

CHANGES: INDEX TO CHANGES IN TMEP EIGHTH EDITION

Attention is directed to the following changes in the 8th edition of the TMEP.

SECTION	CHANGE
104	Deleted statement that X-Search is available for public use in some PTDLs. Updated to clarify that the Public Search Facility does not contain copies of insignia of Native American tribes and that X-Search or TESS can be used to search for them. Updated information regarding resources for obtaining trademark searches.
109.02	Updated information regarding requesting access to paper files. Deleted statements regarding unsent letters or drafts.
304.01	Updated examples of acceptable e-mail communications. Language changes.
304.02	Updated examples of communications that are not acceptable by e-mail. Added procedure for e-mail communications requesting an advisory opinion. Added cross references.
305.02(f)	Clarified when the time period for notifying the Office of correspondence filed with a certificate of mailing, but not received by the Office, begins to run.
305.03	Deleted requirement to submit a request to change the filing date for "Lost Documents."
401.01	Changed "preliminary" amendment to "voluntary" amendment to correspond with the title of the TEAS form.
405.04	Revised examples of "change of purpose." Updated instructions for submitting refund requests.
602.03(a)	Added procedure regarding individuals suspected of engaging in unauthorized practice.
609.01	Clarified procedure for sending correspondence when documents submitted by a qualified practitioner do not include a separate address for the practitioner.
611.01(b)	Updated to clarify that signatory's name must be printed or typed below or adjacent to the signature.
611.01(c)	Added section (d) of Rule 2.193. Updated to clarify that signatory using an electronic signature must set forth his or her name below the signature on documents submitted in connection with applications, registrations, or TTAB proceedings.
611.04	Clarified that "other documents" refers to documents that must be signed by the applicant or registrant, or by someone with legal authority to bind the applicant or registrant.
705.06	Added requirement for examining attorney's e-mail address.
706.01	Added example to clarify circumstance in which jurisdiction

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	would be restored to issue a new refusal.
707.01	Added cross references. Language change.
709.04	Clarified procedures regarding telephone and e-mail communications.
709.05	Updated examples of communications that are acceptable by e-mail. Added procedures for informal communications requesting an advisory opinion and continuing or prolonged communications. Clarified procedures for making informal communications of record. Added example regarding applicant's duty to monitor the status of its application.
710.01(b)	Added requirement to attach Internet evidence to Office actions.
712.02	Added information for examining attorneys regarding issuing a notice of incomplete response.
714.05(a)(i)	Added procedures for examining attorneys when applicant responds to refusal in §1(b) application by filing an allegation of use and an amendment to the Supplemental Register or to §2(f).
715.01	Added information regarding applicant's request to suspend application after final action when the applicant has filed an "insurance" extension request in conjunction with a statement of use.
715.03	Added cross references.
715.03(a)	Updated to clarify procedures for handling request for reconsideration when there is no new issue and no appeal has been filed and procedures for handling responses signed by unauthorized persons, unsigned responses, TEAS responses consisting only of a signature, and TEAS responses missing significant data or attachments.
716.02(b)	Language changes.
716.02(e)	Changed section title.
716.02(f)	New section: Pending Expiration of "Insurance" Extension Request
716.02(g)	New section: Pending Correction of or Limitation to an International Registration
716.06	Added reference to circumstance in which applicant may request suspension after filing insurance extension request.
718.03	Clarified procedures for handling properly signed but incomplete responses to nonfinal actions and TEAS responses consisting only of a signature or missing significant data or attachments.
718.03(a)	Clarified procedures regarding holding application abandoned when applicant submits incomplete response to

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	nonfinal or final action.
718.03(b)	Clarified procedures for granting additional time to perfect a response.
803.03(a)	Added cross reference to codes in International Registration application form. Added information regarding California sole proprietorship.
803.03(i)	Updated to indicate that “limited company” is acceptable for China and that the foreign designations, abbreviations, descriptions, and equivalent U.S. entities listed in Appendix D are acceptable as the entity designation of a foreign applicant.
803.04	Added cross reference to codes in International Registration application form.
804.02	Language change.
804.04	Clarified that the name of the person who signs a document submitted in connection with an application must be set forth in printed or typed form immediately below or adjacent to the signature or identified elsewhere.
804.05	Corrected cite to 15 U.S.C. §1141.
806.03(j)	Added rationale for requiring republication.
807.03(f)	Clarified the characteristics of the marks in foreign registrations that comply with the standards for treatment as a standard character mark.
807.07(a)(i)	Updated requirements for requiring clarification of color claim.
807.07(a)(ii)	Updated requirements for requiring amended mark description.
807.09	Updated requirements regarding drawings for non-visual marks.
807.12(d)	Rearranged listing of cases. Added new case cite.
809	Clarified that requirement for translation also applies to compound word marks comprised of two or more distinct words (or words and syllables) represented as one word, in which one or more of the words in the mark appears to be non-English wording that would clearly be perceived as a distinct word(s) within the compound. Language change for consistency with examples.
812	Updated to indicate procedure when applicant lists numerous prior registrations in application.
812.01	Updated to require that Office action include copies of prior registrations for which applicant is asked to claim ownership.
813.01(a)	Added examples.
815.04	Corrected to delete improper statutory cite.

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816.02	Updated to clarify procedure for handling amendment to allege use and amendment to Supplemental Register submitted in response to a refusal.
816.04	Added cross reference.
819.02(b)	Clarified circumstances in which ITU will require payment of the additional fee.
901.02	Added case cite.
904.01(a)	Added requirement regarding evidence for a full line of pharmaceuticals.
904.02(a)	Added cross references. Deleted statement regarding file size.
904.03(e)	Changed section title. Added information regarding beta version of software submitted as specimen.
904.03(f)	Updated information regarding submitting audio and video files as specimens.
904.03(g)	Corrected page number in case cite.
904.03(i)	Added case cite. Language changes. Added information regarding beta version of website submitted as specimen.
904.03(l)	Updated information regarding submitting audio and video files as specimens.
907	Added reference to Controlled Substances Act and case cites.
1001	Added cross reference.
1002.04	Clarified that applicant must provide a written statement that it has a bona fide and effective industrial or commercial establishment to establish country of origin and clarified procedure for obtaining statement.
1003	Added statement that priority date cannot be later than U.S. filing date.
1003.02	Added requirement that priority date be earlier than U.S. filing date. Modified dates in example.
1003.03	Added cross reference. Added statement regarding claiming more than one filing basis. Deleted paragraph regarding presumption that §44(e) is being asserted as a basis.
1003.04(a)	Updated procedures for suspending applications based solely on §44.
1003.04(b)	Updated procedures for suspending applications based on §§1 and 44.
1008	Language change.
1102.03	Added cross reference to section regarding examination of allegation of use submitted with an amendment to the Supplemental Register and deleted statement that allegation of use must be examined prior to action on amendment to

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	the Supplemental Register.
1104.09(h)	Clarified procedure for examining AAU when application is suspended.
1108	Added statutory cite.
1108.03	Clarified that “insurance” extension request must cover all of the classes stated in the notice of allowance or applicant must delete classes or submit a request to divide.
1109.16(d)	Clarified procedure for requesting suspension when “insurance” extension request expires after the response period for a final action.
1109.17	Added statutory cite.
Chapter 1200	All cited cases reviewed as to relation to section topic and accuracy of parentheticals and quoted material and updated as appropriate. Added new case cites for decisions issued since publication of the 7 th edition. Updated cross references to TMEP sections and added cross references, as appropriate. Rewording for clarity throughout.
1202.03(c)	Updated to indicate that applicant may show secondary source by ownership of a U.S. registration on the Principal Register of the same mark for other goods or services based on a foreign registration under §44(e) for which a §8 affidavit has been accepted.
1202.05(e)	Changed section title.
1202.05(h)	Changed section title.
1202.05(i)	Changed section title.
1202.13	Deleted information regarding requirement for description of the mark.
1202.15	Deleted information regarding requirement for description of the mark, reproductions of sound marks, specimens, and checklist for sound-mark applications, which is discussed in §§807.09 and 904.03(f).
1202.16-1202.16(c)(v)(B)	Incorporated Exam Guide 2-11 (Examination Procedures for Marks with Model and Grade Designations).
1202.16(a)	New section - Examination of Marks with Model and Grade Designations
1202.16(b)	New section - Identifying Model and Grade Designations in Marks
1202.16(b)(i)	New section - Model Designations
1202.16(b)(i)(A)	New section - Stylization of Display
1202.16(b)(i)(B)	New section - Size of Proposed Mark
1202.16(b)(i)(C)	New section - Physical Location
1202.16(b)(ii)	New section - Grade Designations
1202.16(c)	New section - Procedures for Handling Marks with Model and

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	Grade Designations
1202.16(c)(i)	New section - Evidentiary Considerations when Issuing Model or Grade Designation Refusals
1202.16(c)(i)(A)	New section - Model Designations
1202.16(c)(i)(B)	New section - Grade Designations
1202.16(c)(ii)	New section - Entire Mark Consists of Model or Grade Designation in Section 1(a) Applications
1202.16(c)(iii)	New section - Composite Mark with Model or Grade Designation in Section 1(a) Applications
1202.16(c)(iii)(A)	New section - Model or Grade Designations with Arbitrary and/or Suggestive Matter
1202.16(c)(iii)(B)	New section - Model or Grade Designations with Descriptive, Generic, and/or Informational Matter
1202.16(c)(iv)	New section - Drawing and Specimen Agreement Issues in Section 1(a) Applications
1202.16(c)(v)	New section - Model or Grade Designation in Section 1(b), 44, or 66(a) Applications
1202.16(c)(v)(A)	New section - Model Designations
1202.16(c)(v)(B)	New section - Grade Designations
1203.02(f)(i)	Clarified that the wording "made in significant part of" indicates that the goods contain a sufficient amount of the named ingredient/material composition to meet the standard for use of the term in the relevant industry.
1204.05	Changed external link for Seal of the President of the United States.
1205.01	Deleted portion of example 4 and case cites – moved to new sections 1205.01(b) – (b)(vii).
1205.01(b)	New section - Examination Procedures for Marks Comprising Matter Related to the United States Olympic Committee or the Olympics
1205.01(b)(i)	New section - Nature of the Mark
1205.01(b)(ii)	New section - Issuing Other Substantive Refusals
1205.01(b)(iii)	New section - Amendments to Disclaim, Delete, or Amend the Unregistrable Wording or Symbol
1205.01(b)(iv)	New section - Consent to Register
1205.01(b)(v)	New section - First Use On or After September 21, 1950
1205.01(b)(vi)	New section - First Use Before September 21, 1950 – Grandfather Clause
1205.01(b)(vii)	New section - Geographic-Reference Exception
1206.01	Revised to clarify that the standard for determining whether the individual bearing the name in the mark will be associated with the mark as used on the goods/services is that: (1) the person is so well known that the public would

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	reasonably assume a connection between the person and the goods or services; or (2) the individual is publicly connected with the business in which the mark is used (i.e., if the record shows that the individual is associated in some manner with the applicant, is actually connected to the goods or services at issue, and/or is well known in the relevant field of goods/services).
1206.03	Clarified that if there is sufficient evidence that the name, portrait, or signature identifies a particular living individual, or that the individual is generally known or publicly connected with the business in which the mark is used, the examining attorney may exercise discretion regarding whether to issue a §2(c) refusal instead of an inquiry. Clarified that if the mark comprises the name of a famous deceased person or historical character that is distinctive and well known, the examining attorney may consult with his or her manager regarding foregoing an inquiry.
1207.01(d)(viii)	Clarified that (1) a consent agreement must be signed by both parties if it makes representations about both parties' beliefs regarding likelihood of confusion and/or indicates that both parties have agreed to undertake certain actions to avoid confusion and (2) if signed only by the registrant (because only the registrant has provided its consent, agreed to take certain actions, or made representations as to the likelihood of confusion), it is not unacceptable, but its persuasive value should be determined in light of all other evidence in the record.
1207.01(d)(ix)	Changed section title. Revised to shorten section because the fame of a cited mark is usually treated as neutral in ex parte proceedings.
1207.01(d)(xi)	Revised to shorten section because a family-of-marks argument is not available to an applicant in an ex parte proceeding.
1207.01(d)(xii)	New section - Pharmaceuticals or Medicinal Products
1207.04	Incorporated information from §1207.04(c) regarding bases on which a concurrent use registration may be issued.
1207.04(b)	Changed section title.
1207.04(c)	Deleted section. Incorporated information into §1207.04.
1207.04(d)	Renumbered as §1207.04(c). Changed section title. Revised to indicate that concurrent registration may be sought pursuant to a decision by the Board in a prior concurrent use proceeding.
1207.04(d)(i)	Renumbered as §1207.04(d). Revised to indicate that concurrent registration may be sought pursuant to a decision

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	by the Board in a prior concurrent use proceeding.
1207.04(e)	Clarified that if an application that seeks registration, or is amended to seek registration through a concurrent use proceeding, complies with the relevant requirements and appears to be otherwise entitled to registration but for the question of concurrent rights, the examining attorney must not issue a §2(d) refusal as to any registration named by the applicant as an exception to its exclusive rights and must withdraw any previously issued refusal or advisory as to any registration or application named by the applicant as an exception to its exclusive rights.
1207.04(e)(i)	Deleted outdated information regarding concurrent use summary page.
1207.04(g)	New section - Application for Concurrent Use Registration Based on Final Board Decision in Prior Concurrent Use Proceeding
1207.04(g)(i)	New section - Preparing the Record for Publication
1208.03	Incorporated information from §1208.03(b). Deleted information regarding standards for declaring interference; moved example regarding extraordinary circumstance to §1208.03(b).
1208.03(b)	Deleted information that was moved to §1208.03. Incorporated example regarding extraordinary circumstance from §1208.03.
1209.02	Added example of circumstance when additional information should be required.
1209.03(o)	Clarified that a map of the world or a depiction of a globe is generally not considered the pictorial equivalent of the terms "INTERNATIONAL," "GLOBAL," or "WORLDWIDE."
1210.05(d)(i)	Clarified that if the examining attorney determines that the misdescription would be material to the decision to purchase, and the application claims use in commerce prior to December 8, 1993, a refusal under §2(a) must be issued.
1212.01	Updated to indicate that the examining attorney's review of the record in applicant's prior registration may assist in resolving whether the mark in question has acquired distinctiveness, and thereby obviate the necessity of determining the issue on appeal.
1212.02(b)	Clarified that the examining attorney may rely on applicant's claim of distinctiveness under §2(f), whether made in the application as filed or in a subsequent amendment, to establish that the subject matter is not distinctive.
1212.02(c)	Updated to indicate that the examining attorney's review of the record in applicant's prior registration may reveal whether

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	the applicant previously conceded descriptiveness or whether the Board found the mark descriptive on appeal.
1212.02(f)(ii)(A)	Changed example for geographically descriptive matter combined with an inherently distinctive element.
1212.02(i)	Deleted paragraph referring to failure to function as a mark as inappropriate in context of section.
1212.02(j)	Corrected example of statement regarding §2(f) in part (not as to the entire mark), restricted to a portion of the goods/services. Clarified that separate limitation statement is required for claims of §2(f) in part.
1212.06(e)(i)	Clarified evidence of intentional copying of a product design is not probative of acquired distinctiveness.
1213.03(c)	Clarified that a map of the world or a depiction of a globe is generally not considered the pictorial equivalent of the terms "INTERNATIONAL," "GLOBAL," or "WORLDWIDE."
1213.08(c)	Updated procedures regarding unnecessary voluntary disclaimers.
1301.03(a)	Language changes. Added information regarding beta version of specimens for services.
1304.02	Added case cite.
1304.04	Clarified that the applicant for a membership mark may be a person as well as an organization. Added statutory and case cites.
1306.02	Clarified that, in some circumstances, the goods may originate in a broader region that includes the region identified by the geographical term in the mark.
1306.02(a)	Updated to indicate when the defined region in the certification statement may be broader than the place named in the mark.
1306.06(f)(ii)	Updated to indicate that standards must cover the full scope of the goods/services identified in the application.
1401.06(a)	Deleted reference to plastic in pellet form.
1401.09	Corrected cross reference.
1402.01(c)	Changed section title. Clarified examination procedures for amendments to identifications in §66(a) applications.
1402.01(e)	Language changes.
1402.03(a)	Added examples.
1402.03(c)	Added requirement regarding evidence for a full line of pharmaceuticals. Language changes. Added example of evidence sufficient to establish use on a full line of a genre of products.
1402.03(e)	Language change. Added examples.
1402.04	Language changes.

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1402.07(a)	Languages changes. Updated to clarify that applicant may not amend to add items in other classes when the original identification is a class heading.
1402.08	Clarified circumstances in which applicant may request that goods/services be moved between companion applications.
1402.09	Changed section title. Clarified that no registered mark may appear in an identification and that applicants should not include their own registered or unregistered mark in an identification.
1402.11	Deleted examples.
1402.11(a)	Deleted "Note" regarding the wording "providing a website in the field of."
1402.11(e)	Deleted example.
1505.01(a)	Updated to include procedure for filing amendment electronically.
1505.03(a)	Added examples.
1505.03(b)	Added examples.
1601.01(b)	Language change. Corrected fax information.
1604.07(a)	Clarified that owner may submit correction in response to an Office action.
1604.08(b)	Clarified that the relevant filing period includes the available grace period.
1604.09(b)	Clarified that goods/services/classes deleted from registration may not be reinserted.
1604.17(a)	Clarified that deficiencies may be corrected after notification from the Office.
1604.07(b)	Clarified that deficiencies may be corrected after notification from the Office.
1605	Clarified that owner is given six months to respond to an Office action regarding any inconsistency or error in a §15 affidavit.
1605.03	Clarified procedure when a §15 affidavit is filed alone during the period for filing a §8 affidavit.
1609.02	Updated to include procedure for request to add a standard character claim to a registered extension of protection.
1609.02(c)	Deleted duplicative information regarding specimen requirement.
1609.07	Language changes.
1609.10(b)	Added requirement that request be signed and may be supported by a declaration.
1613.07(a)	Clarified that a correction of the holder name may be submitted after notification from the Office.
1613.08(b)	Clarified that the relevant filing period includes the available

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	grace period.
1613.09(b)	Clarified that goods/services/classes deleted from registration may not be reinserted.
1613.13	Clarified that standard for determining materiality is the same as that for a registration based on §1 or §44.
1613.13(a)	Changed section title. Clarified that mark in a registered extension of protection cannot be amended under §7(e), but holder may, in some situations, request to add a standard character claim.
1613.17(a)	Clarified that deficiencies may be submitted after notification from the Office.
1613.17(b)	Clarified that deficiencies may be submitted after notification from the Office.
1713.02	Changed section title. Clarified procedure when applicant does not receive or fails to respond to an action granting additional time to complete a response.
1714.01(b)(i)	Updated information regarding processing when statement of use is filed with petition to revive via TEAS.
1714.01(c)	Updated information regarding processing of petition to revive for failure to respond to a notice of allowance when the notice of allowance was not received.
1714.01(e)	Clarified that applicant should state that non-receipt of Office action or notice of allowance caused the unintentional delay in responding.
1715.01(a)	Added new example.
1715.01(b)	Added new example.
1715.03(a)	Deleted first sentence.
1715.04	Clarified the type of evidence that should be submitted with a letter of protest. Added requirement for a separate index for submissions of evidence that exceed 75 pages. Language change to indicate that a separate letter of protest must be sent for each application being protested.
1715.04(a)	Added requirement that a separate letter of protest be sent for each application being protested.
1715.05	Added fax number for requesting copy of letter of protest.
1903.02	Updated hyperlink to WIPO website.
1904.02(c)	Added information regarding IB's terms for identifying unclear language in the identification of goods/services in an international registration and the effect on examination of a request for extension of protection.
1904.02(c)(iv)	Added cross reference.
Appendix A	Added requirements for request for remand to submit additional evidence. Deleted appeal brief introductory

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	caption. Added line for e-mail address in signature section.
Appendix B	Paris Convention table: added Aruba, Curaçao, and Sint Maarten and corrected entries for Belgium, Luxembourg, and Netherlands. World Trade Organization table: corrected entry for Hong Kong.
Appendix D	Language changes to opening paragraph.
Appendix E	Clarified the characteristics of the marks in foreign registrations that comply with the standards for treatment as a standard character mark.