine whether information contained in the database supports ownership of the registration in the applicant's name. If records in the Assignment Recordation Branch's database indicate that the registration is owned by the applicant, the examining attorney must not cite the registration for likelihood of confusion, but must call the registration to the applicant's attention and ask

the applicant to state that the applicant owns the registration, if accurate.

If the request is made in an Office action, the examining attorney must include a copy of the registration.

If there are no other issues necessitating issuance of an Office action, the examining attorney may call or e-mail the applicant. The applicant's statement claiming ownership may be placed in the record through an examiner's amendment.

Generally, the applicant has the burden of proving ownership of a registration. The USPTO's automated search system may not reflect the recordation of changes of ownership in the Assignment Recordation Branch. See TMEP §502 et seq. Therefore, if an applicant does not assert ownership of a pertinent registration in an application when it is filed, the registration must be cited against the current application under §2(d) because the USPTO's records do not indicate that it is owned by the applicant. If so, the applicant must do one of the following to verify its ownership claim: (1) state for the record that the documents have been recorded in the Assignment Recordation Branch for a registration based on an application under §1 or §44 of the Trademark Act, or with the IB for a §66(a) registration; (2) submit copies of documents evidencing the chain of title; or (3) submit a statement, supported by an affidavit or declaration under 37 C.F.R. §2.20, that the applicant is the owner of the cited registration. This also applies to pending conflicting applications that are cited as a potential bar to registration.

A refusal under §2(d) cannot be overcome by a claim of ownership of a registration made by the applicant in another registration file when the USPTO's records do not indicate that the registration is owned by the applicant.

813 Consent to Register by Particular Living Individual Whose Name or Likeness Appears in the Mark

When a name, portrait, or signature in a mark identifies a particular living individual, or a deceased president of the United States during the life of his widow, the mark can be registered only with the written consent of the individual, or of the president's widow, respectively. The requirement for consent also applies to the registration of a pseudonym, stage name, or nickname, if there is evidence that the name identifies a specific living individual who is publicly connected with the goods or services, is generally known, or is well known in the field relating to the relevant goods or services. See TMEP §§1206 et seq. concerning refusal of registration under §2(c) of the Trademark Act, 15 U.S.C. §1052(c), when a mark in an application comprises the name, portrait, or signature of a living individual whose consent to register such name or likeness is not of record.

See TMEP §1206.03 for information about when the examining attorney should issue an inquiry as to whether a name or likeness identifies a particular living individual.

Consent may be presumed where the individual whose name or likeness appears in the mark personally signs the application. See TMEP §1206.04(b) for further information.

If a consent to register is already part of the record in the file of a valid registration for a mark comprised in whole or in part of the same name, portrait, or signature for the same goods or services, the applicant may satisfy the requirement for a consent statement by claiming ownership of the registration and advising the examining attorney that the consent is of record therein. See TMEP §1206.04(c) for further information.

If a mark comprises the name or likeness of a living individual and consent to register is of record or is presumed from signature of the application (TMEP §1206.04(b)), a statement that the mark identifies a living individual whose consent is of record must be printed in the Official Gazette and on the registration certificate. See TMEP §813.01(a). If a name or likeness that could reasonably be perceived as that of a living individual is not that of a specific living individual, a statement to that effect is printed in the Official Gazette and on the registration certificate. See TMEP §813.01(b).

In a TEAS Plus application, if the mark includes an individual's name or portrait, the initial application must include either: (1) a statement that identifies the living individual whose name or likeness the mark comprises, and written consent of the individual; or (2) a

statement that the name or portrait does not identify a living individual. If this statement does not appear in the initial application, the applicant must pay a processing fee per class to have the application examined as a regular TEAS application. 37 C.F.R. §2.22(a)(18). See TMEP §819.01(o) for further information.

See TMEP §813.01(b) and 1206.05 regarding statements that a name or likeness that could reasonably be perceived as that of a living individual is not that of a specific living individual.

813.01 Statement Printed in Official Gazette and on Registration Certificate

813.01(a) Name or Likeness Is That of a Living Individual

If a mark comprises the name or likeness of a living individual and consent to register is of record, a statement to that effect must be printed in the Official Gazette and on the registration certificate. The following are examples of acceptable statements:

The name, portrait, and/or signature shown in the mark identifies a living individual whose consent to register is made of record;

The name shown in the mark identifies a living individual whose consent is of record;

"<JOHN SMITH>" identifies a living individual whose consent is of record;

The portrait or likeness shown in the mark identifies a living individual whose consent is of record;

The portrait or likeness shown in the mark identifies John Smith, whose consent to register is made of record;

The signature shown in the mark identifies a living individual whose consent is of record;

The signature shown in the mark identifies "JOHN SMITH", a living individual whose consent is of record; or

The name, portrait, and/or signature shown in the mark identifies <John Smith>, whose consent to register is made of record.

Only matter that actually appears in the mark should appear in capital letters within quotation marks.

Where the mark comprises a portrait, first name, pseudonym, nickname, surname of an individual who is well known in the field relating to the goods or services (see TMEP §1206.03), surname preceded by initials (e.g., "J.C. Jones"), or title of a living individual, the record must clearly identify the actual name of the individual and indicate that the name shown in the mark identifies that individual. A legible

signature on the consent statement may in itself be sufficient to identify the individual's name. If the actual name is unclear, the examining attorney must issue an inquiry. The name may be entered by examiner's amendment, if appropriate.

Where the mark comprises the name or likeness of a living individual whose consent is of record, the consent statement must always be printed, even if the name that appears in the mark is that of the applicant. The statement must also be printed if consent is presumed from signature of the application (TMEP §1206.04(b)), or if consent is of record in a valid registration owned by applicant (TMEP §1206.04(c)).

Where consent is presumed from signature (TMEP §1206.04(b)), the examining attorney must ensure that the required statement is entered in the Office's database. The examining attorney must also enter a Note to the File in the record indicating that the statement must be printed. No prior approval by the applicant or the applicant's qualified practitioner is required.

The examining attorney must ensure that the Trademark database is updated, if necessary. See TMEP §813.01(c).

813.01(b) Name or Likeness Is Not That of a Living Individual

If a name or likeness that could reasonably be perceived as that of a living individual is not that of a specific living individual, a statement to that effect must be printed in the Official Gazette and on the registration certificate. The statement should read as follows: "_____ does not identify a living individual."

Or "The name(s), portrait(s), and/or signature(s) shown in the mark does not identify a particular living individual."

The applicant should explain any additional relevant circumstances. For example, if the matter identifies a certain character in literature or a deceased historical person, then a statement of these facts in the record may be helpful, but this information will not be printed in the Official Gazette or on the registration certificate.

No statement should be printed unless the name or portrait might reasonably be perceived as that of a specific living individual. This is true even if the applicant submits an unsolicited statement that a particular name or portrait does not identify a living individual.

Generally, if the name or likeness is such that an inquiry would have been required as to whether it identifies a living individual (see TMEP §1206.03), and the applicant states that the mark does not identify a living individual, then the statement that the name or

likeness does not identify a living individual should be printed.
The examining attorney must ensure that the Trademark database is updated, if necessary. See TMEP §813.01(c).
If the applicant owns a valid registration for a mark comprised in whole or in part of the same name, portrait, or signature for any goods or services, and the record for the registration contains a statement that the name or likeness is not that of a living individual, the applicant should claim ownership of the registration and advise the examining attorney that the statement is of record therein. The examining attorney may then enter the same statement in the record for the application, even if applicant does not resubmit or reference the statement. It is not necessary to issue an inquiry in this situation.

813.01(c) Updating the Trademark Database

All statements in the Trademark database as to whether a mark comprises the name, portrait, or signature of a living individual whose consent is of record will automatically be printed in the Official Gazette and on the certificate of registration. Accordingly, when an examining attorney determines that such a statement should be printed, the examining attorney must ensure that the statement is entered into the database. Where consent is presumed from signature (TMEP §1206.04(b)), the examining attorney must also enter a Note to the File in the record indicating that the statement must be printed.
When an examining attorney determines that such a statement should not be printed, the examining attorney must ensure that the statement is deleted from the database. The examining attorney must also enter a Note to the File in the record indicating that the statement has been deleted. The document containing the information deleted from the Trademark database will remain of record for informational purposes. See TMEP §817 regarding preparation of an application for publication or issuance.

814 Requesting Additional Information

Sometimes, it is necessary for the examining attorney to request additional information from an applicant in order to examine the application properly, pursuant to 37 C.F.R. §2.61(b). If the applicant does not comply with a requirement for additional information, registration may be refused.

If the applicant does not comply with the examining attorney's request for information, the requirement should be repeated and, if appropriate, made final. See In re AOP LLC, 107 USPQ2d 1644, 1651 (TTAB 2013) ("Failure to comply with a request for information is grounds for refusal," where applicant provided equivocal responses to the examining attorney's questions and did not address this issue in its brief); In re DTI Partnership LLP, 67 USPQ2d 1699 (TTAB 2003) (deeming §2(e)(1) refusal moot, since failure to comply with requirement for information is sufficient basis, in itself, for refusal); In re SPX Corp., 63 USPQ2d 1592 (TTAB 2002) (finding registration properly refused where applicant ignored request for information); In re Page, 51 USPQ2d 1660 (TTAB 1999) (finding intent-to-use applicant's failure to comply with requirement for information as to the intended use of the mark constituted grounds for refusal); In re Babies Beat Inc., 13 USPQ2d 1729, 1731 (TTAB 1990) (finding registration properly refused where applicant failed to comply with examining attorney's request for copies of patent applications and other patent information); In re Air Products and Chemicals, Inc., 192 USPQ 157, 158 (TTAB 1976) ("[Trademark Rule 2.61(b)] has the effect of law.").

The examining attorney may request literature, exhibits, affidavits or declarations, and general information concerning circumstances surrounding the mark, as well as, if applicable, its use or intended use. See 37 C.F.R. §2.61(b). Requests for information that is not public knowledge, but is within the knowledge of the applicant or available to the applicant, are particularly appropriate. The examining attorney should explain why the information is needed, if the reason is not obvious.

If applicant wants to provide information from its website in response to the examining attorney's request for information, applicant should attach the relevant information to its response. It is not sufficient to provide only the applicant's website address. In addition, a mere statement that information about the goods or services is available on applicant's website is an inappropriate response to the examining attorney's request for information, and insufficient to make the

relevant information of record. In re Planalytics, Inc., 70 USPQ2d 1453 (TTAB 2004).

If applicant does not believe that it has relevant information, applicant should submit a statement to this effect.

An applicant's failure to comply with an information request may lead to the presumption that had applicant responded to the requirement, the response would have been unfavorable to the applicant. See In re AOP LLC, 107 USPQ2d at 1651 (noting because applicant had failed to comply with the examining attorney's information requirement, "to the extent there is any ambiguity regarding the origin and certification of applicant's goods we address both [merely descriptive and deceptively misdescriptive] refusals in the alternative based on the presumption that had applicant directly and fully responded to the examining attorney's inquiries, the responses would have been unfavorable,"); In re Cheezwhse.com, Inc., 85 USPQ2d 1917, 1919 (TTAB 2008) (making factual presumptions unfavorable to the applicant in considering alternative statutory refusals under §2(e)(2) and 2(e)(3), in view of the applicant's failure to comply with the examining attorney's requirement for information as to the geographic origin of the goods).

If the requested information is confidential, or if, for a valid reason, the applicant does not want to have the information become part of a public record, the applicant should consider redacting such portions of documents prior to their submission. Documents filed in the USPTO by the applicant become part of the official record and will not be returned or removed. 37 C.F.R. §2.25; TMEP §404. Placing confidential information in the record is not required. Sometimes a written explanation or summary will suffice.

815 Application Filed on Supplemental Register

Sections 23 through 28 of the Trademark Act, 15 U.S.C. §1091 through 1096, provide for registration on the Supplemental Register. Certain marks that are not eligible for registration on the Principal Register, but are capable of distinguishing an applicant's goods or services, may be registered on the Supplemental Register. Marks registered on the Supplemental Register are excluded from receiving the advantages of certain sections of the Act of 1946. The excluded sections are listed in 15 U.S.C. §1094. See TMEP §801.02(b).

If the applicant seeks registration on the Supplemental Register, the application should state that registration is requested on the Supplemental Register. If no register is specified, the USPTO will presume that the applicant seeks registration on the Principal Register.

A mark in an application under §66(a) of the Trademark Act, 15 U.S.C. §1141f (a), based on a request for extension of protection of an international registration to the United States, cannot be registered on the Supplemental Register. 15 U.S.C. §1141h (a)(4); 37 C.F.R. §2.47(c) and 2.75(c).

Upon approval of the mark for registration, the record will indicate that the mark has been "Allowed for Supplemental Registration" rather than that the mark has been approved for publication. Marks on the Supplemental Register are not published for opposition, but are issued as registered marks on the date that they are printed in the Official Gazette.

Applications on the Supplemental Register are not subject to opposition under 15 U.S.C. §1063, but are subject to cancellation under 15 U.S.C. §1064. 15 U.S.C. §1092.

See TMEP §816 et seq. regarding amendments to the Supplemental Register.

815.01 Marks Eligible for Principal Register Not Registrable on Supplemental Register

A mark that is clearly eligible for the Principal Register may not be registered on the Supplemental Register.

An application requesting registration on the Supplemental Register must be amended to the Principal Register, or refused registration, if the mark is registrable on the Principal Register. Daggett & Ramsdell, Inc. v. I. Posner, Inc., 115 USPQ 96 (Comm'r Pats. 1957).

See TMEP §816 et seq. regarding amendments to the Supplemental Register.

815.02 Elements Required

An application requesting registration on the Supplemental Register should state that the applicant requests registration on the Supplemental Register. If no register is specified, the USPTO will assume that the applicant is requesting registration on the Principal Register.

In an application under §1(b), the mark must be in lawful use in commerce on or in connection with the goods/services before the mark can register. 15 U.S.C. §1091(a). Under 37 C.F.R. §2.47(d), an intent-to-use applicant is not eligible for registration on the Supplemental Register until the applicant has filed an acceptable allegation of use. When the applicant amends to the Supplemental Register after filing an acceptable allegation of use, the effective filing date of the application is the date on which the applicant filed the allegation of use, i.e., the date on which the applicant met the minimum filing requirements of 37 C.F.R. §2.76(e) for an amendment to allege use (see TMEP §1104.01), or 37 C.F.R. §2.88(e) for a statement of use (see TMEP §1109.01). 37 C.F.R. §2.75(b). See also TMEP §816.02 and 1102.03 regarding intent-to-use applications and the Supplemental Register.

If an applicant submits a §1(b) application requesting registration on the Supplemental Register for which no acceptable allegation of use has been filed, the examining attorney must refuse registration under §23 of the Trademark Act, 15 U.S.C. §1091, on the ground that the mark is not in lawful use in commerce. The examining attorney will withdraw the refusal if the applicant submits an acceptable allegation of use.

If the application is based solely on §44, the applicant may seek registration on the Supplemental Register without alleging use in commerce or use anywhere in the world. 15 U.S.C. §1126(e); 37 C.F.R. §2.47(b); TMEP §1009. However, the §44 applicant must verify that the applicant has a bona fide intention to use the mark in commerce. 15 U.S.C. §1126(d) and (e); 37 C.F.R. §2.34(a)(3)(i) and 2.34(a)(4)(ii).

815.03 Filing on Supplemental Register Is Not an Admission That the Mark Has Not Acquired Distinctiveness

Under 15 U.S.C. §1095, registration of a mark on the Supplemental Register does not constitute an admission that the mark has not acquired distinctiveness.

815.04 Basis for Refusal of Registration of Matter That Is Incapable

When the examining attorney refuses registration on the Supplemental Register on the ground that the proposed mark is incapable of

distinguishing the applicant's goods or services, the examining attorney should cite §23(c) of the Trademark Act, 15 U.S.C. §1091(c) , as a basis for refusal. See In re Controls Corp. of America, 46 USPQ2d 1308, 1309 n.2 (TTAB 1998).

816 Amending Application to Supplemental Register

816.01 How to Amend

If an application meets the requirements noted in TMEP §815.02, the application may be amended by requesting that the words "Principal Register" be changed to "Supplemental Register," or that "the application is amended to the Supplemental Register."

An application under §66(a) of the Trademark Act cannot be amended to the Supplemental Register. Section 68(a)(4) of the Act, 15 U.S.C. §1141h(a)(4); 37 C.F.R. §2.47(c) and 2.75(c).

816.02 Effective Filing Date

Intent-to-Use Applications

As noted in TMEP §815.02, an intent-to-use applicant may file an amendment to the Supplemental Register only after the applicant has begun using the mark and filed an acceptable allegation of use. 37 C.F.R. §2.47(d). In such a case, if the application is based solely on §1(b), the effective filing date of the application is the filing date of the allegation of use, i.e., the date on which the applicant met the minimum filing requirements of 37 C.F.R. §2.76(c) for an amendment to allege use (see TMEP §1104.01), or 37 C.F.R. §2.88(c) for a statement of use (see TMEP §1109.01). 37 C.F.R. §2.75(b); TMEP §1102.03. Note, however, that if the application includes a §44(d) filing basis with a priority filing date in addition to the §1(b) basis, the effective filing date (i.e., the priority filing date) is not changed to the filing date of the allegation of use. When the applicant files an allegation of use that complies with the minimum requirements of 37 C.F.R. §2.76(c) or 37 C.F.R. §2.88(c) and an amendment to the Supplemental Register in response to a refusal, the examining attorney must follow the procedures outlined in TMEP §714.05(a)(i).

Amendment of an application from the Supplemental to the Principal Register does not change the effective filing date of an application. Kraft Grp. LLC v. Harpole, 90 USPQ2d 1837 (TTAB 2009) (holding that the filing date did not change when an applicant who originally sought registration on the Supplemental Register, without alleging use in commerce, amended to seek registration on the Principal Register under §1(b)).

Applications Filed Before November 16, 1989

Prior to November 16, 1989, one year's lawful use of the mark in commerce was required to apply for registration on the Supplemental

Register. Effective November 16, 1989, an applicant may apply for registration on the Supplemental Register at any time after commencing use of the mark in commerce.

An applicant may amend a pending application to request registration on the Supplemental Register at any time after use of the mark has commenced. The date of the amendment to the Supplemental Register becomes the effective filing date of the application if: (1) the applicant had not used the mark in commerce for one year before the application filing date; and (2) the applicant amends to the Supplemental Register on or after November 16, 1989.

See also TMEP §206–206.04 regarding effective filing date.

816.03 Amendment to Different Register

Although there is no restriction on the number of times an applicant may amend from one register to another, one amendment is usually sufficient, and subsequent amendments should be avoided except for unusual circumstances.

816.04 Amendment After Refusal

In an application under §1 or §44 of the Trademark Act, the applicant may amend to the Supplemental Register after a refusal to register on the Principal Register, including a final refusal. If the final refusal was under §2(e)(1), §2(e)(2), or §2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(1), 1052(e)(2), or 1052(e)(4), or on grounds pertaining to other non-inherently distinctive subject matter, amendment to the Supplemental Register is procedurally an acceptable response. See 37 C.F.R. §2.75. When the applicant files an allegation of use that complies with the minimum requirements of 37 C.F.R. §2.76(e) and an amendment to the Supplemental Register in response to a refusal, the examining attorney must follow the procedures outlined in TMEP §714.05(a)(i).

The applicant may argue the merits of the examining attorney's refusal of registration on the Principal Register and, in the alternative, request registration on the Supplemental Register. Similarly, the applicant may seek registration on the Principal Register based on acquired distinctiveness under §2(f), 15 U.S.C. §1052(f), and, in the alternative, on the Supplemental Register. See TMEP §1212.02(c).

An amendment to the Supplemental Register after refusal presents a new issue requiring consideration by the examining attorney, unless the amendment is irrelevant to the outstanding refusal. If the examining attorney determines that the proposed mark is incapable of identifying

and distinguishing the applicant's goods or services, the examining attorney must issue a nonfinal refusal of registration on the Supplemental Register, under §23 and 45 of the Trademark Act, 15 U.S.C. §1091 and 1127. See TMEP §714.05(a)(i).

An applicant may not seek registration of a mark on both the Principal and Supplemental Registers in the same application. See 15 U.S.C. §1051, 1091; 37 C.F.R. §2.46, 2.47. Therefore, if an applicant responds to a refusal or requirement by expressly amending to the Supplemental Register as to only certain goods/services/classes, the examining attorney will not accept the request to amend unless it is also accompanied by a request to divide. See TMEP §801.02(b) and 1110-1110.10.

A mark in an application under §66(a) of the Trademark Act cannot be amended to the Supplemental Register. Section 68(a)(4) of the Act, 15 U.S.C. §1141h(a)(4); 37 C.F.R. §2.47(c) and 2.75(c).

816.05 Amendment After Decision on Appeal

An applicant may not amend to the Supplemental Register after the Trademark Trial and Appeal Board has affirmed a refusal of registration on the Principal Register. After having elected one of the remedies available for contesting the basis for the refusal, namely, appeal rather than amendment to the Supplemental Register, and having pursued the remedy to a conclusion, the applicant may not return to its previous position and pursue another remedy for the same refusal anew. In the following cases, the USPTO refused to grant petitions to reopen prosecution and return jurisdiction to the examining attorney to consider an amendment to the Supplemental Register after decision on appeal: Ex parte Simoniz Co., 161 USPQ 365 (Comm'r Pats. 1969); Ex parte Helene Curtis Industries, Inc., 134 USPQ 73 (Comm'r Pats. 1962); Ex parte Sightmaster Corp., 95 USPQ 43 (Comm'r Pats. 1951). See also TMEP §1501.06 and cases cited therein.

The applicant may file a new application requesting registration on the Supplemental Register.

817 Preparation of Application for Publication or Registration

When an application is ready to be approved for publication or registration, the examining attorney must carefully review the application record to ensure the accuracy of the information contained therein and to ensure that all information that should be printed in the Official Gazette and on the certificate of registration has been properly entered into the Trademark database. The type of information that should be printed includes:

(1) Disclaimer statements (TMEP §1213 et seq.);

(2) Notations of acquired distinctiveness, i.e., "2(f)" or "2(f) in part as to . . .," as appropriate (TMEP §1212 et seq.);

(3) Lining and/or stippling statements, if necessary (TMEP §808.01(b));

(4) Consent to register a name or portrait and/or statements that a name or portrait does or does not identify a living individual (TMEP §813.01 et seq.);

(5) Translations of non-English wording and transliterations of non-Latin characters in the mark, or statements that the non-English wording or transliterated term has no meaning in English (TMEP §809.03);

(6) Ownership of related United States registrations (TMEP §812);

(7) Description of mark statements (TMEP §808 et seq.);

(8) Dates of use of the mark in another form (TMEP §903.07); and

(9) Color claims and color location statements (TMEP §807.07(a) et seq.).

All statements in the Trademark database relating to the above-listed items will automatically be printed in the Official Gazette and on the registration certificate. Therefore, examining attorneys must ensure that information about these items that should not be printed (e.g., claims of ownership of unrelated or cancelled United States registrations, statements such as disclaimers that have been amended and are no longer valid, or unnecessary §2(f) statements) is deleted from the Trademark database. The documents containing the information deleted from the Trademark database will remain of record for informational purposes. It is not necessary to notify the applicant that the information will not be printed. If an applicant provides information by phone that should not be printed (e.g., a statement that a particular term has no meaning in the relevant industry), the examining attorney should enter a Note to the File in the record detailing the information that will not be entered into the database.

In addition, the examining attorney must check to ensure the accuracy of the following critical data elements:

(1) The mark;

(2) The register for which application is made;

(3) The identification of goods and/or services;

(4) International classification;

(5) Filing date;

(6) Dates of use for each class, if applicable;

(7) Foreign application and registration data, if applicable;

(8) Whether §1(b) of the Act is a basis for registration;

(9) In a multiple-basis application, which goods are covered by which basis; and

(10) In concurrent use cases, information as to the proposed geographic limitation.

If any of the above items are not accurately entered into the Trademark database, the examining attorney must ensure that the necessary correction(s) are made.

If there has been an assignment, the examining attorney must check the records of the Assignment Recordation Branch of the USPTO to ensure that there is a clear chain of title, and ensure that the change of ownership is entered into the Trademark database, if necessary. See TMEP §§502.02(a) and 502.02(c).

818 Application Checklist

This section may be used to determine whether materials submitted as a trademark application are complete, and to ensure that appropriate requirements and refusals are made. See 37 C.F.R. §2.21 and TMEP §202 regarding the elements that must be received before the USPTO will grant a filing date to an application.

An application for trademark registration must include the following:
(1) a clear drawing of the mark (37 C.F.R. §2.21(a)(3), 2.51 through 2.54; TMEP §202.01 and 807 et seq.);
(2) a verified statement signed by a person properly authorized to sign on behalf of the applicant (15 U.S.C. §1051(a)(3) and (b)(3); 37 C.F.R. §2.33; TMEP §804 et seq.);
(3) a written application that includes the following:
(a) the date on which the application was signed;
(b) the applicant's name, and DBA designation if appropriate (37 C.F.R. §2.32(a)(2); TMEP §803.02 et seq.);
(c) the applicant's legal entity (TMEP §803.03 et seq.);
(d) the country of which the applicant is a citizen, or the state or country of incorporation or organization of a juristic applicant (15 U.S.C. §1051(a)(2) and (b)(2); 37 C.F.R. §2.32(a)(3)(i) and (ii); TMEP §803.04);
(e) if the applicant is a domestic partnership or domestic joint venture, the names and citizenship (or state or country of incorporation or organization) of the general partners or active members of the joint venture (37 C.F.R. §2.32(a)(3)(iii) and (iv); TMEP §803.03(b) and 803.04);
(f) the applicant's domicile and post office address (15 U.S.C. §1051(a)(2) and (b)(2); 37 C.F.R. §2.32(a)(4); TMEP §803.05);
(g) a statement that the applicant is using the mark in commerce in a §1(a) application, or has a bona fide intent to use the mark in commerce in an application under §1(b) or §44 (15 U.S.C. §1051(a)(3)(C), 1051(b)(3)(B), 1126(d)(2), and 1126(e); 37 C.F.R. §2.33(b)(1) and (2));
(h) an identification of the goods/services (15 U.S.C. §1051(a)(2) and (b)(2); 37 C.F.R. §2.32(a)(6); TMEP §1402 et seq.);
(i) the class(es) of the goods/services, if known to the applicant (37 C.F.R. §2.32(a)(7); TMEP §1401 et seq.);
(j) the dates when the mark was first used and first used in commerce with the goods/services in each class, in an application under §1(a) (15 U.S.C. §1051(a)(2); 37 C.F.R. §2.34(a)(1)(ii) and (iii); TMEP §903

et seq.);
(k) a statement that the mark is being used by a related company or companies, in a §1(a) application where use of the mark is only by one or more related companies and inures to the applicant's benefit (37 C.F.R. §2.38; TMEP §901.05);
(l) if the applicant claims priority under §44(d), a claim of the benefit of the applicant's first-filed foreign application in a treaty country within the preceding six months, specifying the filing date, country, and serial number of such application (15 U.S.C. §1126(d); 37 C.F.R. §2.34(a)(4); TMEP §1003 et seq.);
(m) a basis for filing (37 C.F.R. §2.32(a)(5) and 2.34; TMEP §806 et seq.);
(n) an averment by the person making the verification that he or she believes the applicant to be the owner of the mark sought to be registered in an application under §1(a), or to be entitled to use the mark in commerce in a §1(b) or §44 application (15 U.S.C. §1051(a)(3)(A) and 1051(b)(3)(A); 37 C.F.R. §2.33(b)(1) and (2); TMEP §804.02);
(o) an averment that the mark is in use in commerce in a §1(a) application (37 C.F.R. §2.33(b)(1) and 2.34(a)(1)(i); TMEP §901);
(p) an averment that, to the best of the verifier's knowledge and belief, no other person, firm, corporation, or association has the right to use such mark in commerce either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods of the other person, to cause confusion, or to cause mistake, or to deceive (15 U.S.C. §1051(a)(3)(D) and (b)(3)(D); 37 C.F.R. §2.33(b)(1) and (2); TMEP §804.02);
(q) a description of the mark, if the mark is not in standard characters (37 C.F.R. §2.37 and 2.52(b)(5); TMEP §808 et seq.);
(r) if the mark includes color, a color claim naming the colors that are a feature of the mark, and a separate statement describing where the color(s) appear on the mark. (37 C.F.R. §2.52(b)(1); TMEP §807.07(a) et seq.);
(s) a translation of non-English wording and transliteration of non-Latin characters in the mark, if any (TMEP §809 et seq.);
(t) a statement that identifies any living individual whose name or likeness the mark comprises and indicates that his or her consent is of record, or a statement that the name or portrait does not identify a living individual, if appropriate (15 U.S.C. §1052(c); TMEP §813.01 et seq.);
(u) a claim of the applicant's ownership of prior registrations of the

same or similar marks, if any (37 C.F.R. §2.36; TMEP §812); and
(v) if the applicant seeks to register the mark in standard characters, a statement that "The mark consists of standard characters without claim to any particular font style, size, or color" (TMEP §807.03(a));
(3) a designation of a domestic representative is encouraged, if the applicant is not domiciled in the United States (15 U.S.C. §1051(e); 37 C.F.R. §2.24; TMEP §610);
(4) a filing fee for each class of goods/services (15 U.S.C. §1051(a)(1) and 1051(b)(1); 37 C.F.R. §2.6(a)(1); TMEP §810 et seq.);
(5) in a §44(e) application, a true copy, a photocopy, a certification, or a certified copy of the registration in the applicant's country of origin, and a translation of the foreign registration if it is not in English (15 U.S.C. §1126(e); 37 C.F.R. §2.34(a)(3)(ii); TMEP §1004.01 et seq.); and
(6) in a §1(a) application, one specimen for each class (15 U.S.C. §1051(a)(1); 37 C.F.R. §2.34(a)(1)(iv), 2.56(a), and 2.86(a)(3); TMEP §904 et seq.).
See 15 U.S.C. §1051(a)(3)(D) and 1052(d), 37 C.F.R. §2.99, and TMEP §1207.04 et seq. regarding requirements for applications for concurrent use registration.
See 37 C.F.R. §2.44 and TMEP §1303 et seq. regarding the requirements for collective trademark and collective service mark applications; 37 C.F.R. §2.44 and TMEP §1304 et seq. regarding collective membership mark applications, and 37 C.F.R. §2.45 and TMEP §1306 et seq. regarding certification mark applications.
The following are substantive grounds for refusal. Registration may be refused on the ground that:
(1) The applicant is not the owner of the mark (15 U.S.C. §1051; TMEP §1201);
(2) The subject matter for which registration is sought does not function as a mark (15 U.S.C. §1051, 1052, 1053, and 1127) because, for example, the proposed mark:
(a) is used solely as a trade name (TMEP §1202.01);
(b) is functional, i.e., consists of a utilitarian design feature of the goods or their packaging (15 U.S.C. §1052(e)(5); TMEP §1202.02(a) et seq.);
(c) is a nondistinctive configuration of the goods or their packaging (TMEP §1202.02(b) et seq.);
(d) is mere ornamentation (TMEP §1202.03 et seq.);
(e) is the generic name for the goods or services (TMEP §1209.01(c) et seq.); or

(f) is the title of a single creative work or the name of an author or performing artist (TMEP §1202.08 et seq. and 1202.09 et seq.);
(3) The proposed mark comprises immoral or scandalous matter (15 U.S.C. §1052(a); TMEP §1203.01);
(4) The proposed mark is deceptive (15 U.S.C. §1052(a); TMEP §1203.02 et seq.);
(5) The proposed mark comprises matter that may disparage or falsely suggest a connection with persons, institutions, beliefs, or national symbols, or bring them into contempt or disrepute (15 U.S.C. §1052(a); TMEP §1203.03 et seq.);
(6) The proposed mark comprises the flag, coat of arms, or other insignia of the United States or any State, municipality, or foreign nation (15 U.S.C. §1052(b); TMEP §1204 et seq.);
(7) The applicant's use of the mark is or would be unlawful because it is prohibited by statute (TMEP §1205 et seq.);
(8) The proposed mark comprises a name, portrait, or signature identifying a particular living individual without the individual's written consent, or the name, portrait, or signature of a deceased president of the United States during his widow's life, without written consent of the widow (15 U.S.C. §1052(c); TMEP §1206 et seq.);
(9) The proposed mark so resembles a previously registered mark as to be likely, when used with the applicant's goods and/or services, to cause confusion or mistake, or to deceive (15 U.S.C. §1052(d); TMEP §1207 et seq.);
(10) The proposed mark is merely descriptive or deceptively misdescriptive of the applicant's goods and/or services (15 U.S.C. §1052(e)(1); TMEP §1209 et seq.);
(11) The proposed mark is primarily geographically descriptive of the applicant's goods and/or services
(15 U.S.C. §1052(e)(2); TMEP §1210.01(a));
(12) The proposed mark is primarily geographically deceptively misdescriptive of the applicant's goods and/or services (15 U.S.C. §1052(e)(3); TMEP §1210.01(b)); or
(13) The proposed mark is primarily merely a surname (15 U.S.C. §1052(e)(4); TMEP §1211 et seq.).
An applicant may submit a claim and proof of distinctiveness of the mark or a portion of the mark, under §2(f). See 15 U.S.C. §1052(f); TMEP §1212 et seq.
A mark that is capable of distinguishing the applicant's goods or services may be registrable on the Supplemental Register, in an application under §1 or §44 of the Trademark Act. See 15 U.S.C. §1091

through 1096; TMEP §815 et seq.

The examining attorney will require a disclaimer of an unregistrable component of an otherwise registrable mark. See 15 U.S.C. §1056; TMEP §1213 et seq.

819 TEAS Plus

TEAS Plus permits an applicant who files an application for registration of a trademark or service mark based on §1 or §44 of the Trademark Act, 15 U.S.C. §1051 or §1126, to pay a reduced filing fee, if the applicant:

(1) Files a complete application, using the USPTO's TEAS Plus form, available at http://www.uspto.gov;

(2) Agrees to file certain communications regarding the application, such as responses to Office actions, through TEAS; and

(3) Agrees to receive communications concerning the application by e-mail.

A notice of final rulemaking setting forth the requirements for a TEAS Plus application was published at 70 Fed. Reg. 38768 (July 6, 2005). The requirements that must be met at the time of filing are set forth in 37 C.F.R. §2.22 (see TMEP §819.01 et seq.), and the requirements that must be met during the pendency of the application are set forth in 37 C.F.R. §2.23 (see TMEP §819.02 et seq.). If an applicant files a TEAS Plus application but does not meet these requirements, the applicant will be required to pay an additional TEAS Plus processing fee, i.e., the difference between the filing fee for a regular TEAS application and the reduced fee for a TEAS Plus application. 37 C.F.R. §2.6(a)(1)(iv). See TMEP §819.04.

819.01 TEAS Plus Filing Requirements

To be eligible for the reduced fee, a TEAS Plus application must request registration of a trademark or service mark on the Principal Register, and must include the following at the time of filing:

- Applicant's Name and Address;
- Applicant's Legal Entity and Citizenship (or state or country of incorporation of a juristic applicant);
- Paper Correspondence Address. A name and address for paper correspondence;
- E-mail Correspondence Address and Authorization. An e-mail correspondence address and authorization for the USPTO to send correspondence to the applicant by e-mail;
- Filing Basis or Bases. One or more bases for filing, and all requirements of 37 C.F.R. §2.34 for each basis;
- Identification and Classification of Goods/Services . A correctly classified and definite identification of goods/services taken directly from the USPTO's Acceptable Identification of Goods and Services Manual ("USPTO ID Manual"), at http://tess2.uspto.gov

/netahtml/tidm.html;

- Filing Fee. A filing fee per class for all classes listed in the application;
- Signed Verification. A verified statement, dated and signed by a properly authorized person;
- Drawing. A clear drawing of the mark comprising either: (1) a claim of standard characters and the mark, typed in the appropriate TEAS Plus field; or (2) a digitized image of a mark in special form. If the mark includes color, the digitized image must show the mark in color;
- Color Claim and Description of Color(s). If the mark includes color, a claim that the color(s) is a feature of the mark; and a statement in the "Description of the Mark" field naming the color(s) and describing where the color(s) appears on the mark;
- Description of Mark. If the mark is not in standard characters, a description of the mark;
- Prior Registrations for Same Mark. If the applicant owns one or more registrations for the same mark, a claim of ownership of the registration(s), identified by the United States registration number(s);
- Translation. If the mark includes foreign wording, a translation of that wording;
- Transliteration of Non-Latin Characters. If the mark includes non-Latin characters, a transliteration of those characters;
- Consent to Registration of Name or Portrait. If the mark includes an individual's name or portrait, either: (1) a statement that identifies the living individual whose name or likeness the mark comprises, and written consent of the individual; or (2) a statement that the name or portrait does not identify a living individual;
- Concurrent Use. If the application is a concurrent use application, the application must meet the requirements of 37 C.F.R. §2.42;
- Multiple-Class Applications. If the application contains goods/services in more than one class, the application must meet the requirements of 37 C.F.R. §2.86; and
- Section 44 Applications. In a §44 application, the scope of the goods/services covered by the §44 basis may not exceed the scope of the goods/services in the foreign application or registration.

37 C.F.R. §2.22(a).

As long as the applicant has made a reasonable attempt to supply the required information in the initial application, the applicant has met the TEAS Plus filing requirements and generally will not lose TEAS

Plus status if the information is later amended, either in response to an examining attorney's requirement or on the applicant's initiative, as long as the amendment is filed through TEAS or entered by examiner's amendment. See TMEP §819.01(a) through 819.01(q) for further guidance as to when the additional fee will be required in particular situations.

If an applicant files a TEAS Plus application but does not meet these requirements, the examining attorney must issue an Office action requiring the applicant to pay the additional TEAS Plus processing fee. 37 C.F.R. §§2.6(a)(1)(iv) and 2.22(b). If a required field is filled with irrelevant or clearly inappropriate information, the required element will be considered omitted (e.g., if the notation "???" is entered as the translation in a mark that includes foreign wording).

When an application loses TEAS Plus status, the application will be examined as a regular TEAS application.

The application will retain its original filing date, assuming that the initial application met the minimum filing requirements required of all applications, which are set forth in 37 C.F.R. §2.21. The examining attorney must perform the proper transaction to change the application status in the USPTO's automated systems.

819.01(a) Type of Mark

TEAS Plus is available only to applicants seeking registration of a trademark or service mark on the Principal Register under §1 and/or §44 of the Trademark Act. Applications for certification marks, collective marks, and collective membership marks and applications for registration on the Supplemental Register cannot be filed using TEAS Plus. 37 C.F.R. §2.22(c).

The additional fee will be required if the mark in a TEAS Plus application is amended to a collective, collective membership, or certification mark.

No additional fee will be required if the application is amended from the Principal to the Supplemental Register, as long as the amendment is filed through TEAS or entered by examiner's amendment.

TEAS Plus does not apply to applications filed under §66(a) of the Act, 15 U.S.C. §1141f(a), because they cannot be filed through TEAS.

819.01(b) Applicant's Name and Address

The application must include the applicant's name and address. 37 C.F.R. §2.22(a)(1). The additional fee will be required if this

information is omitted. 37 C.F.R. §2.6(a)(1)(iv) and 2.22(b).
If the application includes this information, no additional fee will be required if the application is amended to clarify the information or to correct an inadvertent error, as long as the amendment is filed through TEAS or entered by examiner's amendment.

819.01(c) Applicant's Legal Entity and Citizenship

The application must include the applicant's legal entity. 37 C.F.R. §2.22(a)(2). The application must also set forth the citizenship of an individual applicant, or the state or country of incorporation or organization of a juristic applicant. 37 C.F.R. §2.22(a)(3). The additional fee will be required if this information is omitted. 37 C.F.R. §2.6(a)(1)(iv) and 2.22(b).
If the application includes this information, no additional fee will be required if the application is amended to clarify the information or correct an inadvertent error, as long as the amendment is filed through TEAS or entered by examiner's amendment.
Trademark Rule 2.22(a)(4) requires that where the applicant is a partnership, the application must include the names and citizenship of the applicant's general partners. However, the USPTO has waived the requirement that this information be provided at the time of filing. If this information is not included in the initial application, the applicant will not lose TEAS Plus status, but the information will be required before the mark is approved for publication. Note: The requirement for the names and citizenship of the general partners applies only to domestic partnerships. 37 C.F.R. §2.32(a)(3)(iii); TMEP §803.04.

819.01(d) Name and Address for Paper Correspondence

The application must include a name and address to which the USPTO can send paper correspondence. 37 C.F.R. §2.22(a)(5). The additional fee will be required if this information is omitted. 37 C.F.R. §2.6(a)(1)(iv) and 2.22(b). The application must also include an e-mail address and an authorization for the USPTO to send correspondence by e-mail. 37 C.F.R. §2.22(a)(6); TMEP §819.01(e). The USPTO will send most official correspondence to the applicant by e-mail, but a paper correspondence address is also required.
If the application includes this information, the applicant will not lose TEAS Plus status if the application is amended to clarify the information or to correct an inadvertent error, as long as the amendment is filed through TEAS or entered by examiner's amendment.

819.01(e) E-mail Address and Authorization for the USPTO to Send Correspondence By E-Mail

The application must include an e-mail address and an authorization for the USPTO to send correspondence by e-mail. 37 C.F.R. §2.22(a)(6). TEAS Plus will not accept transmission of an application that does not include this information.

If the application includes an e-mail address and an authorization for the USPTO to send correspondence by e-mail, no additional fee will be required if the e-mail address is amended to correct an inadvertent error in the address, as long as the amendment is filed through TEAS or entered by examiner's amendment, or if the applicant changes the e-mail address via TEAS (see TMEP §609.02(b)).

The additional fee will be required if the applicant or the applicant's qualified practitioner files a change of correspondence address, and the correspondence address change does not authorize e-mail correspondence.

37 C.F.R. §2.6(a)(1)(iv), 2.23(a)(2) and 2.23(b); TMEP §819.02(a). The applicant cannot avoid paying the fee by subsequently agreeing to authorize e-mail correspondence.

819.01(f) Basis or Bases for Filing

The application must include at least one basis for filing under §1 and/or §44 of the Act that meets the requirements of 37 C.F.R. §2.34. If more than one basis is set forth, the applicant must comply with the requirements of 37 C.F.R. §2.34 for each asserted basis. 37 C.F.R. §2.22(a)(7). Otherwise, applicant will lose TEAS Plus status and will be required to pay the TEAS Plus processing fee.

In a multiple-basis application, if the applicant fails to comply with the requirements of 37 C.F.R. §2.34 for one of the bases claimed in the initial application, the applicant cannot avoid paying the TEAS Plus processing fee by deleting the relevant basis.

819.01(f)(i) Section 1(a) - Use in Commerce

The requirements for establishing a §1(a) basis are set forth in 37 C.F.R. §2.34(a)(1). See also TMEP §806.01(a).

Specimen(s). The application must include one specimen showing how the applicant uses the mark in commerce for each class of goods/services. TEAS Plus will not accept transmission of a §1(a) application that does not include an attachment in the "Specimen" field. As long as the specimen depicts the mark, no additional fee will be required if

registration is refused because the specimen is unacceptable.

An additional fee will be required if the mark on the specimen is materially different from the mark on the drawing. If the marks on the specimen and the drawing are materially different, the applicant has, in effect, failed to submit a specimen showing use of the mark sought to be registered. However, no additional fee will be required if the difference between the mark on the specimen and the mark on the drawing is not material.

Example: The mark on the drawing is ZZZ, and the mark on the specimen is ZEBRAMAX. Amending the drawing to match the specimen would materially alter the mark on the drawing, so the applicant, in effect, has failed to submit a specimen showing use of the mark on the drawing. As a result, the applicant loses TEAS Plus status and the examining attorney will require the additional fee.

Example: The mark on the drawing is ZEBRAMAXX, and the mark on the specimen is ZEBRAMAX. The mark on the drawing is not a substantially exact representation of the mark on the specimen, but the difference between the marks is not material, so the applicant may amend the drawing, or submit a substitute specimen showing use of the mark on the drawing, without paying the additional fee.

Verified Statement of Use in Commerce. The application must include a verified statement that the mark is in use in commerce on or in connection with the goods/services listed in the application. The TEAS Plus form will always include this statement when the applicant asserts a §1(a) basis. See TMEP §819.01(l) regarding verification.

Dates of Use. The application must include a date of first use of the mark anywhere and a date of first use of the mark in commerce for each class of goods/services. When the applicant indicates that it is filing under §1(a), the TEAS Plus form brings up free-text fields in which applicant must type the date of first use anywhere and date of first use in commerce. TEAS Plus will not accept the transmission unless these fields are completed in the appropriate format (MM/DD/YYYY). The applicant will not lose TEAS Plus status if the dates are later amended, as long as the amendment is filed through TEAS.

819.01(f)(ii) Section 1(b) - Intent to Use

A §1(b) application must include a verified statement that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods/services listed in the application. 37 C.F.R. §2.34(a)(2). The TEAS Plus form will always include this statement when the applicant asserts a §1(b) basis. See TMEP §819.01(l)

regarding verification.

819.01(f)(iii) Section 44(e) - Foreign Registration

The requirements for establishing a §44(e) basis are set forth in 37 C.F.R. §2.34(a)(3). See also TMEP §806.01(d). The application must include a digitized image of a copy, a certification, or a certified copy of a registration in the applicant's country of origin showing that the mark has been registered in that country, and that the registration is in full force and effect. If the foreign registration is not in the English language, the applicant must submit a translation. The following are examples of situations where an additional fee will be required:

- Foreign Registration Omitted. TEAS Plus will not accept transmission of a §44(e) application that does not include an attachment in the "Foreign Registration" field. The additional fee will be required if the applicant attaches inappropriate material, such as a copy of the drawing or of the foreign application. 37 C.F.R. §§2.6(a)(1)(iv) and 2.22(b).
- Translation of Foreign Registration Omitted. 37 C.F.R. §§2.22(a)(7) and 2.34(a)(3)(iii). The additional fee will be required if the foreign registration is not in the English language and the applicant does not include a translation.
- Mark Not on Foreign Registration. The additional fee will be required if the mark shown in the drawing does not appear on the foreign registration.
- Material Alteration. The additional fee will be required if the mark on the drawing is a material alteration of the mark on the foreign registration. However, no additional fee will be required if the difference between the mark on the foreign registration and the mark on the drawing is not material.

Example: The mark on the drawing is HI-TECH, and the mark on the foreign registration is HI-TECH! The mark on the drawing is unacceptable because it is not a substantially exact representation of the mark on the foreign registration, but the difference between the marks is not material, so the applicant may amend the drawing to match the foreign registration without paying the additional fee.

Example: The mark on the drawing is HI-TECH, and the mark on the foreign registration is TECHNIQUES. Amending the drawing to match the foreign registration would materially alter the mark on the drawing. The applicant loses TEAS Plus status and must pay the additional fee.

- Goods/Services Exceed Scope of Foreign Registration. The additional fee will be required if the examining attorney determines that the goods/services for which registration is sought under §44(e) in the United States application exceed the scope of those in the foreign registration. 37 C.F.R. §2.22(a)(8).

Foreign Registration Due to Expire - No Fee Required. No additional fee will be required if the foreign registration will expire before the United States registration will issue, and the applicant does not submit evidence in the initial application that the foreign registration will be in effect when the United States registration issues. Prior to registration, however, the applicant will be required to submit a digitized image of a copy, a certification, or a certified copy from the country of origin to establish that the foreign registration has been renewed.

Bona Fide Intention to Use the Mark in Commerce. The application must include a verified statement that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods/services listed in the application. The TEAS Plus form will always include this statement when the applicant asserts a §44(e) basis. See TMEP §819.01(l) regarding verification.

819.01(f)(iv) Section 44(d)

The requirements for establishing a filing basis under §44(d) are set forth in 37 C.F.R. §2.34(a)(4). See also TMEP §806.01(c).

Claim of Priority Filed Within Six Months of Foreign Filing. The additional fee will be required if the claim of priority is not filed through TEAS within six months of the filing date of the foreign application.

The applicant can submit the priority claim after the filing date of the United States application, as long as the priority claim is filed within six months after the foreign filing.

First Filed Application. The applicant must: (a) specify the filing date and country of the first regularly filed foreign application; or (b) state that the application is based upon a subsequent regularly filed application in the same foreign country, and that any prior-filed application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without having any rights outstanding, and has not served as a basis for claiming a right of priority. The additional fee will be required if applicant does not meet this requirement.

Goods/Services Exceed Scope of Foreign Registration. The additional fee will be required if the examining attorney determines that the goods/services for which registration is sought under §44 in the United States application exceed the scope of those in the foreign application or registration. 37 C.F.R. §2.22(a)(8).

Serial Number of Foreign Application Omitted - No Fee Required. No additional fee is required if a §44(d) filing basis is asserted and the applicant fails to specify the serial number of the foreign application in the initial application, because some applicants will not yet know the serial number of the foreign application at the time of filing in the United States. However, the serial number must be provided before the application can be approved for publication. 37 C.F.R. §2.34(a)(4)(i)(A).

Bona Fide Intention to Use the Mark in Commerce. The application must include a verified statement that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods/services listed in the application. The TEAS Plus form will always include this statement when the applicant asserts a §44(d) basis. See TMEP §819.01(l) regarding verification.

819.01(g) Identification and Classification of Goods/Services

USPTO ID Manual. The application must include correctly classified goods and/or services, with an identification of goods/services from the USPTO ID Manual. 37 C.F.R. §2.22(a)(8). The TEAS Plus form will automatically provide the correct class for goods/services selected from the USPTO ID Manual, and it will not permit the applicant to edit the "Classification" field.

To enter an identification of goods/services, the TEAS Plus form will instruct the applicant to enter search terms appropriate for the desired goods/services within the identified field on the TEAS Plus form. The TEAS Plus system will then retrieve relevant entries from the USPTO ID Manual, and the applicant must select one or more of the entries.

Amendment of Identification. No additional fee is required if the identification of goods/services is acceptable and correctly classified as filed, but is later amended, either in response to a requirement or on the applicant's initiative. This is true even if the amendment is unacceptable.

Example: The goods are identified in the application as "pants" and "shirts," and the applicant files a voluntary amendment to "pants, shirts and dresses." The examining attorney will refuse the amended

identification because "dresses" is beyond the scope of the original identification (37 C.F.R. §2.71(a)), but no additional fee will be required.

Fill-in-the-Blank Element. Some USPTO ID Manual entries require the applicant to complete parenthetical information (e.g., "specify the function of the programs"). The display of such entries will include a free-text field so the applicant can type the necessary information, following the instructions within the listing. If an applicant attempts to use such a listing without completing the required information, TEAS Plus will generate an error message.

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: (1) sets forth goods/services in another class (e.g., headgear, namely, football helmets (headgear that is clothing is in Class 25, helmets are in Class 9)); (2) is indefinite (e.g., maternity clothing, namely, sportswear); or (3) is inaccurate (see TMEP §1402.05).

However, an additional fee is required if the applicant leaves the fill-in-the-blank element empty, inserts information that is clearly inappropriate for the selected identification, or inserts additional goods/services that are unrelated to the selected identification. For example, an additional fee is required if the goods/services in the original application are identified as follows:

- "processed meat, namely, laptop computers;"
- "bicycle parts, namely, bicycle parts;"
- "cutlery, namely forks, knives, and rain jackets for dogs;" or
- "sound recordings featuring music, and sunglasses."

In these situations, the applicant has, in effect, failed to submit an identification from the USPTO ID Manual.

The additional fee is required even if the applicant deletes the unacceptable terminology.

Classification. Trademark Rule 2.22(a)(8) indicates that if the applicant classified the goods/services in the wrong class in the initial application, the applicant will lose TEAS Plus status and will be required to pay the additional fee for all classes in the application. However, this is unlikely to occur, because the TEAS Plus form will automatically provide the correct class for goods/services selected from the USPTO ID Manual, and it will not permit the applicant to edit the "Classification" field. No additional fee is required if

the identification is acceptable and correctly classified as filed, but is amended during examination to add or substitute another class (e.g., amendment from "headwear" in Class 25 to "protective helmets for sports" in Class 9; or amendment from "footwear" in Class 25 to "orthopedic footwear" in Class 10), as long as the amendment is filed through TEAS or entered by examiner's amendment. See TMEP §819.03 regarding the addition of classes to a TEAS Plus application.

Section 44 - Goods/Services Exceed Scope of Foreign Registration. In a §44 application, the additional fee is required if the examining attorney determines that the goods/services for which registration is sought under §44 in the United States application exceed the scope of those in the foreign registration. 37 C.F.R. §2.22(a)(8).

819.01(h) Filing Fee

The application must include a filing fee for each class of goods/services as required by 37 C.F.R. §2.6(a)(1)(iii). TEAS Plus will not accept transmission of an application that does not include a fee for each class.

See TMEP §819.03 regarding the fee for adding a class during examination.

819.01(i) Drawing

The application must include a clear drawing of the mark comprising either: (1) a claim of standard characters and the mark, typed in the appropriate TEAS Plus field; or (2) a digitized image of a mark in special form. 37 C.F.R. §2.22(a)(12). TEAS Plus requires the applicant to indicate whether the mark is stylized or in standard characters, and will not accept the transmission unless the applicant selects one of these options.

If the applicant claims standard characters, TEAS Plus will not accept transmission unless something has been typed in the appropriate field. The TEAS Plus system will generate a digitized image of the standard character mark and attach it to the application.

A "clear drawing of the mark" is the same standard used in 37 C.F.R. §2.21(a)(3), which sets forth the requirements for receipt of an application filing date. Thus, if the TEAS Plus application does not include a clear drawing of the mark, the application will be denied a filing date, in accordance with standard procedures for processing informal applications (see TMEP §202 et seq. and 204 et seq.). If the application meets the requirement for a clear drawing of the mark, the applicant will not lose TEAS Plus status if the examining attorney

requires amendment of the drawing because it does not meet all the requirements of 37 C.F.R. §2.51 through 2.53.

Marks That Include Color. If the mark includes color, the drawing must show the mark in color, or the applicant will lose TEAS Plus status. 37 C.F.R. §2.22(a)(12). The application must also include a color claim and a statement in the "Description of the Mark" field naming the color(s) and describing where they appear on the mark. 37 C.F.R. §2.22(a)(14) and 2.52(b)(1). See TMEP §819.01(j).

See TMEP §807.03 et seq. for further information about standard character drawings, and TMEP §807.05(c) for the requirements for digitized images.

819.01(j) Color Claim

As noted above, if the mark includes color, the drawing must show the mark in color. 37 C.F.R. §2.22(a)(12).

In addition, the application must include: (1) a claim that the color(s) is a feature of the mark; and (2) a statement in the "Description of the Mark" field naming the color(s) and describing where the color(s) appear on the mark. 37 C.F.R. §2.22(a)(14) and 2.52(b)(1). The TEAS Plus form includes a checkbox in the "Color(s) Claimed" field to indicate whether the mark is in color. When the applicant checks this box, the applicant must name the colors claimed in the text field below the checkbox in the same "Color(s) Claimed" field. The applicant must then enter the color location statement in a separate "Description of the Mark" field.

As long as the initial application has a color drawing and applicant makes a reasonable attempt to identify the colors claimed in either the "Color(s) Claimed" field or the "Description of the Mark" field, no additional fee is required if the application is amended to clarify the information or to correct an inadvertent error, as long as the amendment is filed through TEAS or entered by examiner's amendment. For example, applicant will not lose TEAS Plus status if the list of colors claimed is incomplete, or if the mark description does not identify the location of the colors claimed. However, the additional fee is required if the applicant fails to identify any colors.

See TMEP §807.07(a) et seq. for further information about color claims.

819.01(k) Description of the Mark

If the mark is not in standard characters, the application must include a description of the mark. 37 C.F.R. §§2.22(a)(15) and 2.37. The applicant must enter the description in the "Description of the Mark"

field of the TEAS Plus application.

TEAS Plus will not accept transmission of an application that does not include either: (1) a standard character claim; or (2) a description of the mark. If the applicant makes a good faith effort to describe the mark, no additional fee is required if the description is later amended, either in response to an examining attorney's requirement or on applicant's initiative, as long as the amendment is filed through TEAS or entered by examiner's amendment. However, the additional fee is required if the applicant enters completely inappropriate information in the "Description of the Mark" field.

If the mark includes color, the "Description of the Mark" field should include a statement naming the color(s) and describing where the color(s) appear on the mark. See TMEP §819.01(j) regarding color claims. The examining attorney should not require the applicant to delete an accurate description of the mark.

See TMEP §808 et seq. for further information about descriptions of the mark.

819.01(l) Verification

The application must include a verified statement that meets the requirements of 37 C.F.R. §2.33, dated and signed by a person properly authorized to sign on behalf of the applicant pursuant to §2.193(e)(1). 37 C.F.R. §2.22(a)(11). If the application includes a signed verification, no additional fee is required if a substitute verification is later submitted, as long as it is submitted through TEAS.

To provide a signature, the applicant has the option of: (1) entering any combination of letters, numbers, spaces, and/or punctuation marks that the filer has adopted as a signature, placed between two forward slash ("/") symbols in the TEAS Plus form (37 C.F.R. §2.193(c))(1)); (2) signing the verified statement in the traditional pen-and-ink manner, and attaching an image file of the signed document to the TEAS Plus form; or (3) completing the application online and e-mailing it to the signatory for electronic signature and automatic return via TEAS to the party who requested the signature. See TMEP §611.01(c).

If the applicant elects to attach a verified statement with a pen-and-ink signature, the additional fee will be required if the attachment:

- fails to include a signature; or
- does not display the text of the verification and declaration (i.e., only displays a signature).

819.01(m) Translation and/or Transliteration

If the mark includes non-English wording, the application must include an English translation of that wording.

37 C.F.R. §2.22(a)(16) and 2.32(a)(9). If the mark includes non-Latin characters, the application must include a transliteration of those characters.

37 C.F.R. §2.22(a)(17) and 2.32(a)(10). The TEAS Plus form does not include any edits to determine when a translation and/or transliteration is required.

If a translation and/or transliteration is omitted, the examining attorney will issue an Office action requiring the additional fee.

37 C.F.R. §2.6(a)(1)(iv) and 2.22(b). If the initial application includes a translation and/or transliteration, no additional fee is required if the translation/transliteration is later amended, as long as the amendment is filed through TEAS or entered by examiner's amendment. However, the additional fee will be required if the translation or transliteration comprises inappropriate material, such as the notation "???."

819.01(n) Multiple-Class Applications

If the application contains goods/services in more than one class, the application must meet the requirements of 37 C.F.R. §2.86. 37 C.F.R. §2.22(a)(9). That is, the application must include:

(1) An identification of goods/services in each class, from the USPTO ID Manual. 37 C.F.R. §2.22(a)(8) and 2.86(a)(1). See TMEP §819.01(g);

(2) An application filing fee for each class. 37 C.F.R. §2.6(a)(1)(iii) and 2.86(a)(2). TEAS Plus will not accept transmission of an application that does not include a filing fee for each class; and

(3) Either (a) dates of use and one specimen for each class, in an application under §1(a) of the Trademark Act; or (b) a statement that the applicant has a bona fide intention to use the mark in commerce on or in connection with all the goods/services specified in each class, in an application under §1(b) or §44 of the Trademark Act. 37 C.F.R. §2.86(a)(3).

819.01(o) Consent to Registration of Name or Portrait

If the mark includes a name or portrait that could reasonably be perceived as the name or portrait of a particular living individual (see TMEP §813 and 1206 et seq.), the application must include either:

(1) a statement that identifies the living individual whose name or likeness the mark comprises and written consent of the individual; or

(2) a statement that the name or portrait does not identify a living individual. 37 C.F.R. §2.22(a)(18).

The additional fee is required if the mark includes an individual's name or portrait, and these statements are omitted.

37 C.F.R. §§2.6(a)(1)(iv) and 2.22(b).

Exception: If the applicant fails to include a consent to use a name or portrait that appears in the mark, but the individual's consent can be presumed because the individual named or shown in the mark personally signed the application (see TMEP §1206.04(b)), the applicant will not lose TEAS Plus status.

If consent is of record in a valid registration owned by applicant, the applicant may satisfy the requirement for a consent statement by claiming ownership of the existing registration. See TMEP §1206.04(c).

If the initial application includes a statement regarding the name or likeness of an individual, no additional fee is required if the statement is later amended, as long as the amendment is filed through TEAS or entered by examiner's amendment.

The additional fee should be required only where it is clear that the name or likeness could reasonably be perceived as that of a living individual. The fee should be charged if the mark is comprised of a portrait, or of a first and last name. If the mark is comprised of a title, such as Mrs. Smith, a surname, or a first name only, the examining attorney must consider whether the name is that of a particular living individual (see TMEP §1206.03), but should not require the additional fee.

Example: The mark is STEVEN JONES, and the application is silent as to whether this name identifies a living individual. The examining attorney must: (1) inquire whether the name or likeness is that of a specific living individual and advise the applicant that, if so, the individual's written consent to register the name must be submitted; and (2) require the additional TEAS Plus processing fee.

Example: The mark is DOCTOR JONES, and the application is silent as to whether this name identifies a living individual. If there is evidence that the name identifies an individual who is generally known or well known in the field relating to the relevant goods or services (see TMEP §1206.02 and 1206.03), the examining attorney must issue an inquiry and require the individual's written consent to register the name, but should not require the additional TEAS Plus processing fee. If there is no evidence that the individual is generally known or well known in the relevant field, the examining attorney should not inquire or require the additional fee.

Example: The mark is STEVEN, and the application is silent as to whether this name identifies a living individual. If there is no evidence that the individual is generally known or well known in the relevant field, the examining attorney should not inquire or require the additional fee. If there is evidence that the first name identifies an individual who is generally known or well known in the relevant field, the examining attorney must issue an inquiry and require the individual's written consent to register the name, but should not require the additional TEAS Plus processing fee.

See TMEP §1206.03 for further information as to when the examining attorney should issue an inquiry as to whether a name or likeness is that of a particular living individual, and TMEP §1206.02 regarding the connection between the individual and the relevant goods or services.

819.01(p) Prior Registration of the Same Mark

If the applicant owns one or more registrations for the same (i.e., identical) mark as of the application filing date, the application must include a claim of ownership of the prior registration(s), identified by the United States registration number(s). 37 C.F.R. §2.22(a)(19) and 2.36. See TMEP §812. The TEAS Plus form accepts the entry of up to three registration numbers. If the applicant owns more than three registrations for the same mark, the TEAS Plus applicant may check the box "and others" after entering the numbers for the three claimed registrations.

The additional fee is required if a claim of ownership of registration(s) for the same mark is omitted. 37 C.F.R. §2.6(a)(1)(iv) and 2.22(b). If the initial application includes an ownership claim for the same mark, the application will not lose TEAS Plus status if the claim is later amended, as long as the amendment is filed through TEAS or entered by examiner's amendment.

No additional fee is required if a list of claimed registrations for the same mark is incomplete (e.g., applicant owns three registrations for the same mark and only claims two of them), but the examining attorney may require a claim of ownership of additional registrations for the same mark during examination.

No additional fee is required if an applicant fails to claim ownership of a registration(s) for a similar mark (e.g., mark in application is ABC and applicant fails to claim ownership of a registration for ABC WEB BUILDERS). However, the examining attorney will require a claim of ownership of similar marks during examination, where appropriate.

819.01(q) Concurrent Use Applications

If the applicant seeks concurrent use registration, the application must comply with the requirements of 37 C.F.R. §2.42. 37 C.F.R. §2.22(a)(20). That is, the applicant must:

- Set forth the geographic area, the goods, and the mode of use for which applicant seeks registration; and
- State, to the extent of the applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; registrations issued to or applications filed by such others, if any; the geographic areas of such use; the goods on or in connection with which such use is made; the mode of such use; and the periods of such use.

If the elements for a concurrent use application are omitted, the examining attorney will issue an Office action requiring the additional fee. 37 C.F.R. §2.6(a)(1)(iv) and 2.22(b). If the initial application includes a concurrent use claim with the proper elements, the application will not lose TEAS Plus status if an element is later amended, as long as the amendment is filed through TEAS or entered by examiner's amendment.

See TMEP §1207.04(d)(i) for further information about the requirements for concurrent use applications.

819.02 Additional Requirements for a TEAS Plus Application

819.02(a) Receipt of Communications by E-Mail

Trademark Rule 2.22(a)(6), 37 C.F.R. §2.22(a)(6), requires that the application as filed include an e-mail address for correspondence and an authorization for the USPTO to send correspondence concerning the application to the applicant by e-mail. Trademark Rule 2.23(a)(2), 37 C.F.R. §2.23(a)(2), requires that the applicant maintain a valid e-mail correspondence address, and continue to receive correspondence by e-mail throughout the pendency of the application.

The additional fee will be required if the TEAS Plus applicant (or the applicant's qualified practitioner) files a change of correspondence address, and the correspondence address change does not authorize e-mail correspondence, or if it comes to the attention of the USPTO that the applicant has a change in e-mail address, but does not notify the USPTO of the new e-mail address, thereby causing correspondence from the USPTO to be undeliverable. 37 C.F.R. §§2.6(a)(1)(iv) and 2.23(b). The applicant cannot avoid paying the fee by subsequently agreeing to

authorize e-mail correspondence.

When issuing a nonfinal action on a TEAS Plus application, the examining attorney will notify the applicant that the applicant must maintain a valid e-mail correspondence address, and continue to accept correspondence from the USPTO via e-mail throughout the examination process in order to avoid the additional fee. If the applicant files a request to change the correspondence address that does not authorize e-mail correspondence, the requirement for payment of the additional fee will be made final, assuming that the application is otherwise in condition for final refusal.

819.02(b) Additional Documents That Must be Filed Through TEAS

In addition to the filing requirements set forth in 37 C.F.R. §2.22 (see TMEP §819.01 et seq.), to maintain TEAS Plus status, the applicant must file the following documents through TEAS:

- Responses to Office actions (except notices of appeal);
- Requests for reconsideration of final Office actions;
- Requests to change the correspondence address and/or owner's address;
- Appointment and/or revocation of power of attorney;
- Appointment and/or revocation of domestic representative;
- Voluntary amendments;
- Amendments to allege use under §1(c) of the Trademark Act, 15 U.S.C. §1051(c);
- Statements of use under §1(d) of the Trademark Act, 15 U.S.C. §1051(d);
- Requests for extensions of time to file a statement of use under §1(d) of the Trademark Act, 15 U.S.C. §1051(d); and
- Requests to delete a §1(b) basis in a multiple-basis application.

37 C.F.R. §2.23(a)(1). The additional fee(s) for each class of goods/services will be required if the applicant files one of these documents on paper. 37 C.F.R. §§2.6(a)(1)(iv) and 2.23(b).

When issuing a nonfinal action on a TEAS Plus application, the examining attorney will require that the applicant either: (1) respond through TEAS (or by examiner's amendment, if appropriate); or (2) if responding on paper, include the additional TEAS Plus processing fee with the response. If the applicant files a paper response without the required fee, the requirement for payment of the fee will be made final, assuming that the application is otherwise in condition for final refusal. See TMEP §714 et seq. regarding procedures for issuing a final refusal.

If a Notice of Allowance has issued and the applicant files a statement of use or request for an extension of time to file a statement of use on paper, or any other document that is required to be filed electronically, the ITU Unit staff will send a letter requiring payment of the additional fee. If the applicant fails to submit the fee, the examining attorney will require payment of the fee during examination of the statement of use.

819.03 Adding a Class During Examination

Amendments to classification are rare in TEAS Plus applications, since the identification of goods/services is taken from the USPTO ID Manual, and the TEAS Plus form does not permit the applicant to edit the "Classification" field. In the rare case where the TEAS Plus applicant amends the application to add a product or service that is within the scope of the original identification of goods/services, but is in a different class, the fee for the additional class is the reduced TEAS Plus fee, as long as the amendment is filed through TEAS or entered by examiner's amendment. See TMEP §1403.02(c).

Example: The applicant selects the identification "hair shampoo" in Class 3. The applicant later adds "dandruff shampoo" in Class 5, which is within the scope of the original identification. The applicant will pay the reduced TEAS Plus fee, as long as the applicant has not lost TEAS Plus status for some other reason.

If the applicant adds a class after losing TEAS Plus status, the applicant must pay the regular TEAS fee if the fee is paid through TEAS or by examiner's amendment, or the paper fee if the class is added by a paper amendment.

819.04 Procedures for Payment of TEAS Plus Processing Fee Per Class

A TEAS Plus applicant must pay a processing fee per class to have the application examined as a regular TEAS application if: (1) the initial application does not meet the requirements of 37 C.F.R. §2.22(a); (2) the applicant files one of the documents listed in 37 C.F.R. §2.23(a)(1) on paper; or (3) the applicant files a notice of change of correspondence address that does not authorize e-mail correspondence. 37 C.F.R. §2.6(a)(1)(iv) , 2.23(a)(2), and 2.23(b). The application will retain its original filing date, assuming the initial application met the minimum filing requirements that are mandatory for all applications under 37 C.F.R. §2.21(a).

Processing Fee Must Be Paid for All Active Classes. If the applicant loses TEAS Plus status, the applicant must pay the TEAS Plus processing

fee per class for all classes that are in the application at the time the examining attorney issues the Office action requiring the TEAS Plus processing fee.

Example: The original application is for two classes. The applicant loses TEAS Plus status because in the original application, the applicant failed to include a transliteration of the Chinese characters in the mark. The first Office action includes: (1) a requirement for a transliteration; (2) a requirement for the additional fee for two classes; and (3) a refusal of registration as to one class under §2(d) of the Trademark Act. If the applicant responds by submitting a transliteration and deleting the class that was refused, the applicant must pay the processing fee for two classes, because there were two classes in the application when the Office action requiring the processing fee was issued.

Example: The original application is for two classes. One of the items in the identification has a fill-in-the-blank element and requires amendment. The first Office action includes: (1) a requirement to amend the identification of goods/services; and (2) a refusal of registration because the mark is merely descriptive of the goods. The applicant responds through TEAS by deleting a class and submitting evidence that the mark has acquired distinctiveness. The examining attorney issues another refusal. If the applicant responds on paper, the applicant is only required to pay the processing fee for one class, because the applicant deleted the second class before the applicant lost TEAS Plus status.

Examiner's Amendment. If all remaining issues can be handled through a telephone or e-mail conversation with the applicant or the applicant's qualified practitioner, and the applicant uses a deposit account to pay the fee or faxes an authorization to charge the fee to a credit card, the fee may be collected by examiner's amendment. However, a fee cannot be charged to a deposit account by examiner's amendment unless the record contains a written authorization, signed by someone who is authorized to charge fees to the account.

If there is no written authorization in the record, the applicant may submit the authorization by fax or e-mail.

See TMEP §405.03 regarding deposit accounts.

Combined Examiner's Amendment/Priority Action. If all of the issues except payment of the processing fee are resolved by a telephone or e-mail conversation with the applicant or the applicant's qualified practitioner, the examining attorney may issue a combined Examiner's Amendment/Priority Action (TMEP §708.05) to enter the amendment(s) and

require payment of the TEAS Plus processing fee.

No Partial Refusal. If the applicant loses TEAS Plus status, the requirement for the TEAS Plus processing fee applies to the entire application, so an Office action requiring the processing fee can never be a partial refusal.

Paying the Processing Fee Through TEAS. To pay the TEAS Plus processing fee through TEAS, the applicant must use the TEAS Response to Office Action ("ROA") form. The TEAS "Voluntary Amendment Not in Response to USPTO Office Action/Letter" form does not permit payment of the TEAS Plus processing fee. Also, if the requirement for the processing fee is issued in the first action, TEAS will not allow the applicant to use the TEAS ROA form to pay the fee until 48-72 hours after the Office action is entered into the Trademark database.

820 TEAS RF (Reduced Fee)

TEAS RF permits an applicant who files an application for registration of a trademark, service mark,certification mark, collective membership mark, or collective trademark based on §1 or §44 of the Trademark Act, 15 U.S.C. §1051 or §1126, to pay a reduced filing fee of $275 per class, if the applicant:

(1) Files an application, using the USPTO's TEAS RF application, available at http://www.uspto.gov;

(2) Agrees to file certain communications regarding the application, such as responses to Office actions, through TEAS; and

(3) Agrees to receive communications concerning the application by e-mail.

The requirements that must be met at the time of filing are set forth in 37 C.F.R. §2.23(a) (see TMEP §820.01) and the requirements that must be met during the pendency of the application are set forth in 37 C.F.R. §2.23(b) (see TMEP §820.02 – 820.02(b)). If an applicant files a TEAS RF application but does not meet these requirements, the applicant will be required to pay an additional TEAS RF processing fee of $125 per class. 37 C.F.R. §2.6(a)(1)(v). See TMEP §820.04.

820.01 TEAS RF Filing Requirements

To be eligible for the reduced fee, the TEAS RF application must include an e-mail correspondence address and authorization for the USPTO to send correspondence to the applicant by e-mail. 37 C.F.R. §2.23(a).

If the application includes an e-mail address and an authorization for the USPTO to send correspondence by e-mail, no additional fee will be required if the e-mail address is amended to correct an inadvertent error in the address prior to correspondence from the Office being returned as undeliverable, as long as the amendment is filed through TEAS or entered by examiner's amendment, or if the applicant changes thee-mail address via TEAS (see TMEP §609.02(b)).

820.02 Additional Requirements for a TEAS RF Application

820.02(a) Receipt of Communications by E-Mail

Trademark Rule 2.23(b)(2), 37 C.F.R. §2.23(b)(2), requires that the applicant maintain a valid e-mail correspondence address and continue to receive correspondence by e-mail throughout the pendency of the application.

If the TEAS RF applicant (or the applicant's qualified practitioner)

files a change of correspondence address, and the correspondence address change does not authorize e-mail correspondence, or if the applicant has a change in e-mail address, but does not notify the USPTO of the new e-mail address, thereby causing correspondence from the USPTO to be undeliverable, the applicant will be required to pay an additional processing fee. 37 C.F.R. §2.6(a)(1)(v) and 2.23(c). The applicant cannot avoid paying the fee by subsequently agreeing to authorize e-mail correspondence.

When issuing a nonfinal action on a TEAS RF application, the examining attorney will include a reminder that the applicant must maintain a valid e-mail correspondence address and continue to accept correspondence from the USPTO via e-mail throughout the examination process in order to avoid the additional fee. If the applicant files a request to change the correspondence address that does not authorize e-mail correspondence, the requirement for payment of the additional fee will be made final, assuming that the application is otherwise in condition for final refusal.

820.02(b) Additional Documents That Must be Filed Through TEAS

To maintain TEAS RF status, the applicant must also file the following documents through TEAS:

Responses to Office actions (except notices of appeal);

Requests for reconsideration of final Office actions;

Requests to change the correspondence address and/or owner's address;

Appointment and/or revocation of power of attorney;

Appointment and/or revocation of domestic representative;

Voluntary amendments;

Amendments to allege use under §1(c) of the Trademark Act, 15 U.S.C. §1051(c);

Statements of use under §1(d) of the Trademark Act, 15 U.S.C. §1051(d);

Requests for extensions of time to file a statement of use under §1(d) of the Trademark Act, 15 U.S.C. §1051(d); and

Requests to delete a §1(b) basis in a multiple-basis application.

37 C.F.R. §2.23(b)(1). The additional fee(s) for each class of goods / services will be required if the applicant files any of these documents on paper. 37 C.F.R. §2.6(a)(1)(v) and 2.23(c).

When issuing a nonfinal action on a TEAS RF application, the examining attorney will require that the applicant either: (1) respond through TEAS (or by examiner's amendment, if appropriate); or (2) if responding on paper, include the additional TEAS RF processing fee with the response. If the applicant files a paper response without the required

fee, the requirement for payment of the fee will be made final, assuming that the application is otherwise in condition for final refusal. See TMEP §714–714.06 regarding procedures for issuing a final refusal.

If a Notice of Allowance has issued and the applicant files a statement of use or request for an extension of time to file a statement of use on paper, or any other document that is required to be filed electronically between issuance of the Notice of Allowance and filing of the statement of use, the ITU Unit staff will send a letter requiring payment of the additional fee. If the applicant fails to submit the fee, the examining attorney will require payment of the fee during examination of the statement of use.

820.03 Adding a Class During Examination

The fee to add a class to a TEAS RF application during examination is the reduced TEAS RF fee, as long as the amendment is filed through TEAS or entered by examiner's amendment and the applicant has not lost TEAS RF status for some other reason. See TMEP §1403.02(c).

If the applicant adds a class after losing TEAS RF status, the applicant must pay the regular TEAS fee if the fee is paid through TEAS or by examiner's amendment, or the paper fee if the class is added by a paper amendment.

820.04 Procedures for Payment of TEAS RF Processing Fee Per Class

A TEAS RF applicant must pay a processing fee per class if: (1) the initial application does not meet the requirements of 37 C.F.R. §2.23(a); (2) the applicant files one of the documents listed in 37 C.F.R. §2.23(b)(1) on paper; or (3) the applicant files a notice of change of correspondence address that does not authorize e-mail correspondence. 37 C.F.R. §2.6(a)(1)(v), 2.23(b)(2), (c).

The application will retain its original filing date, assuming the initial application met the minimum filing requirements that are mandatory for all applications under 37 C.F.R. §2.21(a). It will subsequently be examined as a regular TEAS application. Processing Fee Must Be Paid for All Active Classes. If the applicant loses TEAS RF status, the applicant must pay the TEAS RF processing fee per class for all classes that are in the application at the time the examining attorney issues the Office action requiring the TEAS RF processing fee.

Example: The original application is for two classes. Prior to assignment of the application to an examining attorney, the applicant

files an unacceptable amendment to the mark via paper correspondence. In addition to addressing the unacceptable amendment, the first Office action will include a requirement for the processing fee for the original two classes and any additional classes that might be added, provided such classes are within the scope of the original identification.

Examiner's Amendment. If all remaining issues can be handled through a telephone or e-mail conversation with the applicant or the applicant's qualified practitioner, and a deposit account is used to pay the fee or an authorization to charge the fee to a credit card is submitted by fax, the fee may be collected by examiner's amendment. However, a fee cannot be charged to a deposit account by examiner's amendment unless the record contains a written authorization, signed by someone who is authorized to charge fees to the account. If there is no written authorization in the record, the applicant may submit the authorization by fax or e-mail. See TMEP §405.03 regarding deposit accounts.

Combined Examiner's Amendment / Priority Action. If all of the issues except payment of the processing fee are resolved by a telephone or e-mail conversation with the applicant or the applicant's qualified practitioner, the examining attorney may issue a combined Examiner's Amendment / Priority Action (TMEP §708.05) to enter the amendment(s) and require payment of the TEAS RF processing fee.

No Partial Refusal. If the applicant loses TEAS RF status, the requirement for the TEAS RF processing fee applies to the entire application, so an Office action requiring the processing fee can never be a partial refusal.

Paying the Processing Fee Through TEAS. To pay the TEAS RF processing fee through TEAS, the applicant may use the TEAS Response to Office Action ("ROA") form or the TEAS Voluntary Amendment Not in Response to USPTO Office Action / Letter form. If the requirement for the processing fee is issued in the first action, TEAS will not allow the applicant to use the TEAS ROA form to pay the fee until 48-72 hours after the Office action is entered into the Trademark database.