

Changes: Index to Changes in TMEP Seventh Edition

Attention is directed to the following changes in the 7th edition of the TMEP.

SECTION	CHANGE
204.02	Updated to include procedure for submitting Request to Restore Filing Date electronically.
401.02	Changed section title. Clarified elements of serial number and requirement to include entire number on communications. Updated to include new series code.
404	Added cross reference.
501.06	Revised to update procedure for applications in which a partial assignment and a request to divide are filed.
611.02(a)	Added example and cross reference.
702.02	Updated to include procedure for submitting Request to Make Special electronically.
703	Clarified that applications amended to §1 can result in a duplicate.
707	Added examples.
708.01	Further clarified what is discussed in and when it is appropriate to issue a priority action.
708.02	Added examples.
708.04	Added examples.
708.05	Added examples.
713.03	Updated to include procedure for requesting that database be updated to show cancellation/expiration of cited registration.
714.05(e)	Revised to clarify procedures followed when the mark on a substitute specimen does not agree with the mark on the drawing.
714.05(f)	Revised to clarify procedures followed when the mark on a substitute specimen does not agree with the mark on the drawing.
715.03(a)	Revised to clarify proper procedures and resolve an inconsistency with §718.03.
715.03(b)	Revised to clarify procedure when a request for reconsideration presents a new issue, and the applicant is instructed not to file an appeal regarding the final refusal.
715.04	Updated to include information regarding Board jurisdiction; corrected cross reference.
715.04(a)	Clarified procedure.
715.04(b)	Clarified procedure when request for reconsideration presents a new issue and proper procedure after remand.
716.02(a)	Revised to clarify procedure followed after termination of a cancellation proceeding that is the basis for suspension. Added discussion of procedure for handling amendments

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	or consent agreements filed in application that has been suspended pending disposition of an applicant's petition to cancel a registration that has been cited under §2(d). Clarified procedure followed when a conflicting application registers during the response period to an Office action and a petition to cancel has been filed.
716.02(c)	Added procedure for handling amendments or consent agreements filed in application that has been suspended pending disposition of an applicant's opposition to an earlier-filed application that has been cited as a potential bar to registration.
716.02(d)	Revised to include procedure for third parties requesting suspension of pending applications. Added cross-references.
716.02(e)	Updated to include procedure for requesting that database be updated to show cancellation/expiration of cited registration.
718.02(a)	Clarified that partial abandonment advisory is not appropriate when multiple-class advisory was given in Office action.
718.03	Clarified when a response to a final action is an incomplete response and moved content regarding incomplete responses to finals to §715.03(a).
718.03(a)	Added cross reference.
803.03(b)	Updated suggested format for identifying a partnership.
803.03(h)	Added "low-profit-limited-liability company" as acceptable entity designation.
803.03(i)	Clarified procedure regarding foreign entity designations.
806.03(c)	Clarified requirement for verified statement and procedure for amending from §1(a) to §1(b) after publication.
806.04(a)	Clarified procedures for deleting §1(b) basis.
807.03(a)	Clarified difference between paper and electronic applications.
807.08	Added cross reference.
807.09	Revised to clarify drawing requirements to enable validation of electronic applications for non-visual marks. Added additional acceptable file formats for TEAS filings.
807.10	Added cross references.
807.12(d)	Added case cites. Added cross reference.
807.14	Added cross references.
807.14(a)	Clarified that deletion of functional matter from drawing is generally not a material alteration.
807.17	Clarified proper procedure.
808.02	Revised to clarify that descriptions of the mark must not include registered marks.

SECTION	CHANGE
813.01(a)	Language change. Cross-reference added. Clarified procedure for ensuring that consent is printed.
813.01(c)	Revised to clarify procedure for entering statement of consent to registration.
819.01(o)	Added example.
904.02(a)	Revised to clarify that electronic submission is preferred.
904.03(d)	Added additional acceptable file formats.
904.03(f)	Added additional acceptable file formats for TEAS filings.
904.03(g)	Added case cite.
904.03(i)	Completed cites to <i>Sones</i> case.
904.03(k)	Added examples of alternative specimens.
904.07(a)	Revised to clarify procedures followed when the mark on a substitute specimen does not agree with the mark on the drawing.
904.07(b)	Added case cite. Revised to clarify procedures followed when the mark on a substitute specimen does not agree with the mark on the drawing.
1004.01(a)	Added requirement for translation of documents evidencing renewal of foreign reg.
1004.01(b)	Changed section title. Added requirement for translation of documents evidencing renewal of foreign reg.
1004.02	Revised to state that amendment to rely on a different foreign registration is not a change in basis, but that such an amendment requires republication.
1103	Added cite to Rule 2.76(a).
1109.02	Clarified when applicant may file "insurance" extension request.
1109.09(b)	Clarified that submission of a specimen is a minimum filing requirement.
1109.11	Clarified that signed verification/declaration is a minimum filing requirement.
1109.15	Clarified that filing fee is a minimum filing requirement.
1109.16(b)	Clarified that section refers to statutory requirements.
1109.16(c)	Clarified that section refers to statutory requirements.
1109.16(d)	Added missing cross reference. Clarified that section refers to statutory requirements.
1110.04	Revised to update procedure for applications in which a request to divide is filed.
1110.07	Clarified when extension request is processed before request to divide.
1201.07(b)(ii)	Changed section title. Added provision whereby applicant may establish unity of control by virtue of joint ownership.
1201.07(b)(iii)	Added reference to joint ownership.
1202.02 –	Updated to clarify procedures for examining trade-dress

SECTION	CHANGE
1202.02(e)	applications.
1202.02(b)(i)	Completed cite to <i>Spector case</i> .
1202.04	Added case cite.
1202.08(b)	Revised to clarify when a mark does not identify a single creative work.
1202.15	Added additional acceptable file formats for TEAS filings.
1203.03(d)	Added case cite.
1203.02(e)(i)	Updated to add provision for disclaimer requirement, if appropriate.
1203.02(e)(ii)	Updated to add provision for disclaimer requirement, if appropriate.
1203.03(c)	Added case law clarifying that when an application is refused as disparaging to the beliefs of a religious group, the referenced group is those persons who adhere to the religious beliefs.
1203.03(d)	Added case cite.
1205.01	Clarified bases for refusal of marks that include designations notified pursuant to Article 6 ^{ter} of the Paris Convention.
1205.02	Clarified nature of designations notified pursuant to Article 6 ^{ter} of the Paris Convention and bases for refusal of marks that include such designations.
1206.03	Added example of situation where it is unnecessary to inquire or require consent to registration of name of a living individual. Added discussion of marks that include the name or likeness of a famous deceased person or historical character.
1206.04(b)	Clarified when consent may be presumed.
1207.01(a)	Added caselaw regarding relatedness of the goods/services.
1207.01(a)(iv)	Added case cite.
1207.01(a)(v)	Updated to clarify the limited application of the expansion-of-trade doctrine in ex parte examination.
1207.01(a)(vi)	Incorporated new caselaw.
1207.01(b)(iii)	Added case cites.
1207.01(c)(ii)	Added case cite.
1207.01(d)(viii)	Clarified signature requirements for consent agreements.
1208.02(c)	Added cross-reference.
1209.01(a)	Added case cites for suggestive and incongruous marks. Clarified that incongruity is an indication that a mark is suggestive.
1209.01(c)(i)	Incorporated new caselaw.
1209.01(c)(iii)	Added case cites. Completed cite to <i>Spector case</i> .
1209.02(a)	Clarified procedural steps for disclaimer of incapable

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	matter when applicant amends to the Supplemental Register or claims acquired distinctiveness.
1209.03	Changed section title.
1209.03(g)	Clarified case parentheticals. Added case cites from prior 1209.03(h) and additional case cite.
1209.03(h)	Changed section title and added new section content regarding acronyms.
1209.03(m)	Incorporated new caselaw.
1209.03(r)	Added case cite.
1209.03(t)	Changed section title. Incorporated new caselaw.
1210.04	Added cross-reference.
1210.07(a)	Updated to clarify that primarily geographically descriptive marks can be incapable.
1211.01(a)(iv)	Added case cite.
1211.01(b)(iii)	Added new caselaw regarding marks that consist of initials preceding a surname.
1211.01(b)(v)	Added case cite.
1212.01	Updated to clarify the effect of use of the same wording by third parties in applicant's field or closely related fields.
1212.02(f)(i)-(f)(ii)(B)	Incorporated content from Exam Guide 2-10.
1212.02(f)(i)	Changed section title. Incorporated content from prior 1212.02.
1212.02(f)(ii)	Changed section title. Incorporated content from prior 1212.02(f)(i).
1212.02(f)(ii)(A)	New section - Appropriate Situations for Claiming Section 2(f) in Part.
1212.02(f)(ii)(B)	New section - Inappropriate Situations for Claiming Section 2(f) in Part. Incorporates content from prior 1212.02(f)(i).
1212.02(i)	Completed cite to <i>Spector</i> case.
1212.02(j)	New section number –prior 1212.02(f)(ii).
1212.04(b)	Added case cites.
1212.04(c)	Clarified procedure for accepting 2(f) claim.
1212.08	Incorporated content from Exam Guide 2-10.
1212.09(a)	Added case cites.
1212.09(b)	Incorporated content from Exam Guide 2-10.
1212.10	Changed section title. Incorporated content from Exam Guide 2-10.
1213.01(c)	Language change.
1213.05(g)	New section – Marks with Design Elements Replacing Letters. Incorporated content from Exam Guide 1-10.
1213.05(g)(i)	New section - Marks with a Distinctive Design Replacing a Letter in Descriptive or Generic Wording. Incorporated

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	content from Exam Guide 1-10.
1213.05(g)(ii)	New section - Marks with Merely Descriptive or Primarily Geographically Descriptive Designs Replacing Letters within Descriptive or Primarily Geographically Descriptive Wording. Incorporated content from Exam Guide 1-10.
1213.05(g)(iii)	New section - Marks with Accurate Pictorial Representations Replacing Letters in Merely Descriptive and Primarily Geographically Descriptive Marks. Incorporated content from Exam Guide 1-10.
1213.05(g)(iv)	New section - Unitary Marks with Design Elements Replacing Letters in Descriptive or Generic Wording. Incorporated content from Exam Guide 1-10.
1215.04	Added case cite.
1215.05	Incorporated new caselaw.
1216.02	Incorporated new caselaw.
1301.01(b)(ii)	Revised to clarify requirements for identifying “warranty services.”
1401.12	Revised to clarify the impact of the “Effective Date” in the ID Manual and procedures for Office actions issued before and after changes to entries.
1402.01	Revised to further clarify indefinite terminology.
1402.01(a)	Revised to indicate that examining attorney must require correction of spelling errors in an identification of goods/services and that British variants are acceptable. Added guidance regarding the use of commas and semicolons in identifications.
1402.03	Revised to further clarify guideline (1).
1402.05	Revised to clarify procedure for identifying goods or services that are a specialized type or are used only in a specialized trade channel.
1402.05(a)	Language changes.
1402.07(e)	Changed section title. Language change.
1402.08	Language change.
1402.11(a)	Revised to clarify the options for amending the indefinite identification “technical support services.”
1402.13	Clarified procedure when multiple-class advisory is given for consistency with §718.02(a).
1403.05	Clarified procedure when multiple-class advisory is given for consistency with §718.02(a).
1504.02	Added provision that Board has no jurisdiction over a pending application that has been suspended pending disposition of an applicant’s petition to cancel a cited registration an applicant’s opposition to an earlier-filed application that has been cited as a potential bar to registration.

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1505.03(a)	Added example.
1505.03(b)	Added example.
1604	Changed section title.
1604.01	Updated cross reference.
1604.04	Added rule text for 37 CFR §2.160(a).
1604.05	Added rule text for 37 CFR §2.161.
1604.07(a)	Updated rule cites.
1604.12(b)	Revised to clarify that electronic submission is preferred.
1604.16	Changed rule cites for petition.
1604.17	Added rule text for 37 CFR §2.164.
1605	Changed section title.
1605.05	Added cross reference.
1606	Changed section title.
1606.12	Changed rule cites for petition.
1608	Added reference to §71 affidavit.
1613	Deleted requirements for §71 affidavits. Content moved to new section 1613.04.
1613.01	New section - Registrations to Which §71 Affidavit Pertains.
1613.02	New section - Notice of When Affidavit Is Due.
1613.03	New section - Form for Filing §71 Affidavit.
1613.04	New section - Time for Filing §71 Affidavit.
1613.05	New section - Requirements for §71 Affidavit or Declaration of Use or Excusable Nonuse.
1613.06	New section heading - Fees for §71 Affidavit.
1613.06(a)	New section - Filing Fee for Affidavit or Declaration.
1613.06(b)	New section - Grace Period Surcharge and Deficiency Surcharge.
1613.06(c)	New section - Processing Affidavit or Declaration Filed With Insufficient Fees.
1613.07	New section heading - Ownership and Who May File §71 Affidavit.
1613.07(a)	New section - Affidavit or Declaration Must Be Filed by Holder.
1613.07(b)	New section - Establishing Ownership.
1613.07(c)	New section - Changes of Legal Entity.
1613.07(d)	New section - Changes of Name.
1613.07(e)	New section - Correction of Mistake in Setting Forth the Name of the Holder.
1613.08	New section heading - Execution of Affidavit or Declaration.
1613.08(a)	New section - Persons Who May Sign Affidavit or Declaration.
1613.08(b)	New section - Date of Execution of Affidavit or

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	Declaration.
1613.08(c)	New section - Signature of Electronically Transmitted Affidavit or Declaration.
1613.08(d)	New section - Form and Wording of Verification.
1613.09	New section heading - Goods and/or Services Set Forth in §71 Affidavit or Declaration.
1613.09(a)	New section - Goods and/or Services Must Be Specified or Expressly Incorporated by Reference.
1613.09(b)	New section - Deletion of Goods and/or Services.
1613.09(c)	New section - Failure to List All Goods and/or Services Recited in Registration.
1613.09(d)	New section - New Goods and/or Services Cannot Be Added.
1613.10	New section - Use in Commerce.
1613.11	New section - “Excusable Nonuse” of Mark.
1613.12	New section heading - Specimen Showing Current Use of Mark in Commerce.
1613.12(a)	New section - Specimen for Each Class Required.
1613.12(b)	New section - Specimens in Electronically Filed Affidavits.
1613.12(c)	New section - Substitute Specimens.
1613.13	New section - Differences in the Mark as Used on the Specimen and the Mark as Registered.
1613.13(a)	New section - Possible Amendment of Mark in Registration.
1613.14	New section - Designation of Domestic Representative by Foreign Holder.
1613.15	New section - Office Actions and Notices Regarding Affidavit.
1613.16	New section - Response to Office Action.
1613.17	New section - Correction of Deficiencies in §71 Affidavit.
1613.17(a)	New section - Correcting Deficiencies in Affidavits or Declarations Timely Filed Within the Periods Set Forth in §71(a) of the Act.
1613.17(b)	New section - Correcting Deficiencies in Affidavits or Declarations Filed During the Grace Period.
1613.17(c)	New section - Defects That Cannot Be Cured After Expiration of the Grace Period.
1613.18	New section - Petition Under 37 C.F.R. §2.146.
1613.18(a)	New section - Response to Examiner’s Refusal Required Before Petition.
1613.18(b)	New section - Decision on Petition Is Final Action of the USPTO.
1613.18(c)	New section - Request for Reconsideration of Denial of Petition.

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1613.18(d)	New section - Appeal to Federal Court.
1705.04	Added petition to revive for partial abandonment to list of deadlines.
1710	Updated procedures for filing a petition to make special.
1710.03	Deleted section. Moved content to §1710.
1711	Updated procedures for filing requests to restore a filing date.
1712.01	Updated procedures for filing requests for reinstatement. Added examples regarding abandonment after partial refusal or requirement.
1712.02(b)	Added language regarding non-issuance of cancellation notice.
1713.01	Added cross reference to §718.02(a).
1714.01(d)	Added requirements for petition to revive after partial abandonment.
1714.01(f)(ii)	Changed rule cite for petitions.
1715.01	Clarified that evidence must be included with letter of protest.
1715.01(a)	Clarified that court proceeding is not considered relevant unless the remedy requested is cancellation, abandonment, or amendment of the relevant application.
1715.01(b)	Added example of inappropriate issue.
1715.04	Clarified that evidence must be included with letter of protest.
1715.04(a)	Added option for filing letters of protest electronically.
1904.01(e)	Clarified procedure regarding claimed priority dates.
1904.02(c)(i)	Added example.
1904.03(f)	Clarified procedure for handling corrections.
1904.03(g)	Clarified procedures for handling limitations as to pending requests for extension of protection.
1904.14	Clarified procedures for handling corrections.
1904.15	Clarified procedures for handling limitations as to registered requests for extension of protection.
Appendix B	Changed hyperlink.
Appendix D	Revised to clarify nature of the German entity GmbH & Co. KG.
Appendix E	Corrected typographical error in page numbering.
Contents	Revised to reflect changes to titles of sections and addition of new sections.
Index	Corrected typographical errors. Added entries regarding amending of dates of use after registration. Added missing section links.