

# Introduction

## Constitutional Basis

The authority of Congress to provide for the registration of marks which are used in commerce stems from the power of Congress under the commerce clause of the Constitution of the United States to regulate commerce.

## Statutes

Under its authority to regulate commerce, Congress has over the years passed a number of statutes providing for the registration of marks in the USPTO. The provisions of statutes cannot be changed or waived by the USPTO. The statute now in effect is Public Law 489, 79th Congress, approved July 5, 1946, 60 Stat. 427, commonly referred to as the Trademark Act of 1946 or the Lanham Act. The Trademark Act of 1946 (as amended) forms Chapter 22 of Title 15 of the United States Code. In referring to a particular section of the Trademark Act, this Manual often gives the citation of the United States Code, e.g., 15 U.S.C. §1051. The text of the current statutes can be downloaded from the USPTO website at <http://www.uspto.gov/web/offices/tac/tmlaw2.html>.

## Rules of Practice

Section 2 of Title 35 of the United States Code authorizes the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office to establish regulations, not inconsistent with law, for the conduct of proceedings in the USPTO. The rules which govern the practices and procedures in the USPTO as they relate to the registration of marks are set forth in Title 37 of the Code of Federal Regulations.

The trademark rules are a part of the Code of Federal Regulations, which is a codification of Federal regulations under the provisions of The Federal Register Act of 1937 and The Administrative Procedure Act of 1946 and which is published pursuant to 44 U.S.C. §1510. Rules relating to patents, trademarks and copyrights are codified in Title 37 of the Code of Federal Regulations. The trademark rules constitute Part 2, the rules relating to assignments constitute Part 3, the classification of goods and services constitutes Part 6, the rules relating to filings under the Madrid Protocol constitute Part 7, and the rules relating to the representation of others before the USPTO constitute Part 10. The text of the current rules is also available on the USPTO website at <http://www.uspto.gov/web/offices/tac/tmlaw2.html>.

In creating numbers for rules, the number of the appropriate Part in Title 37 of the Code of Federal Regulations is placed first, followed by a decimal point and then the number of the rule, so that, for example, Trademark Rule 2.56 is

Rule 56 in Part 2 of Title 37 of the Code of Federal Regulations. In the Code of Federal Regulations itself, and in material published in the Federal Register, the rules are identified by the term "sections." Thus, section 2.56 in 37 C.F.R. (37 CFR §2.56) is Trademark Rule 2.56.

Notices of proposed and final rulemaking are published in the Federal Register and in the *Official Gazette* of the USPTO, and posted on the USPTO website at <http://www.uspto.gov/>.

The primary function of the rules of practice is to advise the public of the regulations that have been established in accordance with the statutes, which must be followed before the USPTO.

### **Director's Orders and Notices**

From time to time the Director of the United States Patent and Trademark Office issues Orders and Notices relating to various specific situations that have arisen in operating the USPTO. Notices, circulars of information or instructions and examination guides have also been issued by other USPTO officials under authority of the Director. These Orders and Notices are published in the *Official Gazette* of the USPTO, and posted on the USPTO website at [www.uspto.gov](http://www.uspto.gov/).

### **Decisions**

In addition to the statutory regulations, the actions taken by the examining attorneys in the examination of applications to register marks are to a great extent governed by decisions on prior cases. Applicants dissatisfied with an examining attorney's action may have it reviewed. In general, procedural matters may be reviewed by petition to the Director (see TMEP §1702) and substantive matters may be reviewed by appeal to the Trademark Trial and Appeal Board (see TMEP §1501).

### **Trademark Manual of Examining Procedure**

The *Trademark Manual of Examining Procedure* sets forth the guidelines and procedures followed by the examining attorneys at the USPTO.

First Edition, January 1974

Revision 1, January 1976

Revision 2, January 1977

Revision 3, January 1978

Revision 4, January 1979

Revision 5, December 1982

Revision 6, December 1983 (Incorporating Exam Guide Nos. 1-83 to 31-83)

Revision 7, January 1986 (Incorporating Office practice and relevant caselaw prior to January 1986; drawing rules amendment effective Sept. 22, 1986; letter of protest procedures effective April 23, 1986; Exam Guide Nos. 1-83 to 2-86)

Second Edition, May 1993 (Incorporating Office practice and relevant caselaw reported prior to April 1993)  
Revision 1, April 1997 (Incorporating Office practice and relevant caselaw reported prior to March 31, 1997)  
Revision 1.1, August 1997 (Corrected errors in Rev. 1)  
Third Edition, January 2002, issued March 18, 2002 (Incorporating Office practice and relevant caselaw reported prior to Jan. 24, 2002)  
Revision 1, June 2002, issued June 24, 2002 (Incorporating Office practice and relevant caselaw reported prior to June 24, 2002)  
Revision 2, May 2003, issued May 1, 2003 (Incorporating Office practice and relevant caselaw reported prior to April 21, 2003)  
Fourth Edition, April 2005, issued April 29, 2005 (Incorporating Office practice and relevant caselaw reported prior to March 25, 2005)  
Fifth Edition, September 2007, issued Sept. 30, 2007 (Incorporating Office practice and relevant caselaw reported prior to August 11, 2007)

### **Trademark Trial and Appeal Board Manual of Procedure**

References in this Manual to the *Trademark Trial and Appeal Board Manual of Procedure* ("TBMP") refer to the Second Edition, 1<sup>st</sup> Revision, March 12, 2004, currently available on the USPTO website at <http://www.uspto.gov/web/offices/dcom/ttab/tbmp/index.html>. The TBMP sets forth guidelines and practices followed in proceedings held before the Trademark Trial and Appeal Board.