

CHANGES: INDEX TO CHANGES IN TMEP FOURTH EDITION

Attention is directed to the following changes in the 4th edition of the TMEP, dated April, 2005.

SECTION	CHANGE
103	Updated list of documents that can be filed through TEAS, ESTTA and ETAS.
104	Assignment database can be searched online.
106	USPTO distributes <i>Trademark Official Gazette</i> only in electronic format.
108.02	Deleted.
108.03	Renumbered 108.02.
108.04	Renumbered 108.03. Due diligence standard changed from one year to six months.
109.01	Old §109.01 (access by public to pending unpublished application files) merged with §109.02 (access to files of pending but published application files, registrations, abandoned applications and terminated <i>inter partes</i> proceeding files). New §109.01 covers electronic image files (new section).
109.02	Title changed; merged with old §109.01. New locations for requests by public for access to paper files.
109.03	Public can view and print images of copies of trademark files from USPTO website.
201	Sets forth what constitutes filing date of §66(a) applications.
202	Rule 2.21 applies only to §1 and §44 applications. Compliance with minimum filing requirements for §66(a) applications is determined by International Bureau of World Intellectual Property Organization ("IB").
202.01	Drawing in §66(a) application must meet requirements of Madrid Protocol and Madrid Common Regulations. IB will determine compliance before sending application to USPTO.
202.02	This section (listing of recognizable goods or services) applies only to §1 and §44 applications.
202.03	Amount of application filing fee varies depending on whether application is filed through TEAS or on paper. Filing fee for §66(a) application is sent to USPTO by IB; Examining attorney should not require additional fees during examination.
203	IB determines compliance with minimum filing requirements in §66(a) applications.
204-204.03	These sections (procedures for processing informal applications) apply only to §1 and §44 applications.
205	This section (application normally void if it is discovered during examination that applicant did not meet minimum filing

INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
206	requirements) applies only to §1 and §44 applications. When the effective filing date of an application changes, Office does not alter the original filing date in its automated records.
206.02	Section 66(a) application may include priority claim.
Chapter 300	Extracts of rules updated.
301	Updated list of documents that can be filed through TEAS, ESTTA and ETAS.
304.01	E-mail attachments must be in .jpg format.
304.02	Responses to examining attorneys' Office actions cannot be filed by e-mail.
304.06	Deleted.
304.07	Renumbered 304.06. If outgoing electronic mail is returned as undeliverable, USPTO will mail paper copy to the correspondence address of record.
304.08	Renumbered 304.07. Scanned image of signed document must be in .jpg format.
304.09	Renumbered 304.08.
304.10	Renumbered 304.09.
305.01	New addresses for trademark correspondence.
305.02(a)	Titled changed. Updated list of documents for which certificate of mailing cannot be used.
305.04	New section - interruptions in U.S. Postal Service.
306.01	Titled changed. Updated list of documents that cannot be filed by fax.
307	New location for hand delivery of trademark documents.
Chapter 400	Extracts of rules updated.
401	This section (processing new applications) applies only to §1 and 44 applications.
401.01	Renumbered 401.02.
401.02	Renumbered 401.03.
401.03	Renumbered 401.04. Title changed. Office does not create paper files for TEAS applications.
401.03(a)- 401.04	Deleted.
402	Old §402 (filing receipts) renumbered 401.01; added discussion of §66(a) applications. New §402 covers electronic application and registration files (new section).
402.01	New section - USPTO no longer creates paper copies of certain trademark-related documents.
403	If outgoing electronic mail is returned as undeliverable, USPTO will mail paper copy to correspondence address of record. Papers and envelopes returned by USPS are scanned into TICRS.
404	Once any document has been filed with respect to an application or registration, it becomes part of the public record

INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
	and will not be returned.
405.01(a)	Renumbered 405.06. Revised to include all types of payments refused by financial institutions.
405.02(a)	Discussion of checks returned unpaid moved to §405.06.
Chapter 500	Extracts of rules updated.
501.01(b)	New section - assignability of extension of protection of international registrations.
501.07	New section - assignment of extension of protection of international registration.
502	Some text moved to 502.01. Added discussion of §66(a) applications.
502.01	Old §502.01 (issuance of certificate in name of new owner) renumbered 502.02(a); title changed; rewritten. Applies only to §1 and §44 applications. New §502.01 (establishing right to take action in application or registration) includes some material previously in 502, plus discussion of §66(a) applications.
502.01(a)	Renumbered 502.02(c).
502.02	Renumbered 502.03. Added discussion of §66(a) applications.
502.02(b)	New section - issuance of certificate to assignee of §66(a) application.
502.03	Added discussion of §66(a) applications.
503.03(a)	Requests to record documents in USPTO should be filed electronically to expedite recordation. Requests to record changes of ownership of requests for extension of protection of international registrations to the United States must be filed with IB.
503.03(b)	Documents filed for recordation electronically should be in TIFF format. If filing a request for recordation on paper, original documents should not be submitted.
503.03(e)	Cover sheets and requests to record documents should be filed electronically to expedite recordation.
503.05	New owner of §66(a) application or registered extension of protection must record assignment with IB.
503.06, 503.06(b)	Requests to correct errors in documents recorded with IB must be corrected at IB.
503.08	Public can search assignment records on USPTO website.
504 <i>et seq.</i>	New section - automatic updating of ownership in trademark database.
Chapter 600	Extracts of rules updated.
602.01	Powers of attorney can be filed through TEAS.
602.01(a)	Owner may appoint an attorney through TEAS for up to 20 applications or registrations that have the identical owner and

INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
	attorney.
602.01(c)	Powers of attorney can be filed through TEAS.
602.03	Response signed by unauthorized party should be treated as incomplete response.
602.04	Revocation of power of attorney can be filed through TEAS.
602.04(a)	Renumbered 602.05. Request to withdraw as attorney in pending application can be filed through TEAS. Office will not process request for permission to withdraw in abandoned application.
603.01(a)	New section - correspondence in §66(a) applications.
604	Designations of domestic representative can be filed through TEAS.
Chapter 700	Extracts of rules updated.
703	Application under §66(a) not regarded as duplicate of application under §1 or §44. Mark in which the drawing is lined for color is considered duplicate of color drawing, if the colors are identical.
705.07	Title changed.
706	New refusal cannot be made in §66(a) application more than 18 months after the date on which the IB sends the request for extension of protection to the USPTO.
707	Examiner's amendment may not be issued on first action in §66(a) application.
707.02	Examining attorney may issue examiner's amendment to enter a standard character claim without prior approval of applicant or applicant's attorney, when the record clearly indicates that the drawing is intended to be in standard characters.
711.02	In §66(a) application, new refusal cannot be issued more than 18 months after the date on which the IB sends the request for extension of protection to the USPTO.
712.01	If response to Office action is signed by an unauthorized person, the examining attorney should treat the response as incomplete, and require a properly signed response.
712.03	New section - response signed by unauthorized party will be treated as incomplete response; response cannot be ratified by examiner's amendment.
714.05(a)	Amendment to drawing that materially alters mark raises new issue, if examining attorney had required new drawing because original drawing was of poor quality, but had not previously raised issue of material alteration.
714.05(a)(i)	In §66(a) application, amendment to Supplemental Register does not raise a new issue.
714.05(b)	In §66(a) application, refusal under §2(d) may be issued more than 18 months after the date on which the IB sends the request for extension of protection to the USPTO, provided

INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
	that USPTO had notified IB of conflicting application prior to expiration of the 18-month period.
716.02	Examining attorney should not suspend action on application pending a decision on petition (previously stated in 1705.06).
716.02(b)	If applicant claims §44(d) in addition to another basis, there are no other outstanding issues, and examining attorney is unable to reach applicant by phone, examining attorney should issue Office action requiring a copy of foreign registration, advising applicant that it may retain the priority filing date even if it does not perfect the §44(e) basis, and inquiring as to whether applicant wants to retain §44(e) as a second basis.
716.02(c)	Where examining attorney is not persuaded by applicant's arguments that there is no conflict with an earlier-filed pending application, examining attorney should issue a suspension notice, with a statement that applicant's arguments were not persuasive. It is not necessary to address merits of applicant's arguments prior to initial suspension.
717.01	If outgoing electronic mail is returned as undeliverable, USPTO will mail paper copy to correspondence address of record. Papers and envelopes returned by USPS are scanned into TICRS.
718.01	Letter of express abandonment can be filed through TEAS. In §66(a) application, applicant may file letter of express abandonment with either USPTO or IB. Petition to withdraw an express abandonment must be filed within two months of the effective date of abandonment.
718.02(a)	New section - partial abandonment. When an applicant fails to respond to a refusal or requirement that is expressly limited to only certain goods/services/class(es), the examining attorney should issue an examiner's amendment deleting (abandoning) the goods/services/classes to which the refusal or requirement pertained.
718.03	Inquiry, request to extend response period, or communication on a matter unrelated to the preceding Office action will be treated as a non-responsive communication, not as an incomplete response.
718.03(b)	If an applicant does not receive action granting additional time to complete a response under 37 C.F.R. §2.65(b), or if applicant is unable to respond to such an action due to some other extraordinary circumstance, applicant may file a petition to the Director under 37 C.F.R. §2.146.
719	Old §719 (fraud) renumbered 720. New §719 covers non-responsive communications (new section).
Chapter 800	Extracts of rules updated.

INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
801.02(b)	Mark in §66(a) application cannot be registered on Supplemental Register.
802	Section 66(a) applications are sent to USPTO by IB.
803.03(e)(i)	New section - business trusts.
803.03(i)	Added reference to the French entity société par actions simplifiée (SAS).
803.03(j)	New section - Federally recognized Indian tribe is acceptable designation of applicant's entity.
804	Verification in §66(a) application is part of international registration on file at IB. Examining attorney does not have to examine verification.
804.01	Title changed. Section applies only to §1 and §44 applications.
804.02	Titled changed. Section applies only to §1 and §44 applications.
804.03	Titled changed. Section applies only to §1 and §44 applications.
804.04	Added discussion of §66(a) applications.
804.05	In TEAS document, if the signatory's name is not set forth, examining attorney should require that it be stated for the record.
804.06	New section - verification of §66(a) application
806.01(e)	New section - requirements for §66(a) basis.
806.02(a)	Section 66(a) applicant cannot claim more than one basis.
806.02(f)	If applicant claims §44(d) in addition to another basis, there are no other outstanding issues, and examining attorney is unable to reach applicant by phone, examining attorney should issue Office action requiring a copy of the foreign registration, advising applicant that it may retain the priority filing date even if it does not perfect §44(e) basis, and inquiring as to whether applicant wishes to retain §44(e) as a second basis.
806.02(g)	New section - not necessary to repeat allegation of bona fide intention to use mark in commerce in multi-basis application (previously stated in 806.02(e)).
806.03(g)	Old §806.03(g) (effect of substitution of basis on application filing date) renumbered 806.03(h). New §806.03(g) covers amendment of basis from §1(b) to §44 (new section).
806.03(h)	Renumbered 806.03(i).
806.03(j)	New section - petitions to amend basis after publication. Director will not grant petition to amend the basis after publication if the amendment could substantially delay prosecution of the application.
806.03(j)(i)	New section - amending the basis of a §1(b) application after publication but before issuance of notice of allowance.

INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
806.03(j)(ii)	New section - amending the basis of a §1(b) application between issuance of notice of allowance and filing of statement of use. Director will not grant a petition to add §44 and retain the §1(b) basis unless a statement of use is filed with the petition.
806.03(k)	New section - basis cannot be changed in §66(a) application.
806.04(a)	Request to delete §1(b) basis from multi-basis application should be filed through TEAS, to expedite processing.
807.01-	Deleted.
807.01(d)	Deleted.
807.02	Deleted.
807.03	Old §807.03 (drawing must show only one mark) renumbered 807.01. New §§807.03 <i>et seq.</i> covers standard character drawings (new sections; replace sections on “typed” drawings).
807.03(f)	New section - standard character drawing and foreign registration. If foreign registration certificate does not indicate that the mark is in standard characters (or the equivalent), examining attorney must inquire whether the foreign registration includes a claim that the mark is in standard characters.
807.04	Renumbered 807.02.
807.05	Old §807.05 (drawing no longer considered separate element) deleted; substance moved to 807.01 and 807.06(c). New §§807.05 <i>et seq.</i> cover TEAS drawings (new sections).
807.06 <i>et seq.</i>	Old §807.06 <i>et seq.</i> (typed drawings) renumbered 807.03 <i>et seq.</i> ; title changed (standard character drawings); reorganized & rewritten to incorporate rules change. New §§807.06 <i>et seq.</i> covers paper drawings (new sections).
807.07 <i>et seq.</i>	Old §807.07 <i>et seq.</i> (special form drawings) renumbered 807.04 <i>et seq.</i> ; rewritten. New §§807.07 <i>et seq.</i> cover revised rules for color drawings.
807.08	Renumbered 807.12(e).
807.09 <i>et seq.</i>	(Color drawings) Renumbered 807.07 <i>et seq.</i> , reorganized & rewritten to incorporate rules change.
807.09(e)	(Markings that do not indicate color) Renumbered 808.01(d); rewritten.
807.10	Renumbered 807.08.
807.11	Renumbered 807.09.
807.12	Renumbered 807.10.
807.12(c)	New section - mark in §66(a) application must be substantially exact representation of mark in international registration.
807.13	Old §807.13 (marks with motion) renumbered 807.11. New §§807.13 <i>et seq.</i> cover amendment of mark.
807.13(b)	Mark in §66(a) application cannot be amended.

INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
807.14	(Mark on drawing must agree with mark on specimen or foreign registration) Renumbered and broken into subsections 807.12 through 807.12(b).
807.14(a)	(Material alteration) Renumbered 807.14 <i>et seq.</i> ; rewritten.
807.14(a)(i)	Renumbered 807.14(c).
807.14(b)	Renumbered 807.12(d).
807.15	Renumbered 807.14(a).
807.16	Renumbered 807.15.
807.17	Renumbered 807.16.
807.18	Old §807.18 renumbered 807.17. New §807.18 covers mark drawing codes (new section).
808.01(c)	Statement that a term has no meaning should not be entered as a description of the mark.
808.01(d)	New section - lining and stippling statements.
808.03	If description of mark should not be printed, examining attorney should delete it from TRAM and enter note to file.
809.02	If translation or transliteration should not be printed, examining attorney should delete it from TRAM and enter note to file.
810	Amount of the trademark application filing fee varies depending whether the application is filed through TEAS or on paper. Filing fee for §66(a) application is sent to USPTO by IB; examining attorney should not require additional fees during examination.
810.01	Filing fee for §66(a) application will be sent to USPTO by IB. Examining attorney should not require additional fees during examination. Classes cannot be added or changed.
812	If claim of ownership of prior registration should not be printed, examining attorney should delete it from TRAM and enter note to the file.
813	If mark is comprised, in whole or in part, of the name or likeness of an individual, consent to register is implicit if the individual whose name or likeness appears in the mark signs the application, personally or through an authorized signatory. If statement as to whether mark comprises name, portrait or signature of a living individual should not be printed, examining attorney should delete it from TRAM and enter note to the file.
814	Statement that information about the goods/services is available on applicant's website is inappropriate response to examining attorney's requirement for information about goods/services.
815	Mark in §66(a) application cannot be registered on Supplemental Register.
816.01 & 816.04	Mark in §66(a) application cannot be amended to

INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
817	Supplemental Register. When preparing application for publication or registration, examining attorney should ensure that information to be printed has been properly entered, and that information that should not be printed is deleted from TRAM.
901	Use not required in §66(a) applications.
903.07	When applicant sets forth indefinite dates of use, only the information provided by applicant is printed in <i>Official Gazette</i> and on certificate of registration.
903.07(a)	Rewritten to clarify.
904.02	(Physical form of specimens) Broken into subsections (a) (electronic specimens) and (b) (paper specimens) (new sections).
904.02(a)	Old §904.02(a) (color specimens) renumbered 904.02(c). New §904.02(a) covers electronic specimens. TEAS specimen must be in .jpg format. In application for registration of sound mark that comprises music or words set to music, applicant may submit the musical score for the record, in .wav format, as an attachment to e-mail message, after filing the application.
904.02(b)	Old §904.02(b) (marks used on publications) renumbered 904.02(d). New 904.02(b) covers paper specimens.
904.04(d)	Specimen showing use of proposed mark on a website for downloadable software is acceptable only if it provides sufficient information to enable user to download software from website.
904.06(a)	An advertisement that includes a phone number, Internet address and/or mailing address is not an acceptable catalog specimen under <i>Lands' End Inc. v. Manbeck</i> , if there is no offer to accept orders or instructions on how to place an order on the specimen.
904.06(b)	New section - electronic displays as specimens for trademarks.
904.09	When submitting an additional specimen in support of a multiple class application that is not identical to the specimen originally filed, applicant must include affidavit or declaration under 37 C.F.R. §2.20 verifying that specimen is in use in commerce.
Chapter 1000	Title changed (applications under §44).
1003.03	Section 44(d) applicant cannot assert a §66(a) basis.
1003.04	If an applicant claims §44(d) in addition to another basis, there are no other outstanding issues, and examining attorney is unable to reach applicant by phone, examining attorney should issue Office action requiring copy of foreign registration, advising applicant that it may retain the priority

INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
	filing date even if it does not perfect a §44(e) basis, and inquiring as to whether applicant wishes to retain §44(e) as a second basis.
1004	Applicant may not file application under §44(e) before registration in applicant's country of origin has issued.
1004.01	In §44(e) application, examining attorney will not suspend application pending submission of a copy of foreign registration unless applicant establishes that it cannot obtain a copy of the foreign registration due to extraordinary circumstances.
1004.01(a)	Caselaw updated.
1005	If application is properly filed based on §1(a) or §1(b), and applicant later amends the application to add or substitute §44 as a basis, applicant must be the owner of the foreign application or registration as of the filing date of the amendment adding or substituting §44 as a basis for registration. If the applicant owned the foreign application or registration on the filing date of the amendment, but not on the U.S. application filing date, applicant will retain the original filing date, as long as there was a continuing valid basis since the U.S. application filing date.
1007	Caselaw updated.
1011.01	If foreign registration certificate does not indicate that mark is in standard characters, examining attorney must inquire whether the foreign registration includes a claim that mark is in standard characters.
1016	New section - international registration as basis for §44 application
1104.01	Amendment to allege use ("AAU") that omits allegation of use in commerce, but asserts verified date of first use in commerce, may be accepted as substantially in compliance with the minimum filing requirement of 37 C.F.R. §2.76(e)(3) for a verified statement that the mark is in use in commerce.
1104.04	If application is under extension of time to oppose when a timely AAU is associated with an application, the potential opposer must continue to file further request(s) for extension(s) of time to oppose, or file a notice of opposition. Board will not suspend the potential opposer's time to file a notice of opposition.
1104.09(c)	If applicant files AAU through TEAS, and fails to identify and pay the fee for an entire class(es), then examining attorney should consider the goods/services in the omitted class(es) to have been expressly deleted, and should not issue any inquiry with respect to those goods/services. If the applicant lists all the goods/services identified in the application in the section of

INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
1104.09(e)	<p>a pre-printed AAU form designated for the identification of goods that are not in use, then the applicant has not expressed a clear intention to delete these goods/services, and examining attorney must inquire as to the discrepancy. TEAS specimen must be in .jpg format.</p> <p>If applicant submits additional specimen in support of a multiple class application that is not identical to specimen originally filed, applicant must verify that applicant used new specimen in commerce on or in connection with goods/services prior to filing the AAU.</p>
1108.02(d)	<p>In extension request, if applicant lists goods/services to be deleted and the result would be to delete all the goods/services in the notice of allowance, the Office will presume this was a typographical error and will allow the applicant to correct the mistake. However, if applicant mistakenly lists goods/services to be deleted and this would not result in the deletion of all the goods/services, the goods/services specifically listed will be deleted and may not later be reinserted.</p>
1109.09(b) 1109.13	<p>TEAS specimen must be in .jpg format.</p> <p>If applicant files SOU through TEAS, and fails to identify and pay the fee for an entire class(es), then examining attorney should consider the goods/services in the omitted class(es) to have been expressly deleted, and should not issue any inquiry with respect to those goods/services.</p>
1110.02	<p>Since request to divide cannot be filed through TEAS, applicant who seeks to divide out some, but not all, of the goods or services in a class must pay the paper application filing fee for each new separate application created by the division.</p>
1110.08	<p>Old §1110.08 (division of registration) renumbered 1110.09; rewritten; substance moved to §1615. New §1110.08 covers division of pending §66(a) application after change of ownership with respect to some but not all the goods/services (new section).</p>
1201	<p>§66(a) application must be filed by the holder of the international registration.</p>
1201.02(c)	<p>If applicant has been identified as “ABC Corporation, formerly known as XYZ, Inc.,” and the true owner is “XYZ, Inc.,” applicant’s name may be amended to “XYZ, Inc.,” as long as “ABC Corporation, formerly known as XYZ, Inc.” was not a different <i>existing</i> legal entity.</p>
1202.02(b)(ii) 1202.02(d)	<p>Caselaw updated.</p> <p>Examining attorney should ensure that description of mark has been entered into TRAM.</p>

INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
1202.02(f)	New section - trade dress in §44 and §66(a) applications
1202.05(i)	New section - applications for color marks based on §44 or §66(a).
1202.12	Registration should be refused if an applicant seeks to register a varietal or cultivar name as a mark for fresh fruits or vegetables.
1202.15	When filing a musical score in sound mark application through TEAS, applicant must send .wav file after application is filed, as attachment to an e-mail message.
1203.01	Dictionary definitions alone may be sufficient to establish that a proposed mark comprises scandalous matter, where multiple dictionaries, including at least one standard dictionary, uniformly indicate that a word is vulgar, and the applicant's use of the word is limited to the vulgar meaning of the word.
1203.02(a)	Discussion of distinction between deceptive matter and primarily geographically deceptively misdescriptive matter moved to 1210.05(a).
1203.03(f)	Caselaw updated.
1205.02	When USPTO receives requests for protection under Article 6 ^{ter} of Paris Convention, USPTO searches its records for conflicting marks, but the requests are not subject to a full examination.
1207.01(a)(i)	Caselaw updated.
1207.01(a)(ii)(A)	New section - food and beverage products versus restaurant services
1207.01(b)	Caselaw updated.
1207.01(b)(i)	Caselaw updated.
1207.01(b)(iii)	Caselaw updated.
1207.01(b)(vi)	Doctrine of foreign equivalents is not an absolute rule, but merely a guideline that should be applied only when it is likely that the ordinary American purchaser would stop and translate a foreign word into its English equivalent.
1207.01(d)(iii)	Caselaw updated.
1207.01(d)(ix)	New caselaw incorporated.
1207.04(b)	Applicant may seek concurrent use registration in application under §44 or §66(a).
1207.04(e)(i)	Deleted reference to paper copies of application.
1209.01(b)	Caselaw updated.
1209.01(c)(i)	Caselaw updated.
1209.03(d)	Caselaw updated.
1209.03(i)	Caselaw updated.
1209.03(m)	Caselaw updated.
1210.01(b)	New test for determining whether a mark is primarily geographically deceptively misdescriptive.

INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
1210.02(b)	(Primary significance) Subsections added. Some text moved to 1210.02(b)(i), 1210.02(b)(i)(A), 1210.02(b)(ii) & 1210.02(c)(i).
1210.02(c)	Renumbered 1210.02(b)(iv).
1210.02(d)	Renumbered 1210.02(b)(iii); caselaw updated.
1210.04(a)	Old §1210.04(a) (place does not have to be well known for the goods or services) deleted. New §1210.04(a) covers goods/place association.
1210.04(b)	Old §1210.04(b) (geographically descriptive marks - association presumed unless applicant raises genuine issue as to whether primary significance of term is geographic or place is obscure or remote) deleted; incorporated in 1210.04. New §1210.04(b) covers services/place association (new section).
1210.04(c)	Old §1210.04(c) (establishing goods/place or services/place association) broken & renumbered 1210.04(a) (goods) & 1210.04(b) (services).
1210.04(d)	Renumbered 1210.04(c).
1210.04(e)	Renumbered 1210.04(d).
1210.05(a)	Old §1210.05(a) (deceptive geographical marks - in general) deleted. New §1210.05(a) (basis for refusal) discusses new caselaw regarding distinction between deceptive matter and primarily geographically deceptively misdescriptive matter, and basis for refusal of deceptive geographic marks.
1210.05(b)	Old §1210.05(b) renumbered 1210.08. New §§1210.05(b) <i>et seq.</i> discuss materiality of deception.
1210.06-06(b)	Renumbered 1210.07-07(b).
1210.07	(Geographic terms combined with additional matter) Renumbered 1210.02(c); some text moved to 1210.06 (procedure for examining geographic composite marks).
1210.07(a)	Renumbered 1210.02(c)(ii); title changed.
1210.07(b)	Renumbered 1210.06(a).
1210.07(c) & (d)	Merged & renumbered 1210.06(b).
1210.07(e)	Renumbered 1210.02(c)(iii).
1210.08	(Disclaimer) Deleted; incorporated in 1210.06(a), (b), and (c).
1211.01(a)(v)	Media attention is factor to be considered in determining how rarely a surname is used.
1212.02(d)	Unnecessary §2(f) claim should be deleted from TRAM.
1212.08	This section also applies to §66(a) applications.
1212.10	Examining attorney should ensure that §2(f) claim has been entered into the TRAM database, so that it will be printed in <i>Official Gazette</i> and on certificate of registration.
1213.08(d)	Examples of disclaimers added.
1214.04	New section - if application under §44 or §66(a) indicates that the applicant is seeking registration of a “phantom mark,”

INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
	examining attorney should issue a refusal of registration on ground that application seeks registration of more than one mark.
1215.02(f)	New section - if record indicates that proposed mark would be perceived merely as an informational indication of the address used to access a web site rather than an indicator of source, examining attorney should refuse registration in a §44 or §66(a) application, on ground that subject matter does not function as a mark.
1215.04	New caselaw incorporated.
1215.05	New caselaw incorporated.
1304.09(a)	In §66(a) applications, collective membership marks are not reclassified in Class 200.
1306.03	Caselaw updated.
1306.06(e)	In §66(a) applications, certification marks are not reclassified in Classes A and B.
1401.02	If registration issued under U.S. classification system, registrant may amend to reclassify under international classification system.
1401.03(a)-(c)	Title changed. These sections apply only to §1 and §44 applications.
1401.03(d)	New section - classification is determined by IB in §66(a) applications; USPTO does not reclassify.
1401.04	Generally, examining attorney will not question sufficiency of filing fee in §66(a) application.
1401.04(b)	Generally, examining attorney will not question sufficiency of filing fee in §66(a) application. Classes cannot be added or changed.
1402.01(c)	Old §1402.01(c) (location of identification of goods and services) renumbered 1402.01(d). New §1402.01(c) covers identification of goods/services in §66(a) application (new section).
1402.01(d)	Renumbered 1402.01(e).
1402.02	This section applies only to §1 and §44 applications. Office will not deny a filing date if the applicant uses the language of an international class heading as an identification of goods/services. However, the Office strongly discourages the use of the language of the international class headings or statements that the mark is used on all goods or services in a class to identify the goods or services for which registration of the mark is sought, and will require amendment of any such identification.
1402.03(b)	Applicant who seeks to register a house mark in application under §44 or §66(a) must submit evidence that mark is in fact used as house mark.

INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
1402.03(c)	Applicant who seeks to register mark for a “full line of” a genre of products in an application under §44 or §66(a) must submit evidence that mark is in fact used for a full line of products.
1402.08	Goods and services can be moved between companion applications only in §1 or §44 applications.
1402.13	New section - requirement for amendment of portion of identification of goods/services. When applicant fails to respond to a requirement to amend some terminology in an otherwise acceptable identification of goods/services, examining attorney should issue an examiner’s amendment deleting the unacceptable terminology from the identification.
1402.14	New section - identification of goods/services must conform to rules and policies in effect at the time of examination.
1403.02	Classes cannot be added or changed in §66(a) application.
1403.02(b)	Classes cannot be added or changed in §66(a) application.
1403.02(c)	Amount of fee for adding classes to §1 or §44 application varies depending on whether the amendment adding additional classes is filed through TEAS or on paper.
1403.05	Classes cannot be added or changed in §66(a) application. If applicant fails to respond to a refusal or requirement that is expressly limited to only certain class(es), application shall be abandoned only as to those class(es).
1501	If appeal is dismissed for failure to file a brief, applicant may file a motion or request with Board to set aside the dismissal and accept a late-filed brief; applicant cannot file petition to revive.
1501.03	When a refusal or requirement is withdrawn after appeal, examining attorney does not have to notify the Board.
1503.01	Notice of opposition to §66(a) application must be filed through ESTTA.
1503.04	TTAB will not grant an extension of time to oppose aggregating more than 180 days from date of publication. Request for extension of time to oppose a §66(a) application must be filed through ESTTA. Extension request must be signed by potential opposer or potential opposer’s attorney.
1503.05	Opposition must be accompanied by required fee for each party joined as opposer for each class in application for which registration is opposed.
1503.06	New section - opposition to §66(a) applications.
1504.02	In §66(a) application, examining attorney may not request a remand during an opposition.
1504.03	It is not necessary for examining attorney to notify the Board when taking an action on an application that is the subject of a request for extension of time to oppose.

INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
1504.04	When deciding whether to grant requests for jurisdiction of §66(a) applications, Director will consider time limits for notifying IB of refusal.
1504.05(a)	In §66(a) application, examining attorney may not request a remand during an opposition.
1505.01(b)	Republication not required when classification is amended after publication. Classification cannot be changed in §66(a) application.
1505.01(f)	Applicant cannot change basis in §66(a) application. In §1 or §44 application, once the Director has granted a petition to amend the basis after publication, the Director will not grant a second petition to amend the basis with respect to the same application.
1505.02(b)	Title changed. This section applies to all cases where no opposition has been filed, regardless of whether extension of time to oppose has been filed or granted.
1505.02(c)	Title changed. It is not necessary for an examining attorney to notify the Board of an action taken on an amendment of an application that is under an extension of time to oppose. Board will not suspend potential opposer's time to file a notice of opposition pending consideration of post-publication amendment.
1601.01(c)	New section - registered extension of protection of international registration.
1601.06	Registrant may amend from U.S. classification system to international classification.
1602.01	Requirement for renewal under §9 of the Act applies only to registrations based on applications under §1 or §44; renewal of registered extensions of protection of international registrations to the United States is made at IB.
1604.01	Section 8 applies only to registrations based on applications under §1 or §44 of the Trademark Act; §71 requires affidavit of use or excusable nonuse for registered extensions of protection.
1604.05	Extract of rule updated.
1604.08(b)	If §8 affidavit is signed but not dated, owner must provide date of execution for the record.
1604.11	Discussion of excusable nonuse rewritten.
1604.12(b)	TEAS specimen must be in .jpg format.
1604.16	Failure to receive Office action is extraordinary circumstance that warrants waiver of deadline for response to Office action.
1605	Acknowledging receipt of §15 affidavit provides notice to the public that affidavit has been filed; it is not a determination by the Office that the registration is in fact incontestable. New filing fee is required with substitute affidavit.

INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
1605.01	Section 15 affidavit may be filed for registered extension of protection.
1605.03	If §15 affidavit is filed too early, Office will not review it and will refund the filing fee.
1605.04	If Office finds that there is a proceeding pending that involves registrant's right to register the mark or to keep the mark on the register, Office will not acknowledge §15 affidavit, even if proceeding was instituted after the registrant executed and filed the affidavit but before the affidavit was reviewed by the Office.
1606.01	New filing fee is required with substitute affidavit. Old §1606.01 (renewal of registrations issued under prior acts) renumbered 1606.01(c); title changed. New §§1606.01 <i>et seq.</i> discuss which registrations must be renewed under §9.
1606.01(b)	Requirement for §9 renewal does not apply to registered extensions of protection.
1606.02	Renumbered 1606.04; title changed.
1606.04	Renumbered 1606.02.
1606.12	Failure to receive Office action is extraordinary circumstance that warrants waiver of deadline for response to Office action.
1608	Surrender of registered extension of protection can be filed either with IB or with USPTO.
1609.01	Text moved to 1609.01(b) (amendment of registration resulting from §1 and 44 applications).
1609.01(a)	New section - Registered extension of protection cannot be amended under §7.
1609.02	Mark in registered extension of protection cannot be amended.
1609.02(a)	Changing from special form to standard characters, or the reverse, may be a material alteration.
1609.02(d)	New section - substitution of color drawing for black and white drawing of mark for which color is claimed.
1609.03	Identification of goods/services cannot be amended in registered extension of protection.
1609.04	Old §1609.04 (disclaimer) renumbered 1609.05. New §1609.04 covers amendment of classification (new section). Registrant may amend from U.S. classification system to international classification. Classification cannot be amended in registered extension of protection.
1609.05	Renumbered 1609.06.
1609.06	Renumbered 1609.07.
1609.07	Renumbered 1609.08.
1609.08	Renumbered 1609.09.
1609.09	(Correction of mistake) Renumbered 1609.10 <i>et seq.</i>

INDEX TO CHANGES IN TMEP FOURTH EDITION

SECTION	CHANGE
	expanded; broken into subsections.
1609.10(a)	Correction of Office error.
1609.10(b)	Correction of registrant's error by registrant in registered extension of protection must be corrected at IB.
1609.11	New section - owner's address can be changed through TEAS.
1612	Appointment of attorney or domestic representative can be filed through TEAS.
1613	New section - affidavits of use or excusable nonuse under §71.
1614	New section - renewal of international registrations.
1615 <i>et seq.</i>	New section - division of registrations.
1616	New section - replacement.
1702	Text of rule updated.
1705.05	Due diligence standard changed from one year to six months. Two-month deadline in 37 C.F.R. §2.146(d) applies where a petitioner does not receive the action that prompts the filing of a petition, running from the date of the petitioner's actual knowledge of said action.
1705.07	Old §1705.07 (processing petition papers) deleted. New §1705.07 covers signature of petition (new section). Petition must be signed by petitioner's attorney or by someone with legal authority to bind petitioner.
1711	Application filing date may be restored if applicant provides evidence that applicant attempted to file the application through TEAS, but TEAS was unavailable due to technical problems.
1712.02	Generally, where there is proof that a registration was cancelled solely due to an Office error, the USPTO will not deny a request for reinstatement solely because the registrant was not diligent in monitoring the status of a §8 affidavit or renewal application.
1714	Petitions to revive should be filed through TEAS, to expedite processing. Text of rule updated.
1714.01(f)(ii)	Applicant cannot file petition to revive if application is abandoned because the Board dismisses an appeal for failure to file a brief.
1715.03(a)	Letter of protest procedure applies only to pending applications. Letters of protest are denied as untimely if the mark registers before issuance of decision on the protest.
1715.03(b)	Board will not suspend a potential opposer's time to file a notice of opposition when a letter of protest has been filed.
1801.01	Text of rule updated.
1803	New address for sending FOIA requests.
1900	New chapter - Madrid Protocol.

INDEX TO CHANGES IN TMEP FOURTH EDITION