

Trademark Laws and Regulations

§44(c), accompanying the application, a certificate of the trademark office of the applicant's country of origin showing that the mark has been registered in such country and also showing the mark, the goods or services for which the mark is registered, the date of filing of the application on the basis of which registration was granted and that said registration is in full force and effect and, if the certificate is not in the English language, a translation thereof;

- (ix) In an application claiming the benefit of a foreign application in accordance with §44(d) of the Act, compliance with the requirements of §2.39;
- (x) In an application under §1(a) of the Act, the mode, manner or method of applying, affixing or otherwise using the mark on or in connection with the goods or services specified or, in an application under §1(b) of the Act, the intended mode, manner or method of applying, affixing or otherwise using the mark on or in connection with the goods or services specified.
- (2) If more than one item of goods or services is specified in the application, the dates of use required in paragraph (a)(1)(vii) of this section need be for only one of the items specified, provided the particular item to which the dates apply is designated.
- (3) The word "commerce" as used throughout this part means commerce which may lawfully be regulated by Congress, as specified in §45 of the Act.

(b)(1) In an application under §1(a) of the Act, the application must include averments to the effect that the applicant is believed to be the owner of the mark sought to be registered; that the mark is in use in commerce, specifying the nature of such commerce; that no other entity to the best of the declarant's knowledge and belief, has the right to use such mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of such other entity, to cause confusion, or to cause mistake, or to deceive; that the specimens or facsimiles show the mark as used on or in connection with the goods or services; and that the facts set forth in the application are true; or

- (2) In an application under §1(b) or 44 of the Act, the application must include averments to the effect that the applicant is believed to be the owner of the mark sought to be registered; that the applicant has a bona fide intention to use the mark in commerce on or in connection with the specified goods or services; that no other entity, to the best of the declarant's knowledge and belief, has the right to use such mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of such other entity, to cause confusion, or to cause mistake, or to deceive; and that the facts set forth in the application are true.

(c) For an application for the registration of a mark for goods or services falling within multiple classes, see §2.86.

(d) An applicant may not file under both §§1(a) and 1(b) of the Act in a single application, nor may an applicant in an application under §1(a) of the Act amend that application to seek registration under §1(b) of the Act.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37589, Sept. 11, 1989]

37 CFR 2.35 Description of mark.

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

37 CFR 2.36 Identification of prior registrations.

Prior registrations of the same or similar marks owned by the applicant should be identified in the application.

*Trademark Laws and Regulations***37 CFR 2.37 Authorization for representation; U.S. representative.**

The authorization of a qualified person to represent applicant (§2.17(b)) and the designation of a domestic representative (§2.24) may be included as a paragraph or paragraphs in the application.

[41 FR 758, Jan. 5, 1976]

37 CFR 2.38 Use by predecessor or by related companies.

(a) If the first use, the date of which is required by paragraph (a)(1)(vii) of §2.33, was by a predecessor in title, or by a related company (§§5 and 45 of the Act), and such use inures to the benefit of the applicant, the date of such first use may be asserted with a statement that such first use was by the predecessor in title or by the related company as the case may be.

(b) If the mark is not in fact being used by the applicant but is being used by one or more related companies whose use inures to the benefit of the applicant under §5 of the Act, such facts must be indicated in the application.

(c) The Office may require such details concerning the nature of the relationship and such proofs as may be necessary and appropriate for the purpose of showing that the use by related companies inures to the benefit of the applicant and does not affect the validity of the mark.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37589, Sept. 11, 1989]

37 CFR 2.39 Priority claim based on foreign application.

(a) An application claiming the benefit of a foreign application in accordance with §44(d) of the Act shall specify the filing date and country of the first regularly filed foreign application or, if the application is based upon a subsequent regularly filed application in the same foreign country, the application shall so state and shall show that any prior filed application has been withdrawn, abandoned or otherwise disposed of, without having been laid open to public inspection and without having any rights outstanding, and has not served as a basis for claiming a right of priority.

(b) Before the application can be approved for publication, a basis for registration under §1(a), 1(b) or 44(e) of the Act must be established.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37589, Sept. 11, 1989]

37 CFR 2.41 Proof of distinctiveness under §2(f).

(a) When registration is sought of a mark which would be unregistrable by reason of §2(e) of the Act but which is said by applicant to have become distinctive in commerce of the goods or services set forth in the application, applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, affidavits, or declarations in accordance with §2.20, depositions, or other appropriate evidence showing duration, extent and nature of use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and affidavits, or declarations in accordance with §2.20, letters or statements from the trade or public, or both, or other appropriate evidence tending to show that the mark distinguishes such goods.

(b) In appropriate cases, ownership of one or more prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness. Also, if the mark is said to have become distinctive of applicant's goods by reason of substantially exclusive and continuous use in commerce thereof by applicant for the five years before the date on which the claim of distinctiveness is made, a showing by way of statements which are verified or which include declarations in accordance with §2.20, in the application may, in appropriate cases, be accepted as prima facie evidence of distinctiveness. In each of these situations, however, further evidence may be required.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37590, Sept. 11, 1989]

37 CFR 2.42 Concurrent use.

An application for registration as a lawful concurrent user shall specify and contain all the elements required by the preceding sections. The applicant in addition shall state in the application

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the area, the goods, and the mode of use for which applicant seeks registration; and also shall state, to the extent of the applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; registrations issued to or applications filed by such others, if any; the areas of such use; the goods on or in connection with which such use is made; the mode of such use; and the periods of such use.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 34897, Aug. 22, 1989]

37 CFR 2.43 Service mark.

In an application to register a service mark, the application shall specify and contain all the elements required by the preceding sections for trademarks, but shall be modified to relate to services instead of to goods wherever necessary.

37 CFR 2.44 Collective mark.

(a) In an application to register a collective mark under §1(a) of the Act, the application shall specify and contain all applicable elements required by the preceding sections for trademarks, but shall, in addition, specify the class of persons entitled to use the mark, indicating their relationship to the applicant, and the nature of the applicant's control over the use of the mark.

(b) In an application to register a collective mark under §1(b) or 44 of the Act, the application shall specify and contain all applicable elements required by the preceding sections for trademarks, but shall, in addition, specify the class of persons intended to be entitled to use the mark, indicating what their relationship to the applicant will be, and the nature of the control applicant intends to exercise over the use of the mark.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37590, Sept. 11, 1989]

37 CFR 2.45 Certification mark.

(a) In an application to register a certification mark under §1(a) of the Act, the application shall specify and contain all applicable elements required by the preceding sections for trademarks. It shall, in addition, specify the manner in which and the conditions under which the certification mark is used; it shall allege that the applicant exercises legitimate control over the use of the mark and that the applicant is not engaged in the production or marketing of the goods or services to which the mark is applied.

(b) In an application to register a certification mark under §1(b) or 44 of the Act, the application shall specify and contain all applicable elements required by the preceding sections for trademarks. It shall, in addition, specify the manner in which and the conditions under which the certification mark is intended to be used; it shall allege that the applicant intends to exercise legitimate control over the use of the mark and that the applicant will not engage in the production or marketing of the goods or services to which the mark is applied.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37590, Sept. 11, 1989]

37 CFR 2.46 Principal Register.

All applications will be treated as seeking registration on the Principal Register unless otherwise stated in the application. Service marks, collective marks, and certification marks, registrable in accordance with the applicable provisions of §2 of the Act, are registered on the Principal Register.

37 CFR 2.47 Supplemental Register.

(a) In an application to register on the Supplemental Register under §23 of the Act, the application shall so indicate and shall specify that the mark has been in lawful use in commerce, specifying the nature of such commerce, by the applicant.

(b) In an application to register on the Supplemental Register under §44 of the Act, the application shall so indicate. The statement of lawful use in commerce may be omitted.

(c) A mark in an application to register on the Principal Register under §1(b) of the Act is eligible for registration on the Supplemental Register only after an acceptable amendment to allege use under §2.76 or statement of use under §2.88 has been timely filed.

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(d) An application for registration on the Supplemental Register must conform to the requirements for registration on the Principal Register under §1(a) of the Act, so far as applicable.

[38 FR 18876, July 16, 1973, as amended at 54 FR 37590, Sept. 11, 1989]

DRAWING

Authority: Sections 2.51 to 2.55 also issued under §1, 60 Stat. 427; 15 U.S.C. 1051.

37 CFR 2.51 Drawing required.

(a)(1) In an application under §1(a) of the Act, the drawing of the trademark shall be a substantially exact representation of the mark as used on or in connection with the goods; or

(2) In an application under §1(b) of the Act, the drawing of the trademark shall be a substantially exact representation of the mark as intended to be used on or in connection with the goods specified in the application, and once an amendment to allege use under §2.76 or a statement of use under §2.88 has been filed, the drawing of the trademark shall be a substantially exact representation of the mark as used on or in connection with the goods; or

(3) In an application under §44 of the Act, the drawing of the trademark shall be a substantially exact representation of the mark as it appears in the drawing in the registration certificate of a mark duly registered in the country of origin of the applicant.

(b)(1) In an application under §1(a) of the Act, the drawing of a service mark shall be a substantially exact representation of the mark as used in the sale or advertising of the services; or

(2) In an application under §1(b) of the Act, the drawing of a service mark shall be a substantially exact representation of the mark as intended to be used in the sale or advertising of the services specified in the application and, once an amendment to allege use under §2.76 or a statement of use under §2.88 has been filed, the drawing of the service mark shall be a substantially exact representation of the mark as used in the sale or advertising of the services; or

(3) In an application under §44 of the Act, the drawing of a service mark shall be a substantially exact representation of the mark as it appears in the drawing in the registration certificate of a mark duly registered in the country of origin of applicant.

(c) The drawing of a mark may be dispensed with in the case of a mark not capable of representation by a drawing, but in any such case the application must contain an adequate description of the mark.

(d) Broken lines should be used in the drawing of a mark to show placement of the mark on the goods, or on the packaging, or to show matter not claimed as part of the mark, or both, as appropriate. In an application to register a mark with three-dimensional features, the drawing shall depict the mark in perspective in a single rendition.

(e) If the application is for the registration of only a word, letter or numeral, or any combination thereof, not depicted in special form, the drawing may be the mark typed in capital letters on paper, otherwise complying with the requirements of §2.52.

[30 FR 13193, Oct. 16, 1965 as amended at 54 FR 37590, Sept. 11, 1989]

37 CFR 2.52 Requirements for drawings.

(a) Character of drawing. All drawings, except as otherwise provided, must be made with the pen or by a process which will provide high definition upon reproduction. A photolithographic reproduction or printer's proof copy may be used if otherwise suitable. Every line and letter, including color lining and lines used for shading, must be black. All lines must be clean, sharp, and solid, and must not be fine or crowded. Gray tones or tints may not be used for surface shading or any other purpose. The requirements of this paragraph are not necessary in the case of drawings permitted and filed in accordance with paragraph (e) of §2.51.

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(b) Paper and ink. The drawing must be made upon paper which is flexible, strong, smooth, nonshiny, white and durable. A good grade of bond paper is suitable; however, water marks should not be prominent. India ink or its equivalent in quality must be used for pen drawings to secure perfectly black solid lines. The use of white pigment to cover lines is not acceptable.

(c) Size of paper and margins. The size of the sheet on which a drawing is made must be 8 to 8 1/2 inches (20.3 to 21.6 cm.) wide and 11 inches (27.9 cm.) long. One of the shorter sides of the sheet should be regarded as its top. It is preferable that the drawing be 2.5 inches (6.1 cm.) high and/or wide, but in no case may it be larger than 4 inches (10.3 cm.) high and 4 inches (10.3 cm.) wide. If the amount of detail in the mark precludes a reduction to this size, such detail may be verbally described in the body of the application. There must be a margin of at least 1 inch (2.5 cm.) on the sides and bottom of the paper and at least 1 inch (2.5 cm.) between it and the heading.

(d) Heading. Across the top of the drawing, beginning one inch (2.5 cm.) from the top edge and not exceeding one third of the sheet, there must be placed a heading, listing in separate lines, applicant's complete name; applicant's post office address; the dates of first use of the mark and first use of the mark in commerce in an application under §1(a) of the Act; the priority filing date of the relevant foreign application in an application claiming the benefit of a prior foreign application in accordance with §44(d) of the Act; and the goods or services recited in the application or a typical item of the goods or services if a number of items are recited in the application. This heading should be typewritten. If the drawing is in special form, the heading should include a description of the essential elements of the mark.

(e) Linings for color. Where color is a feature of a mark, the color or colors employed may be designated by means of conventional linings as shown in the following color chart:

[51 FR 29921, Aug. 21, 1986, as amended at 54 FR 37591, Sept. 11, 1989]

37 CFR 2.53 Transmission of drawings.

Drawings transmitted to the Patent and Trademark Office, other than those typed in accordance with §2.51(e), should be sent flat, protected by a sheet of heavy binder's board, or should be rolled for transmission in a suitable mailing tube to prevent mutilation or folding.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37591, Sept. 11, 1989]

SPECIMENS

Authority: Sections 2.56 to 2.58 also issued under §1, 60 Stat. 427; 15 U.S.C. 1051.

37 CFR 2.56 Specimens.

An application under §1(a) of the Act, an amendment to allege use under §2.76, and a statement of use under §2.88 must each include three specimens of the trademark as used on or in connection with the goods in commerce. The specimens shall be duplicates of the labels, tags, or containers bearing the trademark, or the displays associated with the goods and bearing the trademark (or if the nature of the goods makes use of such specimens impracticable then on documents associated with the goods or their sale), when made of suitable flat material and of a size not to exceed 8 1/2 inches (21.6 cm.) wide and 11 inches (27.9 cm.) long.

[39 FR 12248, Apr. 4, 1974, as amended at 54 FR 37591, Sept. 11, 1989]

37 CFR 2.57 Facsimiles.

(a) When, due to the mode of applying or affixing the trademark to the goods, or to the manner of using the mark on the goods, or to the nature of the mark, specimens as above stated cannot be furnished, three copies of a suitable photograph or other acceptable reproduction, not to exceed 8 1/2 inches (21.6 cm.) wide and 11 inches (27.9 cm.) long, and clearly and legibly showing the mark and all matter used in connection therewith, shall be furnished.

(b) A purported facsimile which is merely a reproduction of the drawing submitted to comply with 2.51 will not be considered to be a facsimile depicting the mark as used on or in connection with the goods or in connection with the services.