

## CHANGES: INDEX TO CHANGES IN TMEP FIFTH EDITION

Attention is directed to the following changes in the 5th edition of the TMEP.

<b>SECTION</b>	<b>CHANGE</b>
108.02	Trademark Assistance Center (“TAC”) is open from 8:00 a.m. to 8:30 p.m., Eastern Time, Monday through Friday, except Federal holidays.
202	Applicant must provide a physical address to which paper correspondence can be mailed in order to receive a filing date.
202.01	A drawing that includes multiple elements that do not comprise an identifiable mark, or that consists of wording describing the mark, does not constitute a clear drawing of the mark.
202.03	Discussion of TEAS Plus applications added.
204.02	Added discussion of procedures for filing a request to restore an application filing date.
301	Added reference to Trademark Electronic Application System (TEAS) “Success” page.  List of TEAS forms expanded to include applications for international registration, subsequent designations and responses to notices of irregularity.  Deleted statement that credit card payments cannot be processed during the hours between 12:00 a.m. to 4:00 a.m. Sunday, Eastern Time; this is no longer true.
302.01	Original certificates of registration are not required for requests for amendment or correction under §7 of the Trademark Act, and owners are strongly discouraged from submitting them.
303.02(a)	Language changes.
303.02(b)	Language changes.
303.02(c)	Language changes.
304.01	Office will accept attachments to Internet e-mail in .jpg or .pdf format.
304.03	Authorization for electronic communications deemed to end upon the date of registration.
304.07	Signatory must personally sign documents filed by e-mail.
307	Documents may be hand delivered to TAC between 8:00 a.m. and 8:30 a.m., Eastern Time, Monday through Friday,

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
	except Federal holidays.
401.01	New e-mail address for requesting correction of inconsistencies between summary of data on TEAS “Success” page and information transmitted by applicant.
401.04	Applications are electronically routed to law offices.
403	Language changes.
405.03	Authorization to charge a fee to a deposit account cannot be entered by examiner’s amendment unless the record already contains a written authorization, signed by an authorized party.
502.01	Text of rule 3.73(b) updated.
505	New section - Request to Update Ownership Information. Where the recordation of a document does not automatically update the ownership field in the Trademark Database, the USPTO will update Trademark Reporting and Monitoring (“TRAM”) System and Trademark Applications and Registrations Retrieval (“TARR”) database to identify the new owner of a registered mark only if the new owner: (1) records the appropriate document; (2) files a written request that TRAM and TARR be updated; and (3) pays the required fee.
Chapter 600	Rewritten to incorporate Exam Guide 03-06.
601	Discussion of communications with an applicant who is represented by an attorney moved to new §601.02.
601.02	New section - Communications With Applicant Who Is Represented By Attorney. Once an applicant is represented by a practitioner meeting the requirements of 37 C.F.R. §10.14, USPTO will conduct business only with the practitioner. The applicant may not sign responses nor authorize examiner’s amendments, priority actions or changes of correspondence address without first revoking power of attorney.
602	Contacting the USPTO by telephone does not constitute an “appearance” by an attorney within the meaning of 37 C.F.R. §2.17(c).  Discussion of foreign attorneys abbreviated; detailed discussion moved to new §§602.06 <i>et seq.</i>  Discussion of paralegals and legal assistants moved to §602.03.

## INDEX TO CHANGES IN TMEP FIFTH EDITION

<b>SECTION</b>	<b>CHANGE</b>
602.01	<p>Contacting the USPTO by telephone does not constitute an “appearance” by an attorney within the meaning of 37 C.F.R. §2.17(c).</p> <p>If an applicant is represented by a practitioner meeting the requirements of 37 C.F.R. §10.14, any new attorney who wishes to take action must file a new power of attorney or revocation of the previous power, signed by applicant.</p>
602.02	<p>Discussion of signature and certificate moved to §605.01.</p>
602.03	<p>Old §602.03 renumbered 605; rewritten and expanded to incorporate Exam Guide 03-06.</p> <p>New §602.03 sets forth actions that cannot be taken by an individual who is not qualified under 37 C.F.R. §10.14.</p> <p>Paralegals and legal assistants cannot authorize examiner’s amendments or priority actions, even if only conveying the appointed attorney’s approval by indicating that the appointed attorney has approved the amendment or action.</p>
602.04	<p>If the applicant/registrant files a new power of attorney naming a new attorney as its representative, this will be treated as a revocation of any previous power, even if the applicant does not specifically revoke the previous power.</p> <p>A revocation must be personally signed by the applicant/registrant or someone with legal authority to bind the applicant/registrant. A new attorney cannot sign the TEAS revocation/appointment form.</p>
602.05	<p>Title changed. Section applies to both mandatory and permissive withdrawal of attorney.</p> <p>Requests to withdraw that are filed through TEAS are processed electronically.</p> <p>Requests to withdraw as attorney can now be filed through TEAS after registration.</p>
602.06-602.06(e)	<p>New sections – Foreign attorneys. Incorporates Exam Guide 03-06.</p>
602.06(a)	<p>New section - Canadian Attorneys. Sets forth internal procedures for determining whether a Canadian attorney/agent has been recognized by the Office of Enrollment and Discipline.</p>
602.06(b)	<p>New section - Foreign Attorneys and Agents From Countries Other Than Canada. Covers material previously in §602.</p>
602.06(c)	<p>New section - Papers Filed by Foreign Attorneys and</p>

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
	Agents. Foreign attorneys may sign cover letters or receive correspondence, but cannot sign responses to Office actions or authorize examiner's amendments and priority actions.
602.06(d)	New section - Representatives of Holders of International Registrations. In a §66(a) application, if the applicant's appointed representative, as communicated from the International Bureau of the World Intellectual Property Organization ("IB"), has an address outside the United States, the address will be considered the correspondence address, but the representative will not be recognized by the USPTO without further clarification.
602.06(e)	New section - Identification of Foreign Attorney in Original Application. Sets forth procedures for issuing first actions in applications in which the attorney section identifies a person with an address outside the United States.
602.07	New section - Change of Attorney. If an applicant/registrant is already represented by an attorney, and a new attorney from a different firm wishes to take action with respect to the application/registration, the new attorney must file a revocation of the previous power, signed by a person with legal authority to bind the applicant/registrant, before the USPTO will accept filings by or correspond with the new attorney.
602.08	New section - Individuals Excluded or Suspended from Practice. Sets forth procedures for processing papers signed by individuals who have been excluded or suspended from practice before the USPTO.
603.01	If an application or other submission is signed by an attorney on behalf of the applicant/registrant, but the submission does not contain a separate address for that attorney, the USPTO will direct correspondence with the attorney in care of the correspondence address of record. If an Office action is required, the examining attorney will require the attorney to either specify his or her address for correspondence, or affirmatively state that the USPTO should continue to address correspondence to his or her attention in care of the previously submitted correspondence address.
	Language changes.
603.02	Once an applicant/registrant is represented by an attorney authorized to practice under 37 C.F.R. §10.14, the attorney

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
	must sign any request to change the correspondence address. If the applicant/registrant is not represented by an attorney authorized to practice under 37 C.F.R. §10.14, the request must be signed by someone with legal authority to bind the applicant/registrant.
603.02(a)	Once an applicant/registrant is represented by an attorney authorized to practice under 37 C.F.R. §10.14, the USPTO will not accept a change of correspondence address signed by the applicant, or by a different attorney, unless the applicant revokes the power of attorney.
603.02(b)	Requests to change the correspondence address submitted through TEAS may identify up to twenty (20) application serial numbers in one submission. Parties must identify the original application serial number of each file, whether pending or registered, for which a change of correspondence address is requested.
603.02(c)	Owners of registered marks who use TEAS to change correspondence address must submit original application serial number rather than registration number.  USPTO will not process a request to change the correspondence address in a cancelled or expired registration, unless submitted in conjunction with a petition or request for reinstatement.  Language changes.
603.04	Renumbered 605.05; subsections added setting forth detailed procedures for processing correspondence signed by unauthorized parties.
603.05	Renumbered 603.04.
605-605.05(c)	New sections setting forth detailed procedures for processing correspondence signed by unauthorized parties.
605.02	New section - Signatures By Authorized Parties Required. Amendments, responses to Office actions, petitions, letters of express abandonment, requests to change the correspondence address, and other papers must be signed by an attorney authorized to practice under 37 C.F.R. §10.14 or by someone with legal authority to bind the applicant/registrant.  Authorized signatory must personally sign his or her name.
605.03	New section - Signatures of Verifications and Cover Letters. Individuals not qualified under 37 C.F.R. §10.14 may transmit and receive correspondence, and may sign

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
	verifications if they meet the requirements of 37 C.F.R. §2.33(a).
605.04	New section lists examples of persons who are authorized and potentially unauthorized to sign.
605.05	Sets forth procedures for processing papers signed by someone other than the applicant or applicant's attorney.  When it appears that a response to an Office action was signed by a potentially improper party, the examiner should treat the response as incomplete. When it appears that a paper other than a response to an Office action was signed by a potentially improper party, the examiner should notify the applicant/registrant that no action will be taken on the paper unless the applicant/registrant either: (1) establishes the signatory's authority; or (2) submits a properly signed copy.
605.05(a)	New section - Notice of incomplete response must be sent when authority of person signing response is unclear.
605.05(b)	New section - Sets forth procedures for replying to notice of incomplete response.
605.05(c)	New section - Sets forth procedures for processing applications and registrations when there is an unsatisfactory response or no response to a notice of incomplete response.
702.02	When petition to make special is granted, only initial examination is made special.  Deleted statement that reinstated and revived applications are made special. This is no longer done.
702.03(a)	Deleted statement that examining attorney must search Office records to determine whether the applicant has any companion applications. This search is done electronically.
702.03(a)(i) & (ii)	Revised to set forth new procedures for identifying and assigning companion applications electronically.
702.03(a)(iv)	Language changes.
703	Application for registration of a mark depicted in standard characters is considered a duplicate of an application for registration of the same mark in typed format for the same goods/services.  Where the international classification of goods/services has changed, a new application for registration of the same mark for the same goods/services in a different class is not

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
	considered to be a duplicate. When an application is a duplicate of a registration owned by the applicant, and the registration is subject to cancellation for failure to file an affidavit of continued use or excusable nonuse, or due to expire for failure to file a renewal application, the examining attorney should suspend the application until the TRAM system is updated to show that the registration is cancelled or expired.
704.01	Language changes.
704.02	In a §66(a) application, if some goods/services are so indefinite that the examining attorney cannot make a proper search, the examining attorney may defer the search in part. Examining attorney must specifically indicate the goods/services for which a search has been conducted by either listing the goods/services for which no conflicting marks have been found, or issuing a §2(d) refusal that is specifically limited to certain goods/services. If all the goods/services in a §66(a) application are so indefinite that the examining attorney cannot make a proper search, the examining attorney must issue a full refusal.  Examining attorney should consult with the managing attorney or senior attorney before issuing a letter deferring action.
705.01	Language changes.
705.03	Deleted reference to duplicate paper copies of Office actions.  Language changes.
705.04	Added discussion of citation of articles downloaded from the Internet.
705.05	While a non-precedential decision is not binding on the Board, such a decision "may be cited for whatever persuasive value it might have."
705.06	Sets forth form for electronic signature of Office action by examining attorney.
705.07	Updated procedures for processing outgoing Office actions.
707	Authorization to charge a fee to a deposit account cannot be entered by examiner's amendment unless the record already contains an authorization, signed by an authorized party.

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
707.01	<p>To obtain authorization for examiner's amendment, the examining attorney must speak directly with the attorney of record, or to someone with legal authority to bind the applicant.</p> <p>Paralegals and legal assistants cannot authorize examiner's amendments even if only conveying the appointed attorney's approval by indicating that the appointed attorney has approved the amendment.</p> <p>Examining attorney may not issue an examiner's amendment upon leaving a telephone or e-mail message for the applicant or the applicant's attorney indicating that an amendment shall be entered if the applicant or attorney does not respond to the message.</p>
707.02	<p>Examining attorney may correct obvious typographical errors and redundancies by examiner's amendment without applicant's approval.</p> <p>Bracketed material should not be included in an identification of goods, but sometimes appears in the <i>Acceptable Identification of Goods and Services Manual</i>. If this material is entered into an identification, it will be automatically deleted in a TEAS Plus application. In a TEAS or paper application, the bracketed material may be deleted with a no-call examiner's amendment.</p>
707.03	<p>Examiner's amendment should indicate any refusals/requirements that are withdrawn by the examining attorney.</p>
708.01	<p>Deleted statement that examining attorney will expedite examination of the response if the applicant responds to the priority action within two months of the mailing date.</p> <p>Deleted statement that applicant must agree to take some action.</p> <p>Priority action must fully discuss all refusals and requirements, include evidence to support the refusals/requirements, and specifically describe what action the applicant may take to place the application in condition for publication or registration.</p>
708.02	<p>Paralegals and legal assistants cannot approve a priority action even if only conveying the appointed attorney's approval by indicating that the appointed attorney has approved the action.</p> <p>Examining attorney must fully discuss all refusals and</p>



## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
	requirements with applicant before issuing priority action.
708.03	Priority action must fully discuss all refusals and requirements, include evidence to support the refusals/requirements, and specifically describe what action the applicant may take to place the application in condition for publication or registration.
708.04	Priority action must include evidence to support all refusals and requirements.
708.05	Examining attorney may not issue “no-call” examiner’s amendment/priority action, because the issues in the priority action have not been discussed with the applicant or applicant’s attorney.
709.02	Deleted statement that examining attorney will agree to an interview with an attorney who claims to be the applicant’s representative, even if the person requesting the interview is not the attorney of record.
710.01(b)	List of Internet search results has little probative value because it does not show the context in which the term is used.  Internet evidence from another country written in the English language may be considered, but the weight given to such evidence will vary depending upon the context and manner in which the term is used.  Examining attorney should check applicant’s website for information about the goods/services.
710.01(c)	Added discussion of online dictionary definitions.
711	Deleted statement that responses to Office actions in §66(a) applications cannot be filed through TEAS.
712	Examining attorney must review the application record to determine whether an applicant is represented by an attorney authorized to practice under 37 C.F.R. §10.14, and must ensure that all responses and amendments are properly signed.  Person who signs response must personally sign his/her name.
712.01	Deleted statement that examining attorneys should presume that a proper person signed a response unless there is evidence in the record indicating that the signatory is not authorized.

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
	Language changes.
712.01(a)	Examining attorney must determine that the record clearly establishes the authority of the signer of the response.
712.01 (a)(ii)	If a partnership is comprised of general partners who are juristic entities (e.g., the general partner is a corporation), a response to an Office action must be signed by someone with legal authority to bind that type of juristic entity.
712.01(a)(iv)	“Vice-Chairman of the Board of Directors” may not sign response on behalf of a corporation.
	Language changes.
712.01(a)(v)	Added examples of types of officers who may sign on behalf of foreign companies and corporations.  Simply stating that a person has been granted authority to act is insufficient to establish the authority of the signatory.
712.01(a)(vi)	Language changes.
712.01(a)(viii)	New section - Signature By Limited Liability Partnership.
712.02	Rewritten to incorporate Examination Guide 03-06.  Deleted statement that unsigned responses may be ratified by examiner’s amendment.  Examining attorney must defer action on the merits of an unsigned response until the applicant files a properly signed response.
712.03	Rewritten to incorporate Examination Guide 03-06. Added discussion of procedures for issuing and replying to notice of incomplete response, where it appears that a response was signed by an unauthorized party.
714.04	Final action must include statement that the only proper response is an appeal, petition or compliance with a requirement.
714.05(a)(ii)	If an examining attorney issues a <i>nonfinal</i> action requiring amendment of the identification because it is indefinite, and the applicant responds with an amended identification that is definite, but is otherwise unacceptable, this is not considered a new issue, and the examining attorney must issue a final requirement for amendment of the identification. However, if the examining attorney issues a <i>final</i> action requiring amendment of the identification because it is indefinite, and the applicant responds with an amended identification that is definite but is otherwise

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
	unacceptable, the examining attorney should treat the response as incomplete, and grant the applicant additional time to cure this deficiency.
714.05(d)	New section - Submission of unacceptable consent agreement or assertion of unity of control in response to <i>nonfinal</i> §2(d) refusal does not raise new issue. Submission of unacceptable consent agreement or assertion of unity of control in response to <i>final</i> §2(d) refusal warrants issuance of new <i>final</i> refusal.
715.02	Examining attorney may issue examiner's amendment after final refusal if he or she believes that it will immediately put the application into condition for publication or registration, or reduce the issues on appeal.
715.03	In responding to the applicant's request for reconsideration, if the examining attorney introduces new evidence that is significantly different from the evidence currently of record, the examining attorney should issue a new, subsequent final action with a six-month response clause.  Language changes; title change.
715.03(a)	Language changes; title change. Discusses examining attorney's action when no new issue is presented in request for reconsideration and no notice of appeal has been filed.
715.03(b)	Language changes; title change. Examining attorney's action when new issue or new evidence is presented in request for reconsideration and no notice of appeal has been filed.  Submission of unacceptable consent agreement or assertion of unity of control after final refusal raises a new issue that warrants issuance of a new <i>final</i> refusal.
715.04	Language changes; subsections added.
715.04(a)	New subsection - Discusses examining attorney's action denying request for reconsideration when notice of appeal has been filed.
715.04(b)	New subsection - Discusses examining attorney's action when new issue is presented and notice of appeal has been filed.
716.02(e)	If examining attorney is ready to issue a <i>final</i> refusal of registration under §2(d), and the grace period for filing a §8 affidavit and/or a §9 renewal application for the cited registration has not passed, the examining attorney must

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
	issue the final refusal.
716.04	Legal instruments examiner (“LIE”) reviews suspended docket and advises examining attorney when continued suspension is no longer necessary.
717	Updated to reflect new procedures for reissuing Office actions.  Applicants and attorneys should be diligent in updating any e-mail addresses and authorizations to correspond by e-mail.
717.01	Language changes.
717.02	Updated to reflect new procedures for reissuing Office actions that were sent to the wrong address due to an Office error.
718.01	Express abandonments filed through TEAS are processed electronically.  Examining attorney must ensure that letter of express abandonment is signed by a proper party.
718.02(a)	If the examining attorney issues a refusal or requirement that applies only to certain goods/services or certain class(es), this should be expressly stated in the Office action.  Unless Office action includes a clear and explicit statement that a refusal or requirement applies to only certain goods/services, then the refusal or requirement applies to all the goods/service.  If fees in a multiple-class application are insufficient to cover all the classes, and applicant fails to respond to an action requiring submission of additional fees, the entire application will be abandoned.
718.03	Revised to incorporate Exam Guide 03-06 with respect to issuing notice of incomplete response for responses that are unsigned or signed by unauthorized parties. Unsigned response cannot be ratified by examiner’s amendment.
718.03(a)	Language changes.
718.03(b)	Updated to reflect new procedures for reissuing an Office action granting additional time to complete a response, where the applicant did not receive the action or was unable to respond to the action due to some other extraordinary circumstance, and the applicant files a successful petition to

## INDEX TO CHANGES IN TMEP FIFTH EDITION

<b>SECTION</b>	<b>CHANGE</b>
	the Director.
718.06	Added reference to partial abandonment. Language changes.
718.08	Upon revival or reinstatement of an abandoned application, if an examining attorney's search shows that there is a later-filed conflicting application being handled by a different examining attorney, the examining attorney handling the earlier-filed application should e-mail the other examining attorney to notify him/her of the revival or reinstatement.
803.01	Added discussion of procedures for setting forth the entity of an applicant who is a minor.
803.02(a)	Language changes.
803.03(b)	Names and citizenship of partners of foreign partnership not required.
803.03(c)	Language changes.
803.03(f)	"Education institution" and "educational organization" are not acceptable designations of an applicant's entity.
803.03(h)	If "LLC" appears in the applicant's name, but entity is listed as a corporation, the examining attorney must inquire as to whether the applicant is a limited liability company or a corporation.  "Limited liability corporation" is not generally recognized as an entity.
803.03(i)	Deleted list of common terms designating entity of foreign applicants and abbreviations therefor. Replaced by new Appendix D.  Added discussion of designation of entities organized under the laws of a Canadian province.  Names and citizenship of partners not required for foreign partnership.  Added link to website listing commonwealth countries.
803.03(k)	New section - Limited Liability Partnerships.
803.04	Names and citizenship of partners of foreign partnership not required.  Added discussion of designation of entities organized under the laws of a Canadian province.
803.06	Case cite added.

## INDEX TO CHANGES IN TMEP FIFTH EDITION

<b>SECTION</b>	<b>CHANGE</b>
804	Language changes.
804.01(b)	Signatory must personally sign his/her name to declaration in lieu of oath.
804.04	Signatory must personally sign his/her name to declaration. Signatory should set forth name and title, or state the relationship between the applicant and the signatory. Language changes.
804.05	Paper documents may be signed by placing a symbol that the filer has adopted as a signature between two forward slash symbols. Signatory must personally sign verification. Added reference to new procedure for signing TEAS documents: Filer may complete document online and e-mail it to the signatory for electronic signature from within TEAS. TEAS attachments may be in .jpg or .pdf format.
806.01(d)	§44(e) applicant must submit a copy of a document that has been certified by the intellectual property office in the applicant's country of origin. A printout from the intellectual property office's website or photocopy of the office's publications is not sufficient.
806.02(a)	When a single class has different bases for goods/services within the same class, the Office uses parenthetical information to indicate the specific basis for specific goods/services. When entering this information into Tradeups, the examining attorney or LIE must refer to "use in commerce" or "intent to use" rather than referring to the statutory citation.
806.03(c)	Since a statement of use cannot be withdrawn, applicant may not amend from §1(a) to §1(b) after a statement of use has been filed for a particular product or service.
806.03(d)	Case cite added.
806.03(h)	Case cite added.
806.04(a)	Sets forth new fax number for paper requests to delete a §1(b) basis filed after publication and before issuance of notice of allowance. Added statement that §1(b) basis can be deleted from a multiple-basis application between the filing date of the statement of use and the date on which the examining attorney approves the mark for registration.

## INDEX TO CHANGES IN TMEP FIFTH EDITION

<b>SECTION</b>	<b>CHANGE</b>
807	Submitting a specimen as the drawing does not satisfy the requirement for a clear drawing of the mark. Language changes.
807.01	Added reference to requirement for single rendition of three-dimensional mark.
807.03(a)	Standard character drawing must show mark in black on white background.
807.03(c)	Language changes.
807.03(f)	Language changes.
807.03(g) and (h)	In §66(a) application, if 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 Madrid Processing Unit (“MPU”) for instructions on how to proceed.
807.05(a)	Deleted reference to digitized images of standard character mark in TEAS application. TEAS applicant no longer has the option of submitting digitized image of the mark; applicant must enter the mark in the appropriate field on the TEAS form, and TEAS will automatically generate a standard character claim. Deleted references to “unsupported characters.” These no longer exist.
807.05(a)(i)	Updated discussion of long marks in standard character drawings filed through TEAS. Deleted reference to digitized images of standard character mark in TEAS application, because these are no longer permitted.
807.05(c)	Language changes.
807.07	If applicant does not claim color as a feature of the mark, applicant may not submit a description of the mark indicating use of color on the mark.
807.07(a)	Language changes to clarify requirements for color drawings.
807.07(a)(i)	If an applicant submits 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 (or amend to a black-and-white drawing, if amendment would not be material alteration). Color claim must include the generic name of the colors

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
	claimed.
807.07(a)(ii)	Color location statement must include the generic name of the colors claimed.
807.07(b)	<p>In §44 application, if foreign registration depicts the mark in color, but no claim of color is made in the foreign registration document, examining attorney must inquire whether the foreign registration includes the color(s) shown as claimed features of the mark.</p> <p>In §66(a) application, if the drawing includes color but no color claim is made in the international registration, the examining attorney should require the applicant to submit a claim of the color(s) featured in the mark and describe their location, unless the applicant states for the record that no claim of color is made with respect to the international registration.</p>
807.07(d)	Old §807.07(d) renumbered 807.07(e); language changes. New §807.07(d) covers color drawings that contain black, white, or gray. Incorporates Exam Guide 2-06, §II.
807.07(d)(i)	New section - color drawings that contain black, white, or gray in §1 applications. Incorporates Exam Guide 2-06, §II.A
807.07(d)(ii)	New section - color drawings that contain black, white, or gray in §44 applications. Incorporates Exam Guide 2-06, §II.C
807.07(d)(iii)	New section - color drawings that contain black, white, or gray in §66(a) applications. Incorporates Exam Guide 2-06, §II.B
807.07(f)	Old §807.07(f) renumbered 807.07(e); language changes. New §807.07(f) covers black-and-white drawings that contain gray, or black-and-white drawings with a mark description that refers to black, white or gray. Incorporates Exam Guide 2-06, §I.
807.07(f)(i)	New section - Black-and-white drawings in TEAS, TEAS Plus and §66(a) applications that contain gray or are accompanied by a mark description that refers to black, white or gray. Incorporates Exam Guide 2-06, §I.A.
807.07(f)(ii)	New section - Black-and-white drawings in paper applications that contain gray or are accompanied by a mark description that refers to black, white or gray. Incorporates Exam Guide 2-06, §I.B.



## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
807.08	Matter depicted in broken lines is not part of the mark and should not be considered in determining likelihood of confusion.
807.09	Rewritten to clarify procedures for submitting “drawing” and description of sound marks and other non-visual marks.  Although a drawing is not required for completely non-visual matter, the applicant should submit an audio or video reproduction of a sound mark, to supplement and clarify the description of the mark. For TEAS filings, the reproduction must be in .wav, .mp3, .mpg, or .avi format, sent after the TEAS document is transmitted, as an attachment to an e-mail message directed to TEAS@uspto.gov.
807.12(a)	Extraneous, non-distinctive punctuation appearing on the specimen that is not part of the mark may be omitted from the drawing.
807.12(b)	In §44 application, if the U.S. 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 U.S. drawing does not agree with the mark in the foreign registration. In general, the black-and-white drawing in the U.S. application should be amended to agree with the colored mark in the foreign registration.  If the U.S. application has a color drawing, the same colors must be part of the mark in the foreign registration.
807.12(c)	In §66(a) application, if the drawing is in color and the international registration contains no color claim, the 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. This is not considered to be an amendment to the mark, but rather a clarification of the ambiguity.  Added discussion of notice from the IB of a correction to a mark in the International Register.
807.12(d)	New case cites and summaries added.
807.14(d)	Old §807.14(d) renumbered 807.14(e). New §807.14(d) covers amendments to color features of marks, incorporating Exam Guide 05-06, §I.
807.14(d)(i)	New section - amendment of black-and-white drawings. Incorporates Exam Guide 05-06, §II.

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
807.14(d)(ii)	New section - amendment of marks that include color and other elements. Incorporates Exam Guide 05-06, §III.
807.14(d)(iii)	New section - amendment of color marks. Incorporates Exam Guide 05-06, §IV.
807.15	Language changes.
807.16	Examining attorney may create a new standard character drawing and upload the drawing to the TRAM database by using the Word Mark Imager.
807.17	Language changes.
808.01(a)	In a TEAS Plus application, if the mark is not in standard characters, the application must include a description of the mark, even if the mark is composed of easily recognized letters or numerals.
808.01(b)	In a TEAS Plus application, if the mark is not in standard characters, the application must include a description of the mark, even if the mark comprises designs or figurative elements that can be identified without explanation.
808.01(c)	Statement that a term has no meaning should not be printed.
808.02	If the applicant has not made a color claim, the description of the mark may not mention color.
808.03	If description of the mark is deemed unnecessary, examining attorney should delete the description from TRAM database, but should not require the applicant to delete the description from the record.
809	Application for mark that comprises non-Latin characters must include both a statement transliterating the characters, and either a translation of the corresponding non-English word(s) or a statement that the transliterated term has no meaning in English.  In a TEAS Plus application, translation of foreign wording or transliteration of non-Latin characters must appear in the initial application.
809.02	Statement that a term has no meaning in a foreign language should be printed in <i>Official Gazette</i> and on certificate of registration.
810	Discussion of TEAS Plus added.  TEAS and TEAS Plus applicants who add classes by examiner's amendment are entitled to the lower fee.

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
810.01	<p>Authorization to charge a fee to a deposit account cannot be entered by examiner's amendment unless the record already contains an authorization, signed by an authorized party.</p> <p>Action on the merits should be deferred pending receipt of the applicant's response to an Office action requiring payment of missing fees only in limited circumstances. In most cases, examining attorney should act on the merits and require the missing fees.</p>
812	<p>In a TEAS Plus application, if the applicant owns one or more registrations for the <i>same</i> mark, the initial application must include a claim of ownership.</p>
812.01	<p>To establish ownership of a registration that has been cited under §2(d), an applicant may submit a verified statement that it is the owner of the cited registration.</p>
813	<p>If mark is comprised, in whole or in part, of the name of an individual, consent to register is implicit if the individual whose name appears in the mark personally signs the application.</p> <p>An applicant does not have to submit a new consent 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/services. In this situation, the applicant only has to claim ownership of that existing registration, and advise the examining attorney that the consent is of record therein. The examining attorney must make an appropriate note to the file, and ensure that the consent statement is entered into the TRAM database.</p> <p>If an applicant has submitted a consent to register in an application that has <i>not</i> matured to registration, the applicant must submit a copy of the consent for each pending application.</p> <p>If the applicant is an individual and the record indicates that mark is comprised of his or her likeness, consent to register is implicit if the individual whose likeness appears in the mark personally signs the application. However, the examining attorney must ensure that a consent statement is entered into the TRAM database.</p> <p>In 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</p>

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
	name or likeness the mark comprises and a written consent of that individual; or (2) a statement that the name or portrait does not identify a living individual.
815.02	Language changes.
815.03	Deleted; substance moved to §815.
815.04	Renumbered 805.03.
815.05	Renumbered 805.04.
816.02	Language change.
817	It is not necessary to notify the applicant of an examining attorney's determination that information will not be printed. The information deleted from TRAM will remain of record for informational purposes.
819 <i>et seq.</i>	New section - TEAS Plus.
903.04	Language change.
903.05	Language change.
903.07	Language change.
903.09	Language change.
904	When §1(a) application is filed without a specimen, Office action must indicate that, pending submission of an acceptable specimen, registration is refused because the applicant has not provided evidence of use of the mark in commerce.
904.01, 904.01(b)	If a single specimen supports multiple classes, the applicant may so indicate, and the examining attorney need not require multiple copies of the specimen. Examining attorney should make a note to the file indicating which classes the specimen supports.  Interested parties may view specimens on the Trademark Document Retrieval ("TDR") portal on the USPTO website.
904.02(a)	When filing specimens electronically, applicants are encouraged to submit small files, with a duration of two minutes or less.  Added reference to TEAS attachments in .pdf form.
904.02(b)	Added text from the old §§904.03 and 904.08.
904.02(c)	Old §904.02(c) renumbered 904.02(c)(ii).
904.02(c)(i)	New section - Added discussion of procedures for processing materials that do not meet the size requirements

## INDEX TO CHANGES IN TMEP FIFTH EDITION

<b>SECTION</b>	<b>CHANGE</b>
	of 37 C.F.R. §2.56(d)(1), previously in §904.03.
904.02(d)	Renumbered 904.02(c)(iii).
904.03	Old §904.03 deleted; substance moved to §§904.02(b), 904.02(c)(i), and 904.03(d). Language changes. New §904.03 covers material appropriate as specimens for trademarks, previously in §904.04.
904.03(d)	New section - Electronic and Digital Media Attachments to Paper Filings. Updated to set forth the formats of multimedia materials that can be submitted with paper filings. Such materials should contain small files, with a duration of two minutes or less. Includes some material previously covered in §904.03.
904.03(f)	New section - Specimens for sound marks. Previously covered in §904.02(a). Rewritten to clarify requirements for submission of sound mark specimens.
904.03(j)	New section - Manuals. Previously covered in §904.07.
904.03(k)	New section - Specimens that are Impracticable to Place on Goods, Packaging, or Displays. Previously covered in §904.04. New caselaw incorporated.
904.04	Renumbered 904.03. Some text moved to 904.03(k).
904.04(a)	Old 904.04(a) renumbered 904.03(a). New §904.04(a) covers drawing or picture of mark, previously in §904.04.
904.04(b)	Old §904.04(b) renumbered 904.03(b). New §904.04(b) covers advertising material, previously in §904.05.
904.04(c)	Renumbered 904.03(c).
904.04(d)	Renumbered 904.03(e). New caselaw incorporated.
904.05	Renumbered 904.04.
904.06	Renumbered 904.03(g).
904.06(a)	Renumbered 904.03(h). Language changes.
904.06(b)	Renumbered 904.03(i). New caselaw incorporated.
904.07	Old §904.07 renumbered 904.04(c). Discussion of manuals moved to 904.03(j). New §904.07 covers specimens and statutory refusals, previously in §904.11.
904.07(a)	New section - Whether the Specimen Shows the Mark Used in Commerce.
904.07(b)	New section - Whether the Specimen Shows the Mark Functioning as a Mark.

## INDEX TO CHANGES IN TMEP FIFTH EDITION

<b>SECTION</b>	<b>CHANGE</b>
904.08	Deleted. Text moved to §904.02(b).
904.09	Renumbered 904.05.
904.10	Renumbered 904.06.
904.11	Renumbered 904.07. Rewritten to clarify procedures for issuing requirements for specimens and related statutory refusals. Subsections added.
906.02	Language changes.
906.03	Language change.
906.04	Language change.
1002.02	Language changes.
1002.03	Added discussion of §44 application based on an application filed in or registration issued by a “common office of several states.”
1002.04	New caselaw incorporated.
1002.05	Case cite added.
1003	Language changes.
1003.01	Language changes.
1003.02	Language changes.
1003.04	Suspension notice must include search clause.  If applicant elects to rely on §1 basis but retain claim of priority under §44(d), examining attorney must make appropriate note to file.
1003.06	Added statement that where applicant claims priority under §44(d) based upon a foreign application, and proceeds to registration under §44(e) based upon a different foreign registration, both foreign countries must be parties to a treaty or agreement with the U.S., and the foreign registration must be from a country of origin of the applicant.
1003.07	Where application is based on more than one foreign application, the mark in each foreign application must be the same mark for which registration is sought in the U.S.
1004.01	§44(e) applicant must submit a copy of a document that has been certified by the intellectual property office in the applicant’s country of origin. A printout from the intellectual property office’s website or a photocopy of the office’s publications is not sufficient, nor is an English translation of a foreign registration without a copy of the underlying

## INDEX TO CHANGES IN TMEP FIFTH EDITION

<b>SECTION</b>	<b>CHANGE</b>
	document.
1004.01(a)	Language changes.
1006	New caselaw incorporated.
	Language changes.
1010	Language changes.
1011.01	First sentence moved to §1011.
	Revised to clarify requirements for drawings of marks that include color.
1011.04	New section - Drawings and Descriptions of Three-Dimensional and Non-Visual Marks.
1102.01	Examining attorney should search applicant's website to see if it provides information about the goods/services.
1102.03	Language changes.
1104.01(a)	LIE will review amendment to allege use ("AAU") only to determine whether it bears a signed verification stating that the mark is in use in commerce; examining attorney will determine whether the amendment to allege use was filed in the name of the owner.
1104.01(c)	If examining attorney determines that LIE erred in holding that an AAU did not meet minimum filing requirements, examining attorney will advise applicant accordingly and make a note to the file.
1104.09(c)	If goods/services identified in the application are omitted from an AAU filed through TEAS, the examining attorney should not issue any inquiry with respect to the omitted goods/services. The applicant may not reinsert these goods/services.
1104.11	Language changes.
1107.01	Sets forth new procedures for issuance of examiner's amendments after the issuance of the notice of allowance but before the statement of use has been filed.
1108.01	Language changes.
1108.02(d)	Where some goods/services are omitted from an extension request, applicant may not file a petition under Rule 2.66 claiming unintentional delay with respect to the omitted items.
1109.04	Language changes.

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
1109.08	Case cite added.
1109.13	When goods/services are omitted from statement of use (“SOU”) filed through TEAS, examining attorney should not inquire as to whether applicant intended to delete the goods/services, and these goods/services may not be reinserted.
1110	Request to divide must be signed by a proper party.
1110.05	Fee for request to divide cannot be paid by examiner’s amendment unless the record already contains a written authorization, signed by someone who is authorized to charge fees to the account.
1110.08	When the IB notifies the USPTO of the division of an international registration, the USPTO will construe the notice as a request to divide. To obtain a registration in the child application, the applicant must pay the fee for the request to divide.
1201.02(b)	Case cite added.
1201.02(c)	<p>Application may be amended to correct the applicant’s name if the party listed as the applicant did not exist as a matter of law on the application filing date, and the application was filed by the party who owned or was entitled to use mark, albeit under an incorrect name or with an incorrect entity designation.</p> <p>If the original application reflects an inconsistency between the owner name and the entity type, <i>e.g.</i>, an individual and a corporation are each identified as the owner in different places in the application, the application may be amended to clarify the inconsistency. However, in view of the broad definition of a “person properly authorized to sign on behalf of an applicant” in 37 C.F.R. §2.33(a), if the person signing an application refers to a different entity, the Office will presume that the person signing is merely an authorized signatory and will not issue an inquiry regarding the inconsistency, or question the signatory’s authority to sign. If the applicant later requests correction to identify the party who signed the verification as the owner, the Office will not allow the amendment.</p> <p>If an application is filed in the name of corporation A, a wholly owned subsidiary, and the parent corporation (corporation B) owns the mark, the application is void as filed because the applicant is not the owner of the mark.</p>



## INDEX TO CHANGES IN TMEP FIFTH EDITION

<b>SECTION</b>	<b>CHANGE</b>
1201.03(c)	Once the application has been filed in the name of either the parent or the wholly owned subsidiary, the Office will not permit the applicant to amend the applicant's name to specify the other party as the owner. Furthermore, once an application has been filed in the name of either the parent or the wholly owned subsidiary, the Office will not consider documents filed in the name of the other party to have been filed by the owner.
1202	Added statement that, generally, no refusal on the ground that a proposed mark does not function as a mark will be issued in a §1(b) application until the applicant has submitted specimens with an allegation of use.
1202.01	Reference to §2 added as basis for refusal of registration on the ground that matter does not function as a service mark.
1202.02(a)	Added definition of functionality.
1202.02(a)(ii)	Language change.
1202.02(a)(iii)	Title changed.
1202.02(a)(iii)(A)	Discussion of competitive need revised.
1202.02(a)(iii)(C)	Aesthetic functionality section renumbered 1202.02(a)(vi).
1202.02(a)(v)	Rewritten. Detailed discussion of utility patents moved to new §1202.02(a)(v)(A). New caselaw incorporated.
1202.02(a)(v)(A)	Old §1202.02(a)(v)(A) renumbered 1202.02(a)(v)(B). New §1202.02(a)(v)(A) covers utility patents and design patents, which was previously in §1202.02(a)(v); new caselaw incorporated.
1202.02(a)(v)(B)	Old §1202.02(a)(v)(B) renumbered 1202.02(a)(v)(C). New §1202.02(a)(v)(B) covers advertising and promotional materials, previously in §1202.02(a)(v)(A). Examining attorney should require any available advertising and promotional materials, and should check to see if applicant has a website on which the product is described.
1202.02(a)(v)(C)	Old §1202.02(a)(v)(C) renumbered 1202.02(a)(v)(D). New §1202.02(a)(v)(C) covers availability of alternative designs, previously in 1202.02(a)(v)(B); discussion of competitive need revised; new caselaw incorporated.
1202.02(a)(vi)	Aesthetic functionality, previously in §1202.02(a)(iii)(C). Language changes.
1202.02(a)(vii)	New section - Functionality and Service Marks.

## INDEX TO CHANGES IN TMPT FIFTH EDITION

<b>SECTION</b>	<b>CHANGE</b>
1202.02(a)(viii)	New section - Functionality and Non-Traditional Marks.
1202.02(b)	Case cite added.
1202.02(b)(i)	New caselaw incorporated.
1202.02(b)(ii)	Reference to §2 added as basis for refusal of registration on the ground that the proposed mark is nondistinctive trade dress.
1202.02(e)	Case cite added.
1202.02(f)	Case cite added.
1202.03(d)	Added statement that evidence of five years' use is not sufficient to show acquired distinctiveness of a mark that is mere ornamentation, for consistency with §1212.05(a).
1202.04	Case cite added.
1202.05(a)	Reference to §2 added as basis for refusal of registration on the ground that matter does not function as a service mark.
1202.05(e)	Language changes.
1202.05(h)	Reference to §2 added as basis for refusal of registration on the ground that matter does not function as a service mark.
1202.08	Section on title of a single creative work rewritten and expanded to incorporate Exam Guide 04-06, §IV. Subsections 1202.08(a) through (e) added to incorporate Exam Guide §§IV.1 through IV.5. Subsection 1202.08(f) covers title of a single work in intent-to-use applications.
1202.09	Section on names of artists and authors rewritten and expanded to incorporate Exam Guide 04-06, §§II and III.
1202.09(a)	Rewritten to incorporate Exam Guide 04-06. This section now covers both authors and performing artists. Subsections 1202.09(a)(i) through 1202.09(a)(ii)(B) added to incorporate Exam Guide §§II through II.2.b. Subsection 1202.09(a)(iii) covers names of authors and performing artists in intent-to-use applications, previously in §1202.09(a).  Deleted statement that the identification of goods must specifically indicate that there is a series. Discussion of names of artists used on original works of art moved to new §1202.09(b).
1202.09(b)	New section covers names of artists used on original works of art, previously in §1202.09.
1202.10	Old §1202.10 renumbered 1202.16. New §1202.10 added - Names and Designs of Characters in Creative Works.

## INDEX TO CHANGES IN TMEP FIFTH EDITION

<b>SECTION</b>	<b>CHANGE</b>
	Incorporates Exam Guide 04-06, §V.
1202.12	Case cite added.
1202.13	Added discussion of registrability of flavors. Incorporates new caselaw.
1202.15	Rewritten to clarify procedures for submission of electronic sound files.
1203.01	New caselaw incorporated.
1203.02(a)	New caselaw incorporated.
1203.02(b)	Case cite added.
1203.03(c)	Test for determining whether a proposed mark is disparaging clarified. New caselaw incorporated.
1203.03(d)	Case cite added.
1203.03(e)	Case cites added.
1203.03(f)	Case cite added.
1205.01	Added reference to statute protecting the Red Crescent emblem, the Third Protocol Emblem, and the designations “Red Crescent” and “Third Protocol Emblem.”
1205.01(a)	New section - Examination Procedures for Marks Comprising the Red Crescent emblem, the Third Protocol Emblem, or the designations “Red Crescent” and “Third Protocol Emblem.” Incorporates Exam Guide 1-07.
1205.02	Language changes.
1206.01	Case cite added.
1206.02	New caselaw incorporated.
1206.03(a)	Case cite added.
1206.03(b)	New caselaw incorporated.
1207.01(a)(iii)	Case cite added.
1207.01(a)(iv)	Case cite added.
1207.01(b)	Case cite added.
1207.01(b)(ii)	Case cite added.
1207.01(b)(iii)	Case cite added.
1207.01(b)(iv)	Case cite added.
1207.01(b)(vi)	Case cite added.
1207.01(b)(ix)	Case cite added.

## INDEX TO CHANGES IN TMEP FIFTH EDITION

<b>SECTION</b>	<b>CHANGE</b>
1207.01(b)(x)	Case cite added.
1207.01(c)(iv)	New section - Matter depicted in broken lines is not part of the mark and should not be considered in determining likelihood of confusion.
1207.01(d)(ix)	New caselaw incorporated.
1209.01(a)	Case cites added.
1209.01(b)	Case cites added.
1209.01(c)(i)	New caselaw incorporated.
1209.01(c)(iii)	Case cites added.
1209.02	New caselaw incorporated.
1209.03(d)	Case cites added.
1209.03(e)	Language changes.
1209.03(m)	New caselaw incorporated.
1209.03(p)	Case cites added.
1209.03(r)	Case cite added.
1209.03(t)	New section - Repetition of Descriptive Term.
1209.03(u)	New section - Punctuation.
1209.04	New caselaw incorporated. Language changes.
1210.02(a)	Case cite added.
1210.02(b)(iii)	Case cite added.
1210.03	Case cite added.
1210.04	Case cite added.
1210.04(a)	Case cite added.
1210.04(c)	Case cite added.
1210.05(a)	Examining attorney will initially refuse registration of geographically deceptive marks under both §§2(a) and 2(e)(3). If the applicant is not seeking registration on the Supplemental Register with a claim of first use in commerce prior to December 8, 1993, or registration on the Principal Register under §2(f) based on a claim that the mark had acquired distinctiveness prior to December 8, 1993, the examining attorney will withdraw the §2(a) refusal.
1210.05(b)(i)	New caselaw incorporated.

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
1210.08	Rewritten to incorporate Exam Guide 1-06 (Geographic Indications Used on Wines and Spirits). Subsections added.
1211.01(a)(i)	Case cite added.
1211.01(a)(iv)	New caselaw incorporated.
1211.01(a)(vii)	New section – Doctrine of Foreign Equivalents.
1211.01(b)(iv)	Case cite added.
1212.04(a)	Prior registration may not be accepted as <i>prima facie</i> evidence of acquired distinctiveness if the term for which the applicant seeks to prove distinctiveness was disclaimed in the prior registration.
1212.06(d)	Case cite added.
1212.09(a)	In a §2(f) claim based on related goods/services, the showing necessary to establish relatedness will vary from case to case, depending on the nature of the goods/services involved and the language used to identify them. There is no absolute rule that applicant must submit extrinsic evidence to support its contention that the goods are related in every case.
1213.01(b)	Case cites added.
1213.05	Case cites added.
1213.05(a)(ii)	If a mark includes a descriptive hyphenated term combined with registrable matter, the applicant must disclaim the words in the correct spelling.
1213.05(c)	New caselaw incorporated.
1213.05(f)	Case cite added.
1213.08(b)	Separate disclaimers of adjacent components of a mark may be accepted where the components do not form a grammatically or otherwise unitary expression.
1213.08(d)	Deleted erroneous example of disclaimer of non-Latin characters. Corrects error in 4 <sup>th</sup> edition.
1215.02(a)	Reference to §2 added as basis for refusal of registration on the ground that matter does not function as a service mark.
1215.02(d)	Reference to §2 added as basis for refusal of registration on the ground that a top level domain name would not be perceived as a mark.
1215.04	New caselaw incorporated.

## INDEX TO CHANGES IN TMEP FIFTH EDITION

<b>SECTION</b>	<b>CHANGE</b>
1215.05	New caselaw incorporated.
1216.01	Case cite added.
1217	Section on res judicata rewritten. Added discussion of collateral estoppel and stare decisis.
1301	Reference to §2 added as basis for refusal of registration on the ground that matter does not function as a service mark.
1301.01	Reference to §2 added as basis for refusal of registration on the ground that an activity is not a service.
1301.02(f)	New section - Computer Software.
1303.02(b)	Collective mark specimen does not have to state explicitly that the product or service is provided by a member of a collective group and meets its standards for admission. If the mark is used on the specimen to indicate the source of the product or service, and the manner of use, or other information on the specimen, is not inconsistent with the applicant's averments in the application that the mark is a collective mark owned by a collective group and used by members of the group to indicate membership, the specimen should be accepted.
1304.09(c)	Clothing authorized by the parent organization to be worn by members may be an acceptable specimen for a collective membership mark.
1306.02(a)	Certification mark used to certify regional origin will be deemed to have become a generic term as applied to particular goods only if it has lost its significance as an indication of regional origin of those goods.
1306.03	Case cite added.
1306.06(a)	Case cite added.
1306.06(c)	Case cite added.
1306.06(f)	Identification of goods/services in a certification mark application should not include the term "certification."
1306.06(g)(i)	Statement of what the mark certifies should indicate that the mark is used or intended to be used by authorized persons, and should appear separate from the identification of goods/services.
1306.06(g)(vi)	In a TEAS Plus application, an additional TEAS Plus processing fee will be required if the mark is amended to a collective, collective membership, or certification mark.
1401.02(a) and (b)	Language changes, to incorporate 9 <sup>th</sup> edition of the

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
	<i>International Classification of Goods and Services for the Purposes of the Registration of Marks Under the Nice Agreement</i> (“Nice Agreement”).
1401.02(c)	Case cite added.
1401.03(a)	New caselaw incorporated.
1401.06(a)	Deleted reference to classification of goods made of precious metal in Class 14.
1401.07	Added example of goods with plurality of uses.  If a single specimen supports multiple classes, the applicant may so indicate, and the examining attorney need not require multiple copies of the specimen.
1401.09(b)	Deleted.
1401.10- 1401.10(c)	New sections incorporate changes in the 9 <sup>th</sup> edition of the Nice Agreement.
1401.10(a)	New section - Legal Services Transferred to Class 45.
1401.10(b)	New section - Goods Made of Precious Metal are Classified According to Their Function.
1401.10(c)	New section - Transfer of Aquaria and Related Items.
1401.11	New section - Implementation of Changes to the Nice Agreement.
1402.01	New caselaw incorporated.
1402.01(a)	Language changes.
1402.01(b)	New caselaw incorporated.
1402.02	Application is denied a filing date if the goods/services are identified as “business” or “business services.” If the identification is “advertising and business,” the Office will disregard “business,” and the identification may only be amended to services within the scope of the term “advertising.”  If an applicant claims use (or asserts a bona fide intention to use the mark on all goods/services) in a particular class and yet only uses (or has a bona fide intention to use) the mark on some of the goods/services, the resulting registration could be void.
1402.03	“Sports equipment” indefinite.  New caselaw incorporated.
1402.03(c)	The Office will accept an identification of goods that refers

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
	to “a full line of” a genre of products only if all the products are classifiable in one class.
1402.04	Any identification of goods/services in USPTO ID Manual that has a letter "T" in the Trilateral column indicates that the identification is acceptable in the USPTO, the Japanese Patent Office, and the European Trademark Office.
1402.07(a)	<p>Scope of the identification for purposes of permissible amendment is limited by class in §66(a) applications.</p> <p>If the identification is merely a repetition of the entire general class heading for a given class, the Office will look to the ordinary meaning of the words for the purposes of determining the scope of the identification. The Office will not permit the applicant to amend to include any item that falls in the class, unless the item falls within the ordinary meaning of the words identified.</p>
1402.07(b)	<p>Deleted “Publishing of ...” as an example of an ambiguous identification that can be amended to specify either goods or services. This is an acceptable identification of services that cannot be amended to specify goods.</p> <p>Deleted example indicating that “computer systems” could be amended to “custom design of computer programs.”</p>
1402.09	If the examining attorney issues a <i>nonfinal</i> action requiring amendment of the identification because it is indefinite, and the applicant responds with an amended identification that is definite, but is unacceptable because it includes a registered trademark or service mark, this is not considered a new issue, and the examining attorney must issue a final requirement for amendment of the identification. However, if the examining attorney issues a <i>final</i> action requiring amendment of the identification because it is indefinite, and the applicant responds with an amended identification that is definite but includes a registered mark, the examining attorney should treat the response as incomplete.
1402.14	Title & language changes. Case cite added.
1403.01	If a single specimen supports multiple classes, the applicant may so indicate, and the examining attorney need not require multiple copies of the specimen. The examining attorney should make a note to the file indicating which classes the specimen supports.
1403.02(c)	TEAS and TEAS Plus applicants who add classes by examiner’s amendment are entitled to the lower fee.



## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
1501	Appeal brief should not exceed 25 double-spaced pages. Added references to Electronic System for Trademark Trials and Appeals (“ESTTA”), certificates of mailing, requests for reconsideration filed in conjunction with notices of appeal, and petitions to revive applications abandoned for failure to file a notice of appeal.
1501.02	Appeal brief should not exceed 25 double-spaced pages. Language changes.
1501.03	Added reference to e-mail communications between applicant and examining attorney.
1501.05	Added reference to e-mail communications between applicant and examining attorney. Language changes.
1502.01	Updated procedures for requesting correction of errors in the <i>Official Gazette</i> .
1503.03	Added reference to procedure for processing registrations that issue inadvertently after the timely filing of a notice of opposition.
1503.04	Detailed information regarding request for extension of time to oppose replaced with references to relevant sections of <i>Trademark Trial and Appeal Board Manual of Procedure</i> .
1503.05	Deleted.
1503.06	Renumbered 1503.05.
1504.01	Language changes.
1504.04	Language changes.
1504.05	Added reference to evidence submitted with request for reconsideration. Language changes.
1505.01	Renumbered 1505.02; title changed.
1505.01(a)	Renumbered 1505.02(a).
1505.01(b)	Renumbered 1505.02(b).
1505.01(c)	Renumbered 1505.02(c).
1505.01(d)	Renumbered 1505.02(d).
1505.01(e)	Renumbered 1505.02(e).
1505.01(f)	Renumbered 1505.02(f).

## INDEX TO CHANGES IN TMEP FIFTH EDITION

<b>SECTION</b>	<b>CHANGE</b>
1505.02	Renumbered 1505.01.
1505.02(a)	Renumbered 1505.01(a). Rewritten to incorporate new procedures for processing amendments after publication.
1505.02(b)	Renumbered 1505.01(b). Broken into subsections 1505.01(b)(i) through 1505.01(c)(ii). Rewritten to incorporate new procedures for processing amendments after publication.
1505.02(c)	Renumbered 1505.01(e).
1505.02(d)	Renumbered 1505.01(f).
1505.02(g)	New section - Amendments to the Applicant's Name, Citizenship, or Entity Type (after publication)
1601.01(b)	Procedures for issuing duplicate certificates of registration clarified.
1604.04	Added statement that Director has no authority to waive the deadline for filing §8 affidavit.
1604.08(b)	Added reference to e-mail.
1604.11	Owner who files affidavit of nonuse may not substitute affidavit of use after expiration of the statutory filing period. Case cite added.
1604.12(a)	If a single specimen supports multiple classes, the owner may so indicate, and the examiner need not require multiple copies of the specimen.
1604.15	Language changes.
1604.16	Response to Office action must be properly signed. The same guidelines that govern the signature of responses to Office actions issued by examining attorneys during examination of applications for registration are applicable to the signature of responses to Office actions issue by Post Registration examiners.
1604.19	Language changes.
1605.02	Language changes.
1605.05	Language changes.
1606.03	Added statement that Director has no authority to waive the deadline for filing renewal application. Language changes.
1606.11	Language changes.

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
1606.12	Response to Office action must be properly signed. The same guidelines that govern the signature of responses to Office actions issued by examining attorneys during examination of applications for registration are applicable to the signature of responses to Office actions issue by Post Registration examiners.
1609.01(b)	<p>If a request to amend a registration that is the subject of an <i>inter partes</i> proceeding is filed with the Post Registration Section, the examiner will deny the request, and advise the owner to file a motion to amend with the Board.</p> <p>Original certificates of registration should not be submitted with §7 requests. Any originals submitted will be scanned into the Trademark Image Capture and Retrieval System (“TICRS”) and destroyed.</p>
1609.02(e)	New section - Amendment of Black-and-White Drawing to Color Drawing.
1609.02(f)	New section - Amendment to Special Form Drawing Containing Black, White and/or Gray.
1609.10	Original certificates of registration should not be submitted with requests for correction. Any originals submitted will be scanned into TICRS and destroyed.
1609.10(a)	If a clerical error in a registered extension of protection occurred through the fault of the USPTO, the USPTO will correct the error without charge.
1612	Requests to withdraw as attorney can now be filed through TEAS after registration.
1615.02	When the IB notifies the USPTO of the division of an international registration, the USPTO will construe the notice as a request to divide. To obtain a registration in the child registration, the registrant must pay the fee for the request to divide for each new registration created.
1616	Abbreviated. Substance moved to §1904.12.
Chapter 1700	Title change.
1704	Question of who is a proper signatory of a verification of facts on behalf of an application may be reviewed either by petition or appeal.
1705.02	Petition fee will be waived only in an extraordinary situation.
1705.07	Petition under 37 C.F.R. §2.146 must be signed by a practitioner authorized to practice before the Office pursuant to 37 C.F.R. §10.14 or by someone with legal authority to

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
	bind the petitioner. Petition may be accompanied by verification signed by someone who meets the requirements of 15 U.S.C. §2.33, but the petition itself must be separately signed by a practitioner meeting the requirements of 37 C.F.R. §10.14, or by someone with legal authority to bind the petitioner.
	Petitions to revive under 37 C.F.R. §2.66 must include a statement that the delay was unintentional, signed by someone with firsthand knowledge. Where a petition to revive consists only of a statement that the delay was unintentional and/or that the applicant did not receive an Office action or notice of allowance, the petition may be signed by someone with firsthand knowledge, and no separate signature by an authorized practitioner or someone with legal authority to bind the petitioner is required. However, any response to Office action accompanying the petition must be properly signed.
1710	When petition to make special is granted, only initial examination is made special.
1711	Where the applicant believes a filing date was denied in error, the applicant should promptly refile the application, then fax a request to restore the original filing date to the Petitions Office, and include the new serial number in the request.
1712.01	Language changes.
1712.02	Language changes.
1713	<p>If an applicant does not receive an action granting additional time to complete a response under 37 C.F.R. §2.65(b), or if applicant is unable to respond to such an action due to some other extraordinary circumstance, applicant may file a petition to the Director under 37 C.F.R. §2.146.</p> <p>If the petition is granted, the USPTO will send a notice to the applicant directing the applicant to view the action on TDR.</p>
1714.01(a)	On granting a petition to revive that states that applicant did not receive the Office action, the USPTO will either issue a new Office action with a new response period, or, if all issues previously raised remain the same, send a notice to the applicant directing the applicant to view the action on the TDR portal on the USPTO website.
1714.01(c)	Language changes.

## INDEX TO CHANGES IN TMEP FIFTH EDITION

<b>SECTION</b>	<b>CHANGE</b>
1714.01(e)	The person signing the statement that the delay was unintentional must have firsthand knowledge of the facts, but it is not necessary to specifically state in the petition that the signatory has first hand knowledge. Generally, the Office will not question the signatory's authority to sign the statement. However, any response to an Office action accompanying the petition must be signed by a practitioner meeting the requirements of 37 C.F.R. §10.14, or by someone with legal authority to bind the applicant if the applicant is not represented by a practitioner meeting the requirements of 37 C.F.R. §10.14.
1714.01(f)(ii)	Where some goods/services are omitted from an extension request, applicant may not file a petition under 37 C.F.R. §2.66 claiming unintentional delay with respect to the omitted items.
1715	New mailing address for letters of protests.
1715.01(a)	Language change.
1715.02	Deleted statement that Administrator waits until examining attorney has taken a first action before deciding a letter of protest. This is no longer true.
1715.03	Deleted last sentence.
1715.04	Administrator no longer waits until examining attorney takes an action before deciding a letter of protest.
1715.07	Deleted reference to faxed requests for copies of letters of protest.
1801.01	Text of 37 C.F.R. §§104.2 and 104.3 updated.
1902.02(b)	Basic application or registration number(s) required; if there are multiple basic applications or registrations, all numbers are required. If a basic application or registration has been divided, each serial number and/or registration number must be identified.
1902.02(c)	Added reference to petition to review refusal to certify.
1902.02(d)	Language changes.
1902.02(e)	Language changes.
1902.02(f)	If the basic application that has been amended during the course of its examination, the list of goods/services in the international application must be within the scope of the goods/services as amended.  Language changes.

## INDEX TO CHANGES IN TMEP FIFTH EDITION

<b>SECTION</b>	<b>CHANGE</b>
1902.02(h)	Updated discussion of procedure for selecting European Community as a designated contracting party in an international application.
1902.02(i)	Language change.
1902.02(k)	If an international application is based on more than one basic application or registration, any description of the mark must be the same in each basic application and/or registration.  If the basic application has been amended during the course of its examination, the description in the international application must be identical to the description as amended, and not as set forth in the original application.
1902.02(l)	Type of mark may only be specified in an international application if it appears in the basic application or registration.
1902.03(a)	Fee for petition to review denial of certification not refundable unless denial of certification was due to USPTO error or petition is withdrawn.
1902.05	Deleted reference to paper filers from note regarding priority claims that are based on the basic application. The note applies to all filers.  Language changes.
1902.07	Irregularity notices can be viewed in TDR.  Language changes.
1902.07(c)(i)	MPU reviews responses to IB notices of irregularities in classification only to determine whether a proposed class change affects the scope of goods/services as identified in the basic application or registration.
1902.07(c)(ii)	If the goods/services in a response to an IB irregularity notice exceed the scope of the goods/services in the basic application or registration, the response will not be forwarded to the IB.
1902.07(f)	USPTO will not process any response filed after the IB response deadline.
1904.01(f)	Additional filing fee in §66(a) application collected only when ownership changes with respect to less than all of the goods/services.
1904.02(a)	Language changes.
1904.02(b)	Changes in classification not permitted in §66(a) application.

## INDEX TO CHANGES IN TMEP FIFTH EDITION

SECTION	CHANGE
	If they inadvertently occur during examination, MPU will correct the classification and notify the applicant and the IB.
	Language changes.
1904.02(d)	Trademark database tracks 18-month period for refusal of §66(a) application.
1904.02(e)	Response deadline in §66(a) application runs from date on which USPTO sends action to IB, not the date on which IB processes refusal.
1904.02(f)	Address of representative of holder of international registration is considered correspondence address, unless USPTO receives a notice of change of correspondence address.
1904.02(h)	Old §1904.02(h) renumbered 1904.02(i). New §1904.02(h) covers drawings and descriptions of the mark in §66(a) applications. Amendment to mark prohibited in §66(a) application, but applicant must comply with U.S. requirements for drawings, color claims, and descriptions of the mark.
1904.03(a)	Second refusal raising new ground may be issued in §66(a) application, but only so long as time remains in the 18-month refusal period. Examining attorney must notify MPU when a new refusal is issued in a second or subsequent action, so that MPU can notify IB.
1904.03(c)	Language changes.
1904.03(f)	New section - Notification of Correction in the International Register with Respect to a Pending Request for Extension of Protection. Section 66(a) application can be refused by USPTO if protection cannot be granted based on international registration as corrected, if there is ground(s) for refusal that did not apply to the international registration as originally notified.
1904.03(g)	New section - Notification of Limitation in the List of Goods and Services with Respect to a Request for Extension of Protection. USPTO may declare that limitation has no effect.
1904.09(a)	Requests for transformation should not be submitted through TEAS until a TEAS transformation form is available.
1904.09(b)	When examining a transformed application, examining attorney must copy the search strategy from the cancelled extension of protection to the transformed application file

## INDEX TO CHANGES IN TMEP FIFTH EDITION

<b>SECTION</b>	<b>CHANGE</b>
	record.  The examining attorney must require the applicant to submit a verified statement in support of the application that relates back to the date of: (1) the international registration date, if the request for extension of protection to the United States was made in the international application; or (2) the date of recordal of the subsequent designation with the IB, if the request for extension of protection to the United States was made in a subsequent designation.
1904.12	Replacement - deleted previous section, transferred contents of old §1616.
1904.14	New section - Notification of Correction in the International Register with Respect to Registered Extension of Protection.
1904.15	New section - Notification of Limitation of the List of Goods/Services with Respect to Registered Extension of Protection.
Appendix D	New appendix - lists acceptable foreign entity designations and abbreviations therefor. Replaces list previously in §803.03(i).