

TMEP HIGHLIGHTS – MAY 2025

This outline highlights some of the clarifications and changes set forth in the May 2025 version of the TMEP. For a more complete listing, see the “Index to Changes in TMEP May 2025” document, which is posted as part of the TMEP.

INCORPORATION OF EXAMINATION GUIDE 1-25

Examination Procedures for New Fees

Incorporated changes in accordance with *Examination Procedures for New Fees*, Examination Guide 1-25 (Jan. 2025), including replacing TMEP §819: TEAS Plus Applications with the following new sections:

- **TMEP §819:** Base Application Requirements and Additional Fees
- **TMEP §819.01:** Base Application Requirements for Determining Additional Fees
- **TMEP §819.02:** Insufficient Information Fee
 - §819.02(a): Applicant's Name and Domicile Address
 - §819.02(b): Applicant's Legal Entity and Citizenship
 - §819.02(c): Basis or Bases for Filing
 - Added sections to address filing bases §1(a), §1(b), §44(e), and §44(d) for trademarks and service marks, collective trademarks, collective service marks, collective membership marks, and certification marks
 - §819.02(d): Multiple-Class Applications
 - §819.02(e): Filing Fee
 - §819.02(f): Verification
 - §819.02(g): Drawing
 - §819.02(h): Color Claim
 - §819.02(i): Description of Mark
 - §819.02(j): Translation and/or Transliteration
 - §819.02(k): Consent to Registration of Name or Portrait
 - §819.02(l): Prior Registration of the Same Mark
 - §819.02(m): Concurrent Use Applications
 - §819.02(n): Qualified U.S. Attorney Required for Applicant with Foreign Domicile
- **TMEP §819.03:** Free-form Text ID Fee
- **TMEP §819.04:** Excess Character ID Fee
- **TMEP §819.05:** Fee Considerations and Procedures
 - §819.05(a): Payment of All Fees Required at Filing
 - §819.05(b): Same Fee Paid at Filing May Not be Required for Same Classes During Examination
 - §819.05(c): Different Fees for Same Application
 - §819.05(d): Examiner's Amendments and Priority Actions
- **TMEP §819.06:** TEAS Standard, TEAS RF, and TEAS Plus Applications
 - §819.06(a): TEAS Standard and TEAS RF Applications
 - §819.06(b): TEAS Plus Applications

SUSPENSION

Circumstances Under Which Action May Be Suspended (TMEP §716.02)

- Any request to stay a deadline for responding to an Office action pending disposition of a petition to the Director should be *submitted using the Response to Office action form, explaining that a petition on the outstanding issue(s) is currently pending. The examining attorney should then request permission from the Petitions Office, which is part of the Office of the Deputy Commissioner for Trademark Examination Policy, to suspend action on the case pending a decision on the petition.* The examining attorney must **not** suspend action on an application pending a decision on petition to the Director except upon permission from the Petitions Office or when expressly permitted.

Similar changes were made in TMEP §1705.06.

§44(d)

The "First-Filed" Requirement (TMEP §1003.01) (citations omitted)

- The requirement for the same goods or services means that the identification may not exceed the scope of the identification in the foreign application and must be different from, *and not equivalent to*, the identification covered by any previous application or registration for the mark in a treaty country. Thus, for example, if evidence in the record indicates that an applicant who owns *an EU trademark registration with the European Union Intellectual Property Office for "footwear" subsequently files a French trademark application for "coats, pants, and shoes,"* and then files a U.S. application within six months seeking a priority filing date for *"coats, pants, and shoes"* based on the *French* trademark application, the §44(d) priority claim would be valid only as to *"coats, pants"* because the *French* trademark application was not the first filed in a treaty country for *"shoes," which is encompassed by or equivalent to "footwear" in the EU trademark registration.* Note, however, that if the foreign application that formed the basis for the *EU trademark* registration was itself filed within six months of the filing date of the U.S. application, the *EU trademark* application may serve as a basis for priority for *"shoes"* in the U.S. A single U.S. application may claim priority for different goods and services on the basis of different foreign applications for the same mark as long as all foreign applications claimed were the first-filed for the identified goods/services and were filed no earlier than six months prior to the U.S. application filing date.

FUNCTIONALITY

Evidence and Considerations Regarding Functionality Determinations (TMEP §1202.02(a)(v)) (citations omitted)

- The *Morton-Norwich* factors are not exhaustive and do not “limit the kinds of evidence that might be relevant to functionality.” For example, evidence that a design feature or element is common or widely used for similar products is highly pertinent to a functionality refusal.

Utility Patents and Design Patents (TMEP §1202.02(a)(v)(A))

- It is important to thoroughly read the patent to determine whether the patent actually claims the features presented in the proposed mark *or discloses that it is functional*. If it does, the utility patent is strong evidence that the particular product features claimed as trade dress are functional. *The patent, however, does not need to explicitly disclose that the claimed feature is functional or mention the same goods for which trademark protection is sought.*

§2(e)(1)

Picture or Illustration (TMEP §1209.03(f))

- To be considered merely descriptive, the illustration or representation “need not be completely accurate, realistic or true-to-life.” (citations omitted)
- However, if the illustration or representation is sufficiently stylized, it may no longer be merely descriptive and thus may be registrable. See, e.g., *In re LRC Prods. Ltd.*, 1984 TTAB LEXIS 39, at *1, *5-6 (finding the representation of two gloved hands not merely an illustration of applicant’s gloves, but rather sufficiently stylized as to “remove it from the category of merely descriptive marks”); *In re Gen. Elec. Co.*, Ser. No. 73110126, 1980 TTAB LEXIS 72, at *4 (1980) (finding the representation of an electrical plug and cord to be “stylized, rather than realistic, in nature” and thus not merely descriptive of rechargeable batteries); *In re Curtiss-Wright Corp.*, Ser. No. 73443625, 1974 TTAB LEXIS 159, at *1-2 (1974) (finding the representation of a rotor and rotor housing of the Wankel-type rotary combustion engine to be fanciful and thus not merely descriptive of engines for land, water and air vehicles).

§2(f)

Survey Evidence, Market Research and Consumer Reaction Studies (TMEP §1212.06(d)) (citations omitted)

- A survey is probative only if it deals with conditions at the time registration is being sought, as acquired distinctiveness is a time-based concept: "it exists at a specific time, in a specific place, among a specific group of people who recognize that specified matter indicates commercial origin of a specified type of product or service from one unique commercial source."
- For registration of trade dress marks, a survey must use the drawing of the mark for which acquired distinctiveness is at issue, not a photograph of a product, since the drawing reflects the mark being registered. A photograph could introduce other features or irrelevant matter not part of the matter sought to be registered, which "reduces the survey's probative value in proceedings concerning registrability."

CLAIM PRECLUSION AND STARE DECISIS

Res Judicata, Collateral Estoppel, and Stare Decisis (TMEP §1217)

Relating to claim preclusion (citations omitted):

- The doctrine of claim preclusion may apply "even when the prior judgment resulted from default, consent, or dismissal with prejudice."
- Numerous factors may be considered when determining whether the claims are based on the same set of transactional facts, including "whether the facts are so woven together as to constitute a single claim (due to relatedness in time, space, origin, or motivation), and whether, taken together, they form a convenient unit for trial purposes."

Relating to stare decisis:

- If the facts are not substantially the same in the prior precedent and current situation, stare decisis does not apply. *See In re Audemars Piguet Holding SA*, Ser. No. 90045780, 2025 TTAB LEXIS 1, at *13-14 (2025) (stare decisis was not applicable where prior court precedent pertained to elements of a watch configuration mark that were not subject to drawing requirements underlying subsequent refusals being challenged on appeal). Stare decisis is further limited to legal issues decided in prior precedential decisions and does not apply to issues of fact previously decided, such as acquired distinctiveness and functionality. *See id.* (citing *Deckers Corp. v. United States*, 752 F.3d 949, 956 (Fed. Cir. 2014)).

IDENTIFICATIONS OF GOODS AND SERVICES

Identification and Classification of Kits, Gift Baskets, and Items Sold as a Unit (TMEP §1401.05(a))

- Generally, kits are identified and classified in two ways:
 - (1) If the *kit is for making a single object, and it is comprised of component parts or ingredients for making that object, the kit is generally* classified by the object it is intended to make. *With the exception of certain specific kits listed in the ID Manual, the identification must indicate the kit components and indicate the item to be made.* For example, kits for making wine consisting of fresh grapes and chemicals for fermenting wine would be classified in Class 33, the class for wine, even though the individual components would be classified in other classes (e.g., fresh grapes in Class 31 and chemicals for fermenting wine in Class 1).
 - (2) If the kit is a combination of a number of components around a theme (e.g., nail care kits), the class that includes the majority of individual components in the kit generally controls the classification for the entire kit. Thus, a nail care kit comprised of nail polish (Class 3), nail files (Class 8), nail polish remover (Class 3), a printed instruction manual (Class 16), and false nails (Class 3) is classified in Class 3, which is the class of the majority of individual components in the kit; however, the identification must be modified to list all of the components in Class 3 at the beginning of the list of components. In such cases, the identification must indicate the type of kit and list the components, with all of the items in the predominant class listed first. Components that are secondary should be set forth after the primary components.

NEW SECTION: Virtual Goods (TMEP §1401.15(d))

This section has been added to incorporate guidance on virtual goods. Virtual goods are intangible, digital objects used in virtual worlds, virtual environments, and online games. Explanations regarding definite identifications for virtual goods and examples are provided in this new section.

NEW SECTION: Biomanufacturing (TMEP §1401.15(e))

This section has been added to incorporate guidance on biomanufacturing services. Biomanufacturing is defined as “the use of living organisms and cells to produce molecules or other biological materials for making products such as medicines, food, and drinks.” Under Nice 12-2025, the identification “biomanufacturing” and “biomanufacturer” are indefinite and overbroad because the nature of the services is unclear and may encompass services in

more than one class. Additional explanation and examples are provided in this new section.

General Guidelines for Acceptable Identifications of Goods or Services (TMEP §1402.01(a))

Added the following paragraph:

- Identifications for retail and wholesale store services require specification of the goods featured by those services, e.g., retail clothing stores. See TMEP §1402.11(a)(vi). If a retail or wholesale store service features more than one type of good, the list of goods featured by the retail and wholesale store services should generally be separated with commas and the term “and” should precede the last item in the list, e.g., “retail store services featuring clothing, jewelry, and purses.” Semicolons must not be used in the list of goods featured by a retail or wholesale store service because the use of semicolons would cause ambiguity regarding the nature of the goods or services. For example, the identification “retail store services featuring clothing; jewelry; and purses” may encompass “retail store services featuring clothing” in Class 35, “jewelry” in Class 14, and “purses” in Class 18.

Retail Services (TMEP §1402.11(a)(vi))

- Regardless of whether the retail services are provided in person, online, or by other means, identifications for “retail services” must indicate the nature of the retail activity (e.g., retail outlets or online retail stores). Additionally, identifications for retail store, catalog, or ordering services and identifications for retail services by direct solicitation by sales agents must indicate the type or field of *the physical or virtual goods* offered by the services (e.g., “*clothing*” or “*downloadable image files of virtual clothing*”). The type of goods is required in order to facilitate informed judgments concerning likelihood of confusion under 15 U.S.C. §1052(d).

Additional examples of acceptable identifications are provided including: “Online retail store services featuring virtual goods, namely, {specify type, e.g., furniture, jewelry, sunglasses, etc.} for use in online virtual worlds,” in Class 35.

POST REGISTRATION

Substitute Specimens (TMEP §1604.12(c))

- While a substitute specimen and supporting affidavit or declaration may be filed after the expiration of the period specified in §8 of the Act, the supporting affidavit or declaration must attest to use of the specimen within the time period specified in §8 of the Act. Therefore, if the

affidavit or declaration supporting the substitute specimen does not state that the specimen was in use in commerce prior to the end of the relevant period specified in §8 of the Act, the USPTO will not accept the affidavit or declaration, and the registration will be cancelled *unless: (1) the owner deletes the class(es) for which no proper specimen was submitted and pays the fee(s) for deleting such classes from the registration during pendency of the §8 affidavit or declaration (see 37 C.F.R. §2.6(a)(12)(iii), (iv)); and (2) other class(es) supported by proper specimens remain in the registration.*

Similar changes were made in TMEP §1613.12(c) relating to §71 affidavits or declarations.

PETITIONS

Petition to Waive Domicile Address Requirement (TMEP §1708.01) (citations omitted)

Section has been updated to outline procedures for filing a separate response to an Office action requesting that an application be suspended, or a post registration filing be held, pending disposition of a petition to waive the domicile address requirement.

Section has also been updated to indicate the number of simultaneously pending applications or pending post-registration filings that may be covered by a single petition:

- *One petition will cover a limited number of simultaneously pending applications or pending post-registration filings.* If, at the time the petition is filed, a party has more than one application pending and/or more than one registration for which there are post-registration maintenance documents (e.g., Section 8 or Section 71 affidavits or declarations, or Section 7 requests) pending, they may file one petition that identifies up to nine additional pending applications and/or registrations that have pending post-registration submissions. If the petition is granted, the decision will apply to each of the identified applications and/or registrations and will be uploaded into each identified application and/or registration record. If the party has more than nine additional pending applications and/or registrations with pending post-registration maintenance documents for which the party seeks a waiver of the domicile address requirement, the party must file additional petitions, along with the appropriate fees, each of which may cover up to ten total applications and/or registrations.
- *Petition may not be amended to identify additional pending applications or post-registration filings.* Once a petition is filed, a party may not amend the petition to identify additional applications and/or

registrations. Therefore, if the party files new applications or post-registration maintenance documents for additional registrations while the petition is pending, or after the petition is decided, the party must file a new petition or petitions, as appropriate, to request a waiver of the domicile address requirement for the newly filed applications and additional registrations.

Standard of Review for Petition to Reverse Holding of Abandonment of Application for Incomplete Response (TMEP §1713.01)

- A petition to the Director is also not a means for submitting an additional request for reconsideration, or a request to extend the deadline to file a notice of appeal to the Board, after the application has been abandoned for incomplete response.