

TMEP HIGHLIGHTS – MAY 2024

This outline highlights some of the clarifications and changes set forth in the May 2024 version of the TMEP. For a more complete listing, see the “Index to Changes in TMEP May 2024” document, which is posted as part of the TMEP.

ATTORNEY RECOGNITION

Three Ways to Be Recognized as a Representative (TMEP §604.01)

- Neither a telephone call nor an email from a qualified U.S. attorney satisfies the “appearance” requirements of 37 C.F.R. §2.17(b)(1)(iii). However, after issuance of an Office action to a pro se applicant *or registrant*, and prior to response, a qualified U.S. attorney may appear by being identified as the representative in a document submitted on behalf of an applicant or registrant, *such as the Change Address or Representation (CAR) form*. *Such document need not be signed by an individual with legal authority to bind (e.g., a corporate officer or general partner of a partnership) the applicant or registrant to meet the appearance requirements of 37 C.F.R. §2.17(b)(1)(iii). Alternatively, a qualified U.S. attorney may be recognized as an unrepresented applicant’s or registrant’s representative by signing a document such as a CAR form or a response.*

ELECTRONIC SIGNATURES GENERATED USING DOCUMENT-SIGNING SOFTWARE

Requirements for Electronic Signatures Generated Using Document-signing Software (TMEP §611.01(c)(ii))

- The requirements regarding submissions signed using document-signing software apply only to documents that must be signed in accordance with Rule 2.193(e). *This includes verified statements in support of an application and verified statements in support of an amendment to an application or registration, such as verified statements submitted to support a claim of acquired distinctiveness under Section 2(f).*
- The pdf signature page generated in the USPTO’s forms containing the USPTO timestamp is currently only available for declarations or verifications *and when using the CAR form*. Accordingly, only these types of signatures, and not any other submission signatures, can meet the requirements of an acceptable electronic signature generated using document-signing software as set forth immediately above.

CITATION

Citation of Decisions and USPTO Publications (TMEP §705.05)

- Citation to precedential Board decisions may be to the USPQ, LEXIS/NEXIS, or Westlaw. The serial number or registration number for appeal cases and the proceeding number for trial cases should be included. If the submitting party does not have any access to legal research databases, citation may be made to a USPTO public electronic database containing the decision (e.g., TTABVUE), indicating the relevant docket entry and page. The citation should include the serial number or registration number for appeal cases and the proceeding number for trial cases.
- Any nonprecedential cases referenced must be clearly identified as nonprecedential.

EXAMINER'S AMENDMENTS

Examiner's Amendment Without Prior Authorization by Applicant or Applicant's Attorney (TMEP §707.02)

Added the following situation when a no-call examiner's amendment may be entered:

- If the examining attorney determines that a translation statement will not be published in the Trademark Official Gazette or included on the registration certificate, and it is not necessary to issue an Office action or a regular examiner's amendment regarding other matters, the examining attorney may enter a Note to the File in the record or issue a "no-call" amendment to that effect.

EVIDENCE

Internet Evidence (TMEP §710.01(b))

- With respect to evidence taken from the online dictionary of slang terms, Urban Dictionary®, the Board has noted that Urban Dictionary® entries suffer from the same potential reliability problems as Wikipedia because it is "a collaborative website that permits anyone to submit or edit a definition." The Board has stated that it "will consider dictionary definitions taken from Urban Dictionary so long as the non-offering party

has an opportunity to rebut that evidence by submitting other definitions that may call into question the accuracy of the particular Urban Dictionary definitions.” . . . If the examining attorney relies upon Wikipedia® or Urban Dictionary® evidence and makes it of record, then additional supportive and corroborative evidence from other sources should also be made of record, especially when issuing final actions.

Evidence of Third-Party Registrations (TMEP §710.03)

- To make a third-party registration of record, or a registration owned by the applicant or registrant not the subject of the appeal, a copy of the registration (from either the electronic records of the Office or the paper USPTO record) must be submitted.

EXTENSIONS OF TIME TO RESPOND

Supplemental Office Action Resetting Response Period (TMEP §711.03)

- When the examining attorney must issue a supplemental Office action in a §1 and/or §44 application to address a refusal or requirement that should have been raised in the previous Office action, and the applicant was granted an extension of time to respond to the previous Office action, the USPTO will refund the fee for the extension of time to respond if the response period for the supplemental Office action is earlier than the extended response period for the previous Office action. The examining attorney will submit the request to TM Finance with the information necessary for processing the refund.

ABANDONMENT

Examining Attorney's Action When New Issue or New Evidence is Presented and Notice of Appeal Has Been Filed (TMEP §715.04(b))

- Whenever the examining attorney issues a new nonfinal action after remand of an application by the Trademark Trial and Appeal Board (Board), the Office action must include a response clause (see TMEP §705.08) and should explain that the applicant must respond to all refusals and/or requirements within the time period set forth in the Office action, but should not file another appeal to the Board. *If the applicant does not respond to the new nonfinal action, the application will be abandoned for failure to respond.*

SUSPENSION

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

- The USPTO will not suspend an application when a Section 2(d) refusal is issued and the record of the cited registration includes a show-cause order or an order for sanctions.
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SOLE PROPRIETORSHIP

Various sections have been revised to clarify that for a foreign sole proprietorship, the name and national citizenship of the sole proprietor must be provided, including:

Common Terms Designating Entity of Foreign Applicants (TMEP 803.03(i))

- For foreign entities, the applicant must also specify the foreign country under the laws of which it is organized. The applicant, however, *generally* is not required to provide other information even if additional information would be required for a U.S. 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. . . . *However, foreign sole proprietorships must indicate the foreign country of organization of the sole proprietorship and specify the name and national citizenship of the sole proprietor.*
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SUPPLEMENTAL REGISTER

Elements Required (TMEP §815.02)

- *In an application with §1(b) and §44 bases, the effective filing date of the application will not change to the date on which the applicant files an allegation of use to amend the application to the Supplemental Register. In such case, a new search would not be required.*
- If an applicant submits a §1(b) *sole-basis application* or *combines it with a §44 basis* and requests registration on the Supplemental Register for which no acceptable allegation of use has been filed, the examining attorney must refuse registration under §23 on the ground that the mark is not in lawful use in commerce. The examining attorney will withdraw the refusal *for a §1(b) sole-basis application* if the applicant submits an acceptable allegation of use *or withdraws the request to amend to the Supplemental Register. For applications with §1(b) and §44 bases where the applicant deletes or divides out the goods,*

services, or classes with the §1(b) basis, the examining attorney will also withdraw the refusal for the §44 sole-basis application. However, the refusal under §23 will be maintained against the application with the §1(b) basis.

Similar changes were made in TMEP §§1014 and 1102.03.

Filing on Supplemental Register Is Not an Admission that the Mark Has Not Acquired Distinctiveness (TMEP §815.03)

- 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. *However, seeking registration on the Supplemental Register is an admission that the mark is not inherently distinctive.*

INFORMATIONAL MATTER

Only certain citations are included. These sections incorporate the following recent precedential cases: *In re Lizzo LLC*, 2023 USPQ2d 139, at *3 (TTAB 2023), *In re Black Card LLC*, 2023 USPQ2d 1376, at *4 (TTAB 2023), and *In re GO & Assocs., LLC*, 90 F.4th 1354, 2024 USPQ2d 616, at *3 (Fed. Cir. 2024).

Informational Matter (TMEP §1202.04)

- The critical inquiry in determining whether matter functions as a trademark or service mark is how the proposed mark would be perceived by the relevant public—*in other words, whether the evidence shows the proposed mark would be understood as a means to identify and distinguish the applicant’s goods or services from those of others.*
- Evidence of third-party use does not need to show commercial use of the proposed mark with goods or services to be probative of consumer perception, *but must be competent to suggest that upon encountering the proposed mark, consumers would be unlikely to consider it as indicating the source of the applicant’s goods or services.* As the critical focus of the refusal or disclaimer requirement is consumer perception, any evidence demonstrating widespread use of the matter in question is relevant to determining whether consumers would perceive the matter as a mark. *In addition, the evidence need not necessarily include third-party use in connection with the specific goods or services at issue to support the failure-to-function refusal. However, where evidence of use in other contexts is included, the evidence must be sufficient to demonstrate that the matter in question conveys a single, common sentiment or meaning across a variety of goods or services such that*

consumers will view it as conveying that same sentiment or meaning regardless of the goods or services in connection with which it is used.

Widely Used Messages (TMEP §1202.04(b))

- The more commonly a term or phrase is used in everyday speech or in an associational or affinitive manner by various sources, the less likely consumers will perceive the matter as a trademark or service mark for any goods and services. *Thus, where the evidence suggests the "ordinary consumer would take the words at their ordinary meaning rather than read into them some special meaning distinguishing the goods and/or services from similar goods and/or services of others, then the words fail to function as a mark."*
- Evidence demonstrating that the public would perceive the wording merely as conveying the ordinary meaning of the message, or enthusiasm for, affinity with, or endorsement of the message, *when encountering it in the context of the applicant's goods or services*, supports this refusal. *"When assessing such evidence, the focus is not only on common use of the phrase, but on whether the various uses inform how the phrase would be perceived by consumers of the identified goods or services." In re Black Card LLC, 2023 USPQ2d 1376, at *4 (TTAB 2023). When supporting the refusal with evidence showing use of the term or expression across a variety of contexts, the evidence must demonstrate that a single, commonly understood sentiment or meaning exists, such that consumers will view the phrase as conveying that same sentiment or meaning in the context of the applicant's goods or services. Id. (reversing a failure-to-function refusal because the evidence showed that the phrase FOLLOW THE LEADER has different meanings in different contexts such that the Board could not reasonably infer a commonly understood meaning applicable to applicant's services that would render it incapable of being perceived as a source indicator for those services).*

TITLE OF A SINGLE CREATIVE WORK

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

- A creative work that is merely translated into a different language is still considered a single creative work and is akin to selling a book or record album in different media formats.

CHARACTERS IN CREATIVE WORKS

Characters in Creative Works (TMEP §1202.10)

- Marks that merely identify a character in a creative work, whether used in a series or in a single work, are not registrable. . . . These types of marks encompass “any matter that identifies a character, including names, designs, images, nicknames, and the like.”

REFUSAL OF MATTER PROTECTED BY STATUTE OR CONVENTION

Sections have been revised to incorporate the repeal of the following statutes: 18 U.S.C. §§707 (4-H Club), 708 (Swiss coat of arms), 711 (“Smokey Bear”), and 711a (“Woodsy Owl” and slogan, “Give a Hoot, Don’t Pollute”). References to these statutes have been deleted.

Statutory Protection (TMEP §1205.01)

- In certain circumstances the USPTO may remove a non-registration record from its search records, such as when a statutory restriction has been repealed. Removal of a non-registration record does not mean a refusal is not warranted under the Trademark Act. For example, it may still be appropriate for the examining attorney to refuse registration of a mark consisting of formerly statutorily protected matter under §2(a) on the ground that the mark comprises matter that may falsely suggest a connection with a person, institution, belief, or national symbol or under §2(b) for matter that comprises a flag, coat of arms, or other similar insignia.

Examination Procedures for Marks Containing the Swiss Confederation Coat of Arms or Flag (TMEP §§1205.01(d)-1205.01(d)(iii))

Sections regarding a refusal under Sections 1 and 45 for the Swiss coat of arms (formerly TMEP §1205.01(d)(i)-1205.01(d)(i)(E)) have been deleted and the remaining sections were renumbered. For example, TMEP §1205.01(d)(ii) (Refusal Under §2(b): Swiss Flag or Swiss Coat of Arms) is now renumbered as TMEP §1205.01(d)(i). References to a Sections 1 and 45 refusal in the remaining sections were deleted.

TRADE DRESS

Three-Dimensional Trade Dress Service Marks (TMEP §1301.02(c))

- Trade dress for services, which is analogous to product packaging, can be inherently distinctive.

- The test for determining inherent distinctiveness set forth in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344, 196 USPQ 289, 291 (C.C.P.A. 1977) is applied to trade dress for services.

IDENTIFICATIONS OF GOODS AND SERVICES

Effective Date of Changes to USPTO ID Manual (TMEP §1401.10)

- In the ID Manual, the “Effective Date” indicates the date on which the status (i.e., Added, Modified, Example, or Deleted) of a particular entry went into effect. When the Effective Date changes, the new requirements established by that particular entry apply only to applications filed on or after the date of the change. *However, marks registered to an entity other than applicant may not be used in identifications of goods and services regardless of the Effective Date of an ID Manual entry.*

Non-fungible Tokens (NFTs) (TMEP §1401.15(b))

The section title was revised and this section is no longer limited to downloadable digital files authenticated by NFTs. The revised section incorporates general guidance for identifications for NFTs and adds examples of acceptable identifications. Other relevant additions are set forth below:

- While an NFT may include information *about* a good or service, it is not the good or service itself. For example, an NFT for a piece of digital artwork may contain information, such as the artwork’s name, artist’s name, a record of past ownership, and details about where one can find the artwork. However, the actual digital artwork file is stored elsewhere. Thus, these digital identifiers on a blockchain are similar to certificates of authenticity or ownership and are not considered goods or services under the Trademark Act. Accordingly, “non-fungible tokens,” “NFTs,” and equivalent wording are not acceptable identifications of goods or services because they do not clearly indicate goods in trade or services under the Trademark Act. The USPTO will deny a filing date for §1 or §44 applications with the identifications “non-fungible tokens,” “NFTs,” or equivalent wording because the wording fails to identify recognizable goods or services.
- An identification must not include square brackets around the acronym NFT. In general, identifications must not include square brackets; however, parentheses may surround acronyms following the wording for which the acronym stands, such as “non-fungible tokens (NFTs).”

NEW SECTION: Virtual Services (TMEP §1401.15(c))

This section has been added to incorporate guidance on virtual services. Virtual services include both real-world service activities that are delivered by means of a computer or the internet and simulations of real activities that take place in virtual worlds or virtual environments. Virtual services are classified according to the nature of the services and their relation to the real world, that is, whether the virtual services have the same purpose or result as the real activity in the real world. Additional explanation and examples are provided in this new section.

Use of Marks or Terms "Applicant" and "Registrant" Inappropriate in Identifications (TMEP §1402.09)

- The guidance in this section applies to all types of marks, including certification marks, collective trademarks, and collective service marks. Similarly, the statement identifying the nature of a collective membership organization in an application for a collective membership mark must not include a mark registered to an entity other than the applicant or the terms "applicant" or "registrant." If a mark that is registered to an entity other than the applicant is used in the statement identifying the nature of a collective membership organization, the examining attorney must require that it be deleted and replaced with generic wording.

Identification of Services (TMEP §1402.11)

- However, "sales" cannot be listed *as a service* in an identification, because the sale of one's own goods or services is not a registrable service. Moreover, the Explanatory Note for Class 35 of the Nice Classification specifically indicates that "[for] the purposes of classification, the sale of goods is not considered to be a service." Thus, "sales" is also unacceptable *as a service* in an identification because it is not classifiable under the Nice Classification. *The wording "retail sales" and "wholesale sales" are similarly unacceptable identifications and cannot be classified under the Nice Classification.*

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

- The type of goods featured by the services must be limited to items that are goods in trade under the Trademark Act. For example, "online retail store services featuring non-fungible tokens" is indefinite as an identification of services because "non-fungible tokens" does not clearly indicate the type of goods featured by the services and encompasses items that are not goods in trade. . . . Instead, the identification must set forth the particular type of goods featured by the retail services, such as downloadable music files authenticated by non-fungible tokens.