

**Introduction to the May 2026 Edition,
September 2026 Update**

**PRACTITIONER'S TRADEMARK MANUAL
OF EXAMINING PROCEDURE**

Please note that this September 2026 Update consists of two soft-bound volumes. For ease of handling, the materials in this shipment may ship in more than one box.

- **Doctrine of Foreign Equivalents Reshaped by *Vetements*** (§ 1207.01(b)(vi); cross-references at §§ 1207.01(b)(vi)(B), 1209.03(g), 1210.05(b), 1210.10, 1211.01(a)(vii)): The Federal Circuit's decision in *In re Vetements Group AG* now controls and extends the doctrine of foreign equivalents beyond likelihood-of-confusion analysis to descriptiveness, genericness, geographic descriptiveness and misdescriptiveness, and surname analysis.

- **First Board Review of a Section 16B Reexamination (§ 1716):** *In re Everwise Credit Union* affirmed cancellation of a registration where the registrant could not prove source-indicating use as of the statement-of-use deadline. The original examining attorney's acceptance of the SOU is not preclusive on reexamination.

- **Color-Mark Registrability Framework Softened, but Genericness Now an Independent Ground** (§ § 1202.05, 1202.05(b), 1202.05(h), 1202.05(i)): The November 2025 TMEP replaced absolute language with "generally is not" / "generally are not," opening a narrow but real path for color marks. At the same time, genericness has been added as an independent ground of refusal for color marks on both the Principal and Supplemental Registers, requiring a two-step inquiry separate from functionality and acquired distinctiveness.

- **Failure-to-Function Refusals Require Analytical Rigor (§ 1202.04):** *In re Brunetti* vacated the Board's failure-to-function refusal and remanded for the Board to articulate a coherent, rational standard for determining when widely-used or common words can serve as source identifiers.

- **Section 44(d) Priority Available Based on Reciprocity Even Without Treaty Relationship (§ 1003):** *CandyVerse, LLC v. Zeeth Ltd.* awarded Section 44(d) priority to a British Virgin Islands applicant based on the BVI Trade Marks Act's reciprocal grant of priority to Paris Convention and WTO nationals, even though the BVI is not a party to a relevant treaty with the United States.

- **Partial Replacement of National Registrations Under the Madrid Protocol (§ 1904.12):** Effective July 2, 2025, an international registration may replace a U.S. national registration only as to overlapping goods or services, rather than only in full. Practitioners can now consolidate maintenance under the international registration while preserving non-overlapping coverage in the national registration.

- **Personal-Signature Rule Is Substantive, Not Technical (§ 611.01(b)):** *In re Stelcore Management Services, LLC* confirms that signature

defects can support sanctions and that the affected document cannot be relied upon to support registration.

- **Domicile-Address Requirement Is Non-Substitutable (§§ 601.01, 803.05(a)):** *In re Solace Brand Studio, LLC* affirmed three refusals where the applicant listed counsel's law-firm address rather than its own domicile. The applicant's actual domicile must be verified at intake—for individuals, the permanent legal residence; for entities, the principal place of business under 37 C.F.R. § 2.2(p).

- **Argument Preservation on Ex Parte Appeal Is Unforgiving (§§ 1501.02(a), 1501.02(b)):** Arguments made during prosecution but omitted from the appeal brief may be deemed waived and arguments "incorporated by reference" to the prosecution record may be deemed forfeited.

- **DuPont Factor Analysis: Similarity Remains Primary and the Scope of Factors Must Be Consistent (§ § 1207.01(b), 1207.01(d)(iii)):** Mark dissimilarity under the first factor can carry the entire likelihood-of-confusion analysis even when other factors favor confusion.

- **Mid-Litigation Assignment of Common Law Rights Remains a Viable Priority Strategy (§ 501):** Cancellation affirmed where the applicant established priority through a mid-opposition assignment of pre-existing common law rights. Section 1060(a)(1) bar applies only to bare intent-to-use applications and does not reach common law rights that exist independently of an ITU.

- **Incontestability Does Not Insulate a Registered Mark from a Genericness Challenge (§ 1209.01(c)):** An incontestable registration can be cancelled if the mark has become generic, and the "primary significance" of the mark to the relevant public controls the analysis—even on preliminary-injunction review.