

Chapter 800

Application Requirements



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801 Types of Applications

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

See TMEP Chapter 1300 regarding the examination of applications for different types of marks.

801.01 Single or Combined Application

801.01(a) Single (Single-Class) Application

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

801.01(b) Combined (Multiple-Class) Application

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

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

801.02 Principal Register or Supplemental Register

801.02(a) Act of 1946, Principal Register

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

- Constructive notice to the public of the registrant’s claim of ownership of the mark (15 U.S.C. §1072);

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

If the applicant seeks registration on the Principal Register, the application should state that registration is requested on the Principal Register. However, if the applicant does not specify a register, the Office will presume that the applicant seeks registration on the Principal Register.

801.02(b) Act of 1946, Supplemental Register [R-2]

Certain marks that are not eligible for registration on the Principal Register, but are capable of distinguishing an applicant's goods or services, may be registered on the Supplemental Register. Sections 23 through 28 of the Trademark Act, 15 U.S.C. §§1091 through 1096, provide for registration on the Supplemental Register. This is a continuation of the register provided for in the Act of March 19, 1920. Marks registered on the Supplemental Register are excluded from receiving the advantages of certain sections of the Act of 1946. The excluded sections are listed in 15 U.S.C. §1094.

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

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

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

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802 Application Form

The Office prefers that an applicant file an application for registration of a mark electronically, using the Trademark Electronic Application System (TEAS), available at <http://www.uspto.gov>, or on the Office's pre-printed scannable form. The applicant may obtain the Office's form by calling the Trademark Assistance Center at (703) 308-9000 or (800) 786-9199.

Trademark applications may not be filed by facsimile (fax) transmission. 37 C.F.R. §1.6(d)(3); TMEP §306.01.

The Office strongly discourages self-created forms, but will accept them if they meet the requirements for receipt of a filing date set forth in 37 C.F.R. §2.21(a) (*see* TMEP §202). If a self-created form is used, the application should be on letter size (*i.e.*, 8½ inches (21.6 cm.) by 11 inches (27.9 cm.)) paper, typewritten, double spaced, with margins of at least 1½ inches (3.8 cm.) at the left and top of the pages. The application should be written on only one side of the paper.

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

The Office does not generally require the submission of original documents, so the applicant may file a copy of a signed application. 37 C.F.R. §1.4(d)(1)(ii); TMEP §302.01.

803 Applicant

803.01 Who May Apply

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

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

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

Nations, states, municipalities, and other related types of bodies operating with governmental authorization may apply to register marks that they own. *See* *NASA v. Record Chemical Co.*

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Inc., 185 USPQ 563 (TTAB 1975); *In re U.S. Department of the Interior*, 142 USPQ 506 (TTAB 1964).

The question of whether an application can be filed in the name of a minor depends on state law. If the minor can validly enter into binding legal obligations in the state in which he or she is domiciled, then the application may be filed in the name of the minor. Otherwise, the application should be filed in the name of a parent or legal guardian, clearly setting forth their status as a parent or legal guardian. If the record indicates that an application has been filed in the name of a minor, the examining attorney should inquire as to whether the person can validly enter into binding legal obligations under the law of the state in which he or she is domiciled, and require correction of the entity statement, if necessary.

See TMEP Chapter 500 regarding assignments, name changes, and issuance of a registration in the name of an assignee or in an applicant's new name.

803.02 Name of Applicant

The name of the applicant should be set out in its correct legal form. For example, a corporate applicant should be identified by the name set forth in the articles of incorporation.

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

803.02(a) Individual

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

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

If the record is ambiguous as to whether a corporation or an individual owns the mark, the examining attorney must require the applicant to clarify the record regarding ownership. 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) (see TMEP §804.04), the fact that the title of the person signing an application refers to a different entity is not in itself considered an ambiguity that would warrant an inquiry as to who owns the mark.

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See TMEP §803.03(a) for information about identifying an individual applicant's entity.

See TMEP §§803.06 and 1201.02(c) regarding Office policies regarding correction of an applicant's name and entity.

803.02(b) Partnership, Joint Venture or Other “Firm”

If a partnership, joint venture, or other “firm” has been organized under a particular business name, the application should be filed in that name. If the partnership or firm has not been organized under a business name, then the names of the members should be listed as though they composed a company name. If a partnership or joint venture is doing business under an assumed name, this may be indicated, using an assumed name designation. See TMEP §803.02 regarding assumed name designations.

See TMEP §803.03(b) for information about identifying a partnership or joint venture as a legal entity.

803.02(c) Corporation and Association

If the applicant is a corporation, the official corporate name must be set out as the applicant's name. Listing an assumed business name is optional. The name of a division of the applicant should *not* be included in or along with the applicant's name. If the applicant wishes to indicate in the application that actual use of the mark is being made by a division of the applicant, the applicant may provide a statement that “the applicant, *through its division* [specify name of division], is using the mark in commerce.” This statement should not appear in the preamble in conjunction with the listing of the applicant's name, and will not be printed on the registration certificate.

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

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

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

803.03 Legal Entity of Applicant

Immediately after the applicant's name, the application should set out the applicant's form of business, or legal entity, such as partnership, joint venture, corporation, or association. The words “company” and “firm” are indefinite for purposes of designating an applicant's legal entity, because those words do not identify a particular type of legal entity in the United

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States. (However, the word “company” is acceptable to identify entities organized under the laws of foreign countries that are equivalent or analogous to United States corporations or associations. *See* TMEP §803.03(i).)

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

If other material in the record shows a different type of entity than is set out in the written application, the examining attorney should ask for an explanation, and require amendment if necessary. However, in view of the broad definition of a “person properly authorized to sign on behalf of an applicant” in 37 C.F.R. §2.33(a) (*see* TMEP §804.04), no explanation is usually required merely because the person signing a declaration has a title that refers to a different type of entity. *See* TMEP §§803.06 and 1201.02(c) regarding Office policies governing correction of an applicant’s name.

803.03(a) Individual or Sole Proprietorship

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

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

If the application specifically identifies the applicant as a sole proprietorship and indicates the state of organization of the sole proprietorship and the name and citizenship of the sole proprietor, the Office will accept the characterization of the entity without further action. On the other hand, if the application refers to a sole proprietorship but lacks some of the necessary information or is ambiguous as to whether the applicant should be identified as a sole proprietorship or as an individual, the examining attorney must require appropriate clarification of the entity type.

803.03(b) Partnership, Joint Venture or Other “Firm”

The application of a partnership or a joint venture, after setting forth the applicant’s name and entity, should specify the state or country under whose laws the partnership or joint venture is organized. 37 C.F.R. §2.32(a)(3)(ii). In addition, the applicant should set forth the names, legal entities, and national citizenship (or the state or country of organization) of all general partners or active members that compose the partnership or joint venture. 37 C.F.R. §2.32(a)(3)(iii). This requirement also applies to a partnership that is a general partner in a larger partnership. Limited partners or silent or inactive partners need not be listed. The following format should be used:

“ _____, a (partnership, joint venture) organized under the laws of _____, composed of _____.”

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In the case of a partnership consisting of ten or more general partners, if the partnership agreement provides for the continuing existence of the partnership in the event of the addition or departure of specific partners, the Office will require that the applicant provide the names, legal entities, and national citizenship (or the state or country of organization) of the principal partners only. If the principal partners exceed ten, the applicant need list only the first ten principal partners. If there is no class of principal partners, the applicant may list any ten general partners.

Upon death or dissolution of a partner or other change in the members that compose a partnership, that legal entity ceases to exist and any subsequent arrangement constitutes a new entity, unless the partnership agreement provides for continuation of the partnership in the event of changes in partners. This same principle also applies to joint ventures. *See* TMEP Chapter 500 regarding changes of ownership.

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

803.03(c) Corporation and Association

In the United States, the term “corporation” is proper for juristic entities that are incorporated under the laws of the various states or under special federal statutes. Likewise, “association” is a proper term for juristic entities organized under state laws or federal statutes that govern this form of organization. The term “company” is indefinite for describing a United States entity because it does not have a specific meaning as indicating a particular type of entity, but is acceptable to identify entities organized under the laws of foreign countries that are equivalent or analogous to United States corporations or associations. *See* TMEP §803.03(i) regarding foreign companies.

In addition to specifying that an applicant is a corporation, the application must specify the applicant’s state or country of incorporation. It is customary to follow the applicant’s name by the words “a corporation of the state (or country) of . . .” This also applies to a nonprofit or tax-exempt corporation. If no state or country of incorporation is given for an applicant corporation, or the incorrect state or country of incorporation is given, this defect may be corrected by amendment. The amendment does not have to be verified.

For an association, the application must specify the state or country under whose laws the applicant is organized or exists. The applicant should also indicate whether the association is incorporated or unincorporated. If a corporation or association exists by virtue of a specific state or federal statute, this should be stated. Verification is not required.

803.03(d) Joint Applicants

An application may be filed in the name of joint applicants or joint owners. *Ex parte Pacific Intermountain Express Co.*, 111 USPQ 187 (Comm’r Pats. 1956); *Ex parte Edward Taylor*

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and Isabelle Stone Taylor doing business as Baby's Spray-Tray Co., 18 USPQ 292 (Comm'r Pats. 1933).

An application by joint applicants must be verified by all the applicants, since they are individual parties and not a single entity. However, if only one of the joint applicants signs the verification, the Office will presume that he or she is signing on behalf of all the joint applicants, and will not require an additional verification or declaration unless there is evidence in the record indicating that the party who signed the application was not in fact authorized to sign on behalf of all the joint applicants under 37 C.F.R. §2.33(a). See TMEP §804.04 regarding persons authorized to sign a verification on behalf of an applicant, and TMEP §712.01(a)(i) regarding the proper party to sign a response to an Office action filed by joint applicants who are not represented by an attorney.

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

803.03(e) Trusts, Conservatorships and Estates

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

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

The application must first refer to the trustee(s) as the applicant and indicate the name of the trust, if any. Then the state under whose laws the trust exists must be set forth. Finally, the names and citizenship of the individual trustees must be listed.

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

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

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

803.03(f) Governmental Bodies and Universities

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

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

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

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

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

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

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

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

Again, these examples are not exhaustive of the entity designations that are acceptable.

803.03(g) Banking Institutions

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

First American Bank of Virginia, a Virginia corporation.

Pathway Financial, a federally chartered savings and loan association.

This is not an exhaustive listing of acceptable entity designations.

803.03(h) Limited Liability Companies

Most of the states have amended their laws to recognize an entity commonly identified as a “limited liability company.” The entity has attributes of both a corporation and a partnership. Therefore, the Office must accept the entity designation “limited liability company,” or any appropriate variation provided for under relevant state law. The applicant should indicate the state under whose laws the limited liability company is established. For the purpose of service of process, the limited liability company is like a corporation. Therefore, it is not necessary to list the “members” or owners of the limited liability company when identifying the entity.

See TMEP §712.01(a)(vii) regarding the proper party to sign a response to an Office action filed by a limited liability company that is not represented by an attorney.

803.03(i) Common Terms Designating Entity of Foreign Applicants

In designating the legal entity of foreign applicants, acceptable terminology is not always the same as for United States applicants. The word “corporation” as used in the United States is

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not necessarily equivalent to juristic entities of foreign countries; the word “company” is sometimes more accurate. If the applicant is from the United Kingdom or another commonwealth country (*e.g.*, Canada or Australia) and the term “company” is used, no inquiry is needed. In any other case, the examining attorney must clarify what type of entity is applying.

A statement of the accepted foreign designation (or an abbreviation therefor) of the legal entity of a foreign applicant is sufficient. The applicant may specify the legal entity by indicating the entity that would be its equivalent in the United States, but is not required to do so. The examining attorney should inquire further into the specific nature of a foreign legal entity if it is not clear that it is in fact a designation of legal entity in the particular country. The examining attorney may request a description of the nature of the foreign entity, if necessary.

Listed below are common terms used by several foreign countries to identify commercial entities.

France

A “Société anonyme” (S.A.) is a joint stock company whose capital is divided into shares. An S.A. is similar to a corporation.

A “Société a responsabilité limitée” (S.A.R.L.) is a limited liability company. The S.A.R.L. is analogous to a small closely held American corporation.

A “Société en nom collectif” is a general partnership. Each partner represents the firm and their liability is unlimited.

A “Société en commandite simple” is a special partnership very similar to an American limited partnership.

A “Société en commandite par actions” is a special partnership by shares and occupies a position between a limited partnership (*société en commandite simple*) and corporation (*société anonyme*).

Germany

The “Aktiengesellschaft” (A.G.) is a joint stock company, which can also be loosely described as a corporation.

The “Gesellschaft mit beschränkter Haftung” (G.m.b.H.) is a company with limited liability.

The “Kommanditgesellschaft” (K.G.) is a limited partnership whose entity survives even though the partners might change. It is not necessary to list the names of the partners.

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The “Offene Handelsgellschaft” (O.H.G.) is a type of German partnership that is comparable to a United States partnership. Thus, all relevant information with respect to the partnership must be provided.

German law permits a business to be conducted by an individual with the assets of the business held by the “company” in the name of the company, not by the proprietor as an individual. This form of business is generally referred to as a “Firma.” However, “Firma” is a broad term that may also connote other situations and the examining attorney should ascertain, if there is any doubt, that a sole proprietorship form of business is intended when the term “Firma” is used.

The “Stiftung” is a foundation having some attributes of a corporation but being more in the nature of a trust. It is governed by a Board of Management, two members of which are denominated Mandatory and Deputy Mandatory. *See Carl Zeiss Stiftung v. VEB Carl Zeiss Jena*, 433 F.2d 686, 167 USPQ 641, 642 n.6 (2d Cir. 1970), *cert. denied*, 403 U.S. 905, 170 USPQ 1 (1971).

Italy

A “Societa per azioni” is analogous to an American corporation.

A “Societa a responsabilita limitata” is the equivalent of a joint stock company with limited liability.

A “Societa in nome collettivo” is a general partnership whose members have unlimited liability for all its obligations.

A “Societa semplice” is a simple partnership. This form of partnership need not be made public as long as there is an agreement between the partners.

“Societa cooperativa” is a cooperative society. This type of entity may be incorporated with either limited or unlimited liability, but the society’s name must bear a qualification as to whether it is a limited or unlimited cooperative.

Japan

A “Kabushiki Kaisha” most closely resembles a United States joint stock corporation. This type of entity is incorporated and will issue shares.

A “Yugen Kaisha” is similar to a United States closely held corporation. It is a small corporation that may not surpass certain specified capitalization or numbers of members.

A “Gomer Kaisha” is an entity that is established by formal legal documents. However, all members are jointly and severally liable for the obligations of the firm in the event of bankruptcy, similar to a United States partnership.

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A “Goshi Kaisha” is similar to the “Gomer Kaisha” listed above. It differs to the extent that members may have either unlimited or limited liability for the corporate obligations.

Spain

A “Sociedad regular colectiva” is a regular collective company and is similar to an American partnership.

A “Sociedad de responsabilidad limitada” is a limited liability company and may be identified as a joint stock company with limited liability.

A “Sociedad anonima” is a joint stock corporation and may be identified as a corporation.

United Kingdom and Other Commonwealth Countries

The word “company” is commonly used in the United Kingdom to identify juristic entities (similar to United States corporations) organized under the law of that country, and thus the word “company” is an acceptable entity designation for applicants from that country.

The same is true for other Commonwealth countries, such as Canada and Australia.

There are two types of limited liability companies in Great Britain: (1) public limited companies, which would be indicated by using “PLC,” “plc” or “Public Limited Company;” and (2) private limited companies that use the designation “Limited” or “Ltd.” A public limited company in Wales uses the designation “Cwmni & Cyfyngedig Cyhoeddus” or “CCC.”

803.04 Citizenship of Applicant

Under 37 C.F.R. §2.32(a)(3), an application for registration must specify the applicant’s citizenship or the state or nation under whose laws the applicant is organized. If ambiguous terms such as “American” are used, the examining attorney must require the applicant to clarify the record by setting forth the required information with greater specificity (*e.g.*, “United States”).

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

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

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For a corporation, the application must set forth the state or country of incorporation. 37 C.F.R. §2.32(a)(3)(ii).

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

For a partnership or other firm, the application must set forth the state or country under which the partnership is organized, and provide citizenship information for each general partner in the partnership or active member in the firm. 37 C.F.R. §2.32(a)(3)(iii). This requirement also applies to a partnership that is a general partner in a larger partnership. *See* TMEP §803.03(b) for the proper format for identifying a partnership.

For joint applicants or a joint venture, the application should set forth the citizenship or state or country of organization of each party.

803.05 Address of Applicant

The written application must specify the applicant's address. 37 C.F.R. §2.32(a)(4). Addresses should include United States post office ZIP code numbers or their foreign equivalents. The applicant's address may include a post office box.

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

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

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

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

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

The application must also include an address for correspondence concerning the application. *See* 37 C.F.R. §§2.18 and 2.21(a)(2). This is referred to as the correspondence address. *See* TMEP §§603 *et seq.*

803.06 Applicant May Not Be Changed

While an application can be amended to correct an inadvertent error in the manner in which an applicant's name is set forth (*see* TMEP §1201.02(c)), an application cannot be amended to substitute another entity as the applicant. If the application was filed in the name of a party who had no basis for his or her assertion of ownership of (or entitlement to use) the mark as of the filing date, the application is *void*, and registration must be refused. 37 C.F.R.

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§2.71(d); TMEP §1201.02(b). *Huang v. Tzu Wei Chen Food Co. Ltd.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988); *American Forests v. Sanders*, 54 USPQ2d 1860 (TTAB 1999), *aff'd*, 232 F.3d 907 (Fed. Cir. 2000); *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689 (TTAB 1991); *In re Lettmann*, 183 USPQ 369 (TTAB 1974); *Dunleavy v. Koepfel Steel Products, Inc.*, 114 USPQ 43 (Comm'r Pats. 1957), *aff'd*, 328 F.2d 939, 140 USPQ 582 (C.C.P.A. 1964); *Richardson Corp. v. Richardson*, 51 USPQ 144 (Comm'r Pats. 1941); *Celanese Corporation of America v. Edwin Crutcher*, 35 USPQ 98 (Comm'r Pats. 1937). The Office will not refund the application filing fee in such a case.

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

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

804 Verification and Signature

An application must include a statement that is verified by the applicant. 15 U.S.C. §§1051(a)(3) and 1051(b)(3); 37 C.F.R. §2.32(b).

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

804.01 Form and Wording of Verification

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

804.01(a) Verification, with Oath

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

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

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

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

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

Verification (with oath) made in a foreign country may be made (1) before any diplomatic or consular officer of the United States, or (2) before any official authorized to administer oaths in the foreign country. In those foreign countries that are members of The Hague Convention Abolishing the Requirement of Legislation for Foreign Public Documents, a document verified before a foreign official should bear or have appended to it an apostille (*i.e.*, a certificate issued by an official of the member country). Member countries, territories, and Departments in Europe participating in this Convention are as follows:

Andorra	Cyprus	Italy
Angola	Czech Republic	Japan
Anguilla	Djibouti	Jersey
Antigua & Barbuda	Dominica	Kiribati
Argentina	El Salvador	Latvia
Armenia	Falkland Islands	Lesotho
Aruba	Fiji	Liberia
Australia	Finland	Liechtenstein
Austria	France	Lithuania
Bahamas	French Guiana	Luxembourg
Barbados	French Polynesia	Macau
Belarus	Germany	Macedonia
Belgium	Gibraltar	Malawi
Belize	Greece	Malta
Bermuda	Grenada	Marshall Is.
Bosnia-Herzegovina	Guadeloupe	Martinique
Botswana	Guernsey	Mauritius
British Virgin Islands	Guyana	Mexico
Brunei	Hong Kong	Montserrat
Cayman	Hungary	Mozambique
Comoros Islands	Isle of Man	Netherlands
Croatia	Israel	Netherlands Antilles

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Nevis	St. Helena	Swaziland
New Caledonia	St. Kitts & Nevis	Sweden
New Hebrides	St. Lucia	Switzerland
Niue	St. Pierre	Tonga
Northern Ireland	St. Vincent	Trinidad & Tobago
Norway	Samoa	Turkey
Panama	San Marino	Turks and Caicos
Portugal	Seychelles	Tuvalu
Réunion	Slovenia	United Kingdom
Romania	Solomon Islands	Vanuatu
Russian Fed.	South Africa	Virgin Islands, British
St. Christopher (Kitts)	Spain	Wallis and Futuna
St. Georgia	Suriname	Zimbabwe

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

APOSTILLE	
(Convention de La Haye du Oct. 5, 1961)	
1.	Country: _____ This public document
2.	has been signed by _____
3.	acting in capacity of _____
4.	bears the seal/stamp of _____
CERTIFIED	
5.	at _____
6.	the _____
7.	by _____
8.	No. _____
9.	Seal/stamp: _____
10.	Signature: _____

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

If a verification is made before a foreign official in a country that is not a member of the Hague Convention, the foreign official's authority must be proved by a certificate of a diplomatic or consular officer of the United States. 15 U.S.C. §1061.

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

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States must allege that “I declare (or certify, verify, or state) under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.” *See* TMEP §804.01(b).

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

804.01(b) Declaration in Lieu of Oath

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

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

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

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

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

(Signature)

(Print or Type Name and Position)

(Date)

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

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Wherever, under any law of the United States or under any rule, regulation, order, or requirement made pursuant to law, any matter is required or permitted to be supported, evidenced, established, or proved by the sworn declaration, verification, certificate, statement, oath, or affidavit, in writing of the person making the same (other than a deposition, or an oath of office, or an oath required to be taken before a specific official other than a notary public), such matter may, with like force and effect, be supported, evidenced, established, or proved by the unsworn declaration, certificate, verification, or statement, in writing of such person which is subscribed by him, as true under penalty of perjury, and dated, in substantially the following form:

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

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

A declaration that does not attest to an awareness of the penalty for perjury is unacceptable. 35 U.S.C. §25. *In re Hoffmann-La Roche Inc.*, 25 USPQ2d 1539 (Comm’r Pats. 1992), *overruled on other grounds* 47 USPQ2d 1762, 1763 (1997) (failure to include a statement attesting to an awareness of the penalty for perjury, which is the very essence of an oath, is not a “minor defect” that can be provisionally accepted under 35 U.S.C. §26); *In re Stromsholmens Mekaniska Verkstad AB*, 228 USPQ 968 (TTAB 1986); *In re Laboratories Goupil, S.A.*, 197 USPQ 689 (Comm’r Pats. 1977).

If a declaration under 37 C.F.R. §2.20 or 28 U.S.C. §1746 is not dated, the examining attorney should require the applicant to state the date on which the declaration was signed. This statement does not have to be verified, and may be entered through a note to the file.

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

804.02 Averments Required in Verification of Application for Registration

The requirements for the verified statement in an application for registration are set forth in §§1(a)(3), 1(b)(3) and 44 of the Trademark Act, 15 U.S.C. §§1051(a)(3), 1051(b)(3) and

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1126, and 37 C.F.R. §§2.33 and 2.34. These allegations are required regardless of whether the verification is in the form of an oath (TMEP §804.01(a)) or a declaration (TMEP §804.01(b)).

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

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

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

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

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

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

Concurrent Use. The verification for concurrent use should be modified to indicate an exception, that no one else *except as specified in the application* has the right to use the

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mark. 15 U.S.C. §1051(a)(3)(D). *See* TMEP §§1207.04 *et seq.* regarding concurrent use registration.

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

Affirmative, Unequivocal Averments Required

The verification must include affirmative, unequivocal averments that meet the requirements of the Act and the rules. Statements to the effect that “the undersigned [person signing the declaration] has been informed that the applicant is using [or has a bona fide intention to use] the mark in commerce...” are unacceptable.

Substitute Verification

If the verified statement does not include all the necessary averments, the examining attorney will require a substitute or supplemental affidavit or declaration under 37 C.F.R. §2.20.

804.03 Time Between Execution and Filing of Papers

Papers Must Be Filed Within a Reasonable Time After Execution

All applications and papers must be filed within a reasonable time after their execution. Under 37 C.F.R. §2.33(c), if the verified statement supporting an application for registration is not filed within a reasonable time after it is signed, the Office will require the applicant to submit a substitute affidavit or declaration under 37 C.F.R. §2.20 of the applicant’s continued use or bona fide intention to use the mark in commerce. Re-execution is also required where allegations of use and requests for extensions of time to file a statement of use are not filed within a reasonable time after the date of execution. 37 C.F.R. §§2.76(i), 2.88(k), and 2.89(h); TMEP §§1104.09(b), 1108.02(b) and 1109.11(c).

The Office considers one year between execution and filing as reasonable for all applicants and all papers. No new verification should be required if the paper is filed within one year of execution. If an application, allegation of use, or request for extension of time to file a statement of use is filed more than one year after its execution, the examining attorney will require that the applicant submit re-executed papers or a statement that is verified or includes a declaration under 37 C.F.R. §2.20, of the applicant’s continued use or bona fide intent to use the mark in commerce, as appropriate.

Papers Cannot Be Filed Before They Are Executed

If an applicant files an application that is signed and lists a date of execution that is subsequent to the application filing date, the examining attorney will inquire as to the actual date on which the application was signed. However, where an application is executed in a foreign country located across the international date line, the fact that an application shows a

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date of execution as of the day after the application filing date is not inconsistent with its having been executed before filing. No inquiry is required in this limited situation.

804.04 Persons Authorized to Sign Verification or Declaration

Extract from 37 C.F.R. §2.33(a). The application must include a statement that is signed and verified (sworn to) or supported by a declaration under §2.20 by a person properly authorized to sign on behalf of the applicant. A person who is properly authorized to sign on behalf of the applicant is:

- (1) a person with legal authority to bind the applicant; or*
- (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant; or*
- (3) an attorney as defined in §10.1(c) of this chapter who has an actual or implied written or verbal power of attorney from the applicant.*

Effective October 30, 1999, the Trademark Act does not specify the appropriate person to sign on behalf of an applicant. The definition of a “person properly authorized to sign on behalf of an applicant” is set forth in 37 C.F.R. §2.33(a). This definition applies to applications for registration, amendments to allege use, statements of use, requests for extensions of time to file statements of use, affidavits of continued use or excusable nonuse under 15 U.S.C. §1058, affidavits of incontestability under 15 U.S.C. §1065; and combined filings under 15 U.S.C. §§1058 and 1059. 37 C.F.R. §§2.76(b)(1), 2.88(b)(1), 2.89(b)(3), and 2.161(b). It also applies to declarations supporting amendments to dates of use, use of substitute specimens, claims of acquired distinctiveness under 15 U.S.C. §1052(f), amendments changing the basis for filing, and designations of domestic representative.

Generally, the Office does not question the authority of the person who signs a verification, unless there is an inconsistency in the record as to the signatory’s authority to sign. The Office presumes that papers are properly signed. 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), the fact that an application is signed by someone whose title refers to a different entity is not considered an inconsistency that warrants an inquiry as to whether the verification was properly signed.

Example: If an application is filed by “ABC Company, Inc.,” and the verification is signed by an officer of “XYZ Company, Inc.,” the Office will presume that XYZ Company, Inc. is a related company properly authorized to sign on behalf of ABC Company, Inc. The Office will not ask the applicant to explain how the person has authority to sign.

It is not necessary to set forth the title of the person signing the verification or to state the relationship between the applicant and the person who signed the verification.

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

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Example: If the applicant is Mary Smith, an individual, and the application is signed by John Smith, the Office will not question whether the proper party is listed as applicant.

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

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

This policy applies to both individual applicants and juristic applicants.

The broad definition of a “person properly authorized to sign on behalf of an applicant” in 37 C.F.R. §2.33(a) applies *only* to verifications of facts by the applicant and designations of domestic representatives. It does *not* apply to powers of attorney, revocations of powers of attorney, responses to Office actions, or consent agreements.

A non-attorney who is authorized to verify facts on behalf of an applicant under 37 C.F.R. §2.33(a) is *not* necessarily entitled to sign responses to Office actions, or to authorize examiner’s amendments and priority actions. Authorizing an amendment to an application, or submitting legal arguments in response to an examining attorney’s requirement or refusal of registration, is, in effect, representing the applicant in a trademark matter. Under 5 U.S.C. §500(d) and 37 C.F.R. §10.14(e), non-attorneys may not represent a party in a trademark proceeding before the Office. See TMEP §§712 *et seq.* regarding signature of responses to Office actions.

804.05 Signature of Electronically Transmitted Applications

In an application filed through the Trademark Electronic Application System (TEAS), the applicant does not apply a conventional signature. Instead, the applicant does one of the following:

- (1) The applicant enters a “symbol” that the applicant has adopted as a signature. The Office will accept *any* combination of letters, numbers, spaces and/or punctuation marks as a valid signature if it is placed between two forward slash (“/”) symbols. 37 C.F.R. §§1.4(d)(1)(iii) and 2.33(d). Examples of acceptable signatures for TEAS applications include */john doe/*, */drl/*, and */544-4925/*. When examining a TEAS application, the examining attorney should not ask the applicant to verify that the symbol is the applicant’s signature, and should not require the applicant to submit a new declaration with a pen-and-ink signature; or
- (2) The application is completed on-line, printed in text form, and given or sent to the signatory. The signatory signs the application in the traditional pen-and-ink manner. An image file of the signed declaration is then transmitted electronically through TEAS. This method of signature is used primarily by attorneys who complete the

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application online, print it, and mail or fax it to the client for signature in text form. The client signs the application and returns it to the attorney. The attorney scans the returned document to create a .gif or .jpg image file, affixes it to the application, and files the application electronically through TEAS.

These principles also apply to the signature of an electronically filed amendment to allege use, statement of use, request for extension of time to file a statement of use, affidavit of continued use or excusable nonuse under 15 U.S.C. §1058, affidavit or declaration of incontestability under 15 U.S.C. §1065; and combined filing under 15 U.S.C. §§1058 and 1059.

See TMEP §301 for more information about electronic filing.

805 Identification and Classification of Goods and Services

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

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

806 Filing Basis

An application for registration must specify and meet the requirements of one or more filing bases before the mark will be approved for publication for opposition or registration on the Supplemental Register. 37 C.F.R. §2.32(a)(5). There are four filing bases: (1) use of a mark in commerce under §1(a) of the Trademark Act, 15 U.S.C. §1051(a); (2) bona fide intention to use a mark in commerce under §1(b) of the Act, 15 U.S.C. §1051(b); (3) a claim of priority, based on an earlier-filed foreign application under §44(d) of the Act, 15 U.S.C. §1126(d); and (4) registration of a mark in the applicant's country of origin under §44(e) of the Act, 15 U.S.C. §1126(e). 37 C.F.R. §2.34.

An applicant is not required to specify the basis for filing to receive a filing date. If the application does not specify a basis, the examining attorney must require in the first Office action that the applicant specify the basis for filing and submit all the elements required for that basis. If the applicant timely responds to the first Office action, but fails to specify a basis for filing, or fails to submit all the elements required for a particular basis, the examining attorney will issue a final Office action, if the application is otherwise in condition for final action.

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

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806.01 Requirements for Establishing a Basis

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

806.01(a) Use in Commerce - §1(a)

Under 15 U.S.C. §1051(a) and 37 C.F.R. §2.34(a)(1), the requirements for establishing a basis under §1(a) of the Trademark Act are:

- (1) The applicant must submit a verified statement that the mark is in use in commerce on or in connection with the goods or services listed in the application. If this verified statement is not filed with the initial application, the verified statement must state that the mark was in use in commerce on or in connection with the goods or services listed in the application *as of the application filing date* (37 C.F.R. §2.34(a)(1)(i));
- (2) The applicant must specify the date of the applicant's first use of the mark anywhere on or in connection with the goods or services (37 C.F.R. §2.34(a)(1)(ii); TMEP §903.01);
- (3) The applicant must specify the date of the applicant's first use of the mark in commerce as a trademark or service mark (37 C.F.R. §2.34(a)(1)(iii); TMEP §903.02); and
- (4) The applicant must submit one specimen for each class, showing how the applicant actually uses the mark in commerce (37 C.F.R. §§2.34(a)(1)(iv) and 2.56; TMEP §§904 *et seq.*).

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

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

An applicant may not claim a §1(a) basis unless the mark was in use in commerce on or in connection with *all* the goods or services covered by the §1(a) basis as of the application filing date. 37 C.F.R. §§2.34(a)(1)(i) and (v). *Cf. E.I. du Pont de Nemours & Co. v. Sunlyra International, Inc.*, 35 USPQ2d 1787, 1791 (TTAB 1995).

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

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806.01(b) Intent-to-Use - §1(b)

In an application based on 15 U.S.C. §1051(b), the applicant must submit a verified statement that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. If the verified statement is not filed with the initial application, the verified statement must allege that the applicant had a bona fide intention to use the mark in commerce on or in connection with the goods or services *as of the filing date of the application*. 37 C.F.R. §2.34(a)(2)(i).

The application may list more than one item of goods, or more than one service, if the applicant had a bona fide intention to use the mark in commerce on or in connection with all the specified goods or services as of the filing date of the application. 37 C.F.R. §§2.34(a)(2)(i) and (ii).

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

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

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

806.01(c) Foreign Priority - §44(d)

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

- (1) The applicant must file a claim of priority within six months of the filing date of the foreign application. 37 C.F.R. §§2.34(a)(4)(i) and 2.35(e).
- (2) The applicant must: (a) specify the filing date and country of the first regularly filed foreign application; or (b) state that the application is based upon a subsequent regularly filed application in the same foreign country, and that any prior-filed application has been withdrawn, abandoned or otherwise disposed of, without having been laid open to public inspection and without having any rights outstanding, and has not served as a basis for claiming a right of priority. 37 C.F.R. §§2.34(a)(4)(i)(A) and (B).
- (3) The applicant must verify that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the

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application. This allegation is required even if use in commerce is asserted in the application. TMEP §806.02(e). If the verified statement is not filed with the initial application, the verified statement must allege that the applicant had a bona fide intention to use the mark in commerce *as of the filing date of the application*. 37 C.F.R. §2.34(a)(4)(ii).

The application may list more than one item of goods, or more than one service, if the applicant had a bona fide intention to use the mark in commerce on or in connection with all the specified goods or services as of the filing date of the application. 37 C.F.R. §§2.34(a)(4)(ii) and (iv).

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

Section 44(d) of the Act provides a basis for receipt of a priority filing date, but not a basis for publication or registration. Before the application can be approved for publication, or for registration on the Supplemental Register, the applicant must establish a basis under §1(a), §1(b), or §44(e) of the Act. 37 C.F.R. §2.34(a)(4)(iii); TMEP §1003.03. If the applicant claims a §1(b) basis, the applicant must file an allegation of use (*i.e.*, either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d)) before the mark can be registered. *See* TMEP §806.01(b) regarding the requirements for a §1(b) basis.

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

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

806.01(d) Foreign Registration — §44(e) [R-2]

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

- (1) The applicant must submit a true copy, a photocopy, a certification, or a certified copy of the registration in the applicant's country of origin. 37 C.F.R. §2.34(a)(3)(ii); TMEP §§1004.01 and 1004.01(b).
- (2) The application must include the applicant's verified statement that it has a bona fide intention to use the mark in commerce on or in connection with the identified goods or services. This allegation is required even if use in commerce is asserted in the application. TMEP §806.02(e). If the verified statement is not filed with the

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initial application, the verified statement must allege that the applicant had a bona fide intention to use the mark in commerce *as of the application filing date*. 37 C.F.R. §2.34(a)(3)(i).

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

The application may list more than one item of goods, or more than one service, provided the applicant had a bona fide intention to use the mark in commerce on or in connection with all the specified goods or services as of the filing date of the application. 37 C.F.R. §§2.34(a)(3)(i) and (iv).

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

An application may be based on more than one foreign registration. If the applicant amends an application to rely on a different foreign registration, this is considered a change in basis. TMEP §1004.02. *See* TMEP §§806.03 *et seq.* regarding amendments to add or substitute a basis.

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

806.02 Multiple Bases

806.02(a) Procedure for Asserting More Than One Basis

If the applicant claims more than one basis, the applicant must satisfy all requirements for each basis claimed. 37 C.F.R. §2.34(b)(1). The applicant must clearly indicate that more than one basis is claimed, and must separately list each basis, followed by the goods or services to which that basis applies. If some or all of the goods or services are covered by more than one basis, this must be stated. 37 C.F.R. §§2.34(b)(2) and 2.35(f).

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

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

The applicant may claim a §44 basis in addition to *either* a §1(a) *or* a §1(b) basis for the same goods or services. However, the applicant may not assert both a §1(a) and §1(b) basis for the identical goods or services. 37 C.F.R. §2.34(b)(1).

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

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

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

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

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

806.02(d) Abandonment of Multi-Basis Applications

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

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

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

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

806.02(f) Section 44(d) Combined With Other Bases [R-2]

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

If an applicant claims §44(d) in addition to another basis, the examining attorney must inquire whether the applicant wishes to retain §44(e) as a second basis for registration (based on the foreign registration that will issue from the application on which the applicant relied for priority). The examining attorney should advise the applicant that it may retain the priority filing date even if it does not perfect the §44(e) basis, and ask the applicant whether it wishes to perfect the §44(e) basis. This inquiry should be made in the first Office action, or by telephone if no Office action is issued. If the applicant does not intend to assert a dual basis for registration, this should be indicated in an examiner's amendment and the mark should be approved for publication or issuance of a registration on the Supplemental Register, if appropriate. *See* TMEP §806.04(b) regarding the processing of an application in which an applicant elects not to perfect a §44(e) basis.

If the applicant wishes to perfect the §44 basis, the examining attorney cannot approve the mark for publication for opposition or registration on the Supplemental Register until the applicant files a copy of the foreign registration. Therefore, if all issues are resolved or in condition for final action, the examining attorney must suspend action pending receipt of the foreign certificate. TMEP §1003.04.

806.03 Amendments to Add or Substitute a Basis

806.03(a) When Basis Can be Changed

Before Publication: An applicant may add or substitute a basis before publication if the applicant meets all requirements for the new basis. 37 C.F.R. §2.35(a).

After Publication: After a mark has been published for opposition, the applicant may amend an application that is not the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board to add or substitute a basis only if the applicant files a petition to the Director. If the petition is granted and the added or substituted basis is established, the mark must be republished. 37 C.F.R. §2.35(b); *In re Monte Dei Maschi Di Siena*, 34 USPQ2d 1415 (Comm'r Pats. 1995).

See 37 C.F.R. §2.133(a) and TBMP §514 regarding the amendment of an application that is the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board.

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

An applicant may add or substitute a §44(d) basis only within the six-month priority period following the filing date of the foreign application. 37 C.F.R. §2.35(e).

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

If a §1(a) basis fails, either because the specimens are unacceptable or because the mark was not in use in commerce as of the application filing date, the applicant may substitute §1(b) as a basis. The Office will presume that the applicant had a continuing valid basis, because the applicant had at least a bona fide intention to use the mark in commerce as of the application filing date. When amending from §1(a) to §1(b), the applicant must submit a verified statement that the applicant had a bona fide intention to use the mark in commerce as of the filing date of the application. 15 U.S.C. §1051(b)(3)(B); 37 C.F.R. §2.34(a)(2)(i).

Once an applicant has filed a statement of use in a §1(b) application, the applicant may *not* withdraw the statement of use and return to the status of awaiting submission of a statement of use. 37 C.F.R. §2.88(g); TMEP §1109.17.

806.03(d) Amendment From §44 to §1(b) Permitted

Amendment of the basis from §44 to §1(b) is permitted. The Office will presume that the applicant had a continuing valid basis, because the applicant had a bona fide intention to use the mark in commerce as of the application filing date. It is not necessary to submit a new verification of the applicant's bona fide intention to use the mark in commerce if there is already one in the record with respect to the goods and/or services covered by the new basis.

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

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

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

An applicant can add or substitute a basis only if the applicant meets all the requirements for the new basis. 37 C.F.R. §2.35(a). Therefore, the applicant may not amend a §44 application to claim a §1(a) basis unless the applicant verifies that the mark was in use in commerce on or before the application filing date, and provides a specimen that was in use in commerce as of the filing date. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(i), 2.59(a); 2.71(c)(1); TMEP §§806.01(a), 806.03(h), 903.05, 904.09.

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

When the applicant substitutes one basis for another, the applicant will retain the original filing date, provided that the applicant has had a continuing valid basis for registration since the application filing date. Unless there is contradictory evidence in the record, the Office will presume that there was a continuing valid basis for registration. 37 C.F.R. §2.35(c).

If the applicant properly asserts a §44(d) basis during the six-month priority period, the applicant will retain the priority filing date, no matter which basis for registration is established, provided that the applicant has a continuing valid basis for registration. 37 C.F.R. §2.35(c) and (d).

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

806.03(h) Verification of Amendment Required

An applicant who adds or substitutes use in commerce under §1(a) as a basis must verify that the mark is in use in commerce and was in use in commerce on or in connection with the goods and/or services covered by the §1(a) basis *as of the filing date of the application*. 37 C.F.R. §2.34(a)(1)(i).

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

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

See TMEP §804.04 regarding persons who may sign a verification on behalf of an applicant under 37 C.F.R. §2.33(a).

806.04 Deleting a Basis

If an applicant claims more than one basis, the applicant may delete a basis at any time, before or after publication. 37 C.F.R. §2.35(a). When the applicant deletes a basis, the applicant must also delete any goods or services covered solely by the deleted basis. 37 C.F.R. §2.35(g).

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

If an application is based on §1(b) in addition to another basis, the applicant may delete the §1(b) basis by amendment at any time. 37 C.F.R. §2.35(a). If the applicant wishes to delete the §1(b) basis after publication, the applicant must submit a written amendment requesting that the §1(b) basis be deleted.

If a notice of allowance has been issued, the amendment should be sent to the ITU Unit within six months of the mailing date of the notice of allowance, or within a previously-granted extension of time to file a statement of use. The ITU Unit will enter the amendment, and take the necessary steps to delete the §1(b) basis and issue the registration.

If the notice of allowance has not yet been issued, the amendment should be sent to the Photocomposition Coordinators in the Publication and Issue Section of the Office. They will withdraw the notice of allowance, delete the §1(b) basis, and issue the registration.

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

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

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

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

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

806.05 Review of Basis Prior to Publication or Issue

If an application claims more than one basis, the examining attorney must ensure that the file clearly and accurately shows which goods are covered by which basis before approving the application for publication for opposition or registration on the Supplemental Register. If there are any errors, the examining attorney must instruct the legal instruments examiner to correct the TRAM database.

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807 Drawing

The drawing shows the mark sought to be registered. An applicant must submit a drawing with the original application in order to receive a filing date in any application for registration of a mark, except in applications for registration of sound, scent and other non-visual marks. *See* TMEP §807.11 regarding “drawings” in applications for registration of non-visual marks. The drawing is used to reproduce the mark in the *Official Gazette* and on the registration certificate.

The main purpose of the drawing is to provide notice of the nature of the mark sought to be registered. The drawing of a mark is promptly entered into the automated records of the Office and is available to the public through Trademark Electronic Search System (TESS) on the USPTO website at <http://tess.uspto.gov> (*see* TMEP §104). Timely public notification of the filing of applications is important because granting a filing date to an application potentially establishes a date of constructive use of the mark (*see* TMEP §201.02). Therefore, an application must include a clear drawing of the mark to receive a filing date. 37 C.F.R. §2.21(a)(3); TMEP §202.01. A clear drawing of the mark is necessary so marks can be promptly and accurately entered into the Office’s database.

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

There are two forms of drawings: “special form drawings,” and “typed drawings.” *See* TMEP §§807.06 *et seq.* for information about typed drawings, and TMEP §§807.07 *et seq.* for information about special form drawings.

The mark in the drawing must agree with the mark as used on the specimens in an application under §1 of the Trademark Act, 15 U.S.C. §1051, or as applied for or registered in a foreign country in an application under §44, 15 U.S.C. §1126. 37 C.F.R. §2.51; TMEP §§807.14 *et seq.* and 1011.01.

807.01 Recommended Format

807.01(a) Separate Drawing Page Preferred

The Office recommends that an applicant submit a drawing of the mark on a separate page from the written application. However, a separate drawing page is not mandatory. *See* TMEP §807.05.

Instead of a drawing page, an applicant may include a drawing of the mark embedded in the application. The drawing might appear in the heading or in the body of the application. However, a mark depicted on the specimens or in the foreign registration certificate will not be considered a drawing.

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

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mark is. The Office will disregard the mark in the written application. See TMEP §§202.01 and 807.05. *In re L.G. Lavorazioni Grafite S.r.l.*, 61 USPQ2d 1063 (Comm'r Pats. 2001).

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

807.01(b) Type of Paper and Size of Drawing

37 C.F.R. §2.52(b). Recommended Format for special form drawings.

(1) Type of paper and ink. The drawing should be on a piece of non-shiny, white paper that is separate from the application. Black ink should be used to depict the mark.

(2) Size of paper and size of mark. The drawing should be on paper that is 8 to 8½ inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long. One of the shorter sides of the sheet should be regarded as its top edge. The drawing should be between 2.5 inches (6.1 cm.) and 4 inches (10.3 cm.) high and/or wide. There should be at least a 1 inch (2.5 cm.) margin between the drawing and the edges of the paper, and at least a 1 inch (2.5 cm.) margin between the drawing and the heading.

The recommended format for special form drawings is set forth in 37 C.F.R. §2.52(b). Under 37 C.F.R. §2.52(b)(2), the mark should be no larger than four inches high by four inches wide. The size limitation is recommended, but not mandatory. However, to ensure that marks can be adequately reproduced in the *Official Gazette* and on the certificate of registration, the Office must reduce the drawing to the proper size before the mark is approved for publication for opposition or registration on the Supplemental Register.

Therefore, if the mark on a drawing is more than four inches wide by four inches high, the examining attorney or legal instruments examiner will use a photocopier to reduce the size of the mark on the drawing to four inches high by four inches wide.

807.01(c) Heading

37 C.F.R. §2.52(b)(3). Heading. Across the top of the drawing, beginning one inch (2.5 cm.) from the top edge, the applicant should type the following: applicant's name; applicant's address; the goods or services recited in the application, or a typical item of the goods or services if numerous items are recited in the application; the date of first use of the mark and first use of the mark in commerce in an application under section 1(a) of the Act; the priority filing date of the relevant foreign application in an application claiming the benefit of a prior foreign application under section 44(d) of the Act. If the information in the heading is lengthy, the heading may continue onto a second page, but the mark should be depicted on the first page.

Across the top of the drawing sheet there should be a heading that lists the following information on separate lines:

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- the applicant's complete name;
- the applicant's address;
- the goods or services;
- in an application filed under §1(a) of the Act, the dates of first use of the mark and first use of the mark in commerce;
- in an application filed under §44(d) of the Act, the priority filing date; and
- in an application under §44(e) of the Act, a statement that the application is based on a foreign registration.

A typewritten heading is preferred. The heading should be placed across the narrow end that serves as the top of the sheet starting one inch (2.5 cm.) from the top edge and should not exceed one third of the sheet.

The main purpose of the heading is to make basic information concerning the application available in the search records of the Office.

While a separate drawing page with a heading is encouraged, it is not mandatory. *See* TMEP §807.01(a).

807.01(d) Single Page Drawing Preferred

When the applicant submits a separate drawing page, it is preferred that the mark and heading appear on a single page. This expedites entry of information about the application into Office records.

807.02 Transmission of Drawings

For an electronically transmitted application, if the drawing is in special form, the applicant must attach a digitized image (*e.g.*, .gif or .jpg) of the mark to the electronic submission. 37 C.F.R. §2.52(c). *See* TMEP §301 for additional information about electronic filing.

Drawings may *not* be submitted by facsimile transmission. 37 C.F.R. §1.6(d)(4).

807.03 Drawing Must Show Only One Mark [R-1]

An application must be limited to one mark. 37 C.F.R. §2.52(a).

Under 37 C.F.R. §2.21(a)(3), an applicant must submit “a clear drawing of the mark” to receive a filing date. An application that includes two or more drawings displaying materially different marks does not meet this requirement. Therefore, an application is denied a filing date if the applicant submits two or more drawings. *See* TMEP §202.01 for further information. Two marks are considered to be materially different if the substitution of one for the other would be a material alteration of the mark, within the meaning of 37 C.F.R. §2.72 (*see* TMEP §807.14(a)).

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However, if an applicant submits a separate drawing page showing a mark, and a different mark appears in the written application, the drawing page controls for purposes of determining what the mark is. The Office will disregard the mark in the written application. *See In re L.G. Lavorazioni Grafite S.r.l.*, 61 USPQ2d 1063 (Comm'r Pats. 2001).

The Office will not deny a filing date if the drawing shows two spatially separate elements. If the applicant submits an application where the “drawing” is composed of multiple elements on a separate page, or multiple elements in a separate area of the body of the application, the applicant has met the requirement for a drawing of the mark. The examining attorney must determine whether the matter presented for registration is a single mark projecting a unitary commercial impression. If the examining attorney determines that two spatially separate elements constitute two different marks, the examining attorney should refuse registration on the ground that the applicant seeks registration of more than one mark. *See In re Hayes*, 62 USPQ2d 1443 (TTAB 2002); *In re Elvis Presley Enterprises, Inc.*, 50 USPQ2d 1632 (TTAB 1999); *In re Walker-Home Petroleum, Inc.*, 229 USPQ 773 (TTAB 1985); *In re Jordan Industries, Inc.*, 210 USPQ 158 (TTAB 1980); *In re Audi NSU Auto Union AG*, 197 USPQ 649 (TTAB 1977); *In re Magic Muffler Service, Inc.*, 184 USPQ 125 (TTAB 1974); *In re Robertson Photo-Mechanix, Inc.*, 163 USPQ 298 (TTAB 1969).

When registration is refused because the matter presented on the drawing does not constitute a single mark, the application filing fee will not be refunded. The applicant may amend the drawing if the amendment does not materially alter the mark, or may submit arguments that the matter on the drawing does in fact constitute a single mark. *See* TMEP §807.14(a) regarding material alteration, and TMEP §807.15 regarding deletion of matter from the drawing.

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

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

807.04 Drawing Must Be Limited to Mark

The purpose of the drawing is to permit proper coding and filing of the mark for search purposes, to indicate what the mark is, and to provide a means for reproducing the mark in the *Official Gazette* and on the certificate of registration. Therefore, matter that appears on the specimen that is not part of the mark should not be placed on the drawing.

On all drawings, the mark should be placed on the sheet in a clear space entirely free of any other printing. Quotation marks and hyphens should not be included in the mark on a drawing unless they are a part of the mark. The drawing should not include extraneous matter such as the letters “TM” or a notice of registration. *See* TMEP §§906 *et seq.* regarding use of the federal registration notice ®.

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See TMEP §807.15 regarding requirements for removal of matter from the drawing.

807.05 Drawing No Longer Considered Separate Element

Prior to October 30, 1999, an applicant was required to submit a separate drawing page in order to receive a filing date, and the drawing page was considered a separate element that was not part of the written application. The Office would look to the drawing to determine what the mark was, and the written application controlled for all other purposes. The applicant was required to set forth the identification of goods/services and basis for filing within the four corners of the written application.

If the written application included an identification of goods or services, and additional goods or services were listed on the drawing page, the additional goods or services listed on the drawing page were not considered part of the identification of goods/services.

Effective October 30, 1999, Office practice changed. Now a separate drawing page is encouraged, but not required. TMEP §807.01(a). If the applicant submits a separate drawing page, this page is considered part of the written application, not a separate element. An application will receive a filing date if the identification of goods or services appears only on the drawing page. If the written application includes an identification of goods or services, and additional goods or services are listed on the drawing page, the additional goods/services listed on the drawing page are considered part of the identification of goods/services in the written application. Dates of use, disclaimers, descriptions of the mark, and other information that appears on the drawing are also considered part of the written application. This applies to substitute drawings as well as original drawings. See TMEP §1402 *et seq.* regarding examination of the identification of goods/services.

However, if an applicant submits a separate drawing page showing a mark, and a different mark appears in the written application, the drawing controls for purposes of determining what the mark is. The Office will disregard the mark in the written application. The applicant may not amend the mark if the amendment is a material alteration of the mark on the drawing page. 37 C.F.R. §2.72. See *In re L.G. Lavorazioni Grafite S.r.l.*, 61 USPQ2d 1063 (Comm'r Pats. 2001). See TMEP §807.14(a) regarding material alteration.

807.06 Typed Drawings

37 C.F.R. §2.52(a)(1). Typed drawing. The drawing may be typed if the mark consists only of words, letters, numbers, common forms of punctuation, or any combination of these elements. In a typed drawing, every word or letter must be typed in uppercase type. If the applicant submits a typed drawing, the application is not limited to the mark depicted in any special form or lettering.

On a “typed drawing,” the mark is depicted by using a typewriter or word processor. A “typed drawing” performs the function of a drawing, since it shows the mark for which the applicant seeks registration.

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The mark must be typed entirely in capital, or upper case, letters. If the applicant wishes to include lowercase lettering in a drawing, the applicant must submit a special form drawing. *In re Walker Research, Inc.*, 228 USPQ 691 (TTAB 1986). See TMEP §§807.07 *et seq.* regarding special form drawings.

There should be no spaces between letters of a word, but a space should be left between words. If an applicant wants to register a mark in which there are spaces between letters of a word, the applicant must submit a special form drawing.

The mark in a typed drawing should be typed on one line, if possible. One line in a single column of the *Official Gazette* consists of about 18 characters or spaces. If the applicant wants a mark comprising less than 18 characters or spaces to appear on two or more lines, the applicant must submit a special form drawing. If the applicant submits a typed drawing of such a mark, the Office will normally not require a substitute drawing. However, the mark will appear on only one line in the *Official Gazette* and on the certificate of registration.

If the mark on a typed drawing contains more than 18 characters, the Office's automated system will automatically break the mark. If the applicant has a preference as to where the mark will be broken, the applicant must submit a special form drawing.

If a mark includes a term that comprises more than 18 characters *unbroken by spaces*, the Office will break the term for publication in the *Official Gazette*. If the applicant has a preference as to what portion of the term will be placed on each line, or if placement is essential to the commercial impression, the applicant must submit a special form drawing. If the applicant submits a typed drawing containing a term that comprises more than 18 characters unbroken by spaces, the Office will normally not require a substitute drawing. However, the term will appear on two different lines in the *Official Gazette* and on the certificate of registration.

If the examining attorney determines that a mark cannot be adequately reproduced in a typed drawing due to the length of the mark, the examining attorney should require a special form drawing.

807.06(a) Characters, Symbols, and Punctuation Marks That May Be Used in Typed Drawings

A typed drawing may be used if no special characteristics are to be shown, such as design, style of lettering, color or unusual forms of punctuation. A typed drawing may not be used if the mark contains any special form feature or matter that cannot be represented using all capital letters in pica or elite type. See notice at 1135 TMOG 44 (February 11, 1992). A special form drawing is required if special styles of lettering or elements of design or color are to be included. See TMEP §807.07(b).

Typed drawings must be limited to matter that can readily be set up in plain block type. In addition to letters and numerals, the following common punctuation marks and symbols may be used in a typed drawing:

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. ? “ - ; () % \$ @ +
, ! ‘ : / & # * = []

The applicant may also use a typed drawing if the mark includes diacritical marks such as the German umlaut, the Spanish tilde, or the French accent. *See* TMEP §807.06(b).

The applicant may *not* use a typed drawing if the mark contains foreign characters or punctuation marks other than those listed above. The degree symbol (°), raised or “rolled” periods, superscripts, subscripts and exponents are *not* permitted in typed drawings. *In re AFG Industries Inc.*, 17 USPQ2d 1162 (TTAB 1990) (special form drawing required for raised numeral). Underlining and bold print are not permitted in a typed drawing.

A special form drawing is required to show a raised period. However, if otherwise appropriate, the mark may be represented by a typed drawing by substituting a hyphen for the raised period.

807.06(b) Typed Drawings that Include Diacritical Marks Permitted

The Office will accept a typed drawing that includes diacritical marks such as the German umlaut, the Spanish tilde, the French accent. The applicant must type the mark entirely in capital letters, and include the relevant diacritical mark(s).

A typed drawing that includes diacritical marks must also conform to certain requirements that apply to special form drawings. Although this drawing is regarded as a typed drawing under Office rules, the Office must process it in the same manner as a special form drawing for purposes of printing in the *Official Gazette* and on the registration certificate. The drawing must meet the requirements of 37 C.F.R. §2.52(a)(2).

The drawing may be prepared using a typewriter or word processor, or by any other means that will display the mark in a manner that will reproduce satisfactorily in special form. The mark must be in pica, elite, or larger type.

The applicant may include the following statement in the record to indicate the nature of such a mark:

The mark is presented without any claim as to special form.

If the applicant submits such a statement, the examining attorney should mark it for printing in the “description-of-the mark” field.

Examining attorneys and legal instruments examiners must ensure that a typed drawing that includes diacritical marks has been scanned and otherwise treated like a special form drawing. The examining attorney should verify on the automated search system that the proper drawing of the mark has been scanned and entered. If the drawing has not yet been processed as a special form drawing, the legal instruments examiner must submit the drawing

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for scanning using the same procedures that would apply to an amended special form drawing. These drawings should be classified in Mark Drawing Code 5.

A “typed drawing” on which the words or letters are arranged in a special display is also classified in Mark Drawing Code 5 and processed as a special form drawing.

807.06(c) Distinguishing Typed From Special Form Drawings

In some cases, an applicant will print or write the mark by hand. In this situation, the examining attorney should ask the applicant whether the applicant wants to use a typed or special form drawing. If the applicant states that it wants a typed drawing, the examining attorney should ask the legal instruments examiner to change the drawing code to Mark Drawing Code 1. It is not necessary to retype the drawing or require a substitute drawing.

If there is any doubt concerning whether a drawing is in typed or special form, the examining attorney should request clarification from the applicant, and instruct the legal instruments examiner to correct the TRAM database, if necessary.

807.07 Special Form Drawings

807.07(a) Characteristics of Special Form Drawings

37 C.F.R. §2.52(a)(2)(i). Special form drawings must be made with a pen or by a process that will provide high definition when copied. A photolithographic, printer’s proof copy, or other high quality reproduction of the mark may be used. Every line and letter, including lines used for shading, must be black. All lines must be clean, sharp, and solid, and must not be fine or crowded. Gray tones or tints may not be used for surface shading or any other purpose.

A “special form drawing” (also referred to as an “ink drawing”) is a drawing that presents a mark comprised, in whole or in part, of special characteristics such as elements of design or color, styles of lettering, or unusual forms of punctuation.

All special form drawings must be of a quality that will reproduce satisfactorily on a black and white photocopier. Only black and white may appear on the drawing. No color is permitted. Every line and letter must be black, clean and crisp, and all filled areas must be solid black. This applies to all lines and shading, however fine. The lining must not be too fine or crowded. Surface shading should be open and indicated by black stippling. Gray tones are unacceptable.

Pasted or taped material does not reproduce satisfactorily, and is therefore unacceptable.

If the drawing is not of a quality that will reproduce satisfactorily for scanning into the Office’s database and printing in the *Official Gazette* and on the certificate of registration, the examining attorney must require a new drawing. If there is any doubt as to whether the drawing is acceptable, the examining attorney should contact the Photocomposition Coordinators in the Publication and Issue Section of the Office.

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

807.07(b) When Special Form Drawing is Required

The Office encourages the use of typed drawings. As a general rule, an applicant may submit a typed drawing when the word, letter, numeral, or combination thereof creates a distinct commercial impression apart from any stylization or design element appearing on the specimens. If a mark remains the same in essence and is recognizable regardless of the form or manner of display that is presented, typing the mark affords a quick and efficient way of showing the essence of the mark. *In re Oroweat Baking Co.*, 171 USPQ 168 (TTAB 1971) (requirement for special form drawing to register OROWEAT displayed with wheat designs in the letter “O” held improper); *In re Electronic Representatives Association*, 150 USPQ 476 (TTAB 1966) (special form drawing not required when acronym makes an impression apart from design).

A special form drawing is required if words, letters or numerals are presented in a distinctive form that changes the meaning or overall commercial impression of the mark. *In re Morton Norwich Products, Inc.*, 221 USPQ 1023 (TTAB 1983); *In re United Services Life Ins. Co.*, 181 USPQ 655 (TTAB 1973); *In re Dartmouth Marketing Co., Inc.*, 154 USPQ 557 (TTAB 1967).

When an application is for a mark in typed form, the examining attorney should consider the manner in which the mark is used on the specimen and decide whether the mark includes an essential element or feature that cannot be produced by typing. See TMEP §807.14 regarding agreement between the mark on the drawing and the mark used on the specimens.

If the examining attorney determines that the mark in a typed drawing should have been presented in special form, the applicant may submit a special form drawing if the amendment would not result in a material alteration of the mark. The applicant cannot substitute a special form drawing if the amendment would materially alter the mark. See 37 C.F.R. §2.72; TMEP §807.14(a).

807.07(c) Special Form and Typing Cannot Be Combined

Special form drawings of a mark should not contain typed matter as part of the mark. All the matter in a mark on a drawing should be depicted by the same technique, unless the mark as actually used (or the mark on the foreign registration in a §44(e) application) is produced by two different techniques. In those rare situations where the mark as actually used or shown on the foreign registration is produced by two different techniques, the Office will accept a typed drawing, but will classify it as Mark Drawing Code 5 and process it as a special form drawing.

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807.08 Compound Word Marks and Telescoped Marks

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

A compound word mark that is appropriately represented by a typed drawing may be presented as one unitary term (*e.g.*, BOOKCHOICE) or as two words (*e.g.*, BOOK CHOICE) on the drawing. The examining attorney should determine whether the mark may be presented as separate words based on its commercial impression, taking into account any specimen(s) of record. It would not be appropriate to represent a compound mark as separate words unless it would be reasonable to conclude that the commercial impression of the mark is that of separable words. (For example, in the mark "ExFone," "Ex" would not be viewed as a separate word; therefore, in a typed drawing, the mark should be presented as one word.)

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

Compound word marks and telescoped marks may be represented by a typed drawing or presented in special form. When examining these marks, the examining attorney must determine whether a typed drawing is acceptable or whether a special form drawing is required. *See* TMEP §807.07(b).

See TMEP §§1213.05(a) *et seq.* regarding disclaimers in these types of marks.

807.09 Color in the Mark

If an applicant uses color in a mark, the applicant usually has the option of showing the mark on the drawing either in black and white or in the color(s) shown on the specimen.

See TMEP §§1202.05 *et seq.* regarding the registration of "color marks." Color marks are marks that consist solely of one or more colors used on particular objects. Composite marks that include words, designs, or product configurations may also include color, but are not considered to be "color marks," because they include other distinctive matter.

807.09(a) Black and White Drawing Required

The Office does not publish marks or issue registrations in color. The applicant must submit a black and white drawing before the mark can be approved for publication or for registration on the Supplemental Register. 37 C.F.R. §2.52(a)(2)(i).

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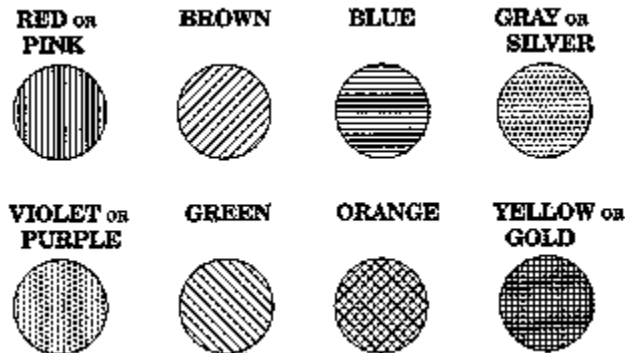
Thus, if the applicant submits a color drawing, the examining attorney must require submission of a black and white drawing. If the examining attorney believes that a photocopier can produce an acceptable black and white drawing, the examining attorney may ask the applicant for permission to make a photocopy of the drawing. The examining attorney should make an appropriate note to the file.

807.09(b) Use of Color Lining No Longer Required

Prior to October 30, 1999, an applicant who wanted to show color in a mark was required to use the Office's color lining system, which was designated in 37 C.F.R. §2.52(e). The color lining system has been deleted from the rules. However, until further notice, the Office will continue to accept drawings that show color by using the color linings. See notice at 64 Fed. Reg. 48900, 48903 (Sept. 8, 1999) and 1226 TMOG 103, 106 (Sept. 28, 1999).

The examining attorney should not require a new drawing if an applicant uses the color linings formerly designated in 37 C.F.R. §2.52(e). If a drawing contains color lining, the applicant must submit a statement explaining the colors that are designated by the lining. If this statement is not in the application when it is filed, the examining attorney will require that a statement be made of record.

The color linings formerly in 37 C.F.R. §2.52(e) are set forth below:



If an applicant uses any of these linings, the examining attorney should ensure that they are accurate.

Description of Color Linings:

- RED or PINK - vertical black lines on white ground
- BROWN - diagonal lower left to upper right black lines on white ground
- BLUE - horizontal black lines on white ground
- GRAY or SILVER - horizontal brick pattern white lines on black ground
- VIOLET or PURPLE - vertical brick pattern white lines on black ground
- GREEN - diagonal upper left to lower right black lines on white ground
- ORANGE - diagonal hatch (crossed) black lines on white ground

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- YELLOW or GOLD - horizontal hatch (crossed) black lines on white ground

807.09(c) Description of Color Required

If a mark includes color and the applicant does not use color lining (see TMEP §807.09(b)), the applicant must submit a black and white drawing of the mark accompanied by a statement describing the color(s) and where they appear in the mark. 37 C.F.R. §2.52(a)(2)(v). If the color is applied only to a portion of the mark, the description must indicate the specific portion. Similarly, if the mark includes gradations of color, this should be stated in the description of the mark.

The applicant may supplement the required written description of the color contained in a mark with a reference to a commercial color identification system. The Office does not endorse or recommend any one commercial color identification system. The written description of the mark must include a generic description of the color, in addition to the reference to the commercial color identification system.

It is usually not necessary to indicate shades of a color, but the examining attorney has the discretion to require that the applicant indicate shades of a color, if necessary to accurately describe the mark.

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

807.09(d) Color a Feature of the Mark

If an application includes a description of the mark indicating that color is used on the mark, or a drawing that is lined for color (TMEP §807.09(b)), the Office will presume that color is a feature of the mark. However, if desired, the applicant may include an affirmative statement that the designated colors are a feature of the mark.

If an application includes a description of the mark indicating that color is used on the mark or a drawing that is lined for color, but color is not a feature of the mark, the applicant may include in the description of the mark the following (or equivalent) wording: "but no claim is made to color" or "but color is not a feature of the mark."

See TMEP §§1202.05 *et seq.* regarding marks that consist solely of color.

807.09(e) Markings That Do Not Indicate Color

Stippling may not be used to indicate color. Some forms of stippling or of lining are occasionally used to indicate shading. This is permissible if the meaning is clear. Also, stippling and non-color types of lining may actually be design features of marks.

If the examining attorney believes that the significance of some particular stippling or non-color type of lining would not be clear without explanation, the examining attorney should

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require that the applicant submit a statement explaining the significance of the lining or stippling. This statement can be entered by examiner's amendment.

807.10 Broken Lines to Show Placement

37 C.F.R. §2.52(a)(2)(ii). If necessary to adequately depict the commercial impression of the mark, the applicant may be required to submit a drawing that shows the placement of the mark by surrounding the mark with a proportionately accurate broken-line representation of the particular goods, packaging, or advertising on which the mark appears. The applicant must also use broken lines to show any other matter not claimed as part of the mark. For any drawing using broken lines to indicate placement of the mark, or matter not claimed as part of the mark, the applicant must include in the body of the application a written description of the mark and explain the purpose of the broken lines.

Occasionally the position of the mark on the goods, or on a label or container, may be a feature of the mark. If necessary to adequately depict the commercial impression of the mark, the examining attorney may require the applicant to submit a drawing that shows the placement of the mark by surrounding the mark with a proportionately accurate broken-line representation of the particular goods, packaging, or advertising on which the mark appears. The applicant must also use broken lines to show any other matter not claimed as part of the mark. For any drawing using broken lines to indicate placement of the mark, or matter not claimed as part of the mark, the applicant must include a written description of the mark, indicating that the matter shown by the dotted lines is not a part of the mark and that it serves only to show the position of the mark. 37 C.F.R. §2.52(a)(2)(ii).

The drawing should clearly define the matter the applicant claims as its mark. *See In re Water Gremlin Co.*, 635 F.2d 841, 208 USPQ 89 (C.C.P.A. 1980); *In re Famous Foods, Inc.*, 217 USPQ 177 (TTAB 1983).

807.11 “Drawing” of Sound, Scent, or Non-Visual Mark

37 C.F.R. §2.52(a)(3). Sound, scent, and non-visual marks. The applicant is not required to submit a drawing if the applicant's mark consists only of a sound, a scent, or other completely non-visual matter. For these types of marks, the applicant must submit a detailed written description of the mark.

The applicant is not required to submit a drawing if the applicant's mark consists *solely* of a sound, a scent, or other completely non-visual matter. For these types of marks, the applicant must submit a detailed written description of the mark that clearly explains the sound or scent. 37 C.F.R. §2.52(a)(3). If the mark comprises music or words set to music, the applicant may also submit the musical score for the record.

The applicant should submit a page that indicates “NO DRAWING” in the place where the mark would otherwise appear. The mark should be coded under Mark Drawing Code 6 in the automated search system. This code formerly included only sound marks, but it now includes all non-visual marks.

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If the mark is a composite comprising both visual and non-visual matter, the applicant must submit a drawing depicting the visual matter, and include a description of the non-visual matter.

807.12 Three Dimensional Marks

If the mark is three-dimensional, the drawing should present the mark in three dimensions. *In re Schaefer Marine, Inc.*, 223 USPQ 170, 175 n. 1 (TTAB 1984). The applicant must include a description of the mark indicating that the mark is three-dimensional.

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

807.13 Marks With Motion

If the mark includes motion (*i.e.*, a repetitive motion of short duration) as a feature, the applicant may submit a drawing that depicts a single point in the movement, or the applicant may submit a square drawing that contains up to five freeze frames showing various points in the movement, whichever best depicts the commercial impression of the mark. The applicant must also submit a detailed written description of the mark. 37 C.F.R. §2.52(a)(2)(iv).

807.14 Mark on Drawing Must Agree with Mark on Specimens or Foreign Registration

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

In an application filed under §1(b) of the Act, the drawing of the mark must be a substantially exact representation of the mark as intended to be used on or in connection with the goods or services, *and* as actually used as shown by the specimen filed with the amendment to allege use or statement of use. 37 C.F.R. §§2.51(a)(2), 2.51(b)(2) and 2.72(b)(1).

In a §44 application, the drawing of the mark must be “a substantially exact representation of the mark as it appears in the drawing in the registration certificate of the mark registered in the applicant’s country of origin.” 37 C.F.R. §§2.51(a)(3) and 2.51(b)(3). The standard for determining whether the mark in the drawing agrees with the mark in the foreign registration is stricter than the standard used to determine whether specimens support use of a mark in an application under §1 of the Trademark Act. *See* TMEP §1011.01. The drawing in the United States application must display the entire mark as registered in the foreign country. The applicant may not limit the mark to part of the mark shown in the foreign registration, even if it creates a distinct commercial impression.

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When the mark on the drawing does not agree with the mark on the specimens or on the foreign registration, the applicant cannot amend the drawing of the mark if the amendment would materially alter the mark on the original drawing. 37 C.F.R. §2.72; TMEP §§807.14(a), 807.14(a)(i), and 1011.01.

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

807.14(a) Material Alteration of the Mark

Section 2.72 Amendments to description or drawing of the mark.

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

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

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

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

(1) The specimens filed with an amendment to allege use or statement of use, or substitute specimens filed under §2.59(b), support the proposed amendment; and

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

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

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

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

The examining attorney will determine whether any proposed amendment of the mark is acceptable in an application for registration. The applicant may not amend the description or drawing of the mark if the amendment materially alters the character of the mark. 37 C.F.R. §2.72. The test for determining whether an amendment is a material alteration is as follows:

The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark.

The general test of whether an alteration is material is whether the mark would

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have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it would be tantamount to a new mark appropriate for a new application.

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

Although the test refers to republication, it also applies to amendments to marks proposed before publication. Material alteration is the standard used for evaluating amendments to marks in all phases of prosecution, *i.e.*, before publication, after publication and after registration. See TMEP §§1609.02 *et seq.* regarding amendment of registered marks.

Ordinarily, an applicant may amend a special form drawing to a typed drawing if the typed version conveys the same commercial impression. The applicant may not amend to a typed drawing if the deletion of a design element or the elimination of the special form would change the commercial impression. Usually, the mere amendment from stylized lettering to typed form will not amount to a material alteration.

Deletion of matter from the mark can result in a material alteration. See *In re Dillard Department Stores, Inc.*, 33 USPQ2d 1052 (Comm’r Pats. 1993) (proposed deletion of highly stylized display features of mark “IN•VEST•MENTS” held to be a material alteration of a registered mark). However, the deletion of nondistinctive matter may not constitute a material alteration. For example, the deletion of the generic name of the goods or services would not generally be considered a material alteration unless it was so integrated into the mark that the deletion would alter the commercial impression. In some circumstances, descriptive or other types of nondistinctive matter may be deleted if the overall commercial impression is not altered. Also, deletions of matter determined to be unregistrable under §§2(a) or 2(b) of the Act (*see* TMEP §§1203 and 1204) are sometimes permissible. See TMEP §807.15 for additional information about amendments to delete matter from a drawing.

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

An amendment adding an element that the applicant has previously registered for the same goods or services may be permitted. The rationale is that “[t]he addition of applicant’s well-known registered mark to the mark sought to be registered ... is not a material change which would require republication of the mark.” *Florasynt Laboratories Inc. v. Mülhens*,

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122 USPQ 284 (Comm’r Pats. 1959) (addition of applicant’s previously registered mark “4711” to the mark “ELAN” held not a material alteration). However, the addition of matter that the applicant has previously registered for *different* goods or services is not permissible. *In re Hacot-Colombier, supra*, 105 F.3d at 620, 41 USPQ2d at 1527; *In re Nationwide Industries Inc.*, 6 USPQ2d 1882, 1886 (TTAB 1988). An amendment adding previously registered matter is also unacceptable if it substantially alters the original mark. *In re John LaBatt Ltd.*, 26 USPQ2d 1077, 1078 (Comm’r Pats. 1992) (“Here, the applicant does not seek to merely add an element from one registration to another. Rather, the applicant seeks to eliminate its original mark, and substitute another. The exception to the material alteration rule clearly does not encompass cases where the original mark disappears.”).

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

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

Proposed amendments to marks were held to be material alterations in the following decisions: *In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001) (amendment describing a mark as the color blue applied to an unlimited variety of objects found to be a material alteration of the mark on the original drawing, which depicted the color blue applied to a building); *In re Hacot-Colombier, supra* (proposed addition of house mark to conform to mark on foreign registration found to be material alteration of mark on drawing filed with original application); *In re Who? Vision Systems, Inc., supra* (proposed amendment from TACILESENSE to TACTILESENSE found to be material alteration); *In re CTB Inc.*, 52 USPQ2d 1471 (TTAB 1999) (proposed amendment of “TURBO AND DESIGN” to typed word “TURBO” is material alteration); *In re Meditech International Corp.*, 25 USPQ2d 1159, 1160 (TTAB 1990) (“[a] drawing consisting of a single blue star, as well as a drawing consisting of a number of blue stars, would both be considered material alterations vis-à-vis a drawing consisting of the typed words ‘DESIGN OF BLUE STAR’”); *In re Vienna Sausage Mfg. Co., supra* (addition of wording “MR. SEYMOUR” to design mark held to be a material alteration); *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989) (proposed amendment to replace typed drawing of “THE WINE SOCIETY OF AMERICA” with a special form drawing including those words with a crown design and a banner design bearing the words “IN VINO VERITAS” held to be a material alteration); *In re Nationwide Industries Inc., supra* (addition of house mark “SNAP” to product mark “RUST BUSTER” held a material alteration); *In re Pierce Foods Corp., supra* (addition of house mark “PIERCE” to “CHIK’N-BAKE” held a material alteration).

Proposed amendments to marks were found *not* to constitute a material alteration in the following cases: *In re Finlay Fine Jewelry Corp.*, 41 USPQ2d 1152 (TTAB 1996) (“NEW YORK JEWELRY OUTLET” not material alteration of “NY JEWELRY OUTLET”); *In re Larios S.A.*, 35 USPQ2d 1214 (TTAB 1995) (“VINO DE MALAGA LARIOS” and design not material alteration of “GRAN VINO MALAGA LARIOS” with similar design); *Visa*

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International Service Association v. Life-Code Systems, Inc., supra (amendment inverting the design portion of the mark held not a material alteration).

See TMEP §§1215.08 through 1215.08(b) regarding material alteration in marks comprised, in whole or in part, of domain names.

807.14(a)(i) Material Alteration Determined by Comparing Proposed Amendment to Original Drawing or Description [R-1]

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

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

Effective October 30, 1999, 37 C.F.R. §2.72 was amended to expressly prohibit amendments that materially alter the mark on the drawing filed with the original application. Furthermore, 37 C.F.R. §2.52(a) was amended to state that the “drawing depicts the mark sought to be registered.” Accordingly, the Office will no longer accept amendments to cure “internal inconsistencies” if these amendments materially alter the mark on the original drawing. See *In re Who? Vision Systems, Inc.*, 57 USPQ2d 1211 (TTAB 2000). See also notice at 64 Fed. Reg. 48900, 48902 (Sept. 8, 1999) and 1226 TMOG 103 (Sept. 28, 1999). This applies to all amendments examined on or after October 30, 1999, regardless of the filing date of the application. However, the Office will not re-examine pending applications with amendments that were accepted by an examining attorney prior to October 30, 1999, relying on *ECCS* or *Dekra*.

If an applicant submits a separate drawing page showing a mark, and a different mark appears in the written application, the drawing controls for purposes of determining what the mark is. The applicant may not amend the mark if the amendment is a material alteration of the mark on the drawing page. *In re L.G. Lavorazioni Grafite S.r.l.*, 61 USPQ2d 1063 (Comm'r Pats. 2001). See also *In re Tetrafluor Inc.*, 17 USPQ2d 1160 (Comm'r Pats. 1990) (examining attorney properly refused to accept amendment to “correct typographical error” that materially altered mark on original drawing page); *In re Meditech International Corp.*, 25 USPQ2d 1159 (TTAB 1990) (amendment that materially alters mark on original drawing page not permitted).

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807.14(b) Mutilation or Incomplete Representation of Mark

The mark on the drawing must be a complete mark, as evidenced by the specimen. The representation on a drawing of matter that does not constitute a complete mark has sometimes been referred to as “mutilation.” This term indicates that essential and integral subject matter is missing from the drawing. An incomplete mark may not be registered.

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

The determinative factor is whether or not the subject matter in question makes a separate and distinct commercial impression apart from the other element(s). *See In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988); *In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257 (C.C.P.A. 1950); *In re Miller Sports Inc.*, 51 USPQ2d 1059 (TTAB 1999); *In re Boyd Coffee Co.*, 25 USPQ2d 2052 (TTAB 1993); *In re Raychem Corp.*, 12 USPQ2d 1399 (TTAB 1989); *In re Sperouleas*, 227 USPQ 166 (TTAB 1985); *In re San Diego National League Baseball Club, Inc.*, 224 USPQ 1067 (TTAB 1983); *In re Volante International Holdings*, 196 USPQ 188 (TTAB 1977); *In re Library Restaurant, Inc.*, 194 USPQ 446 (TTAB 1977); *In re Semans*, 193 USPQ 727 (TTAB 1976); *In re Mango Records*, 189 USPQ 126 (TTAB 1975).

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

In any application, if the mark is refused registration on the ground that the mark on the drawing does not agree with the mark as shown on the specimens or foreign certificate, the applicant may not amend the drawing if the amendment would materially alter the mark on the original drawing. 37 C.F.R. §§2.52(a) and 2.72; TMEP §§807.14(a), 807.14(a)(i), and 1011.01.

807.15 Removal or Deletion of Matter from Drawing

The applicant may request deletions from the mark on the drawing, and the examining attorney may approve the request if he or she believes the deletions are appropriate and would not materially alter the mark. *See* 37 C.F.R. §2.72 and TMEP §807.14(a) regarding material alteration.

The examining attorney may also require deletion of matter from the mark. If a specimen shows that matter included on a drawing is not part of the mark, the examining attorney may

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require that such matter be deleted from the mark on the drawing, if the deletion would not materially alter the mark. *See In re Sazerac Co., Inc.*, 136 USPQ 607 (TTAB 1963) and cases cited therein.

The examining attorney must consider a number of factors in determining whether matter is part of a single or unitary mark: whether it is physically connected by lines or other design features; the relative location of the respective elements; and the meaning of the terminology as used on or in connection with the goods or services. *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 1561, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991).

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

807.16 Substitute Drawings

If the examining attorney requires a change in the drawing, the applicant must submit a substitute drawing, except in the limited circumstances discussed in TMEP §807.17 in which the Office will amend or correct a drawing. The Office will not return the original drawing to the applicant. 37 C.F.R. §2.25.

It is preferred that the applicant submit a substitute drawing on a separate drawing page. However, the Office will accept a substitute drawing embedded in a response to an Office action, if the substitute drawing meets the requirements of 37 C.F.R. §§2.51 and 2.52.

When the applicant voluntarily submits a substitute drawing, the examining attorney must determine whether the substitute drawing is acceptable. *See* TMEP §807.18 regarding the procedures for processing unacceptable amendments to drawings.

When a substitute drawing is submitted and accepted, the original drawing will be cancelled and the substitute drawing substituted. The examining attorney should ensure that the automated records of the Office reflect the amended mark, and instruct the legal instruments examiner to correct the TRAM database, if necessary. The original drawing remains in the file.

807.17 Amendment of Drawings by the Office

If the examining attorney requires correction of a typed drawing, the applicant may submit a substitute drawing (*see* TMEP §807.16), or may request that the Office retype the drawing. If only a minor correction to a typed drawing (such as deletion of the letters “TM”) is required, the examining attorney may retype the mark on his or her own initiative.

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The Office will delete matter from a special form drawing only if the matter to be deleted is sufficiently separate from the matter that is to remain. In such a case, the legal instruments examiner will circle or cross out the matter to be deleted in red ink. If the matter to be deleted is not sufficiently separate from the matter that is to remain, the applicant must submit a substitute drawing.

The examining attorney should ensure that the automated records of the Office reflect the amended mark, and instruct the legal instruments examiner to correct the TRAM database, if necessary.

807.18 Procedures for Processing Unacceptable Amendments to Drawings

If an applicant submits an amendment to the drawing and the examining attorney determines that the amendment is unacceptable, the examining attorney should issue an action refusing to accept the amendment and advising the applicant that it will not be entered. The examining attorney should ensure that the unacceptable amendment has not been entered into the automated records of the Office, and instruct the legal instruments examiner to correct the TRAM database, if necessary.

If the applicant later submits arguments in support of acceptance of the amendment and the examining attorney determines that the amendment is still unacceptable, the examining attorney should issue a final refusal of the amendment, if the application is otherwise in condition for final action.

807.19 Use of Old Drawing in New Application

37 C.F.R. §2.26. Use of old drawing in new application. In an application filed in place of an abandoned or rejected application, or in an application for reregistration (§2.158), a new complete application is required, but the old drawing, if suitable, may be used. The application must be accompanied by a request for the transfer of the drawing, and by a permanent photographic copy, or an order for such copy, of the drawing to be placed in the original file. A drawing so transferred, or to be transferred, cannot be amended.

A drawing from an abandoned application (if the file has not been destroyed) may be transferred to and used in a new application. A drawing from a pending application may be transferred only if there is evidence in the application file that the application will become abandoned before the new application will mature into registration.

A drawing from an expired or cancelled registration (if the file has not been destroyed) may be transferred to and used in a new application.

Transfers of drawings from files of active registrations are not permitted.

Transfers may be made only if the original mark is identical to the mark in the new application and if the drawing meets all relevant requirements. *See* 37 C.F.R. §2.26.

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Transfers of drawings are processed in the Pre-Examination Section of the Office. When a drawing is transferred from one file to another, the Office must place a copy of the drawing in the file from which the drawing is taken so that the original record will remain complete. The applicant should provide a copy of the original drawing for that purpose.

To avoid the erroneous denial of a filing date, it is advisable at the time of filing to include a drawing page and, in the place where the mark would otherwise appear, a notation that the applicant requests transfer of a drawing under 37 C.F.R. §2.26 and the registration number or serial number of the file from which the applicant requests that the drawing be transferred.

The Office destroys abandoned application files and cancelled or expired registration files two years after they become abandoned, cancelled or expired. *See* TMEP §§109.02 and 718.07. Therefore, an applicant should not request transfer of a drawing from a file that has been abandoned, cancelled or expired for more than two years. If an applicant does request the transfer of a drawing from a file that has been destroyed, the application will be denied a filing date for failure to comply with 37 C.F.R. §2.21(a)(3) (clear drawing of the mark required for receipt of a filing date).

808 Description of Mark

37 C.F.R. §2.37. Description of mark. A description of the mark, which must be acceptable to the Examiner of Trademarks, may be included in the application, and must be included if required by the examiner. If the mark is displayed in color or a color combination, the colors should be described in the application.

37 C.F.R. §2.52(a)(2)(vi). If a drawing cannot adequately depict all significant features of the mark, the applicant must also submit a written description of the mark.

808.01 Guidelines for Requiring Description

The examining attorney should require a description of the mark if:

- a significant element of a mark is unclear or ambiguous;
- the mark is three-dimensional, or a configuration of the goods or packaging (TMEP §§807.12 and 1202.02(d));
- the drawing includes broken lines to show placement or to indicate a portion of the product or packaging that is not part of the mark (TMEP §§807.10 and 1202.02(d));
- the mark includes color (TMEP §§807.09(c) and 1202.05(e));
- the mark includes motion (TMEP §807.13); or
- the mark is a sound, scent or non-visual mark.

The applicant may not amend the description of the mark if the amendment is a material alteration of the mark on the drawing or description filed with the original application. 37

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C.F.R. §§2.52(a) and 2.72. *In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001). See TMEP §807.14(a) regarding material alteration.

808.01(a) Letters and Numerals

If a mark is composed of easily recognized letters or numerals, it is not necessary to include a description of the letters or numerals, even if they are presented in an unusual or stylized form. “Describing” letters or numerals merely as being “in stylized form” or as being a “fanciful representation” adds nothing that cannot be observed directly. On the other hand, if letters or numerals of a mark are displayed in a manner that makes it difficult to ascertain what they are, then the examining attorney should require a description.

808.01(b) Designs or Figurative Elements

Designs or figurative elements generally do not require a description. Objects like trees, leaves and flowers, animals and people, buildings and scenery, manufactured products, etc., usually can be identified without explanation.

Marks with designs of symbols that are not well known should be described. Examples are symbols used in astrology; symbols representing mathematical, electrical or other scientific concepts; and legendary or historical symbols used to indicate ideas such as happiness, long life, etc. Designs that present an object in a way that makes it difficult to immediately identify the object should be described. Designs that represent an object that may not commonly be recognized (*e.g.*, a representation of an electrical transformer or a geiger counter) should also be described.

Geometric designs do not have to be described.

Vague descriptions of marks, such as “a design of a two-element circle,” should be avoided. Such wording does little to help explain the real nature of the design.

808.01(c) Meaning of Term in Mark

If it is unclear to the examining attorney whether a term in a mark has meaning in the relevant industry, the examining attorney should make an inquiry of the applicant and should also conduct independent research. If the examining attorney determines that the term is arbitrary or fanciful, this may be indicated in notes to the file. The fact that a term has no meaning should *not* be printed as a description in the *Official Gazette* or on the registration certificate.

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

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808.02 Description Must Be Accurate and Concise

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

A description cannot be used to restrict the likely public perception of a mark. A mark's meaning is based on the impression actually created by the mark in the minds of consumers, not on the impression that the applicant states the mark is intended to convey.

The description of the mark should be concise.

808.03 Printing Description of Mark

When a description of a mark is satisfactory to the examining attorney, it is printed in the *Official Gazette* and on the certificate of registration. If appropriate, the examining attorney should indicate in the file that the description should be printed (*see* TMEP §817).

If a description is placed in the record that is not satisfactory to the examining attorney, but which the examining attorney believes is harmless or unnecessary, the examining attorney should advise the applicant or the applicant's attorney that the description is believed unnecessary and will not be printed. If the application is otherwise in condition for publication or issue, this may be done through a telephone conversation referenced in notes to the file.

If the description is unsatisfactory and harmful to be in the record, the applicant must delete or correct it. This may be done by examiner's amendment.

A statement that a term in a mark has no meaning in the relevant industry should not be printed. TMEP §808.01(c).

809 Translation and Transliteration of Non-English Wording in Mark

An application to register a mark that includes non-English wording must include a statement translating the wording. Similarly, an application for a mark that comprises non-Latin characters must include a statement transliterating the characters. For this purpose, a transliteration is the phonetic spelling, in corresponding Latin characters, of the word(s) in the mark that are in non-Latin characters. A transliteration is required for a mark that comprises non-Latin characters even if the wording has no English translation. An example of a statement translating and transliterating a word in non-Latin characters is the following:

The non-Latin characters in the mark transliterate to "Asahi," and this means "Rising Sun."

Knowledge of the meaning of non-English words in marks is necessary for proper examination, because a non-English term is regarded in the same way as its English equivalent in determining descriptiveness, requiring disclaimer, and citing marks under §2(d)

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of the Act (*see* TMEP §§1207.01(b)(vi) and 1209.03(g)). Therefore, if there is no translation in the record, the examining attorney should ascertain the meaning of non-English wording through sources such as foreign language dictionaries before searching the mark. The examining attorney may also consult the Translations Branch of the Office.

If an application for a mark comprising non-English wording or non-Latin characters does not include an accurate translation and/or transliteration, the examining attorney should require the applicant to submit a statement of translation/transliteration, under 37 C.F.R. §2.61(b). The examining attorney may propose a translation, if appropriate. If the applicant submits a translation that is unacceptable to the examining attorney, the examining attorney should require amendment. The translation can be amended by examiner's amendment.

It is generally unnecessary to provide a translation of a foreign term if the term appears in an English dictionary (*e.g.*, croissant, fiesta or flambé). However, if a term that appears in the English dictionary appears in a mark as part of a foreign idiomatic phrase or other unitary expression, a translation of the idiomatic phrase or unitary expression is required. It would be illogical to break the phrase into its individual word elements and to translate only the individual words that do not appear in the English dictionary. Such a translation would serve no useful purpose because it would not convey the true commercial impression of the phrase.

Example: If the mark included the phrase “la fiesta grande,” an appropriate translation would be “the great celebration” or possibly “the great fiesta.” It would be inappropriate to translate only “la” and “grande.” The ultimate goal is to provide a translation that reflects the true meaning of the non-English wording in the mark and that reflects the commercial impression made by the entire phrase. *See* TMEP §809.01 regarding equivalency in translation.

It is generally unnecessary to provide a translation of foreign articles or prepositions, such as “de,” “le,” “la” or “il,” when combined with English terms, because their meaning is generally understood and, in this context, they are being used to convey an impression different from their foreign meaning. For example, in the mark “LE CASE,” it is unnecessary to translate “LE.”

It is generally not necessary to translate words from dead or obscure languages. *Cf. General Cigar Co. Inc. v. G.D.M. Inc.*, 988 F. Supp. 647, 45 USPQ2d 1481 (S.D.N.Y. 1997) (applicant had no obligation to disclose to USPTO that the term COHIBA for cigars means “tobacco” in the language of the Taino Indians in the Dominican Republic, because cigar smokers in the United States would not be aware of such a meaning). *See* TMEP §§1207.01(b)(vi) and 1209.03(g) regarding the applicability of the doctrine of foreign equivalents to words from dead or obscure languages. The determination of whether a language is “dead” must be made on a case by case basis, based upon the meaning that the term would have to the relevant purchasing public.

Example: Latin is generally considered a dead language. However, if there is evidence that a Latin term is still in use by the relevant purchasing public (*e.g.*, if the term appears in current dictionaries or news articles), then a Latin term is

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not considered dead. The same analysis should be applied to other uncommon languages.

When an application or certificate of registration includes a translation, both the non-English wording and the English translation will appear in the records of the Office. *See* TMEP §809.02 regarding the printing of the translation/transliteration statement in the *Official Gazette* and on the registration certificate.

809.01 Equivalency in Translation

The translation that should be relied upon in examination is the English meaning that has significance in the United States as the equivalent of the meaning in the non-English language. The following are examples of equivalency in translation:

- (1) “Chat Noir” - The exact equivalent in English is “black cat,” and this translation would undoubtedly be recognized by the purchasing public in this country. *Ex parte Odol-Werke Wien Gesellschaft M.B.H.*, 111 USPQ 286 (Comm’r Pats. 1956) (mark “Chat Noir” refused registration because the words “Black Cat” were already registered for related goods).
- (2) “Mais Oui” - The English equivalent of the phrase “mais oui” is “why, certainly,” or “why, of course,” and not “but yes.” *In re Societe Des Parfums Schiaparelli, S.A.*, 122 USPQ 349 (TTAB 1959). A satisfactory translation must be some normal English expression that will be the equivalent in meaning of the term “Mais Oui” in French.
- (3) “Schwarzkopf” - The term can be literally translated as “black head” but, even to German-speaking persons, the primary significance of “Schwarzkopf” is most likely that of a surname. Neither English nor foreign surnames should be translated. *See* TMEP §1211 regarding surnames.

If any question arises as to the proper translation of a mark, the examining attorney may consult the Translations Branch of the Office.

See TMEP §1207.01(b)(vi) regarding the use of the doctrine of foreign equivalents in determining likelihood of confusion under 15 U.S.C. §1052(d), and TMEP §1209.03(g) regarding the doctrine of foreign equivalents in determining questions of descriptiveness under 15 U.S.C. §1052(e)(1).

809.02 Printing of Translations and Transliterations

Generally, non-English wording in a mark must be translated into English and the translation (and transliteration, if applicable) must be printed in the *Official Gazette* and on the registration certificate.

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Sometimes translations that are not precise, or that give a variety of meanings, are placed in the record. While all possible translations, and discussions relative to meaning, are useful for informational purposes, not all such matter is appropriate for printing in the *Official Gazette* or on the certificate of registration. Only a translation that is the clear and exact equivalent (*see* TMEP §809.01) should be printed. This normally means only one translation, because the existence of a variety of alternative translations or general explanations usually indicates a lack of a clearly recognized equivalent meaning.

If an applicant submits a translation that is too verbose or vague to be appropriate for printing in the *Official Gazette* and on the registration certificate, the examining attorney must indicate which translation, if any, is to be printed. The transliteration of non-Latin characters, if any, should be included in the statement to be printed. If necessary, the examining attorney should rewrite the statement at the bottom of the application paper in an appropriate format, initial it, bracket it, and direct that it be printed. Language such as the following should be used for printing purposes whenever possible:

“The English translation of _____ in the mark is _____,” or “The non-Latin characters in the mark transliterate to _____ and this means _____ in English.”

To indicate approval of a translation, the examining attorney should include a marginal notation in the file indicating that the translation is to be printed (*e.g.*, “PRINT”) with the examining attorney’s initials. If the examining attorney determines that a translation of record should not be printed, the examining attorney should include an initialed marginal notation to that effect (*e.g.*, “DO NOT PRINT”).

810 Filing Fee

An application must include a filing fee for each class of goods or services. 15 U.S.C. §1051(a)(1) and (b)(1); 37 C.F.R. §2.6.

The required filing fee for at least one class of goods or services must be received before an application can be given a filing date. 37 C.F.R. §2.21(a)(5).

See TMEP §§202.03(a) and 202.03(a)(i) regarding the processing of applications in which a check submitted as the application filing fee is returned unpaid, or a charge to a credit card is refused by a financial institution. *See also* TMEP §405.01 regarding credit cards, TMEP §405.02(a) regarding returned checks, and TMEP §405.03 regarding deposit accounts.

810.01 Collection of Fees for Multiple Classes

A filing fee is required for each class in a multi-class application. 37 C.F.R. §2.86(a)(2). The Office has established the following policy to ensure the collection of application filing fees from all applicants on an equitable basis.

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If the applicant has specifically authorized the Office to charge any additional fees to a deposit account, the examining attorney should ask the legal instruments examiner to charge the fees, and proceed with examination of the application on the merits. If the applicant has not provided a specific authorization to charge an account, the examining attorney should attempt to contact the applicant by telephone to secure a written authorization to charge fees to a credit card or deposit account by fax. If this is successful, the examining attorney should have the legal instruments examiner charge the necessary fees to the credit card or deposit account and proceed with examination.

If an authorization to charge fees has not been provided and the examining attorney is unable to secure one, the examining attorney should issue a written Office action noting the deficiency and requiring either payment of the fees or deletion of classes. In the action, the examining attorney should advise the applicant that action on the merits of the application is deferred pending receipt of the applicant's response to the action.

This policy applies to any application in which the applicant specifically delineates more than one class of goods or services and the applicant has paid the fee(s) for less than all the classes. The delineation may be by indicating class numbers or any other means demonstrating a clear intention to seek registration in multiple classes.

If the entire record indicates a good faith attempt to pay all relevant fees, the examining attorney should simply act on the merits of the application and require the additional fees. For example, it would be inappropriate to defer action in a *pro se* application or in other cases where the applicant has in good faith attempted to pay the appropriate fees. Before issuing a letter deferring action until additional fees are paid, the examining attorney should consult with the managing attorney or senior attorney.

810.02 Refunds

Only money paid by mistake or in excess (when a fee is not required by the statute or rules, or is not required in the amount paid) may be refunded. A mere change of purpose after the payment of money does not entitle a party to a refund. For example, if an applicant deletes a class from an application, or withdraws an application, the applicant is not entitled to a refund. 37 C.F.R. §1.26.

The filing fee for an application that is denied a filing date will be refunded. After an application has been given a filing date and processed, the filing fee will normally not be returned. However, if an examining attorney erroneously requires a fee, the Office will refund any fee submitted in response to the erroneous requirement.

If the examining attorney determines that an applicant is entitled to a refund, he or she should take the file to the legal instruments examiner to process the refund.

If the examining attorney is uncertain as to whether a refund is appropriate, he or she should discuss the situation with the managing attorney or senior attorney.

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See TMEP §405.04 for additional information about processing refunds.

811 Designation of Domestic Representative [R-2]

Under 15 U.S.C. §1051(e) and 37 C.F.R. §2.24, an applicant not domiciled in the United States may file a document designating the name and address of a person residing in the United States on whom may be served notices or process in proceedings affecting the mark. See TMEP §604 for further information. The Office encourages applicants who do not reside in the United States to designate domestic representatives.

812 Identification of Prior Registrations of Applicant

37 C.F.R. §2.36. Identification of prior registrations. Prior registrations of the same or similar marks owned by the applicant should be identified in the application.

Trademark Rule 2.36, 37 C.F.R. §2.36, states that prior registrations of the same or similar marks owned by the applicant should be identified in the application. The rule does not precisely define when an applicant should claim ownership of prior registration(s), and the examining attorney may exercise discretion in invoking the rule. The main purpose of the rule is to provide the examining attorney with information necessary for proper examination. The information does not have to be given in any specific form. The applicant's claim of ownership of prior registrations will be printed in the *Official Gazette* and on the registration certificate.

Normally, identification of a registration is necessary because the registration would, if not owned by the applicant, be a basis for refusal under §2(d) of the Act, 15 U.S.C. §1052(d). Occasionally it is desirable to ask an applicant to identify a particular registration as being owned by the applicant merely to provide relevant information.

It is not necessary to assert ownership of expired or cancelled registrations. If the applicant wants to include a reference to a cancelled or expired registration, the applicant should indicate that the applicant owns the *mark* disclosed in the cancelled or expired registration, because technically one does not “own” a registration that is not in force and effect. Claims of ownership of pending applications, expired or cancelled registrations, and registrations that are unrelated to an application will not be printed.

Before marking a claim of ownership of prior registrations for printing in the *Official Gazette* and on the registration certificate (see TMEP §817), the examining attorney must ensure that the registrations are active.

If the applicant owns numerous prior registrations, it is not necessary to list them all. The applicant should identify the two or three registration numbers that are most relevant (due to the similarity of the marks and/or relatedness of the goods or services), e.g., “the applicant is the owner of Reg. Nos. _____ and others.”

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812.01 Proving Ownership of Prior Registrations

If an applicant includes a claim of ownership of a prior registration in the application as filed, the examining attorney should accept the claim without further proof of ownership and should not cite the registration as a reference under §2(d) of the Act.

If the applicant does not assert ownership of a pertinent registration in the application when it is filed, but the records of the Office indicate that the registration is owned by the applicant, the examining attorney does not have to cite the registration as a reference, but should call the registration to the applicant's attention and ask the applicant to state that the applicant owns the registration, if accurate. This statement may be placed in the record through an examiner's amendment.

The examining attorney should check the Assignment Historical Database to determine whether information contained in those records supports ownership of the registration in the applicant's name.

Generally, the applicant has the burden of proving ownership of a registration. The Office's automated search system may not reflect the recordation of changes of ownership in the Assignment Services Division. Therefore, if an applicant does not assert ownership of a pertinent registration in an application when it is filed, it is possible that the registration may be cited as a reference under §2(d) even though it is owned by the applicant. If so, the applicant must: (1) provide the reel and frame numbers where documents evidencing the chain of title from the registrant of record to the applicant have been recorded; (2) submit copies of documents evidencing the chain of title; or (3) submit an explanation, supported by an affidavit or declaration under 37 C.F.R. §2.20, of the chain of title (specifying each party in the chain, the nature of each conveyance, and the relevant dates). *See* 37 C.F.R. §3.73; TMEP §502.

813 Consent to Register by Living Individual Depicted in Mark

See TMEP §1206 concerning refusal of registration under §2(c) of the Trademark Act, 15 U.S.C. §1052(c), when a mark in an application comprises the name, portrait or signature of a living individual whose consent to register such name or likeness is not of record.

If a mark comprises a name or likeness that could *reasonably* be perceived as that of a living individual, the examining attorney must inquire whether the name or likeness is that of a specific living individual and must advise the applicant that, if so, the individual's written consent to register the name or likeness must be submitted. The purpose of the inquiry is to avoid the unauthorized registration of an individual's name or likeness. Consent is required for registration of a pseudonym, stage name or nickname if the name identifies a specific living individual. On the other hand, the examining attorney should not make an inquiry when it is clear that the matter identifies a fictitious character (*e.g.*, a name or likeness that is obviously that of a cartoon character).

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If a name or likeness that could reasonably be perceived as that of a living individual is not that of a specific living individual, a statement to that effect should be printed in the *Official Gazette* and on the registration certificate. The statement should read as follows:

“ _____ does not identify a living individual.”

If a mark comprises the name or likeness of a living individual and consent to register is of record, the following statement should be printed in the *Official Gazette* and on the registration certificate:

“ _____ identifies a living individual whose consent is of record.”

The individual does not have to express his or her consent in this exact terminology. However, once consent is in the record, the examining attorney should write the exact statement noted above at the bottom of the application page, initial it, bracket it, and direct that it be printed. As previously noted, a negative statement (advising that a name or likeness that could reasonably be considered to identify a specific living individual does not do so) should also be printed.

The statement of consent to registration of the name or likeness of a living individual must be personally signed by the individual whose name or likeness appears in the mark.

If the applicant is an individual and the mark is comprised, in whole or in part, of his or her name or likeness, consent to register is implicit if the individual whose name or likeness appears in the mark personally signs the application. No inquiry or statement should be made. However, if the application is signed by someone other than the individual whose name appears in the mark, the examining attorney must require a written consent personally signed by the individual. *See* TMEP §1206.03(b) regarding implied consent.

Often, the applicant is a corporation whose corporate name includes a name that appears to be that of an individual, and the mark includes that name as well. For example, where the applicant is John Smith, Inc. and the mark is JOHN SMITH, consent to register the name “John Smith” must be obtained from the individual. If, however, the application is signed by the person whose name appears in the mark, consent to register is implied. The examining attorney should make no further inquiry in that case. The examining attorney must enter the consent statement noted above in the record and mark it for printing.

If an applicant submits an unsolicited statement that a particular name or portrait does not identify a living individual, the examining attorney should mark the statement for printing in the *Official Gazette* and on the registration certificate only if an inquiry on this issue would have been necessary, *i.e.*, if the name or portrait might *reasonably* be perceived as that of a specific living individual.

814 Requesting Additional Information [R-2]

Sometimes it is necessary for the examining attorney to request additional information from an applicant in order to examine the application properly. *In re Air Products and Chemicals*,

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Inc., 192 USPQ 157 (TTAB 1976); 37 C.F.R. §2.61(b). If the applicant does not comply with a requirement for information, registration may be refused.

If the applicant does not comply with the examining attorney's request for information, the requirement should be repeated and, if appropriate, made final. See *In re SPX Corp.*, 63 USPQ2d 1592 (TTAB 2002) (registration properly refused where applicant ignores request for information); *In re Page*, 51 USPQ2d 1660 (TTAB 1999) (intent-to-use applicant's failure to comply with requirement for information as to the intended use of the mark constitutes grounds for refusal); *In re Babies Beat Inc.*, 13 USPQ2d 1729, 1731 (TTAB 1990) (registration properly refused where applicant failed to comply with examining attorney's request for copies of patent applications and other patent information).

The examining attorney may request literature, exhibits, and general information concerning circumstances surrounding the mark and, if applicable, its use or intended use. Requests for information that is not public knowledge, but is peculiarly within the knowledge of the applicant or available to the applicant, are particularly appropriate. The examining attorney should explain why the information is needed, if the reason is not obvious.

If the requested information is confidential, or if for a valid reason the applicant does not want to have the information become part of a public record, the applicant should explain those circumstances. Placing confidential information in a file is not required. Sometimes an explanation will suffice, or material may be shown to the examining attorney without formal filing. Usually a way can be found to give the necessary information to the examining attorney without imposing an undue burden on the applicant.

815 Supplemental Register, Application Filed on

Sections 23 through 28 of the Trademark Act, 15 U.S.C. §§1091 through 1096, provide for registration on the Supplemental Register. Certain marks that are not eligible for registration on the Principal Register, but are capable of distinguishing an applicant's goods or services, may be registered on the Supplemental Register. Marks registered on the Supplemental Register are excluded from receiving the advantages of certain sections of the Act of 1946. The excluded sections are listed in 15 U.S.C. §1094.

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

See TMEP §§816 *et seq.* regarding amendments to the Supplemental Register.

815.01 Marks Eligible for Principal Register Not Registrable on Supplemental Register

A mark that is clearly eligible for the Principal Register may not be registered on the Supplemental Register. An application requesting registration on the Supplemental Register must be amended to the Principal Register, or refused registration if the mark is registrable

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on the Principal Register. *Daggett & Ramsdell, Inc. v. I. Posner, Inc.*, 115 USPQ 96 (Comm'r Pats. 1957).

815.02 Elements Required

An application requesting registration on the Supplemental Register should state that the applicant requests registration on the Supplemental Register. If no register is specified, the Office will assume that the applicant is requesting registration on the Principal Register.

In an application under §1(a) or §1(b), the mark must be in lawful use in commerce on or in connection with the goods and services before the mark can register. 15 U.S.C. §1091(a). Under 37 C.F.R. §2.47(c), an intent-to-use applicant may not seek registration on the Supplemental Register until the applicant has timely filed either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d) that meets minimum filing requirements. (See 37 C.F.R. §2.76(e) and TMEP §1104.01 regarding the minimum filing requirements for an amendment to allege use, and 37 C.F.R. §2.88(e) and TMEP §1109.01 regarding the minimum filing requirements for a statement of use.) 37 C.F.R. §§2.47(c) and 2.75(b). When the applicant amends to the Supplemental Register after filing an acceptable amendment to allege use or statement of use, the effective filing date of the application is the date on which the applicant filed the amendment to allege use or statement of use. See TMEP §§816.02 and 1102.03.

If an applicant submits a §1(b) application requesting registration on the Supplemental Register for which no allegation of use has been filed, the examining attorney must refuse registration under §23 of the Act on the ground that the mark is not in lawful use in commerce. The examining attorney will withdraw the refusal if the applicant submits an acceptable allegation of use. As noted above, the effective filing date of the application will be the date on which the applicant filed the allegation of use. 37 C.F.R. §2.47(c).

If the application is based solely on §44, the applicant may seek registration on the Supplemental Register without alleging lawful use in commerce and without alleging use anywhere in the world. 15 U.S.C. §1126(e); 37 C.F.R. §2.47(b); TMEP §1009. However, the §44 applicant must verify that the applicant has a bona fide intention to use the mark in commerce. 15 U.S.C. §§1126(d) and (e); 37 C.F.R. §§2.34(a)(3)(i) and 2.34(a)(4)(ii).

815.03 Examining Attorney Signs File for Issue

Upon approval of the mark for registration, the examining attorney will sign the face of the file in the space marked "Approved for Supplemental Registration" rather than the space for approval for publication. Marks on the Supplemental Register are not published for opposition, but are issued as registered marks on the date that they are printed in the *Official Gazette*.

Applications on the Supplemental Register are not subject to opposition under 15 U.S.C. §1063, but are subject to cancellation under 15 U.S.C. §1064. 15 U.S.C. §1092.

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815.04 Filing on Supplemental Register is Not an Admission That the Mark Has Not Acquired Distinctiveness

Under 15 U.S.C. §1095, registration of a mark on the Supplemental Register does not constitute an admission that the mark has not acquired distinctiveness.

815.05 Basis for Refusal of Registration of Matter That is Incapable

When the examining attorney refuses registration on the Supplemental Register on the ground that the proposed mark is incapable of distinguishing the applicant's goods or services, the examining attorney should cite §§23(c) and 45 of the Trademark Act, 15 U.S.C. §§1091(c) and 1127, as a basis for refusal. *See In re Controls Corp. of America*, 46 USPQ2d 1308, 1309 n. 2 (TTAB 1998).

816 Supplemental Register, Amending Application to

816.01 How to Amend

If an application meets the requirements noted in TMEP §815.02, the application may be amended by requesting that the words "Principal Register" be changed to "Supplemental Register."

816.02 Effective Filing Date

Intent-to-Use Applications

As noted in TMEP §815.02, an intent-to-use applicant may file an amendment to the Supplemental Register only after the applicant has begun using the mark and filed an amendment to allege use under §1(c) or statement of use under §1(d) that meets minimum filing requirements. In such a case, the effective filing date of the application is the date on which the applicant met the minimum filing requirements for the amendment to allege use or statement of use. 37 C.F.R. §2.75(b); TMEP §1102.03. *See* 37 C.F.R. §2.76(e) and TMEP §1104.01 regarding the minimum filing requirements for an amendment to allege use, and 37 C.F.R. §2.88(e) and TMEP §1109.01 regarding the minimum filing requirements for a statement of use. The examining attorney should examine the amendment to allege use or statement of use before taking any action on the amendment to the Supplemental Register.

Applications Filed Before November 16, 1989

Prior to November 16, 1989, one year's lawful use of the mark in commerce was required to apply for registration on the Supplemental Register. Effective November 16, 1989, an applicant may apply for registration on the Supplemental Register at any time after commencing use of the mark in commerce.

An applicant may amend a pending application to request registration on the Supplemental Register at any time after use of the mark has commenced, even if the original application for

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the Principal Register was filed before November 16, 1989. However, if the application was filed before November 16, 1989, the date of the amendment to the Supplemental Register becomes the effective filing date of the application if: (1) the applicant had not used the mark in commerce for one year before the application filing date; and (2) the applicant amends to the Supplemental Register on or after November 16, 1989.

See TMEP §§206 *et seq.* regarding effective filing date.

816.03 Amendment to Different Register

There is no restriction on the number of times an applicant may amend from one register to another. Normally, however, one amendment is sufficient, and subsequent amendments should be avoided except for unusual circumstances.

816.04 Amendment After Refusal [R-1]

The applicant may amend to the Supplemental Register after a refusal to register on the Principal Register, including a final refusal. If the final refusal was under §2(e)(1), §2(e)(2) or §2(e)(4) of the Trademark Act, or on grounds pertaining to other non-inherently distinctive subject matter, amendment to the Supplemental Register is procedurally an acceptable response. *See* 37 C.F.R. §2.75.

The applicant may argue the merits of the examining attorney's refusal of registration on the Principal Register and, in the alternative, request registration on the Supplemental Register. Similarly, the applicant may seek registration on the Principal Register under §2(f) and, in the alternative, on the Supplemental Register. *See* TMEP §1212.02(c).

An amendment to the Supplemental Register after refusal presents a new issue requiring consideration by the examining attorney, unless the amendment is irrelevant to the outstanding refusal. *See* TMEP §714.05(a)(i). If the examining attorney determines that the proposed mark is incapable of identifying and distinguishing the applicant's goods or services, the examining attorney should issue a nonfinal refusal of registration on the Supplemental Register, under §23 of the Trademark Act, 15 U.S.C. §1091. *See* TMEP §714.05(a)(i).

816.05 Amendment After Decision on Appeal

An applicant may not amend to the Supplemental Register after the Trademark Trial and Appeal Board has affirmed a refusal of registration on the Principal Register. After having elected one of the remedies available for contesting the basis for the refusal, namely, appeal rather than amendment to the Supplemental Register, and having pursued the remedy to a conclusion, the applicant may not return to its previous position and pursue another remedy for the same refusal anew. In the following cases, the Office refused to grant petitions to reopen prosecution and return jurisdiction to the examining attorney to consider an amendment to the Supplemental Register after decision on appeal: *Ex parte Simoniz Co.*,

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161 USPQ 365 (Comm'r Pats. 1969); *Ex parte Helene Curtis Industries, Inc.*, 134 USPQ 73 (Comm'r Pats. 1962); *Ex parte Sightmaster Corp.*, 95 USPQ 43 (Comm'r Pats. 1951). See also TMEP §1501.06 and cases cited therein.

The applicant may, in such a circumstance, file a new application requesting registration on the Supplemental Register.

817 Preparation of Case for Publication or Registration

When a case is ready to be approved for publication or registration, the examining attorney should carefully review the application file to ensure the accuracy of the information contained therein and to clearly indicate printing instructions (where necessary). The examining attorney should bracket the material to be printed and write the term "PRINT" in the margins alongside the relevant statement. The type of information that should be marked for printing includes:

- (1) Disclaimer statements (TMEP §§1213 *et seq.*);
- (2) Notations of acquired distinctiveness, *i.e.*, "2(f)" or "2(f) in part as to . . .," as appropriate (TMEP §§1212 *et seq.*);
- (3) Lining and/or stippling statements (TMEP §§807.09(b) through (e));
- (4) Consent to register a name or portrait and statements that a name or portrait does not identify a living individual (TMEP §813);
- (5) Translations of non-English wording and transliterations of non-Latin characters in the mark (TMEP §809.02);
- (6) Ownership of related United States registrations (TMEP §812);
- (7) Description of mark statements (TMEP §808); and
- (8) Use in another form (TMEP §903.08).

Similarly, examining attorneys should mark "DO NOT PRINT" in the margins next to any of the above-listed items that should not be printed in the *Official Gazette* and on the registration certificate (*e.g.*, claims of ownership of unrelated U.S. registrations, statements such as disclaimers that have been amended and are no longer valid, or unnecessary §2(f) statements).

In addition, the examining attorney should check to ensure the accuracy of the following critical data elements:

- (1) The mark;
- (2) The register for which application is made;

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- (3) The identification of goods and/or services;
- (4) International classification;
- (5) Filing date;
- (6) Dates of use for each class, if applicable;
- (7) Foreign application and registration data, if applicable;
- (8) Whether §1(b) of the Act is a basis for registration;
- (9) In a multi-basis application, which goods are covered by which basis; and
- (10) In concurrent use cases, information as to the proposed geographic limitation.

If any of the above items are not accurately entered into the automated database, the examining attorney should instruct the legal instruments examiner in the law office to make the necessary corrections.

818 Application Checklist [R-2]

This section may be used to determine whether materials submitted as a trademark application are complete and to ensure that appropriate requirements and refusals are made. *See* 37 C.F.R. §2.21 and TMEP §202 regarding the elements that must be received before the Office will grant a filing date to an application.

An application for trademark registration must include the following:

- (1) a clear drawing of the mark (37 C.F.R. §§2.21(a)(3) and 2.51; TMEP §§202.01 and 807 *et seq.*);
- (2) a verified statement signed by a person properly authorized to sign on behalf of the applicant (15 U.S.C. §§1051(a)(3) and (b)(3); 37 C.F.R. §2.33; TMEP §§804 *et seq.*);
- (3) a written application that includes the following:
 - (a) the date on which the application was signed;
 - (b) the applicant's name, and DBA designation if appropriate (37 C.F.R. §2.32(a)(2); TMEP §§803.02 *et seq.*);
 - (c) the applicant's legal entity (TMEP §§803.03 *et seq.*);
 - (d) the country of which the applicant is a citizen, or the state or country of incorporation or organization of a juristic applicant (15 U.S.C. §§1051(a)(2) and (b)(2); 37 C.F.R. §§2.32(a)(3)(i) and (ii); TMEP §803.04);

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- (e) if the applicant is a partnership, the names of the applicant's general partners and their citizenship (or state or country of incorporation or organization) (37 C.F.R. §2.32(a)(3)(iii); TMEP §803.04);
- (f) the applicant's domicile and post office address (15 U.S.C. §§1051(a)(2) and (b)(2); 37 C.F.R. §2.32(a)(4); TMEP §803.05);
- (g) a statement that the applicant has adopted and is using the mark in a §1(a) application, or has a bona fide intent to use the mark in commerce in an application under §1(b) or §44 (15 U.S.C. §§1051(a)(3)(C), 1051(b)(3)(B), 1126(d)(2) and 1126(e); 37 C.F.R. §§2.33(b)(1) and (2));
- (h) an identification of the goods/services (15 U.S.C. §§1051(a)(2) and (b)(2); 37 C.F.R. §2.32(a)(6); TMEP §§1402 *et seq.*);
- (i) the class(es) of the goods/services, if known to the applicant (37 C.F.R. §2.32(a)(7); TMEP §§1401 *et seq.*);
- (j) the dates when the mark was first used and first used in commerce with the goods/services in each class, in an application under §1(a) (15 U.S.C. §1051(a)(2); 37 C.F.R. §2.34(a)(1)(ii) and (iii); TMEP §§903 *et seq.*);
- (k) a statement that the mark is being used by a related company or companies, in a §1(a) application where use of the mark is only by one or more related companies and inures to the applicant's benefit (37 C.F.R. §2.38; TMEP §901.05);
- (l) if the applicant claims priority under §44(d), a claim of the benefit of the applicant's first-filed foreign application in a treaty country within the preceding six months, specifying the filing date, country and serial number of such application (15 U.S.C. §1126(d); 37 C.F.R. §2.34(a)(4); TMEP §§1003 *et seq.*);
- (m) a basis for filing (37 C.F.R. §§2.32(a)(5) and 2.34; TMEP §§806 *et seq.*);
- (n) an averment by the person making the verification that he or she believes the applicant to be the owner of the mark sought to be registered in an application under §1(a), or to be entitled to use the mark in commerce in a §1(b) or §44 application (15 U.S.C. §1051(a)(3)(A) and 1051(b)(3)(A); 37 C.F.R. §§2.33(b)(1) and (2); TMEP §804.02);
- (o) an averment that the mark is in use in commerce in a §1(a) application (37 C.F.R. §§2.33(b)(1) and 2.34(a)(1)(i); TMEP §901);
- (p) an averment that, to the best of the verifier's knowledge and belief, no other person, firm, corporation, or association has the right to use such mark in commerce either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods of the other person, to

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cause confusion, or to cause mistake, or to deceive (15 U.S.C. §§1051(a)(3)(D) and (b)(3)(D); 37 C.F.R. §§2.33(b)(1) and (2); TMEP §804.02);

- (q) a description of the mark, if appropriate (37 C.F.R. §2.37 and 2.52(a)(2)(vi); TMEP §§808 *et seq.*);
 - (r) if the mark has color, a description of the color (37 C.F.R. §2.52(a)(2)(v); TMEP §807.09(c));
 - (s) a translation of non-English wording and transliteration of non-Latin characters in the mark, if any (TMEP §§809 *et seq.*);
 - (t) a statement that identifies any living individual whose name or likeness the mark comprises and indicates that his or her consent is of record, or a statement that the name or portrait does not identify a living individual, if appropriate (15 U.S.C. §1052(c); TMEP §813); and
 - (u) a claim of the applicant's ownership of prior registrations of the same or similar marks, if any (37 C.F.R. §2.36; TMEP §812);
- (3) a designation of a domestic representative is encouraged, if the applicant is not domiciled in the United States (15 U.S.C. §1051(e); 37 C.F.R. §2.24; TMEP §604);
 - (4) a filing fee for each class of goods and/or services (15 U.S.C. §§1051(a)(1) and 1051(b)(1); 37 C.F.R. §2.6(a)(1); TMEP §§810 *et seq.*);
 - (5) a true copy, a photocopy, a certification, or a certified copy of the registration in the applicant's country of origin, and a translation of the foreign registration if it is not in English, in a §44(e) application (15 U.S.C. §1126(e); 37 C.F.R. §2.34(a)(3)(ii); TMEP §§1004.01 *et seq.*); and
 - (6) one specimen for each class, in a §1(a) application (15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), and 2.86(a)(3); TMEP §§904 *et seq.*).

See 15 U.S.C. §§1051(a)(3)(D) and 1052(d), 37 C.F.R. §2.99, and TMEP §§1207.04 *et seq.* regarding requirements for applications for concurrent use registration.

See 37 C.F.R. §2.44 and TMEP §§1303 *et seq.* regarding the requirements for collective trademark and collective service mark applications; 37 C.F.R. §2.44 and TMEP §§1304 *et seq.* regarding collective membership mark applications, and 37 C.F.R. §2.45 and TMEP §§1306 *et seq.* regarding certification mark applications.

The following are substantive grounds for refusal. Registration may be refused on the ground that:

- (1) the applicant is not the owner of the mark (see 15 U.S.C. §1051; TMEP §1201);

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- (2) the subject matter for which registration is sought does not function as a mark (see 15 U.S.C. §§1051, 1052, 1053 and 1127) because, for example, the proposed mark:
 - (a) is used solely as a trade name (see TMEP §1202.01);
 - (b) is functional, *i.e.*, consists of a utilitarian design feature of the goods or their packaging (15 U.S.C. §1052(e)(5); TMEP §1202.02(a) *et seq.*);
 - (c) is a nondistinctive configuration of the goods or their packaging (TMEP §§1202.02(b) *et seq.*);
 - (d) is mere ornamentation (see TMEP §§1202.03 *et seq.*);
 - (e) is the generic name for the goods or services (TMEP §§1209.01(c) *et seq.*);
- (3) the proposed mark comprises immoral or scandalous matter (15 U.S.C. §1052(a); TMEP §1203.01);
- (4) the proposed mark is deceptive (15 U.S.C. §1052(a); TMEP §§1203.02 *et seq.*);
- (5) the proposed mark comprises matter that may disparage or falsely suggest a connection with persons, institutions, beliefs, or national symbols, or bring them into contempt or disrepute (15 U.S.C. §1052(a); TMEP §§1203.03 *et seq.*);
- (6) the proposed mark comprises the flag, coat of arms or other insignia of the United States or any State, municipality, or foreign nation (15 U.S.C. §1052(b); TMEP §1204);
- (7) the applicant's use of the mark is or would be unlawful because it is prohibited by statute (TMEP §§1205 *et seq.*);
- (8) the proposed mark comprises a name, portrait or signature identifying a particular living individual without the individual's written consent, or the name, portrait or signature of a deceased president of the United States during his widow's life, without written consent of the widow (15 U.S.C. §1052(c); TMEP §§1206 *et seq.*);
- (9) the proposed mark so resembles a previously registered mark as to be likely, when used with the applicant's goods and/or services, to cause confusion or mistake, or to deceive (15 U.S.C. §1052(d); TMEP §§1207 *et seq.*);
- (10) the proposed mark is merely descriptive or deceptively misdescriptive of the applicant's goods and/or services (15 U.S.C. §1052(e)(1); TMEP §§1209 *et seq.*);
- (11) the proposed mark is primarily geographically descriptive of the applicant's goods and/or services (15 U.S.C. §1052(e)(2); TMEP §1210.01(a));
- (12) the proposed mark is primarily geographically deceptively misdescriptive of the applicant's goods and/or services (15 U.S.C. §1052(e)(3); TMEP §1210.01(b)); or

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- (13) the proposed mark is primarily merely a surname (15 U.S.C. §1052(e)(4); TMEP §§1211 *et seq.*).

An applicant may submit a claim and proof of distinctiveness of the mark or a portion of the mark, under §2(f). *See* 15 U.S.C. §§1052(f); TMEP §1212 *et seq.*

A mark that is capable of distinguishing the applicant's goods or services may be registrable on the Supplemental Register. *See* 15 U.S.C. §§1091 through 1096; TMEP §§815 *et seq.*

The examining attorney will require a disclaimer of an unregistrable component of an otherwise registrable mark. *See* 15 U.S.C. §1056; TMEP §§1213 *et seq.*