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Trademark specimens overview for experienced filers

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Why specimens

- Specimens are evidence of how a mark is used in commerce.
- The United States Patent and Trademark Office (USPTO) evaluates specimens to make sure a registration accurately reflects how a mark is used in the marketplace.

Definition of “use in commerce”

- The bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.

Use in commerce

- Continuing obligation even after a mark is registered
- Limited exception for excusable nonuse
- Special circumstances beyond the owner's control or forced by outside causes
- Impact from COVID-19 may qualify

Use in commerce

- The rules require “one specimen per class showing the mark as actually used in commerce on or in connection with the goods or services identified.”

Use in commerce on goods

- A mark shall be deemed to be in use in commerce on goods when:
  - It is placed in any manner on the goods, or their containers, or the displays associated therewith; or on the tags or labels affixed thereto; or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale; and
  - The goods are sold or transported in commerce.

Use in commerce on services

- A mark shall be deemed to be in use in commerce on services when:
  - It is used or displayed in the sale or advertising of services and the services are rendered in commerce; or the services are rendered in more than one state; or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

Specimens for goods

- Use on the goods or on packaging or containers for the goods
- Use on a point of sale display of the goods
- Use on an electronic point of sale display of the goods

Specimens for goods – mark is on the goods

Specimens for goods – mark is on the container

Labels and tags

- Unattached labels and tags are acceptable so long as there is sufficient information to show use in commerce.
- If the appearance of the label or tag suggests the goods are not in actual use in commerce, the examining attorney will refuse registration.

Labels and tags - acceptable

Labels and tags - unacceptable

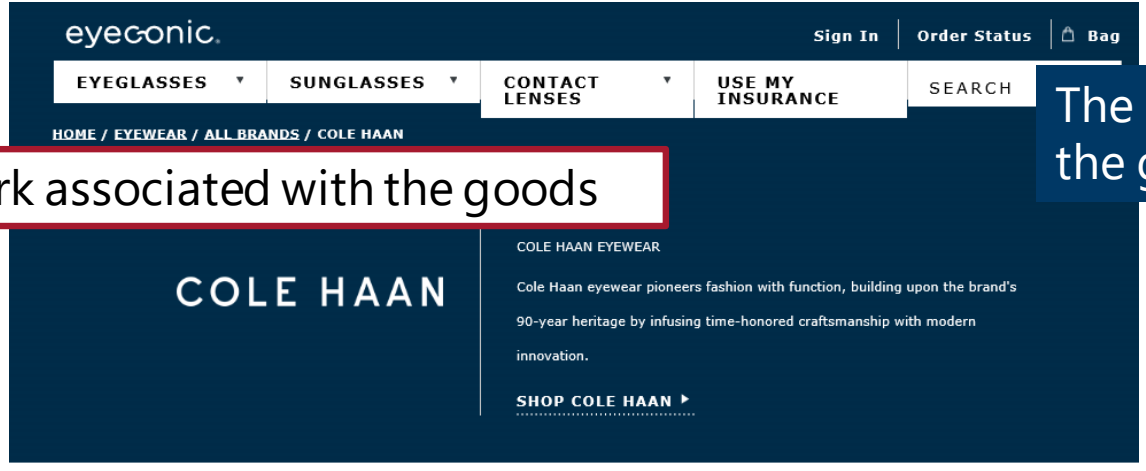
Specimens for goods – physical displays

- Displays associated with the goods essentially comprise point-of-sale material such as banners, shelf-talkers, window displays, menus, and similar devices.
- A display must show use of the mark directly associated with the goods and at the point of sale.

Specimens for goods – catalogs and electronic displays

- A webpage or catalog that displays a product can constitute a "display associated with the goods" if it:
  - Contains a picture or textual description of the identified goods
  - Shows the mark in association with the goods
  - Provides a means for ordering the identified goods

Electronic display

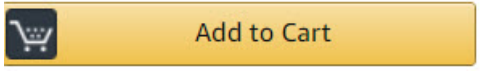


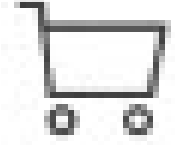
The means for purchasing the goods

The mark associated with the goods

Picture or description of the goods

Means for purchasing the goods





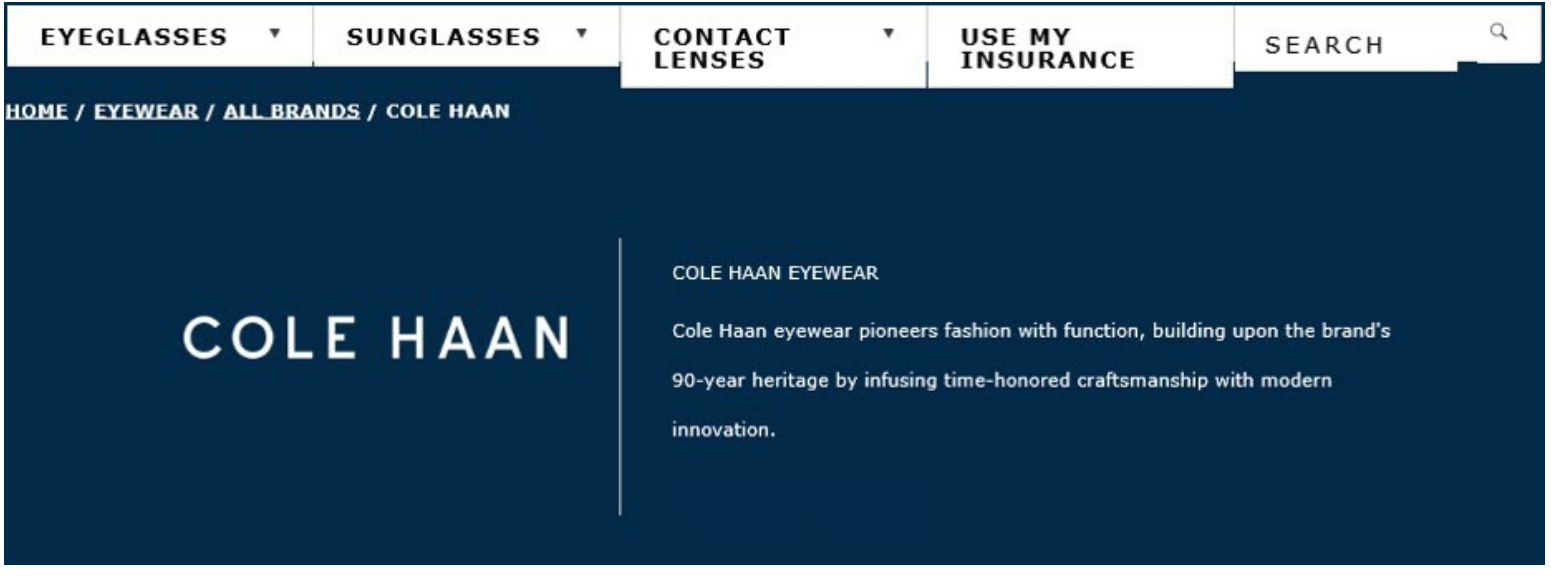
Specimens for goods – components or ingredients

- A specimen that shows use of a mark to identify a component or ingredient of finished goods is not acceptable for the finished goods.
- For components or ingredients as goods, “it is particularly important that the specimen contain some visual or verbal identification of the component to create the required direct association between the mark and the identified goods.”

Advertisements

- Advertising material is generally not acceptable as a specimen for goods and can only be accepted if it comprises a point of sale display.
- Examples:
  - Advertising circulars
  - Brochures
  - Press releases
  - Business cards
  - Invoices

Poll: Would you refuse?



If there is no means for ordering the mark, the display is advertising for goods.

Specimens for services

Service mark specimens may show use by showing the mark:

- Used or displayed as a service mark in the **sale of the services,** which includes use in the course of rendering or performing the services
- **Used or displayed in advertising the services,** which encompasses marketing and promotional materials

Service mark specimens

- The mark must be presented sufficiently prominent on the specimen – mark placement, size, or stylization are considered.
- The specimen must show the mark used in a manner that creates in the minds of potential consumers a direct association between the mark and the services.

Service mark specimens

Advertising the services:

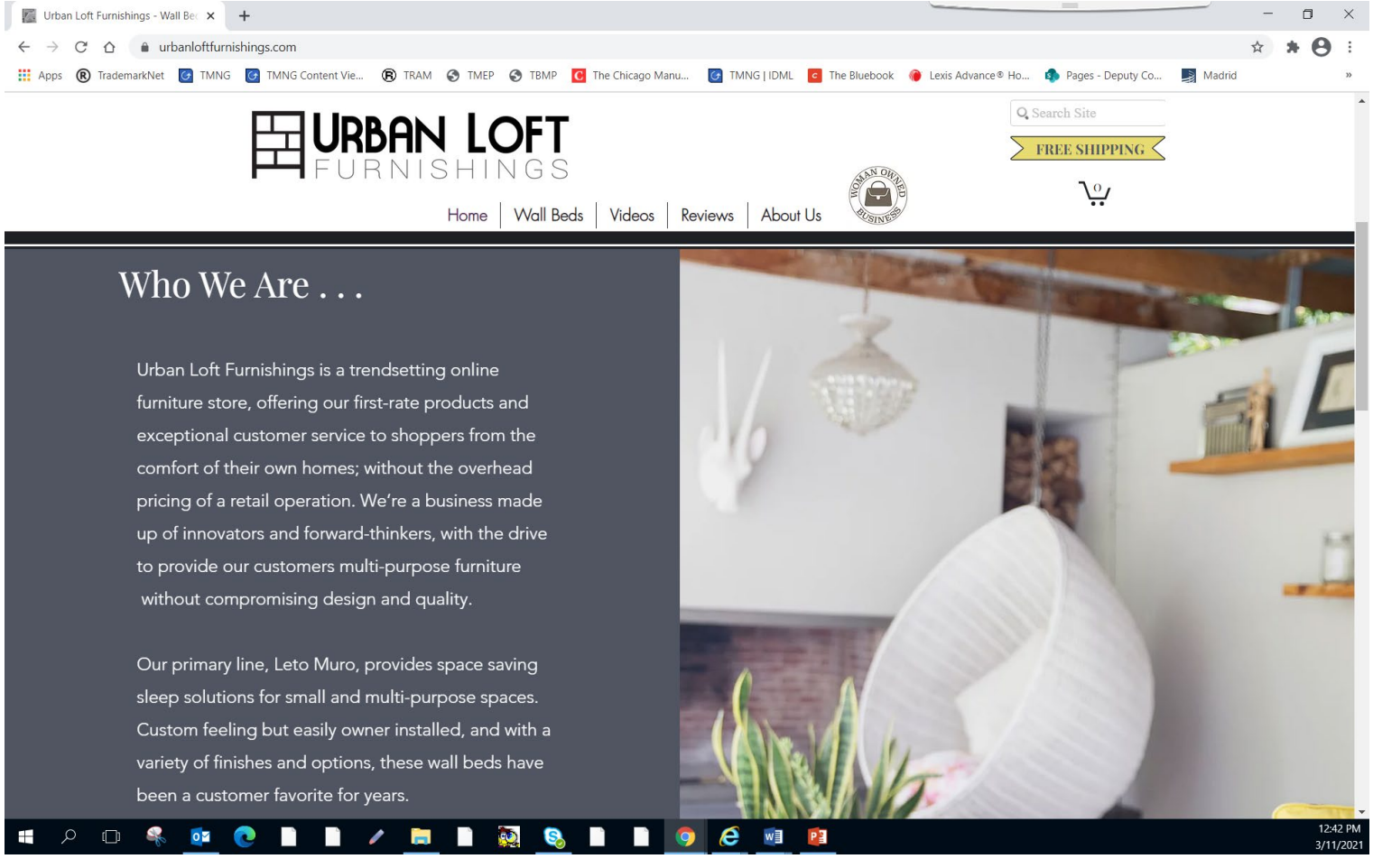
- To establish the requisite direct association:
  - The specimen must contain a reference to the services.
  - The mark must be used on the specimen to identify the services and their source.

Service mark specimens

Rendering the services:

- Direct association may be:
  - Indicated by the **context or environment** in which the services are rendered
  - Inferred based on the consumer's general knowledge of how certain services are provided or from the consumer's prior experience in receiving the services.

Acceptable specimens for services



Unacceptable specimen for services

Unacceptable specimen for services

“Our sincere commitment to all our customers is that we will continue delivering innovative system utilities that are as simple to use as they are powerful and reliable. We also promise that we will keep providing the first-class free software and online service, for personal or non-commercial use."

"We pursue the genuine ambition of becoming one of the world's top utility producers and Windows system service providers on the Internet."

Specimens for services - signage

- Mark appearing on the front door of applicant's offices without reference to the services is unacceptable.
  - The door is advertising, which must create an association between the mark and the services.
  - Display on the door is not using the mark in rendering the services. The door is unconnected to any service without prior knowledge of an existing client.

Software specimens

- Software must be specifically identified as recorded or downloadable, which is a good, or as providing online non-downloadable software, which is a service.
- An acceptable specimen for software services may not be acceptable for recorded or downloadable software.

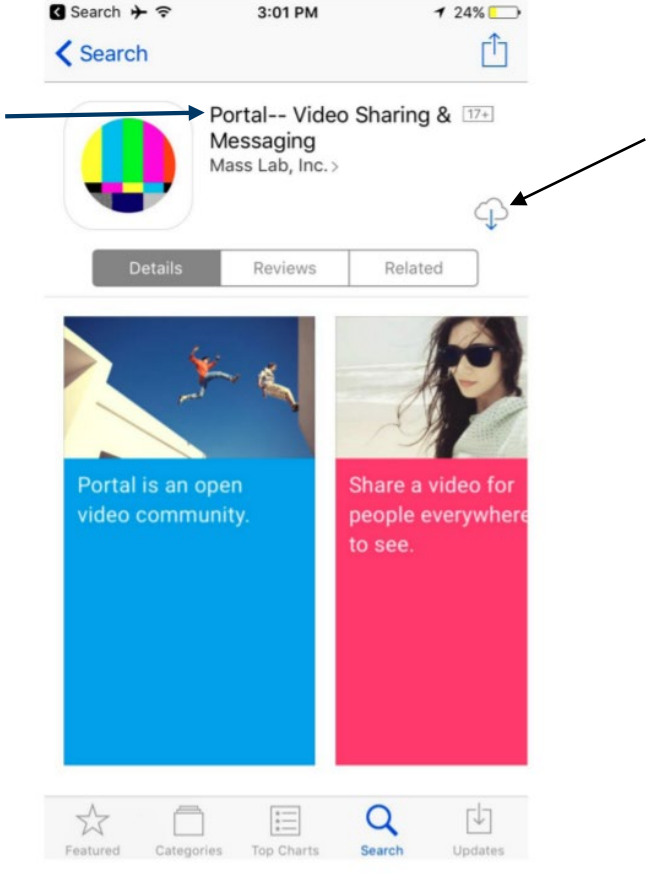
Software specimens - goods

- Recorded or downloadable software:
  - Mark may be on the packaging or the recording itself
  - Mark may be in a display screen for the software or screenshot of software running
  - Downloadable from an app or webpage
    - Must create an association between the mark and the software
    - Must provide means to purchase or download

Software specimens - goods

- Means to purchase or download:
  - Purchaser must see the mark contemporaneously with the ability to purchase.
  - A “Request a demo” button is not sufficient.
  - Ordinary meaning of demo suggests an opportunity to see how the product works, not purchase.

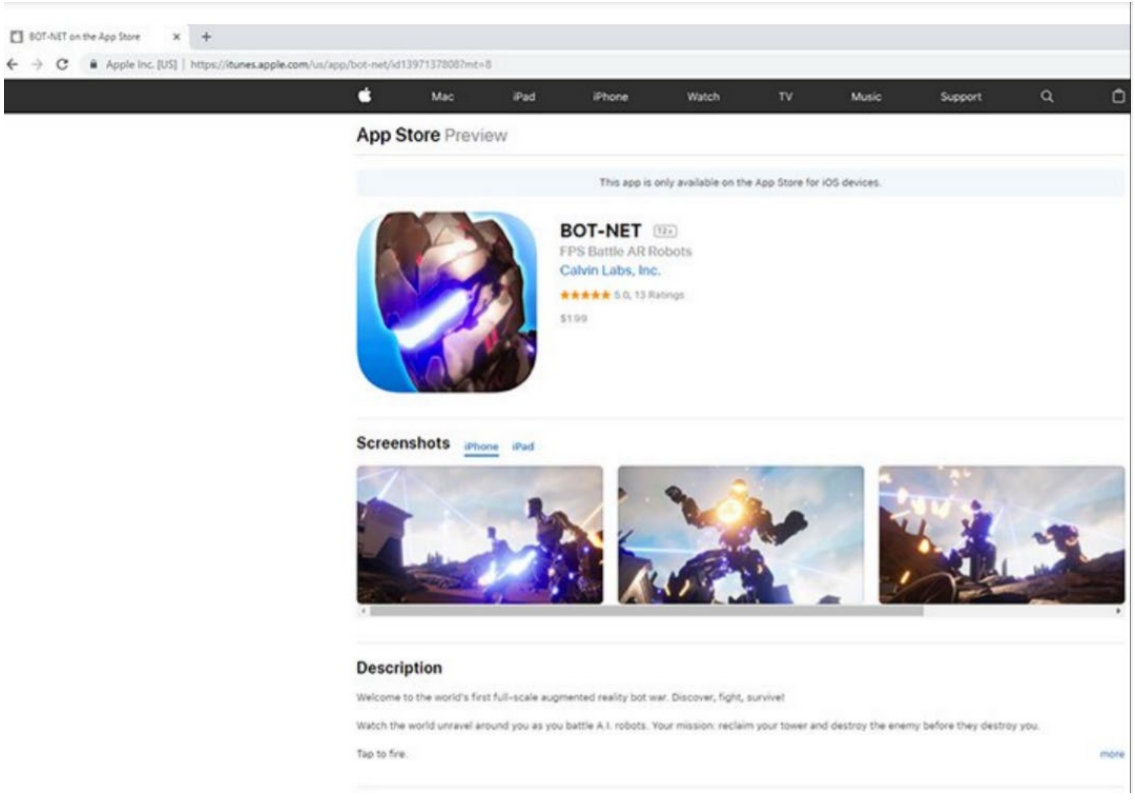
Software specimens - example



Mark: PORTAL

Goods: Downloadable software enabling users to create, edit, distribute, shape, exhibit, transmit, annotate, download, store, comment on, license, and monetize digital media content via computer, mobile device, and communications networks

Poll: Why would you refuse this specimen?



Mark: BOT-NET

Goods: Downloadable computer game software via a global computer network and wireless devices

Specimen: Digital images of a website currently used in commerce.

Software specimens – manuals

- Software user manuals may be acceptable.
- May not be acceptable where wording on the specimen called into question whether the specimen was actually a manual for software.

Software specimens – manuals

Mark: USER FIRST

Goods: Computer software, namely, software development tools for the creation of mobile internet applications and client interfaces.

Specimen is described as a scanned first page of a PDF instruction manual.

Wording "Certification Training Lab:" made it doubtful that these materials would be recognized as a user manual.

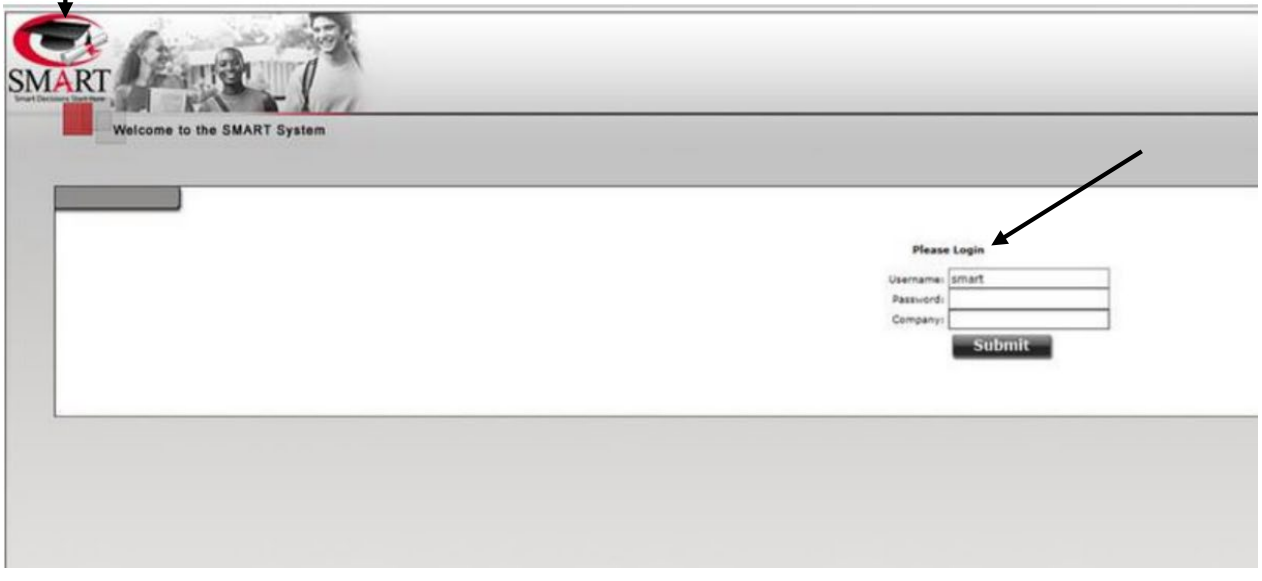
Online non-downloadable software specimens

- Providing temporary use of non-downloadable software is a service.
- Specimens are analyzed form the view point of the purchaser.
- The mark must be shown “in a manner that would be perceived by potential purchasers as identifying the applicant’s services and indicating their source.”

Online non-downloadable software specimens

- Advertising is acceptable if the mark is directly associated with the services.
- Sign-in screens are acceptable specimens if:
  - Display of the mark on the sign-in screen alone sufficient to associate the services with the mark
  - Generally known means of accessing online software
  - Textual description of the software is helpful, but not necessary

Online non-downloadable software specimens – example



URL: https://portal.onlinesmart.net/Login.aspx?ReturnUrl=%2f
Date Accessed: 9/16/2013

Mark:

SMART
Smart Decisions Start Here

Services: Providing temporary use of online non-downloadable software for the management of records, administration and operations for schools and colleges.

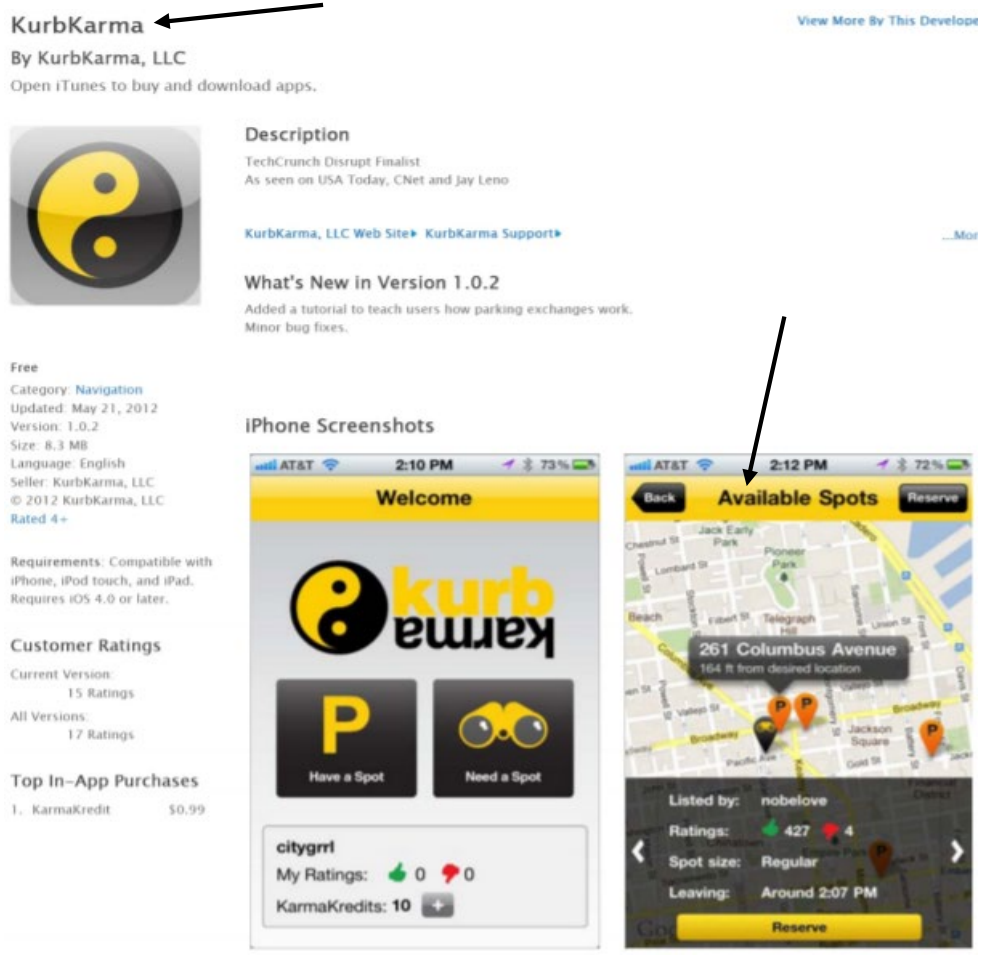
Online non-downloadable software specimens

- Software or services:
  - The primary consideration is whether the specimen indicates that the applicant is actually performing the relevant service activities for others or allows users to perform the activity themselves.

Services accessed via an App

Mark: KURBKARMA

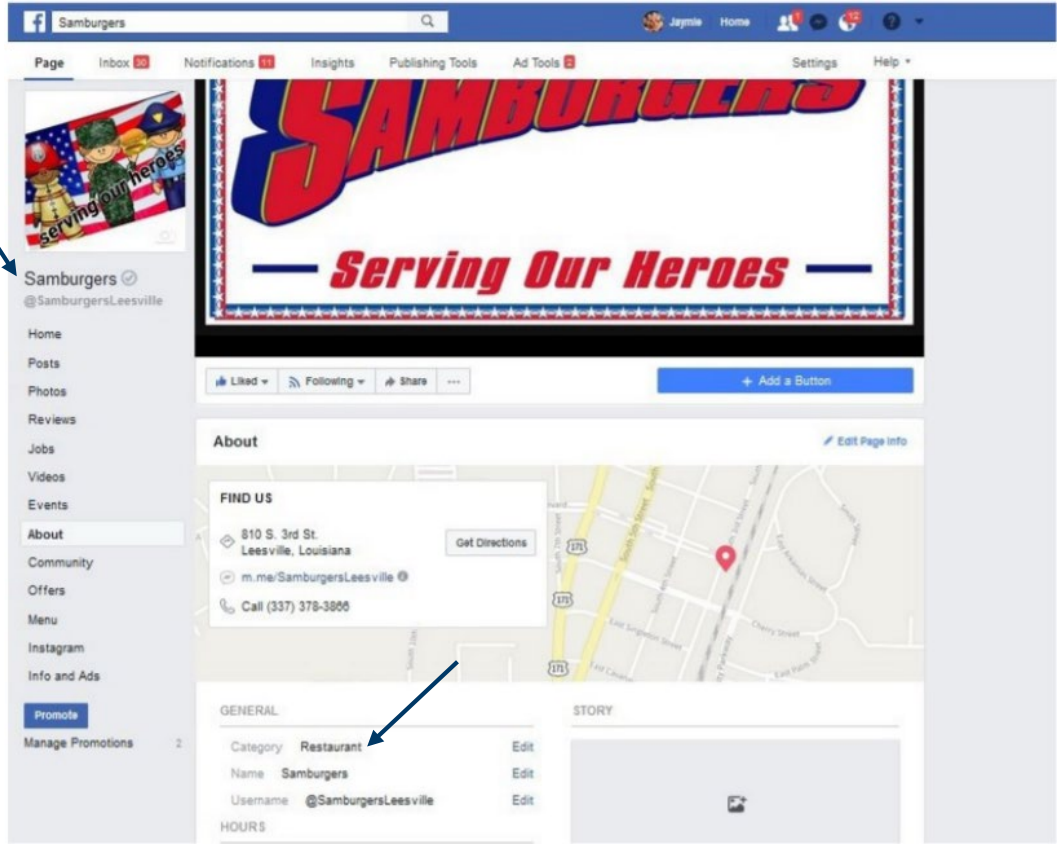
Services: On-line matching services for connecting automobile drivers with other drivers who are, respectively, searching for or departing from parking spaces accessible via a mobile application.



Social media specimens

- Using social media is not the same as providing social media services.
- Social media is usually a means to advertise other goods or services.
- Advertising is not acceptable for goods. Consequently, acceptable social media specimens are usually for services.

Social media specimens



URL: https://www.facebook.com/SamburgersLeesville/
Date Accessed: 7/24/2018

Mark: SAMBURGERS

Services: Fast-food restaurant services

Page displays the mark and associates the mark with the services.

Social media specimens

- Point of sale displays:
  - A page from social media may be accepted for goods, provided the page satisfies the elements of a display specimen. Page must:
    - Contain a picture or textual description of the goods
    - Show the mark in association with the goods
    - Provide means for ordering the identified goods

Specimens not in use in commerce

- Digitally created
- Digitally altered
- Mockup

Such specimens do not show actual use of the mark on or in connection with the goods or services in commerce and registration must be refused under Sections 1 and 45 of the Trademark Act.

Definitions

- Digitally created
  - Digital drawing of a product or packaging on which the mark appears
- Digitally altered
  - Alteration of an existing digital image of a product or packaging, a display associated with the goods, or an advertisement or website
- Mockup
  - Created, typically non-digitally, to show the mark in connection with the goods

Mockups and digitally altered specimens

- Fake specimens present several issues:
  - Fail to show mark as used in commerce
  - Affect integrity of the register
  - Fraud on the USPTO
  - Impact on validity of registration

Examination procedures

- If the specimen shows articulable signs of being digitally altered, created, or a mockup, or the examining attorney finds the identical image without marks or with different marks, the examining attorney must issue:
  - A refusal under Trademark Act Sections 1 and 45 refusal
  - A request for information (RFI) under 37 C.F.R. § 2.61(b)
- In rare circumstances, an RFI may be issued without a refusal.

Request for information under Rule 2.61(b)

- Information that will help examining attorney determine whether the specimen was in use under the statutory definition (and whether there is use in commerce at all):
  - Examples of use in a sales environment for goods or advertising for services
  - Documents showing payment or other consideration for the goods or services (personal or private information redacted)

Applicant's response options

- A properly verified and acceptable substitute specimen with satisfactory answers to the RFI:
  - All questions and requests should be addressed.
  - If no information is available for a particular question or request, then submit a statement to that effect.
  - Redact confidential, personal, or otherwise sensitive information from submitted documents.
- Amendment to assert another basis of Section 1(b) or 44(e)

Tip-offs: digitally created, digitally altered, or mockup

- No depth or surface features or otherwise missing surface features or inappropriate blank spaces
- Drawing of the goods
- Mark does not follow the contours of product or background
- Unrealistic sharp edges
- Floating appearance
- Different level of resolution or sharpness

Tip-offs: digitally created, digitally altered, or mockup

- Different texture from goods
- Odd location or odd wording on the specimen or misspellings
- Use on another party's known, recognizable product
- Questionable information on websites
- Same image used with other marks or no marks
- Incongruous white or other type of border around the mark

Examples

Digitally created label vs. actual packaging

Unacceptable: Label lacks depth, surface features and product information. Effectively only a drawing of the mark

Acceptable: Specimen is a photograph of an actual box with dimension and imperfections associated with an actual box

Digitally created – unrealistic images of the goods

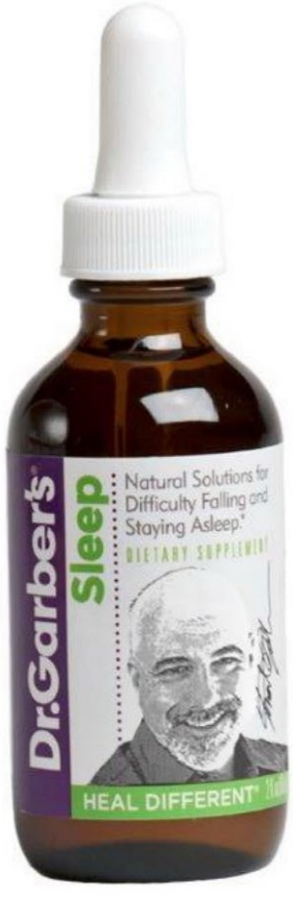
Digitally Altered – mark applied to an existing third party product

Mockup – mark applied to the product in an atypical manner

Poll: Would you refuse?

Mark: Heal Different

Goods: Supplements



Poll: Would you refuse?

Mark: STEALTH

Goods: Golf shoes

Poll: Would you refuse?

Mark: GUIGA

Goods: Knives, forks and spoons

Poll: Would you refuse?

Mark: HEAL DIFFERENT

Goods: Supplements

Poll: Would you refuse?

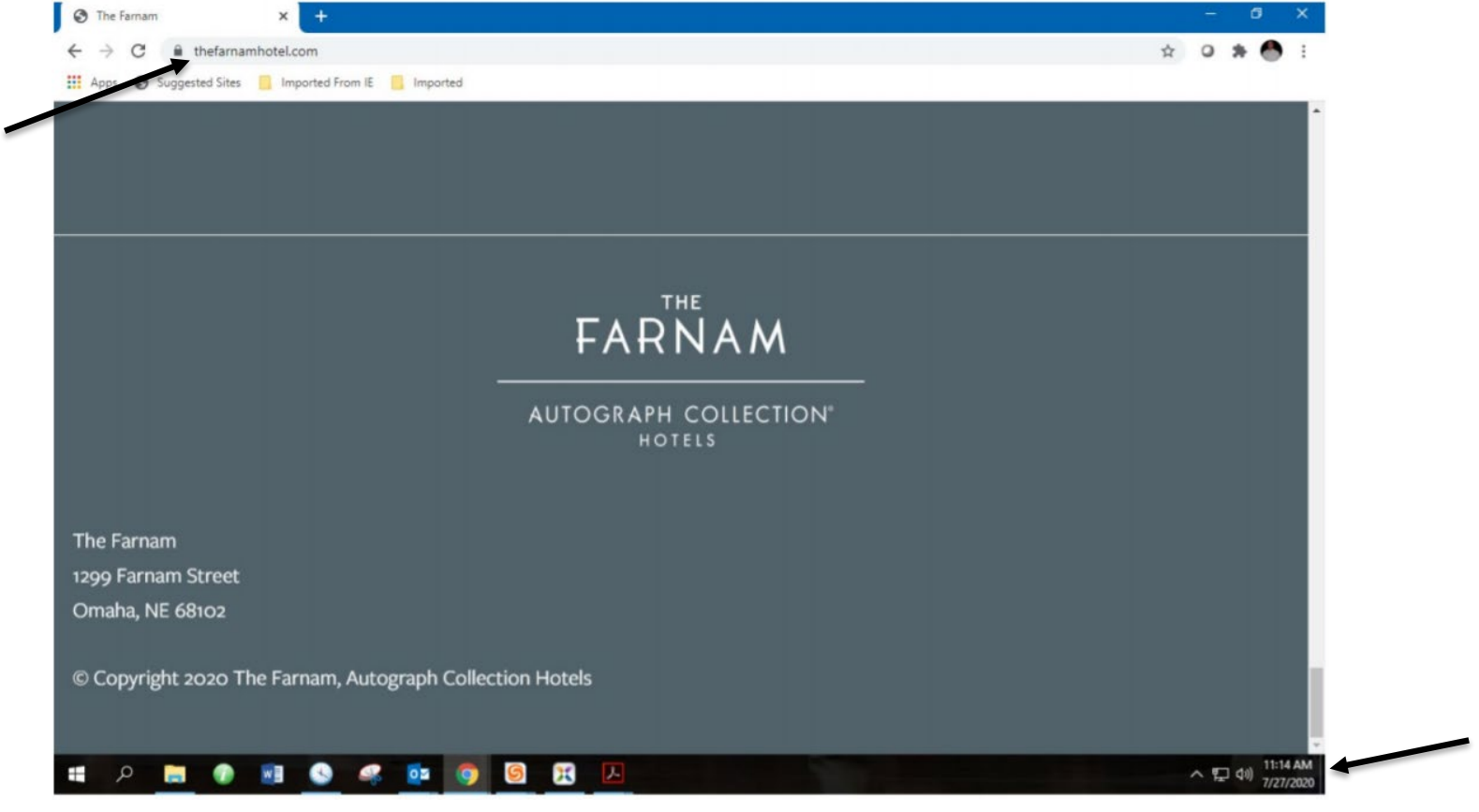
Webpage URL and access date

- A webpage specimen must include the URL and access or print date.
- The URL and access date may be submitted:
  - Directly on the specimen webpage itself
  - Within the electronic form used to submit specimen
  - In a verified statement in a later-filed response

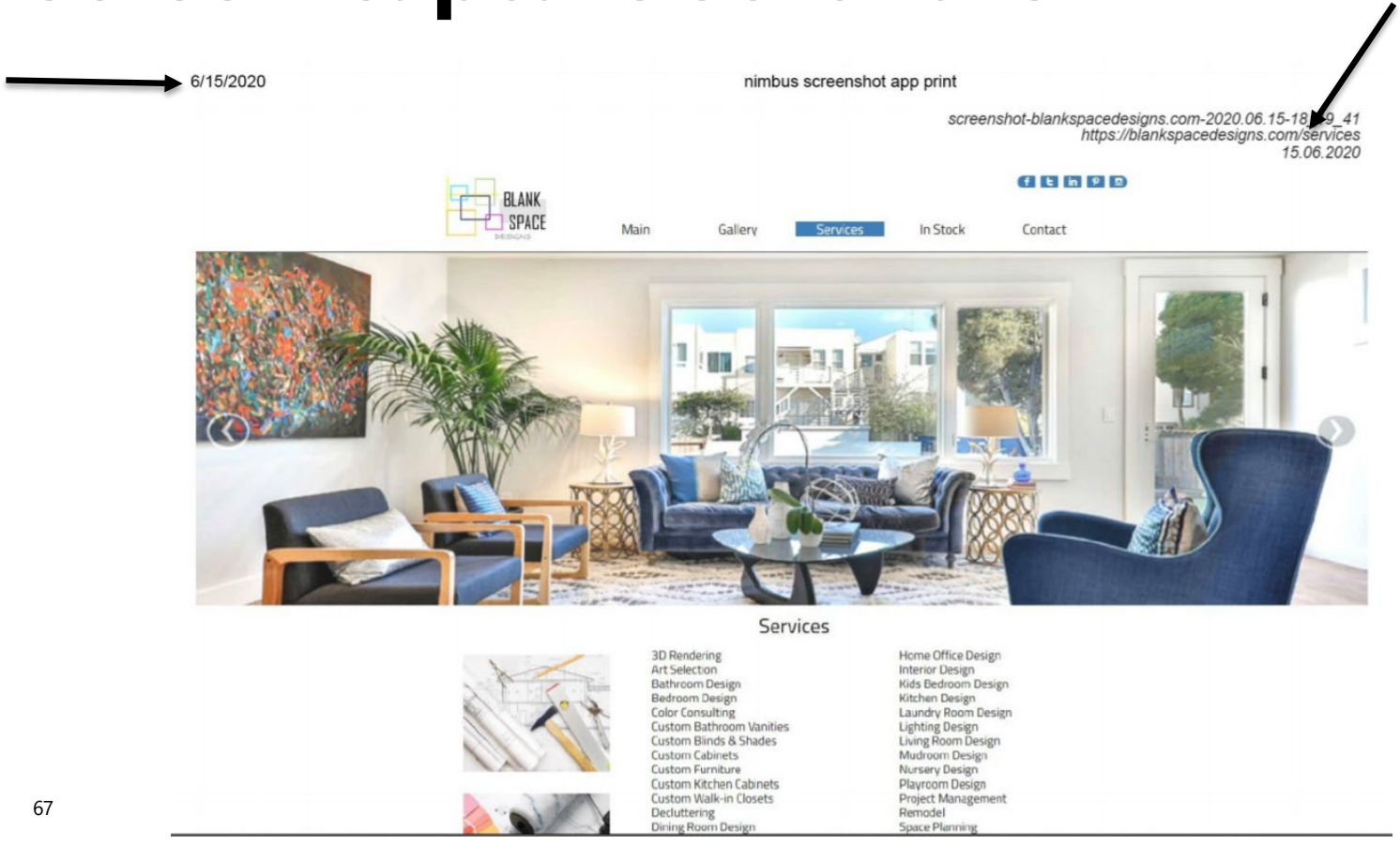
Webpage URL and access date

- Although using the dedicated fields in the electronic filing form is recommended, the URL and access date information may be provided anywhere within the form:
  - specimen description
  - miscellaneous statement
  - arguments

Webpage URL and access date – in the screenshot



Webpage URL and access date – screen-capture software



Webpage URL and access date

Section 1(a), Use in Commerce: The applicant is using the mark in commerce on or in connection with the identified goods/services. The applicant attaches, or will later submit, one specimen as a JPG/PDF image file showing the mark as used in commerce on or in connection with any item in the class of listed goods/services, regardless of whether the mark itself is in the standard character format or is a stylized or design mark. The specimen image file may be in color, and the image must be in color if color is being claimed as a feature of the mark.
NOTE: **The specimen must show the mark as actually used in commerce.** Examples of specimens for goods include tags, labels, instruction manuals, containers, and photographs that show the mark on the actual goods or packaging, or displays associated with the actual goods at their point of sale. Webpages may also be specimens for goods when they include a picture or textual description of the goods associated with the mark and the means to order the goods. Examples of specimens for services include advertising and marketing materials, brochures, photographs of business signage and billboards, and website printouts that show the mark used in the actual sale, rendering, or advertising of the services.
Watch the TMIN Specimen video explaining what is an appropriate trademark or service mark specimen for a good or service.
NOTE: For attachment, the JPG/PDF image file(s) or sound/motion file(s) showing the specimen(s) must be on your local drive.
A specimen should NOT be: (1) the same file used in the mark section; or (2) a newly-created file that shows only the mark by itself. (*Reminder*: Within the earlier mark section, if you attached an image file for a stylized/design mark or a sound/motion file, you must ensure that it only shows the mark by itself, and does not display anything that would not truly be considered part of the actual mark, e.g., a scan of a complete business card would not be an acceptable mark image, although it may be an acceptable specimen).

Remove this 1(a)

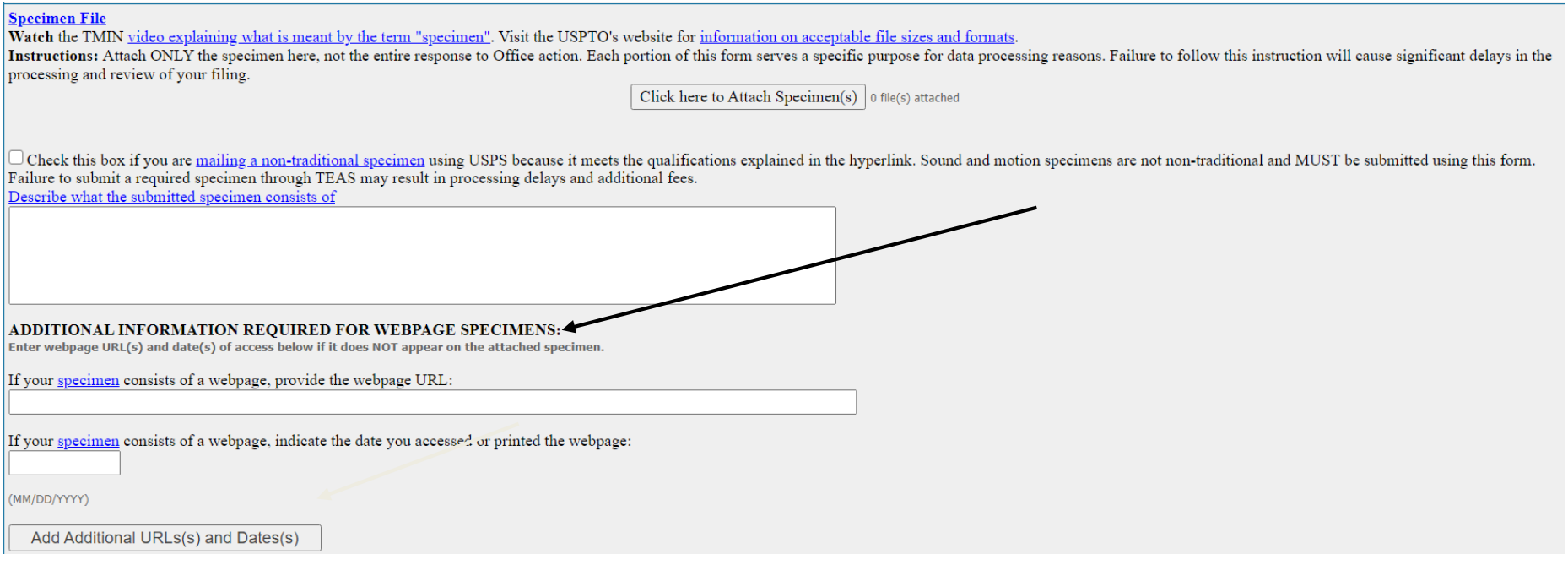
* Attach Specimen	Attach/Remove Specimen ☐ Check this box if you are mailing a non-traditional specimen using USPS because it meets the qualifications explained in the hyperlink. Sound and motion specimens are not non-traditional and MUST be submitted using this TEAS Plus form. Failure to submit a required specimen through TEAS may result in processing delays and additional fees.
Description of Specimen	
Webpage Specimens	If your specimen consists of a webpage, provide the webpage URL: If your specimen consists of a webpage, indicate the date you accessed or printed the webpage: (MM/DD/YYYY)
	Add Additional URLs(s) and Dates(s)
* Date of First Use of Mark Anywhere	By the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as (MM/DD/YYYY)
* Date of First Use of the Mark in Commerce	By the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as (MM/DD/YYYY)

Section 44(d) — Foreign application exists for same goods/services
Section 44(e) — Foreign registration exists for same goods/services

NOTE: To assign the selected filing basis, click on "Assign Filing Basis" button, *below*. If you selected the wrong basis, click on the "Remove this [basis]" button, *above*, and start over. To assign multiple bases, click on another basis button and complete the section (and repeat process again, if appropriate) before clicking on the "Assign Filing Basis" button.

Assign Filing Basis | Exit

Webpage URL and access date



Specimen File

Watch the TMIN video explaining what is meant by the term "specimen". Visit the USPTO's website for information on acceptable file sizes and formats.

Instructions: Attach ONLY the specimen here, not the entire response to Office action. Each portion of this form serves a specific purpose for data processing reasons. Failure to follow this instruction will cause significant delays in the processing and review of your filing.

Click here to Attach Specimen(s) 0 file(s) attached

☐ Check this box if you are mailing a non-traditional specimen using USPS because it meets the qualifications explained in the hyperlink. Sound and motion specimens are not non-traditional and MUST be submitted using this form. Failure to submit a required specimen through TEAS may result in processing delays and additional fees.

Describe what the submitted specimen consists of

ADDITIONAL INFORMATION REQUIRED FOR WEBPAGE SPECIMENS:

Enter webpage URL(s) and date(s) of access below if it does NOT appear on the attached specimen.

If your specimen consists of a webpage, provide the webpage URL:

If your specimen consists of a webpage, indicate the date you accessed or printed the webpage:

(MM/DD/YYYY)

Add Additional URLs(s) and Dates(s)

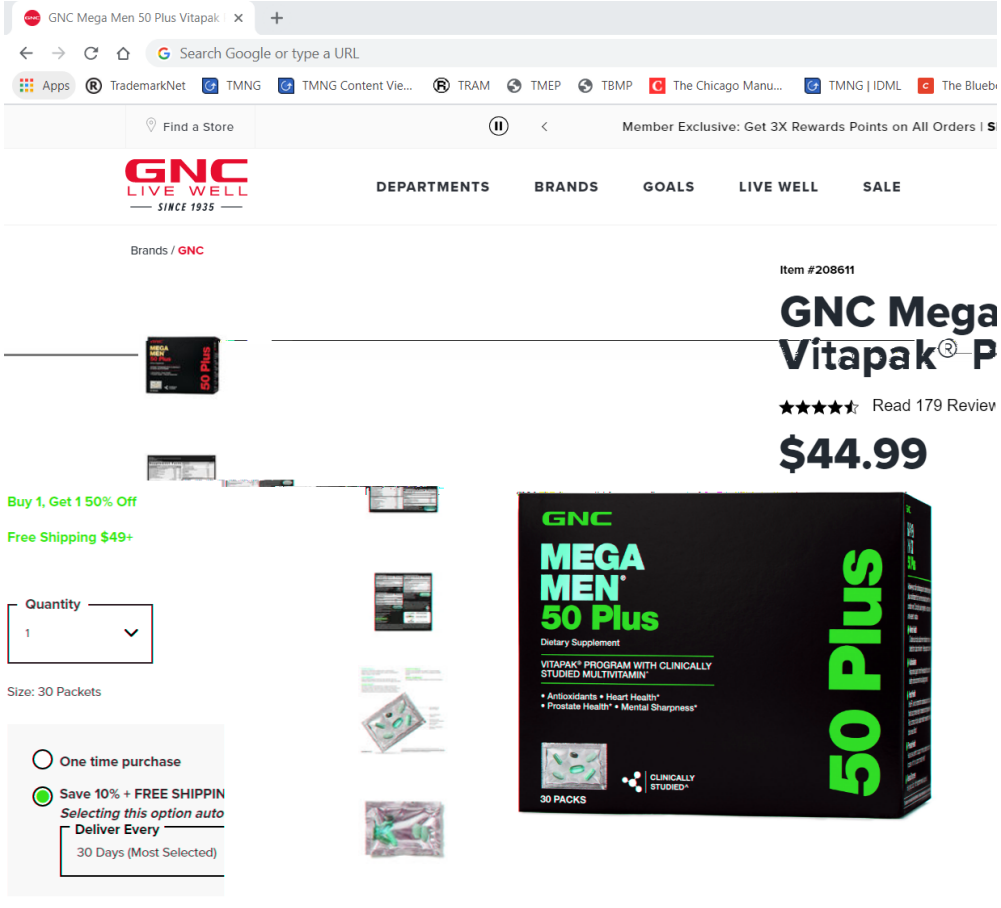
Webpage URL and access date

- If the webpage contains a picture of the goods bearing the mark, the URL and access date are not necessary.
- The picture must be otherwise acceptable as properly showing the mark on the goods.

Webpage URL and access date

Mark: GNC

Goods: Vitamins



Avoiding specimen pitfalls

- Review the client-provided specimen and discuss what it is with the client
- Ask if better specimens are available if what is presented is marginal
- Provide the most legible, clearly acceptable specimen you can up-front

Avoiding specimen pitfalls

- Use entire point of sale display, not a cropped, retouched picture of the goods from a webpage
- Highlight or describe where the mark appears and where the goods or services appear or are referenced

Avoiding specimen pitfalls

- Avoid submitting brochures as specimens for goods.
- Consider providing multiple specimens per class.

Avoiding specimen pitfalls

- Provide a clear and accurate description of each specimen provided, explaining what the specimen shows and its context:
  - Is the specimen a photograph and what does it show?
  - Is the specimen a website excerpt or from printed promotional materials?

Questions?

Please direct to TMPolicy@uspto.gov with the subject line “Specimens CLE presentation.”

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Additional resources and feedback

- Specimens webpage at www.uspto.gov/trademarks/laws/specimen-refusal-and-how-overcome-refusal
- TMEP at tmep.uspto.gov/RDMS/TMEP/current
- General feedback about Trademarks content: TMFeedback@uspto.gov
- Trademarks contact information available at: www.uspto.gov/trademark/contact-trademarks.


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DEPARTMENT OF COMMERCE