

Chapter 900 Use in Commerce

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901 Use in Commerce

In a trademark or service mark application based on use in commerce under §1(a) of the Trademark Act, [15 U.S.C. §1051\(a\)](#), the mark must be in use in commerce on or in connection with all the goods and services listed in the application as of the application filing date. See [37 C.F.R. §§2.2\(k\)\(1\), 2.34\(a\)\(1\)\(i\)](#). The application must include a statement that the mark is in use in commerce, verified in an affidavit or declaration under [37 C.F.R. §2.20](#). See [37 C.F.R. §§2.32\(a\)\(5\), 2.34\(a\)\(1\)\(i\)](#). If this verified statement is not filed with the original application, it must also allege that the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date. [37 C.F.R. §2.34\(a\)\(1\)\(i\)](#). See [TMEP §§804 et seq.](#) regarding verification.

In a trademark or service mark application based on “intent-to-use” under §1(b) of the Trademark Act, [15 U.S.C. §1051\(b\)](#), the applicant typically begins use in commerce after the filing date. The application must include a verified statement that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application as of the application filing date. See [37 C.F.R. §§2.2\(k\)\(1\), 2.32\(a\)\(5\), 2.34\(a\)\(2\)](#). Prior to registration, the applicant must use the mark in commerce on or in connection with all the goods or services specified in the application and file an allegation of use (i.e., either an amendment to allege use under [15 U.S.C. §1051\(c\)](#) or a statement of use under [15 U.S.C. §1051\(d\)](#)). See [37 C.F.R. §§2.72, 2.88; TMEP §902](#).

A §1 applicant must use the mark in commerce even if the applicant asserts §44(d) or §44(e), [15 U.S.C. §1126\(d\)-\(e\)](#), as a second basis for filing. See [TMEP §§806.02 et seq.](#) regarding filing of more than one basis.

Applicants relying *solely* on a foreign registration as the basis for registration under §44(e) of the Trademark Act are not required to assert actual use of the mark prior to registration in the United States. [TMEP §1009](#). See *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909 (TTAB 1984). However, to retain a valid registration, the registrant must file an affidavit or declaration of use of the mark in commerce under [15 U.S.C. §1058](#) at the appropriate times, and establish use in commerce or excusable nonuse. See [TMEP §§1604 et seq.](#) regarding the affidavit or declaration of continued use or excusable nonuse.

Similarly, applicants requesting an extension of protection of an international registration to the United States under §66(a) of the Trademark Act are not required to assert actual use of the mark prior to registration in the United States. However, to retain a valid registration, the registrant must file an affidavit or declaration of use of the mark in commerce under [15 U.S.C. §1141k](#) at the appropriate times, and establish use in commerce or excusable nonuse. See [37 C.F.R. §7.37](#); [TMEP §1613](#).

See [TMEP §1303.01\(a\)\(i\)](#) for use in commerce in a collective trademark or collective service mark application, [TMEP § 1304.02\(a\)\(i\)](#) for use in commerce in a collective membership mark application, and [TMEP §1306.02\(a\)\(i\)](#) for use in commerce in a certification mark application.

901.01 Definitions

The power of the federal government to register marks comes from the commerce clause of the Constitution. Section 1 of the Trademark Act, [15 U.S.C. §1051](#), permits application for registration of “a trademark used in commerce” ([15 U.S.C. §1051\(a\)](#)) or of a trademark that a person has a bona fide intention to use in commerce ([15 U.S.C. §1051\(b\)](#)).

Section 45 of the Trademark Act, [15 U.S.C. §1127](#), defines “commerce” as “all commerce which may lawfully be regulated by Congress.” Section 45 defines “use in commerce” as follows:

The term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this Act, a mark shall be deemed to be in use in commerce--

(1) on goods when—

(A) 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

(B) the goods are sold or transported in commerce, and

(2) 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.

901.02 Bona Fide Use in the Ordinary Course of Trade

The definition of use in commerce ([TMEP §901.01](#)) was amended by the Trademark Law Revision Act of 1988 (TLRA), Public Law 100-667, 102 Stat. 3935, to add the phrase “the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.” The primary purpose of the amendment was to eliminate the practice of “token use,” or use made solely to reserve rights in a mark.

The legislative history of the TLRA makes it clear that the meaning of “use in the ordinary course of trade” will vary from one industry to another. The report of the House Judiciary Committee stated that:

While use made merely to reserve a right in a mark will not meet this standard, the Committee recognizes that “the ordinary course of trade” varies from industry to industry. Thus, for example, it might be in the ordinary course of trade for an industry that sells expensive or seasonal products to make infrequent sales. Similarly, a pharmaceutical company that markets a drug to treat a rare disease will make

correspondingly few sales in the ordinary course of its trade; the company's shipment to clinical investigators during the Federal approval process will also be in its ordinary course of trade....

H.R. Rep. No. 1028, 100th Cong. 2d Sess. 15 (1988).

The report of the Senate Judiciary Committee stated:

The committee intends that the revised definition of “use in commerce” be interpreted flexibly so as to encompass various genuine, but less traditional, trademark uses, such as those made in test markets, infrequent sales of large or expensive items, or ongoing shipments of a new drug to clinical investigators by a company awaiting FDA approval....

S. Rep. No. 515, 100th Cong. 2d Sess. 44-45 (1988). *See also Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1774 n.8 (TTAB 1994), *aff'd*, 108 F.3d 1392 (Fed. Cir. 1997) (Table).

Therefore, some factors to consider when determining compliance with the statutory requirement for a “bona fide use of a mark in the ordinary course of trade” are: (1) the amount of use; (2) the nature or quality of the transaction; and (3) what is typical use within a particular industry. *See Automedx Inc. v. Artivent Corp.*, 95 USPQ2d 1976 (TTAB 2010) (finding sales of demonstration models of portable medical ventilators to military constituted bona fide use of mark in commerce); *see also Clorox Co. v. Salazar*, 108 USPQ2d 1083, 1086 (TTAB 2013) (finding that applicant had not made bona fide use of its mark in commerce, as applicant had not sold or transported goods bearing the mark in commerce as of the application filing date).

901.03 Commerce That May Be Lawfully Regulated By Congress

The scope of federal trademark jurisdiction is commerce that may be regulated by the U.S. Congress. 15 U.S.C. §1127; *see Christian Faith Fellowship Church v. Adidas AG*, 841 F.3d 986, 120 USPQ2d 1640, 1642 (Fed. Cir. 2016) The types of commerce encompassed in this definition are interstate, territorial, and between the United States and a foreign country.

“Territorial commerce” is commerce within a territory of the United States (e.g., Guam, Puerto Rico, American Samoa, or the U.S. Virgin Islands) or between the United States and a territory of the United States.

Intrastate use of a mark may qualify as use in commerce within the meaning of the Act if the intrastate use is of a type that would, taken in the aggregate, have a direct effect on interstate commerce. *See Christian Faith Fellowship Church*, 841 F.3d at ___, 120 USPQ2d at 1645; (finding intrastate sale of two hats to out-of-state customer was “use in commerce” because such a transaction is “quintessentially economic” and, “taken in the aggregate, would cause a substantial effect on interstate commerce”); *Larry Harmon Pictures Corp. v. Williams Rest. Corp.*, 929 F.2d 662, 18 USPQ2d 1292 (Fed. Cir. 1991) (mark used to identify restaurant services rendered at a single-location restaurant serving interstate travelers is in “use in commerce”); *In re Silenus Wines, Inc.*, 557 F.2d 806, 194 USPQ 261 (C.C.P.A. 1977) (intrastate sale of imported wines by importer constitutes “use in commerce,” where goods bearing labels supplied by applicant were shipped to applicant in United States); *In re Gastown, Inc.*, 326 F.2d 780, 140 USPQ 216 (C.C.P.A. 1964) (automotive service station located in one state was rendering services “in commerce” because services were available to customers travelling interstate on federal highways); *U.S. Shoe Corp. v. J. Riggs West, Inc.*, 221 USPQ 1020 (TTAB 1984) (billiard parlor services satisfy the “use in commerce” requirements, where the record showed that applicant’s billiard parlor services were advertised in both Kansas and New

York); *In re G.J. Sherrard Co.*, 150 USPQ 311 (TTAB 1966) (hotel located in only one state has valid use of its service mark in commerce because it has out-of-state guests, has offices in many states, and advertises in national magazines); *In re Federated Dep't Stores, Inc.*, 137 USPQ 670 (TTAB 1963) (mark used to identify retail department store services located in one state was in use in commerce, where the mark was used on credit cards issued to out-of-state residents, and on catalogs and advertisements shipped to out-of-state customers).

In some cases, services such as restaurant and hotel services have been deemed to be rendered in commerce because they are activities that have been found to be within the scope of the 1964 Civil Rights Act, which, like the Trademark Act, is predicated on the commerce clause. See *In re Ponderosa Motor Inns, Inc.*, 156 USPQ 474 (TTAB 1968); *In re Smith Oil Corp.*, 156 USPQ 62 (TTAB 1967).

The term “foreign” is not acceptable to specify the type of commerce in which a mark is used, because it does not clearly indicate that the mark is in use in a type of commerce that the U.S. Congress can lawfully regulate. Unless the “foreign commerce” involves the United States, Congress does not have the power to regulate it. Use of a mark in a foreign country does not give rise to rights in the United States if the goods or services are not sold or rendered in the United States. *Linville v. Rivard*, 41 USPQ2d 1731 (TTAB 1996), *aff'd*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *Aktieselskabet af 21.November 2001 v. Fame Jeans Inc.*, 77 USPQ2d 1861 (TTAB 2006); *Buti v. Impresa Perosa S.R.L.*, 139 F.3d 98, 45 USPQ2d 1985 (2d Cir. 1998); *Mother's Rests. Inc. v. Mother's Bakery, Inc.*, 498 F. Supp. 847, 210 USPQ 207 (W.D.N.Y. 1980); see also *Honda Motor Co., v. Winkelmann*, 90 USPQ2d 1660 (TTAB 2009) (“[T]he evidence that applicant relies upon through its foreign registrations and Internet printouts does not demonstrate trademark use for the claimed goods. Further, these documents do not show that applicant has an intent to use the mark in the United States.”)

Offering services via the Internet has been held to constitute use in commerce, since the services are available to a national and international audience who must use interstate telephone lines to access a website. See *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, 42 USPQ2d 1430 (S.D.N.Y. 1997), *aff'd*, 152 F.3d 920 (2d Cir. 1998) (Table).

An applicant is not required to specify the type of commerce in which the mark is used. The USPTO presumes that an applicant who states that the mark is in use in commerce is stating that the mark is in use in a type of commerce that the U.S. Congress can regulate, unless there is contradictory evidence in the record. See [TMEP §901.04](#) regarding the circumstances where an examining attorney should inquire as to whether the mark is in use in commerce that can be regulated by the U.S. Congress.

901.04 Inquiry Regarding Use in Commerce

It is the responsibility of the applicant and the applicant's attorney to determine whether an assertion of use in commerce is supported by the relevant facts. The validity of an applicant's assertion of use in commerce generally does not arise in ex parte examination. The examining attorney will normally accept the applicant's verified claim of use in commerce without investigation into whether the use referred to constitutes “use in commerce.”

An applicant is not required to specify the type of commerce in which the mark is used. See [TMEP §901.03](#). However, if the applicant specifically states that the mark is in use in commerce that cannot be regulated by the U.S. Congress, the applicant has not met the statutory requirement for a verified statement that the mark is in use in commerce, and a specification of the date of first use in commerce, as defined in §45 of the Trademark Act. Accordingly, the examining attorney must advise the applicant that it appears that the mark is not in use in a type of commerce that can be regulated by the U.S. Congress and must require that

the applicant either submit a verified statement that “the mark is in use in commerce that can be regulated by the U.S. Congress,” or amend the basis of the application to a bona fide intention to use the mark in commerce under §1(b) of the Act, if permitted by [37 C.F.R. §2.35](#). See [TMEP §806.03\(c\)](#) regarding amendment of the basis from §1(a) to §1(b).

If the application record contains evidence or information indicating that the mark may not be in use in commerce that “may lawfully be regulated by Congress,” the examining attorney must ask the applicant whether there is use in commerce that may lawfully be regulated by the U.S. Congress and require a satisfactory explanation or showing of such use. The examining attorney may also require additional information or evidence concerning the use of the mark to permit full consideration of the issue. [37 C.F.R. §2.61\(b\)](#); [TMEP §814](#).

902 Allegations of Use for §1(b) Applications

Section 1(b) of the Trademark Act permits the filing of an application to register a trademark or service mark on the basis of the applicant’s bona fide intention to use the mark in commerce for the identified goods or services. See [37 C.F.R. §§2.2\(l\), 2.32\(a\)\(5\), 2.34\(a\)\(2\)](#). Before a registration will issue, however, the mark must be in actual use in commerce on or in connection with all the goods or services specified in the application and file an allegation of use of the mark in commerce (i.e., either an amendment to allege use under [15 U.S.C. §1051\(c\)](#) or a statement of use under [15 U.S.C. §1051\(d\)](#)) that states that the mark is in use in commerce on or in connection with the goods or services, includes dates of use for each class, and includes one specimen evidencing such use for each class.

See [37 C.F.R. §2.76](#) and [TMEP §§1104](#) *et seq.* regarding amendments to allege use, and [37 C.F.R. §2.88](#) and [TMEP §§1109](#) *et seq.* regarding statements of use.

See [TMEP §1303.01\(a\)\(ii\)](#) regarding an applicant’s bona fide intention to use the mark in commerce for a collective trademark or collective service mark application, [TMEP §1304.02\(a\)\(ii\)](#) regarding an applicant’s bona fide intention to use the mark in commerce for a collective membership mark application, and [TMEP §1306.02\(a\)\(ii\)](#) regarding an applicant’s bona fide intention to use the mark in commerce for a certification mark application.

903 Dates of Use

When asserting use of a mark in commerce in a trademark or service mark application, an applicant must specify the date of first use anywhere and the date of first use in commerce, either in an original application under §1(a) of the Trademark Act (see [37 C.F.R. §2.34\(a\)\(1\)\(ii\)-\(iii\)](#)), or in an allegation of use in an application under §1(b) (see [37 C.F.R. §§2.76\(b\)\(1\)\(iii\), 2.88\(b\)\(1\)\(iii\)](#)). The dates of use must be verified, i.e., supported by an affidavit or declaration under [37 C.F.R. §2.20](#). See [37 C.F.R. §§2.34\(a\)\(1\)\(ii\)-\(iii\), 2.71\(c\)](#). See [TMEP §§804](#) *et seq.* regarding verification.

An applicant filing under §1(b) is not required to state dates of use in the original application, but must include dates of use in an allegation of use under §1(c) or §1(d). See [37 C.F.R. §§2.76\(b\)\(1\)\(iii\), 2.88\(b\)\(1\)\(iii\)](#).

A §1(b) applicant may assert dates of use that are earlier than the filing date of the application in an amendment to allege use or statement of use.

See [TMEP §1303.01\(a\)\(i\)\(B\)](#) regarding dates of use for collective trademarks or collective service marks, [TMEP § 1304.02\(a\)\(i\)\(B\)](#) regarding dates of use for collective membership marks, and [TMEP §1306.02\(a\)\(i\)\(A\)](#) regarding dates of use for certification marks.

903.01 Date of First Use Anywhere

In a trademark or service mark application, the date of first use anywhere is the date when the goods were first sold or transported, or the services were first rendered, under the mark, if such use is bona fide and in the ordinary course of trade. See [15 U.S.C. §1127](#) (definition of “use” within the definition of “abandonment of mark”). For every applicant, whether foreign or domestic, the date of first use of a mark is the date of the first use anywhere, in the United States or elsewhere, regardless of whether the nature of the use was local or national, intrastate or interstate, or of another type.

See [TMEP §1303.01\(a\)\(i\)\(B\)](#) regarding dates of use for collective trademarks or collective service marks, [TMEP §1304.02\(a\)\(i\)\(B\)](#) regarding dates of use for collective membership marks, and [TMEP §1306.02\(a\)\(i\)\(A\)](#) regarding dates of use for certification marks.

903.02 Date of First Use in Commerce

In a trademark or service mark application, the date of first use in commerce is the date when the goods were first sold or transported, or the services were first rendered, under the mark in a type of commerce that may be lawfully regulated by the U.S. Congress, if such use is bona fide and in the ordinary course of trade.

See [15 U.S.C. §1127](#). See [TMEP §901.01](#) for definitions of “commerce” and “use in commerce,” and [TMEP §901.03](#) regarding types of commerce.

In a §1(a) application, the applicant may not specify a date of use that is later than the filing date of the application. If an applicant who filed under §1(a) did not use the mark in commerce on or before the application filing date, the applicant may amend the basis to §1(b). See [37 C.F.R. §2.35\(b\)\(1\)](#). See [TMEP §806.03](#) regarding amendments to the basis.

Neither a date of first use nor a date of first use in commerce is required to receive a filing date in an application based on use in commerce under §1(a) of the Act. If the application does not include a date of first use and/or a date of first use in commerce, the examining attorney must require that the applicant specify the date of first use and/or date of first use in commerce. See [37 C.F.R. §2.34\(a\)\(1\)\(ii\)-\(iii\)](#). The dates must be supported by an affidavit or declaration under [37 C.F.R. §2.20](#). See [37 C.F.R. §§2.34\(a\)\(1\)\(ii\)-\(iii\), 2.71\(c\)](#).

An applicant may not file an application on the basis of use of a mark in commerce if such use has been discontinued.

See [TMEP §1303.01\(a\)\(i\)\(B\)](#) regarding dates of use for collective trademarks or collective service marks, [TMEP §1304.02\(a\)\(i\)\(B\)](#) regarding dates of use for collective membership marks, and [TMEP §1306.02\(a\)\(i\)\(A\)](#) regarding dates of use for certification marks.

903.03 Relation Between the Two Dates of Use

The application or allegation of use must specify both the date of first use anywhere and the date of first use in commerce. If the date of first use anywhere was also in a type of commerce that may be regulated

by the U.S. Congress (*see* [TMEP §901.03](#), the date of first use and the date of first use in commerce will be the same date.

The date of first use anywhere will always be either earlier than or the same as the date of first use in commerce. If the date of first use anywhere specified in an application or allegation of use is later than the date of first use in commerce, the examining attorney must require clarification. *See* [37 C.F.R. §2.61\(b\)](#).

The requirement that an applicant specify the date of first use anywhere as well as the date of first use in commerce applies to all applicants, including foreign applicants, in applications filed under §1(a) or §1(b) of the Act. *In re Sevi S.p.A.*, 1 USPQ2d 1671, 1671 (TTAB 1986).

903.04 Amending Dates of Use

Any change to the dates of use must be supported by an affidavit or declaration under [37 C.F.R. §2.20](#), [37 C.F.R. §2.71\(c\)](#). The affidavit or declaration must be signed by someone properly authorized to sign on behalf of the applicant under [37 C.F.R. §2.193\(e\)\(1\)](#). *See* [TMEP §611.03\(a\)](#). In addition, because a §1(a)-based application must properly allege *current* use of the mark, an applicant must attest to dates of use that are on or before the date such application was signed; an applicant may not allege use that has not yet occurred. *See* [37 C.F.R. §2.33\(b\)\(1\)](#). Likewise, the dates of use specified in an allegation of use under §1(c) or §1(d) must be on or before the date the allegation of use was signed. *See* [37 C.F.R. §§2.76\(b\)\(1\)\(ii\)](#), [2.88\(b\)\(1\)\(ii\)](#); *see also* [TMEP §903.06\(a\)](#) (noting that, when a date of first use would be interpreted under [TMEP §903.06](#) as later than the date on which the application or allegation of use was signed, the USPTO will presume that the date of first use is the date on which applicant signed the application or allegation of use).

In an application under §1(a), the applicant may amend the dates of use to adopt a date of use that is earlier than the date originally stated or later than the date originally stated, but on or before the application filing date. The applicant may not amend to specify a date of use that is later than the filing date of the application. [37 C.F.R. §2.71\(c\)\(1\)](#). If an applicant who filed under §1(a) did not use the mark in commerce on or before the application filing date, the applicant may amend the basis to §1(b). *See* [37 C.F.R. §2.35\(b\)\(1\)](#). *See* [TMEP §806.03](#) regarding amendments to the basis.

Example 1: Section 1(a) application filing date: March 9, 2015

First use anywhere: March 6, 2015

First use in commerce: March 6, 2015

Signature date: March 5, 2015

This sequence requires amendment because although the specified dates of use in this example are prior to the filing date, they are after the signature date.

If the specified dates of use in this example are correct, the applicant must resubmit the alleged use dates, verified with an affidavit or signed declaration under [37 C.F.R. §2.20](#).

If the specified dates of use in this example are incorrect, but the correct dates of use are on or before the application filing date, the applicant must provide the correct dates, verified with an affidavit or signed declaration under [37 C.F.R. §2.20](#).

If the specified dates of use in this example are incorrect and the mark was not in use in commerce on or before the application filing date, the applicant may amend the filing basis to §1(b), if the applicant can

satisfy the requirements for the new basis. If the filing basis is amended to §1(b), a registration may not issue until the applicant files an allegation of use. [TMEP §1103](#).

If the signature date is incorrect in this example and the application was signed on or after the dates of use, the applicant may resolve the discrepancy by specifying the correct signature date.

Example 2: Section 1(a) application filing date: March 9, 2015

First use anywhere: March 12, 2015

First use in commerce: March 12, 2015

Signature date: March 9, 2015

This sequence requires amendment because the specified dates of use in this example are after both the filing date and the signature date.

If the mark in this example was in use in commerce on or before the application filing date, the applicant must amend the dates of use to specify the correct dates, verified with an affidavit or signed declaration under [37 C.F.R. §2.20](#).

If the mark in this example was not in use in commerce on or before the application filing date, the applicant may amend the filing basis to “intent to use” under §1(b), if the applicant can satisfy the requirements for the new basis. If the filing basis is amended to §1(b), a registration may not issue until the applicant files an allegation of use. [TMEP §1103](#).

In an application under §1(b), after the applicant files an amendment to allege use, the applicant may not subsequently amend the dates of use to recite dates of use that are later than the filing of the amendment to allege use. If a §1(b) applicant did not use the mark in commerce before the filing date of the amendment to allege use, the applicant may withdraw the amendment to allege use before the application is approved for publication. [37 C.F.R. §2.76\(f\)](#); *see* [TMEP §§1104.10\(b\)\(iv\)](#), [1104.11](#).

Example 1: Amendment to allege use filed on March 9, 2015

First use anywhere: March 6, 2015

First use in commerce: March 6, 2015

Signature date: March 5, 2015

The sequence requires amendment because although the specified dates of use in this example are prior to the date on which the amendment to allege use was filed, they are after the signature date.

If the specified dates of use in this example are correct, the applicant must resubmit the alleged use dates, verified with an affidavit or signed declaration under [37 C.F.R. §2.20](#).

If the specified dates of use in this example are incorrect, but the correct dates of use are on or before the dates on which the amendment to allege use was filed, the applicant must provide the correct dates, verified with an affidavit or signed declaration under [37 C.F.R. §2.20](#).

If the specified dates of use in this example are incorrect and the mark was not in use in commerce on or before the date on which the amendment to allege use was filed, the applicant may request to withdraw the amendment to allege use. If the amendment to allege use is withdrawn, registration may not be granted until the applicant subsequently files an acceptable allegation of use. [TMEP §1103](#).

If the date of the signature in this example is incorrect and the amendment to allege use was signed on or after the dates of use, the applicant may resolve the discrepancy by specifying the correct signature date.

Example 2: Amendment to allege use filed on March 9, 2015

First use anywhere: March 12, 2015

First use in commerce: March 12, 2015

Signature date: March 9, 2015

This sequence requires amendment because the specified dates of use in this example are after the dates on which the amendment to allege use was signed and filed.

If the mark in this example was in use in commerce on or before the date on which the amendment to allege use was filed, applicant must amend the dates of use to specify the correct dates, verified with an affidavit or signed declaration under [37 C.F.R. §2.20](#).

If the mark in this example was not in use in commerce on or before the date on which the amendment to allege use was filed, the applicant may request to withdraw the amendment to allege use. If the amendment to allege use is withdrawn, registration may not be granted until the applicant subsequently files an acceptable allegation of use. [TMEP §1103](#).

In an application under §1(b), after the applicant files a statement of use, the applicant may not amend the dates of use to dates that are later than the expiration of the statutory deadline for filing a statement of use (i.e., the amended dates must be within six months of the issuance date of the notice of allowance or before the expiration of an extension of time for filing a statement of use). [37 C.F.R. §2.71\(c\)\(2\)](#). If the mark in a §1(b) application was not in use in commerce before the expiration of the deadline for filing a statement of use, the application will be abandoned; the applicant may *not* withdraw the statement of use or otherwise amend the application back to intent to use under §1(b). [37 C.F.R. §§2.88\(f\), \(k\)](#); [TMEP §1109.17](#).

Example 1: Statement of use filed on March 9, 2015

First use anywhere: March 6, 2015

First use in commerce: March 6, 2015

Signature date: March 5, 2015

Statutory deadline for filing statement of use: May 15, 2015

This sequence requires amendment because although the specified dates of use in this example are prior to the date on which the statement use was filed and prior to the statutory deadline for filing a statement of use, they are after the signature date.

If the specified dates of use in this example are correct, the applicant must resubmit the alleged use dates, verified with an affidavit or signed declaration under [37 C.F.R. §2.20](#).

If the specified dates of use in this example are incorrect, but the correct dates of use are prior to the expiration of the deadline for filing a statement of use, the applicant must provide the correct dates, verified with an affidavit or signed declaration under [37 C.F.R. §2.20](#).

If the specified dates of use in this example are incorrect and the mark was not in use in commerce before the expiration of the time allowed for filing a statement of use, the application will be abandoned. The applicant may not withdraw the statement of use or amend the application back to intent to use under §1(b) (i.e., based on a bona fide intent to use the mark).

Example 2: Statement of use filed on March 9, 2015

First use anywhere: March 12, 2015

First use in commerce: March 12, 2015

Signature date: March 9, 2015

Statutory deadline for filing statement of use: May 15, 2015

This sequence requires amendment because although the specified dates of use in this example are prior to the statutory deadline for filing a statement of use, they are after the date on which the statement of use was signed and filed.

If the specified dates of use in this example are correct, the applicant must resubmit the alleged use dates, verified with an affidavit or signed declaration under [37 C.F.R. §2.20](#).

If the specified dates of use in this example are incorrect, but the correct dates of use are prior to the expiration of the deadline for filing a statement of use, the applicant must provide the correct dates, verified with an affidavit or signed declaration under [37 C.F.R. §2.20](#).

If the specified dates of use in this example are incorrect and the mark was not in use in commerce before the expiration of the time allowed for filing a statement of use, the application will be abandoned. The applicant may not withdraw the statement of use or amend the application back to intent to use under §1(b) (i.e., based on a bona fide intent to use the mark).

Example 3: Statement of use filed on March 9, 2015

First use anywhere: March 12, 2015

First use in commerce: March 12, 2015

Signature date: March 9, 2015

Statutory deadline for filing statement of use: March 10, 2015

This sequence requires amendment because the specified dates of use are after the date on which the statement of use was signed and filed, and after the statutory deadline for filing a statement of use.

If the specified dates of use in this example are incorrect and the mark was in use in commerce before the expiration of the time allowed for filing a statement of use, the applicant must amend the dates of use to specify the correct dates, verified with an affidavit or signed declaration under [37 C.F.R. §2.20](#).

If the mark in this example was not in use in commerce before the expiration of the time allowed for filing a statement of use, the application will be abandoned. The applicant may not withdraw the statement of use or amend the application back to intent to use under §1(b) (i.e., based on a bona fide intent to use the mark).

A §1(a) multiple-class application must include dates of use for each class. *See* [37 C.F.R. §2.86\(a\)\(3\)](#), [\(b\)\(3\)](#); [TMEP §1403.01](#). If a single-class application containing dates of use is amended to a multiple-class application, the dates-of-use clause must be amended to reflect dates of use for each class. *See* [37 C.F.R. §2.86\(a\)\(3\)](#), [\(b\)\(3\)](#); [TMEP §1403.01](#). If a single-class application is amended to a multiple-class application, but the applicant does not set forth dates of use for the added classes, the examining attorney must inquire as to whether the dates of use apply to all classes and require an amendment, if appropriate. A supporting affidavit or declaration is not necessary if the dates of use in the original application or in an earlier-filed allegation of use apply to all classes.

A supporting affidavit or declaration is required for any *change* to the dates of use. [37 C.F.R. §2.71\(c\)](#). However, if the applicant has properly verified the date of first use in commerce and, for whatever reason, seeks to amend the date of first use anywhere to the same date as the date of first use in commerce, a verified statement is not required if the originally specified date of first use anywhere is *earlier* than the date of first use in commerce. This is not considered a *change* to the dates of use, because the applicant has already sworn to a date of first use in commerce that necessarily requires, and logically includes, use of the mark “anywhere.” Thus, the applicant has, in fact, already verified in its original application or allegation of use

that the date of first use of the mark anywhere is at least as early as the date of first use of the mark in commerce. Such an amendment may be entered by examiner's amendment.

When the date of first use anywhere is *later* than the date of first use in commerce, an unverified amendment is inappropriate because the validity of the verification is called into question by the impossibility of first use anywhere being later than the first use in commerce.

Example 1: First use anywhere: March 6, 1985
First use in commerce: February 10, 1985

An amendment of the date of first use anywhere to February 10, 1985, must be verified, because the validity of the date of first use in commerce is called into question by the fact that the applicant has specified a later date of first use anywhere.

Example 2: First use anywhere: March 6, 1985
First use in commerce: April 10, 1985

An unverified amendment of the date of first use anywhere to April 10, 1985, is acceptable, because first use in commerce logically includes use anywhere.

Example 3: First use anywhere: March 1985
First use in commerce: March 10, 1985

An unverified amendment of the date of first use anywhere to March 10, 1985, is acceptable because the information in the record is not contradictory on its face. There is only an apparent contradiction resulting from the way in which the USPTO construes the information when an applicant provides only the month and year (i.e., as indicating the last day of the month - see [TMEP §903.06](#) regarding indefinite dates of use).

This policy is not applicable to the converse. That is, an amendment to the date of first use in commerce to conform to the date of first use anywhere is a *change* (because first use anywhere does not necessarily include first use in commerce) and must be verified with an affidavit or signed declaration under [37 C.F.R. §2.20](#).

903.05 First Use by Predecessor or Related Company

If the first use anywhere or the first use in commerce was by a predecessor in title to the applicant, or by a related company of the applicant (see [15 U.S.C. §§1055](#), 1127), and the use inures to the benefit of the applicant, the dates of first use may specify that the use on this date was by the applicant's predecessor in title, or by a related company of the applicant, as the case may be. See [37 C.F.R. §2.38\(a\)](#). It is generally not necessary to give the name of the predecessor in title or the related company.

See [TMEP §§1201.03–1201.03\(e\)](#) regarding current use by a party other than the applicant.

903.06 Indefinite Dates of Use

In specifying the dates of first use, the applicant should provide dates that are as definite as possible.

The only date that will be recognized for USPTO proceedings is the latest definite date specified by the applicant. However, the applicant may use indefinite terms in describing dates if the applicant considers it necessary due to uncertainty as to the particular date. Although terms such as “at least as early as,” “prior

to,” “before,” “on or about,” and “in” are acceptable for the record, these terms are not printed in the *Official Gazette* or on the certificate of registration.

When a month and year are given without a specified day, the date presumed for purposes of examination is the last day of the month. When only a year is given, the date presumed for purposes of examination is the last day of the year. Some examples are as follows:

- “Prior to January 1, 1955” is treated as December 31, 1954.
- “Before February 1961” is treated as January 31, 1961.
- “On or about June 18, 1987” is treated as June 18, 1987.
- “1990” is treated as December 31, 1990.
- “In November 1991” is treated as November 30, 1991.
- “In the 1920s” is treated as December 31, 1929.

When an applicant alleges only a year prefaced by vague or ambiguous language such as “in the Spring of,” the USPTO will construe the date as the last day of that year, unless the applicant amends to specify a particular date or a particular month of the specified year.

When an applicant’s date of first use in commerce is more specific than its date of first use anywhere, the above presumption can result in an unacceptable dates-of-use clause in which the date of first use in commerce precedes the date of first use anywhere. For example:

First use anywhere: 1991

First use in commerce: January 15, 1991

Usual presumption of first use anywhere: December 31, 1991 (which results in a logical inconsistency).

Therefore, when the above presumption would be applicable, and the result is a date of first use in commerce that precedes the date of first use anywhere, the examining attorney must contact the applicant by telephone or e-mail, if appropriate, for authorization to amend the date of first use anywhere to the same date as the date of the first use in commerce. This may be done by examiner’s amendment.

Indefinite phraseology of the type described above is not considered to be misleading, because it does give notice that, when called upon to do so, the applicant may undertake to prove a date earlier than the one stated.

The presumed dates discussed above are *not* entered into the automated records of the USPTO, or printed in the *Official Gazette* or on the certificate of registration. Instead, only the information provided by the applicant is printed. Thus, if the applicant states that the mark was first used “at least as early as January of 1994,” the date printed is “1/0/1994.” If applicant states that the mark was first used “sometime in 1965,” the date printed is “0/0/1965.”

In an inter partes proceeding, a date of use must be established by appropriate evidence. A date of use set forth in an application or registration owned by applicant or registrant is not evidence on behalf of that applicant or registrant. [37 C.F.R. §2.122\(b\)\(2\)](#); *Trademark Trial and Appeal Board Manual of Procedure* (“TBMP”) [§704.04](#).

See [TMEP §903.06\(a\)](#) regarding apparent discrepancies between dates of use and execution dates.

903.06(a) Apparent Discrepancies Between Dates of Use and Date of Execution

Because an application based on §1(a) or an allegation of use under §1(c) or §1(d) must properly allege current use of the mark, an applicant must attest to dates of use in the application or allegation of use that are on or before the date the application or allegation of use was signed; an applicant may not allege use that has not yet occurred. See [37 C.F.R. §§2.33\(b\)\(1\), 2.76\(b\)\(1\)\(ii\), 2.88\(b\)\(1\)\(ii\)](#); [TMEP §§903.04, 1109.09\(a\)](#).

If an application, or an allegation of use under §1(c) or §1(d), specifies a date of first use only by the year, or by the month and the year, and the date would otherwise be interpreted under [TMEP §903.06](#) as later than the date on which the application or allegation of use was *signed*, the USPTO will presume that the date of first use is the date on which applicant signed the application or allegation of use. For example:

Filing date: January 15, 2015

Signature date: December 27, 2014

First use anywhere: 2014

Presumption of first use anywhere under §903.06: December 31, 2014

Amendment to clarify first use date is not required: Although the presumed date of first use under [TMEP § 903.06](#) (December 31, 2014) is later than the signature date (December 27, 2014), it is not later than the filing date (January 15, 2015). Thus, under [TMEP § 903.06\(a\)](#), the examining attorney may presume that the use date is the same as the date of signature.

However, if the date of first use would be interpreted under [TMEP § 903.06](#) as later than the *filing date* of the application or allegation of use, then amendment of the date of use to an earlier date, supported by an affidavit or declaration under [37 C.F.R. §2.20](#), is still required. For example:

Filing date: January 15, 2015

Signature date: December 27, 2014

First use anywhere: 2015

Presumption of first use anywhere under §903.06: December 31, 2015

Amendment to clarify first use date is required: The presumed date of first use under [TMEP § 903.06](#) (December 31, 2015) is later than the filing date (January 15, 2015). Thus, under [TMEP § 903.06\(a\)](#), the examining attorney may not presume that the use date is the date of signature and must require an amendment to indicate the date of use more specifically.

If an application or allegation of use specifies the date of signature only by the year, or by the month and the year, and the date would be interpreted under [TMEP §903.06](#) as later than the date(s) of first use, the USPTO will presume that the date of signature was on or after the date of first use.

903.07 Dates of Use in Another Form

If the mark in the application is a composite mark, the applicant may specify dates of first use of a separable element of the composite mark. These dates will be printed on the certificate of registration for general information. However, the applicant must also specify the dates of first use of the entire composite mark for which registration is being sought.

903.08 More than One Item of Goods or Services

If more than one item of goods or services is specified in a particular class, the date of first use anywhere and date of first use in commerce do not have to pertain to every item in the class. It might be that the mark, although in use on all of the items at the time the application or allegation of use was filed, was first used on various items on differing dates, so that it would be cumbersome to designate the dates for all items individually. See *Sunshine Biscuits, Inc. v. Berke Bakeries, Inc.*, 106 USPQ 222 (PTO 1955); *Ex parte Wayne Pump Co.*, 88 USPQ 437 (PTO 1951).

There must be at least one item in a class to which the specified dates pertain. See [37 C.F.R. §§2.34\(a\)\(1\)\(v\)](#), [2.44\(a\)\(4\)\(i\)\(B\)](#), [2.45\(a\)\(4\)\(i\)\(D\)](#). Where the dates of use do not pertain to all items, the applicant should designate the particular item(s) to which they do pertain.

Where the dates of use do not pertain to every item in the class, and the identification of goods or services is amended to delete the item(s) to which the dates of use pertain, the applicant must amend the dates-of-use clause to specify the dates that apply to an item that remains in the identification. See [TMEP §903.04](#) regarding amendments to dates of use.

If more than one item of goods or services is specified in a particular class, the USPTO will presume that the dates of use apply to all the goods or services, unless the applicant states otherwise.

Where more than one date is specified for a particular class, the earliest date will be printed in the *Official Gazette* and, if a registration issues, on the certificate of registration. The *Official Gazette* and registration certificate will not indicate which item is specified.

See [TMEP §1304.02\(a\)\(i\)\(B\)](#) regarding dates of use for collective membership marks.

904 Specimens

Specimens are required because they show the manner in which the mark is seen by the public. Specimens also provide supporting evidence of facts recited in the application.

A trademark or service mark application for registration under §1(a) of the Trademark Act must include one specimen for each class, showing use of the mark in commerce on or in connection with the goods, or in the sale or advertising of the services. [15 U.S.C. §1051\(a\)\(1\)](#); [37 C.F.R. §§2.34\(a\)\(1\)\(iv\)](#), [2.56\(a\)](#). If an application under §1(a) is filed without a specimen, the examining attorney must issue an Office action requiring the applicant to submit one specimen for each class, with an affidavit or declaration under [37 C.F.R. §2.20](#) stating that the specimen was in use in commerce at least as early as the filing date of the application.

See [37 C.F.R. §2.59\(a\)](#). The Office action must also indicate registration is refused under §§1 and 45 of the Trademark Act because the applicant has not provided evidence of use of the mark in commerce. See [15 U.S.C. §§1051\(a\)\(1\)](#), [1127](#); [37 C.F.R. §§2.34\(a\)\(1\)\(iv\)](#), [2.56\(a\)](#).

In examining a specimen filed with an application under [15 U.S.C. §1051\(a\)](#), an amendment to allege use under [15 U.S.C. §1051\(c\)](#), or a statement of use under [15 U.S.C. §1051\(d\)](#), the examining attorney must refuse registration if the specimen indicates that the goods have not been “sold or transported in commerce.” [15 U.S.C. §1127](#). For example, a webpage for placing pre-sale orders for goods that are not yet available does not show use of the mark in commerce in connection with the goods, even if it otherwise meets the requirements for an acceptable display associated with the goods. See *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 991-92 (TTAB 1982) (finding that the goods to be identified by the mark must

be in existence at the time of a sale); *cf.* *Aycock Eng'g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 1360, 90 USPQ2d 1301, 1308 (Fed. Cir. 2009) (holding that actual use of the mark in commerce in connection with an existing service is required and that mere preparations to use a mark sometime in the future does not constitute use in commerce); *In re Port Auth. of N.Y.*, 3 USPQ2d 1453, 1455 (TTAB 1987) (finding advertising and promoting telecommunications services before the services were available insufficient to support registration); *In re Cedar Point, Inc.*, 220 USPQ 533, 535-37 (TTAB 1983) (holding that advertising of a marine entertainment park, which was not yet open, was not a valid basis for registration); *In re Nationwide Mut. Ins. Co.*, 124 USPQ 465 (TTAB 1960) (holding that stickers placed on policies, bills, and letters announcing prospective name change is mere adoption, not service mark use). See [TMEP §1301.03](#) regarding use of a service mark in commerce. The Office action must indicate that registration is refused under §§1 and 45 of the Trademark Act because the applicant has not provided evidence of use of the mark in commerce for the identified goods. See [15 U.S.C. §§1051\(a\)\(1\), 1127](#); [37 C.F.R. §§2.34\(a\)\(1\)\(iv\), 2.56\(a\)](#).

In an application for registration under §1(b) of the Trademark Act, no specimen is required at the time the application is filed. However, before a registration will issue, the applicant must file an allegation of use that includes one specimen for each class, showing use of the mark in commerce on or in connection with the goods or in the sale or advertising of the services. See [37 C.F.R. §§2.56\(a\), 2.76\(b\)\(2\), 2.88\(b\)\(2\)](#).

No specimen showing use of the mark in commerce is required in an application based solely on §44 or §66(a) of the Trademark Act, [15 U.S.C. §§1126\(d\)-\(e\), 1141f\(a\)](#). While a §44 or §66(a) applicant must assert a bona fide intent to use the mark in commerce, the applicant is not required to assert actual use in commerce prior to registration. *Crocker Nat'l Bank v. Canadian Imperial Bank of Com.*, 223 USPQ 909 (TTAB 1984); [TMEP §§1009, 1904.01\(d\)](#).

If the nature of a specimen is unclear, the applicant must explain what it is and how it is used.

A photocopy or reproduction of the drawing is not an acceptable specimen. [37 C.F.R. §2.56\(c\)](#).

Specimens of value should not be filed.

Interested parties, including potential opposers, may view and print images of the specimens in an application or registration file through the Trademark Status and Document Retrieval ("TSDR") portal on the USPTO website at <http://tsdr.uspto.gov/>. The USPTO does not permit specimens to be removed from the record.

Furthermore, once filed, specimens remain part of the record and will not be returned to the applicant. [37 C.F.R. §2.25](#). This ensures that there is a complete record of the submissions made by the applicant. See [64 Fed. Reg. 48900](#), 48901 (Sept. 8, 1999), 1226 TMOG 103 (Sept. 28, 1999); see also [TMEP §404](#).

For information regarding specimens for collective trademarks and collective service marks, see [TMEP §1303.01\(a\)\(i\)\(C\)](#); for collective membership marks, see [TMEP §1304.02\(a\)\(i\)\(C\)](#); and for certification marks, see [TMEP §§1306.02\(a\)\(i\)\(B\), 1306.04\(c\)-\(d\)](#).

904.01 Number of Specimens

One specimen for each class is required in an application for registration under §1(a) of the Trademark Act, or in an allegation of use in an application under §1(b). If a single specimen supports multiple classes, the applicant should indicate which classes are supported by the specimen. The examining attorney need not require multiple copies of the specimen. The examining attorney should enter a Note to the File in the record indicating which class(es) the specimen supports.

904.01(a) More than One Item Specified in a Class

Generally, if more than one item of goods, or more than one service, is specified in one class in an application, it is usually not necessary to have a specimen for each product or service. When the range of items is wide or contains unrelated articles, the examining attorney may request additional specimen(s) under [37 C.F.R. §2.61\(b\)](#).

If the goods are a “full line of pharmaceuticals,” however, the examining attorney must require the applicant to provide evidence that it uses the mark in connection with pharmaceuticals to treat diseases or health problems in all chapters in the World Health Organization (“WHO”) International Statistical Classification of Diseases and Related Health Problems. See [37 C.F.R. §2.61\(b\)](#).

See [TMEP §1402.03](#) regarding broad identifications, [TMEP §1402.03\(b\)](#) regarding house marks, and [TMEP §1402.03\(c\)](#) regarding marks for “a full line of” a genre of products.

904.01(b) Combined or Multiple-Class Applications

A combined or multiple-class application is a request to register the same mark for goods, services, and/or a collective membership organization in multiple classes in a single application. See [37 C.F.R. §2.86\(a\),\(b\)](#). In a multiple-class application filed under §1(a), an applicant must provide one specimen of the mark supporting each class. [37 C.F.R. §2.86\(a\)\(3\)](#), [\(b\)\(3\)](#). If a single specimen supports multiple classes, the applicant should indicate which classes are supported by the specimen. The examining attorney need not require multiple copies of the specimen. The examining attorney should enter a Note to the File in the record indicating which classes the specimen supports.

See [TMEP §§1403-1403.06](#) regarding the requirements for and examination of multiple-class applications.

904.02 Physical Form of Specimens

904.02(a) Electronically Filed Specimens

In an electronically filed application, allegation of use, affidavit of use under [15 U.S.C. §1058](#) or [§1141k](#) of the Trademark Act (“§8 affidavit” or “§71 affidavit”), or response to an Office action, the specimen(s) must be in .jpg or .pdf format. [37 C.F.R. §§2.56\(d\)\(4\)](#), [2.161\(g\)](#), [7.37\(g\)](#). If the nature of the specimen is unclear, the applicant should describe what it is and how it is used. See [TMEP §904.03\(d\)](#) regarding electronic and digital media attachments and [§904.03\(f\)](#) regarding specimens for sound marks.

Sometimes, although the application indicates that a specimen is included, the specimen is not visible in the record due to a technical problem that occurred during submission of the application. In this situation, the examining attorney should first send an e-mail to the TEAS mailbox to ask whether the problem can be fixed by uploading the file again. If it cannot, the examining attorney must request that the applicant submit: (1) the same specimen (or a true copy) that was attached to the original TEAS submission; and (2) a statement by the person who transmitted the original TEAS submission that the specimen being submitted is a true copy of the specimen originally filed through TEAS. This statement does not have to be verified. Alternatively, the applicant may submit a different specimen from that initially filed, together with an affidavit or declaration of use of the substitute specimen. See [TMEP §904.05](#) regarding the requirements for an affidavit or declaration supporting use of substitute specimens.

The USPTO prefers that the specimen, whether a true copy of the original or a substitute, be submitted electronically via the Trademark Electronic Application System (“TEAS”). In TEAS, the Response to Office Action form can be accessed by clicking on the link entitled “Response Forms” at <http://www.uspto.gov>.

904.02(b) Paper-Filed Specimens

In a paper-filed application, allegation of use, affidavit of use under §8 or §71 of the Trademark Act, or response to Office action, the specimen(s) must be flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. [37 C.F.R. §2.56\(d\)\(1\)](#). The USPTO may create a photocopy or facsimile for the official record and destroy the original.

When the applicant cannot supply an actual specimen meeting these size requirements due to the nature or manner of use of the mark, the application, allegation of use, affidavit of use, or response must include a facsimile, such as a photograph, photocopy, or other acceptable reproduction, that is a suitable size and clearly shows how the mark is used in commerce.

Facsimiles or photographs of actual specimens are preferred. Facsimiles should show the whole article to which the mark is applied, or enough of the article so that the nature of the article can be identified. The mark and all other pertinent written matter on the article should be clear and legible. For example, product photographs appearing on folders or brochures that show the trademark on the applicant's goods are acceptable facsimiles. It is permissible to show the complete article in one photograph and the written matter in another, so that the written matter will be legible, or to show different views of an article either in a single photograph or in separate photographs.

A photocopy or reproduction of the drawing is not an acceptable specimen or facsimile. [37 C.F.R. §2.56\(c\)](#).

If color is a feature of the mark, the applicant should submit facsimiles made by color photography, or by any process that reproduces in color. See [TMEP §904.02\(c\)\(ii\)](#).

If an applicant submits a specimen that exceeds the size requirements (a “bulky specimen”), the USPTO will create a facsimile of the specimen that meets the size requirements of the rule and destroy the original specimen. [37 C.F.R. §2.56\(d\)\(2\)](#). If the copy of the specimen created by the USPTO does not adequately depict the mark, the examining attorney will require a substitute specimen that meets the size requirements of the rule and an affidavit or declaration verifying the use of the substitute specimen. See [TMEP §904.05](#) regarding affidavits supporting substitute specimens.

If necessary, the examining attorney may require one actual specimen for examination purposes, under [37 C.F.R. §§2.56\(a\)](#) and [2.61\(b\)](#).

904.02(c) Additional Requirements

904.02(c)(i) Other Materials Required for Examination

During examination, an examining attorney also has the discretion to request additional materials, under [37 C.F.R. §2.61\(b\)](#), if necessary for proper examination of the mark. [TMEP §814](#). For example, if the mark is a configuration of the goods or of the container for the goods, the examining attorney may require one actual product or container. Or the examining attorney might require a complete copy of a publication

in order to determine whether a mark is merely descriptive of the goods. See [TMEP §904.02\(c\)\(iii\)](#) regarding marks used on publications.

In specific cases, such as when an applicant submits additional materials in response to a requirement made by the examining attorney, and the materials do not meet the size parameters identified above, the USPTO may create facsimiles of these materials to be entered into the record and destroy the originals. However, the examining attorney should encourage the applicant to submit a photograph of the specimen(s) or evidence for the record.

904.02(c)(ii) Specimens for Marks Comprising Color

If color is a feature of the mark, or if the mark consists solely of color, the specimen must show use of the color. [37 C.F.R. §2.51](#); [TMEP §807.12](#). *Note:* In an application filed on or after November 2, 2003, if an applicant submits a color drawing, or a description of the mark that indicates the use of color on the mark, the applicant must claim color as a feature of the mark. [37 C.F.R. §2.52\(b\)\(1\)](#); [TMEP §807.07\(a\)\(i\)](#).

If the applicant submits a specimen that is not in color or not in the appropriate color, the examining attorney will require the applicant to file a substitute specimen that shows use of the appropriate color(s). See [TMEP §904.05](#) regarding substitute specimens.

See also [TMEP §1202.05\(f\)](#) regarding specimens showing use of marks that consist *solely* of color.

904.02(c)(iii) Specimens for Marks Used on Publications

An application for registration of a mark for publications is treated the same as any other application with respect to specimen requirements. The USPTO does not require a complete copy of the publication or a title page in every case. However, the examining attorney may require a copy of the publication under [37 C.F.R. §2.61\(b\)](#) if he or she believes it is necessary for proper examination. For example, a copy of the publication might be necessary to determine whether a mark is merely descriptive of the goods.

904.03 Material Appropriate as Specimens for Trademarks

For a trademark application under §1(a), allegation of use in an application under §1(b), or affidavit of use under §8 or §71 of the Trademark Act, the specimen must show the mark as used on or in connection with the goods in commerce. A trademark specimen should be a label, tag, or container for the goods, or a display associated with the goods. [37 C.F.R. §2.56\(b\)\(1\)](#). A photocopy or other reproduction of a specimen of the mark as used on or in connection with the goods is acceptable. [37 C.F.R. §2.56\(c\)](#).

See [TMEP §§1301.04 et seq.](#) regarding service mark specimens, [TMEP §1304.02\(a\)\(i\)\(C\)](#) regarding collective membership mark specimens, [TMEP §1303.01\(a\)\(i\)\(C\)](#) regarding collective trademark and collective service mark specimens, and [TMEP §1306.02\(a\)\(i\)\(B\)](#) regarding certification mark specimens.

904.03(a) Labels and Tags

In most cases, if a trademark is applied to the goods or the containers for the goods by means of labels, a label is an acceptable specimen. However, if a mark is merely informational or incapable of functioning as a mark for some other reason, it would not be seen as an indicator of source, and registration must be refused even if the specimen of record shows what would otherwise be acceptable trademark use, including use on tags or labels. See [TMEP §1202.04](#).

Shipping or mailing labels may be accepted if they are affixed to the goods or to the containers for the goods and if proper trademark usage is shown. *In re A.S. Beck Shoe Corp.*, 161 USPQ 168 (TTAB 1969); *Elec. Commc'ns, Inc. v. Elec. Components for Indus. Co.*, 443 F.2d 487, 170 USPQ 118 (8th Cir. 1971). They are not acceptable if the mark as shown is merely used as a trade name and not as a trademark. An example of this is the use of the term solely as a return address. *In re Supply Guys, Inc.*, 86 USPQ2d 1488 (TTAB 2008); *Bookbinder's Sea Food House, Inc. v. Bookbinder's Rest., Inc.*, 118 USPQ 318 (Comm'r Pats. 1958); *I. & B. Cohen Bomzon & Co. v. Biltmore Indus., Inc.*, 22 USPQ 257 (Comm'r Pats. 1934). See [TMEP §1202.01](#) regarding trade name refusals.

In connection with labels whose appearance suggests that they are only for temporary use, the examining attorney may consider it necessary to make further inquiry as to how the specimen is used, under [37 C.F.R. §2.61\(b\)](#), in order to properly examine the application. A response to the inquiry may include an additional specimen(s) if labels of a more permanent nature have by that time been adopted. However, nothing prohibits the registration of a mark in an application that contains only “temporary” specimens, provided that the specimens were actually used in commerce. *See In re Chica*, 84 USPQ2d 1845 (TTAB 2007) (specimen deemed unacceptable not because it was temporary but because it comprised a mere drawing of the goods with an illustration of how the mark may be displayed and not an actual specimen that applicant used in commerce).

904.03(b) Stampings

Stamping a trademark on the goods, on the container, or on tags or labels attached to the goods or containers, is a proper method of trademark affixation. *See In re Crucible Steel Co. of Am.*, 150 USPQ 757 (TTAB 1966). The trademark may be imprinted in the body of the goods, as with metal stamping; it may be applied by a rubber stamp; or it may be inked on by using a stencil or template.

When a trademark is used in this manner, photographs or facsimiles showing the actual stamping or stenciling are acceptable as specimens.

When the specimen consists of a stamp on paper, the applicant must explain the nature of the specimen and how it is used.

904.03(c) Commercial Packaging

The terminology “applied to the containers for the goods” means applied to any type of commercial packaging that is normal for the particular goods as they move in trade. Thus, a showing of the trademark on the normal commercial package for the particular goods is an acceptable specimen. *In re Brown Jordan Co.*, 219 USPQ 375 (TTAB 1983) (holding that stamping the mark after purchase of the goods, on a tag attached to the goods that are later transported in commerce, is sufficient use). For example, gasoline pumps are normal containers or “packaging” for gasoline.

A specimen showing use of the trademark on a vehicle in which the goods are marketed to the relevant purchasers may constitute use of the mark on a container for the goods, if this is the normal mode of use of a mark for the particular goods. *In re E.A. Miller & Sons Packing Co.*, 225 USPQ 592 (TTAB 1985). *But see In re Lyndale Farm*, 186 F.2d 723, 88 USPQ 377 (C.C.P.A. 1951).

904.03(d) Electronic and Digital Media Attachments to Paper Filings

In the absence of alternative specimens, the USPTO will accept specimens consisting of compact discs (“CDs”), digital video discs (“DVDs”), videotapes, and audiotapes. See [37 C.F.R. §2.56\(d\)\(3\)](#). Equipment for viewing or listening to these materials is available at the USPTO.

Compact discs, DVDs, audiotapes, and videotapes may contain files in .jpg, .pdf, .wav, .wmv, .wma, .mp3, .mpg, or .avi format. The USPTO is unable to review files in any other format. The USPTO prefers that the applicant submit small files of less than two minutes in duration. Only one specimen should be included on each tape or disc; however, in a multiple-class application, the applicant may include more than one specimen on the same disc or tape. If the nature of the specimen is unclear, the applicant should explain what it is and how it is used.

See [TMEP §904.02\(a\)](#) regarding electronically filed specimens, [TMEP §904.03\(f\)](#) regarding specimens for sound marks, and [TMEP §904.03\(i\)](#) regarding specimens for motion marks. See also [37 C.F.R. §§2.56\(d\)\(1\)](#) and [\(d\)\(2\)](#) and [TMEP §904.02\(b\)](#) regarding the size requirements for specimens attached to paper filings, and the procedures for handling specimens that exceed these requirements.

904.03(e) Specimens for Trademarks Identifying Computer Programs, Movies, and Videos, or Audio Recordings

The computer program, video, and movie industries have adopted the practice of applying trademarks that are visible only when the goods, that is, programs or movies, are displayed on a screen (e.g., on the first several frames of a movie).

An acceptable specimen might be a photograph or printout of a display screen projecting the identifying trademark for a computer program, or a photograph of a frame(s) of a movie or video bearing the mark. It is not necessary that purchasers see the mark prior to purchasing the goods, as long as the mark is applied to the goods or their containers, or to a display associated with the goods, and the goods are sold or transported in commerce. *In re Brown Jordan Co.*, 219 USPQ 375 (TTAB 1983) (holding that stamping the mark after purchase of the goods, on a tag attached to the goods that are later transported in commerce, is sufficient use).

For downloadable computer software, an applicant may submit a specimen that shows use of the mark on an Internet website. Such a specimen is acceptable only if it creates an association between the mark and software and provides sufficient information to enable the user to download or purchase the software from the website. See *In re Azteca Sys., Inc.*, 102 USPQ2d 1955 (TTAB 2012). If the website simply advertises the software without providing a way to download, purchase, or order it, the specimen is unacceptable.

See *In re Dell Inc.*, 71 USPQ2d 1725, 1727 (TTAB 2004); see also *In re Osterberg*, 83 USPQ2d 1220, 1224 (TTAB 2007). See [TMEP §904.03\(i\)](#) regarding electronic displays as specimens for trademarks.

Similarly, a specimen for audio recordings in Class 9 that shows use of the mark on an internet website must include a “download” or similar link to put the consumer on notice that the identified goods are available for download. Absent such a link or the equivalent thereof, the specimen on its face fails to show use of the mark in commerce for the goods. *In re Rogowski*, 104 USPQ2d 1212, 1214-15 (TTAB 2012).

Specimens for software may also indicate that the software is a “beta” version. This term is commonly used in the software field to identify a preliminary version of a product. Although some beta products may not be made available to consumers, others are. Thus, the appearance of this term on a specimen for software

does not, by itself, necessarily mean that the relevant goods are not in actual use in commerce or that the specimen is unacceptable. However, if examination of the specimen indicates that the beta version is not in actual use in commerce, the examining attorney must refuse registration under §§1 and 45 of the Trademark Act because the applicant has not provided evidence of use of the applied-for mark in commerce. [15 U.S.C. §§1051, 1127](#). See [TMEP §1301.03\(a\)](#) regarding service mark specimens containing the term “beta.”

904.03(f) Specimens for Sound Marks

To show that a sound mark actually identifies and distinguishes the goods/services/collective membership organization and indicates their source, an applicant must submit a specimen that contains a sufficient portion of the audio or video content to show how the mark is used on or in connection with the goods/services/collective membership organization.

For paper filings, specimens for sound marks must be submitted on CDs, DVDs, videotapes, or audiotapes. See [37 C.F.R. §2.56\(d\)\(3\)](#); [TMEP §904.03\(d\)](#).

For TEAS applications under §1(a), as well as response, statement of use/amendment to allege use, petition, and registration maintenance/renewal forms, the specimen can be attached to the TEAS form and must be an electronic file in .wav, .wmv, .wma, .mp3, .mpg, or .avi format. Audio files should not exceed 5 MB in size, and video files should not exceed 30 MB, because TEAS cannot accommodate larger files.

See [TMEP §904.02\(a\)](#) regarding specimens filed electronically. See also [TMEP §807.09](#) and [TMEP §1202.15](#) regarding sound marks.

904.03(g) Displays Associated with Goods

A display must be associated directly with the goods offered for sale. It must bear the trademark prominently. However, it is not necessary that the display be in close proximity to the goods. See *In re Marriott Corp.*, 459 F.2d 525, 173 USPQ 799 (C.C.P.A. 1972); *Lands' End Inc. v. Manbeck*, 797 F. Supp. 511, 24 USPQ2d 1314 (E.D. Va. 1992).

Displays associated with the goods essentially comprise point-of-sale material such as banners, shelf-talkers, window displays, menus, and similar devices.

These items must be designed to catch the attention of purchasers and prospective purchasers as an inducement to make a sale. Further, the display must prominently display the mark in question and associate it with, or relate it to, the goods. See *In re Osterberg*, 83 USPQ2d 1220 (TTAB 2007); *In re Morganroth*, 208 USPQ 284 (TTAB 1980) (purported mark was so obfuscated on the specimen that it was not likely to make any impression on the reader). The display must be related to the sale of the goods such that an association of the two is inevitable. See *In re Bright of Am., Inc.*, 205 USPQ 63 (TTAB 1979), and cases cited therein; see also *In re ITT Rayonier Inc.*, 208 USPQ 86 (TTAB 1980); cf. *In re Shipley Co.*, 230 USPQ 691 (TTAB 1986); *In re Jones*, 216 USPQ 328 (TTAB 1982).

Folders, brochures, or other materials that describe goods and their characteristics or serve as advertising literature are not per se “displays.” See *In re Schiapparelli Searle*, 26 USPQ2d 1520 (TTAB 1993); *In re Drilco Indus. Inc.*, 15 USPQ2d 1671 (TTAB 1990). In order to rely on such materials as specimens, an applicant must submit evidence of point-of-sale presentation. Such evidence must consist of more than an applicant's statement that copies of the material were distributed at sales presentations or tradeshow. A mere statement that advertising and promotional materials are used in connection with sales presentations

is not sufficient, in and of itself, to transform advertising and promotional materials into displays used in association with the goods. *Osterberg*, 83 USPQ2d 1220, 1224 (“Applicant’s declaration lacks sufficient detail to transform the web page from advertising into a display used in association with the goods. For example, there is no discussion regarding how the applicant used the web page at sales presentations to make an association between the mark and the products or whether consumers, in fact, associated the mark with the products. The use of advertising material in connection with the sales of a product does not ipso facto make it a display used in association with the goods sufficient to support technical trademark use for registration.”); *see also In re Anpath Grp., Inc.*, 95 USPQ2d 1377 (TTAB 2010) (holding that pamphlet and flyer listing the URL of applicant’s website and/or a telephone number for contacting sales representatives does not create the same point-of-sale situation as a detailed catalogue, a detailed web page, or a situation where there is the option of placing an order based upon detailed information from the specimen); *In re Ancha Elecs. Inc.*, 1 USPQ2d 1318 (TTAB 1986) ; (holding that a photograph showing an informational flyer or leaflet clearly depicting the mark and presented on the goods at a trade show exhibit was an acceptable display associated with the goods); *In re Columbia Chase Corp.*, 215 USPQ 478 (TTAB 1982) (holding that folders and brochures describing goods and their characteristics or serving as advertising literature are not displays, and the appearance of marks and product photographs in such literature does not per se amount to use of a mark on displays without evidence of point-of-sale presentation).

An infomercial was held to be a display associated with the goods, where the goods were shown either immediately before or immediately after the trademark was displayed, and the information on how to order the goods was given within a reasonable time after the goods were shown. The Board found that the infomercial created an association between the trademark and the goods, and the test for constituting a display associated with the goods was, therefore, satisfied. *In re Hydron Techs., Inc.*, 51 USPQ2d 1531 (TTAB 1999) .

Displays associated with the goods also exist in an electronic or online environment in the form of web pages. These “electronic displays” perform the same function as traditional displays and must meet the same standards for an acceptable specimen as traditional displays. *See In re Sones*, 590 F.3d 1282, 1288, 93 USPQ2d 1118, 1123 (Fed. Cir. 2009); *In re Dell Inc.*, 71 USPQ2d 1725, 1727 (TTAB 2004) . See [TMEP §904.03\(i\)](#) regarding electronic displays.

904.03(h) Catalogs

In appropriate cases, catalogs are acceptable specimens of trademark use. *See Lands’ End Inc. v. Manbeck*, 797 F. Supp. 511, 24 USPQ2d 1314 (E.D. Va. 1992). In that case, the applicant had applied to register “KETCH” for purses. The specimen was a catalog page that included a picture of the goods and, below the picture, the mark and a description of the goods. The Court stated, “The alleged trademark ‘KETCH’ appears prominently in large bold lettering on the display of purses in the Lands’ End specimen in a manner which closely associates the term with the purses.” 24 USPQ2d at 1315.

The Court determined that the catalog was not mere advertising and that it met the relevant criteria for displays associated with the goods. The Court evaluated the catalog specimen as follows:

A customer can identify a listing and make a decision to purchase by filling out the sales form and sending it in or by calling in a purchase by phone. A customer can easily associate the product with the word “KETCH” in the display The point of sale nature of this display, when combined with the prominent display of the alleged mark with the product, leads this court to conclude that this mark constitutes a display associated with the goods.

24 USPQ2d at 1316.

Accordingly, examining attorneys may accept any catalog or similar specimen as a display associated with the goods, provided that it: (1) includes a picture or a sufficient textual description of the relevant goods; (2) shows the mark in association with the goods; *and* (3) includes the information necessary to order the goods (e.g., an order form or a phone number, mailing address, or e-mail address for placing orders).

However, the inclusion of a phone number, Internet address, and/or mailing address merely as part of corporate contact information on an advertisement describing the product is not in itself sufficient to meet the criteria for a display associated with the goods. There must be an offer to accept orders or instructions on how to place an order. *See In re MediaShare Corp.*, 43 USPQ2d 1304,1306 (TTAB 1997) (finding applicant's fact sheet brochure, which included an address and phone number but omitted any information as to product price and how to order applicant's software, was merely advertising material). It is not necessary that the specimen list the price of the goods.

904.03(i) Electronic Displays

A web page that displays a product can constitute a “display associated with the goods” if it:

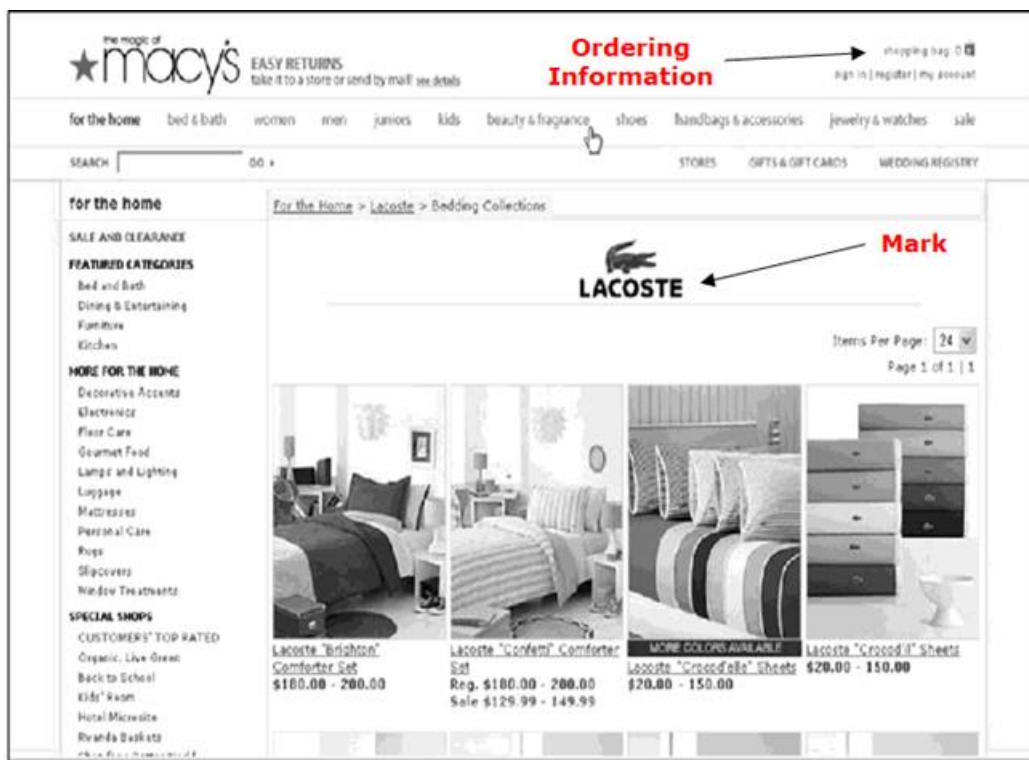
- (1) contains a picture or textual description of the identified goods;
- (2) shows the mark in association with the goods; and
- (3) provides a means for ordering the identified goods.

See In re Sones, 590 F.3d 1282, 1288, 93 USPQ2d 1118, 1123 (Fed Cir. 2009); *In re Azteca Sys., Inc.*, 102 USPQ2d 1955, 1957-58 (TTAB 2012) ; *In re Dell Inc.*, 71 USPQ2d 1725, 1727 (TTAB 2004) ; *Lands' End v. Manbeck*, 797 F. Supp. 511, 514, 24 USPQ2d 1314, 1316 (E.D. Va. 1992).

The mark must also be displayed on the web page in a manner in which customers will recognize it as a mark. *See In re Morganroth*, 208 USPQ 284, 287-88 (TTAB 1980) ; *see also In re Osterberg*, 83 USPQ2d 1220, 1223 (TTAB 2007) (finding that CONDOMTOY CONDOM was not displayed so prominently on web page specimen that consumers would recognize it as a trademark for condoms). See [TMEP §1202.04](#) regarding matter that is merely informational in nature.

Generally, a web page will display the trademark in association with a picture of the goods. However, in *Sones*, the Federal Circuit held that although a visual depiction of the goods “is an important consideration in determining whether a submitted specimen sufficiently associates a mark with the source of the goods,” a picture of the goods on the web page is not mandatory. *In re Sones*. at 1288, 93 USPQ2d at 1123. A textual description may suffice where “the actual features or inherent characteristics of the goods are recognizable from the textual description, given that the more standard the product is, the less comprehensive the textual description need be.” *Id.* at 1289, 93 USPQ2d at 1124.

An applicant need not describe a web-page specimen as a “display” for it to qualify as an acceptable display specimen, nor must the web page come from an applicant's own website. A web page from a third-party website may be acceptable as a display if the mark is sufficiently associated with the applicant's goods. *See In re Osterberg*, 83 USPQ2d at 1221, 1223-24 (finding the specimen unacceptable not because it was a web page from a third-party website, but because it neither showed the mark in association with the goods nor provided a means for ordering the goods). For instance, a manufacturer of bed linens may rely on a third-party retail vendor's web page when the web page shows a picture of the bed linens in association with the mark and provides a means for ordering them, as shown in Example 1.



Example 1: Mark is associated with the goods, goods are pictured and described, and ordering information is provided.

Mark: LACOSTE

Goods: Coverlets, duvet covers, duvets, bed blankets, bed linen, bed sheets, pillow cases, bath linen, washing mitts

The mark is placed below the website navigation tabs and is prominently displayed.

The mark is physically close to the goods and is repeated in the links located under each product, indicating a direct association with the goods.

No other marks appear to be used in connection with the goods apart from the alligator design and the product style names, all of which are associated with the goods.

Product information is provided in the form of pictures and descriptions of the goods along with prices.

There is a “shopping bag” at the top of the web page to enable direct ordering.

Even if the web page did not include the larger LACOSTE mark, the LACOSTE marks depicted under the photographs of the goods (e.g., Lacoste “Brighton” Comforter Set or Lacoste “Confetti” Comforter Set) would be acceptable to show trademark use for the goods.

If the proposed mark were “Macy’s” (as it appears in the upper-left corner), the web page would not be acceptable for goods because of the closer proximity and association of the other marks with the goods (i.e., the LACOSTE and alligator).

Similarly, a web page from a third-party, social-media website may also be accepted provided the web page satisfies the elements of a display specimen.

However, while a web page display associated with the goods is an acceptable specimen for goods, mere advertising material is not. *In re Anpath Grp.*, 95 USPQ2d 1377, 1380 (TTAB 2010); *In re Quantum Foods, Inc.*, 94 USPQ2d 1375, 1379 (TTAB 2010); *In re Osterberg*, 83 USPQ2d at 1224; *In re Dell Inc.*, 71 USPQ2d at 1727; *In re MediaShare Corp.*, 43 USPQ2d 1304, 1307 (TTAB 1997). Acceptable web-page displays are not merely advertising, but instead serve as point-of-sale displays, because the website on which the web page appears is, in effect, an electronic retail store, and the web page is a shelf-talker or banner which encourages the consumer to buy the product and provides the information necessary to do so. A consumer using the link on the web page to purchase the goods is the equivalent of a consumer seeing a shelf-talker and taking the item to the cashier in a store to purchase it. *See In re Dell Inc.*, 71 USPQ2d at 1727. The web page is, thus, a point-of-sale display by which an actual sale is made.

A point-of-sale display is “‘calculated to consummate a sale’”; that is, it includes the information necessary for the consumer to decide to purchase the goods, and it appears in a setting that allows the consumer to immediately buy the goods. *In re Quantum Foods, Inc.*, 94 USPQ2d at 1379 (quoting *In re Bright of Am., Inc.*, 205 USPQ 63, 71 (TTAB 1979)); *In re Anpath Grp.*, 95 USPQ2d at 1382; *In re MediaShare Corp.*, 43 USPQ2d at 1305; *Lands’ End Inc.*, 797 F. Supp. at 514, 24 USPQ2d at 1316. An advertisement, however, merely describes or touts the benefits of the goods, influences people to buy them, or informs the public about the goods and the company that provides them. *In re Anpath Grp.*, 95 USPQ2d at 1381-82; *In re Quantum Foods, Inc.*, 94 USPQ2d at 1379. It does not offer a way to directly purchase the goods, because it either does not contain an offer to accept orders for the goods or does not provide special instructions for placing orders for the goods. *In re Quantum Foods, Inc.*, 94 USPQ2d at 1380; *In re Osterberg*, 83 USPQ2d at 1224.

Therefore, a web page that merely provides information about the goods, but does not provide a means of ordering them, is viewed as promotional material, which is not acceptable to show trademark use on goods.

See In re Genitope Corp., 78 USPQ2d 1819, 1822 (TTAB 2006) (“[T]he company name, address and phone number that appears at the end of the web page indicates only location information about applicant; it does not constitute a means to order goods through the mail or by telephone, in the way that a catalog sales form provides a means for one to fill out a sales form or call in a purchase by phone.”). Merely providing a link to the websites of online distributors is not sufficient. There must be a means of ordering the goods directly from the applicant’s web page, such as a telephone number for placing orders or an online ordering process. *In re Quantum Foods, Inc.*, 94 USPQ2d at 1380; *In re Osterberg*, 83 USPQ2d at 1224.

When a web-page specimen appears to be merely advertising, statements by the applicant that the specimen is used in connection with the sale of the goods, without evidence or a detailed explanation of the manner of use, will not suffice to establish that the specimen is a display associated with the goods. *In re Osterberg*, 83 USPQ2d at 1224 (finding that applicant’s mere statement in a signed declaration that copies of the web page were distributed at sales presentation lacked sufficient detail to transform the web page from an advertisement into a display associated with the goods).

Whether a web-page display qualifies as an acceptable specimen is a question of fact, based on the evidence of record. *In re Azteca Sys., Inc.*, 102 USPQ2d at 1957 (citing *Lands’ End*, 797 F. Supp. at 514, 24 USPQ2d

at 1316); *In re Hydron Techs. Inc.*, 51 USPQ2d 1531, 1533 (TTAB 1999). The presentation on the web page of the picture or description of the goods, the manner of the mark's use in association with those goods, and the nature of the ordering information affect the specimen's acceptability. Thus, a specimen that describes or displays a picture of the goods, shows the mark, and provides ordering information may nonetheless be unacceptable because it fails to demonstrate an association between the mark and the goods. Sometimes, a single fact or piece of evidence may be dispositive. Often, however, a combination of facts and evidence of record may be required to establish the acceptability of the specimen. If ordering information is not readily discernible from the submitted web page, the applicant may provide multiple, sequential web pages as part of the specimen to clarify the ordering process on the website.

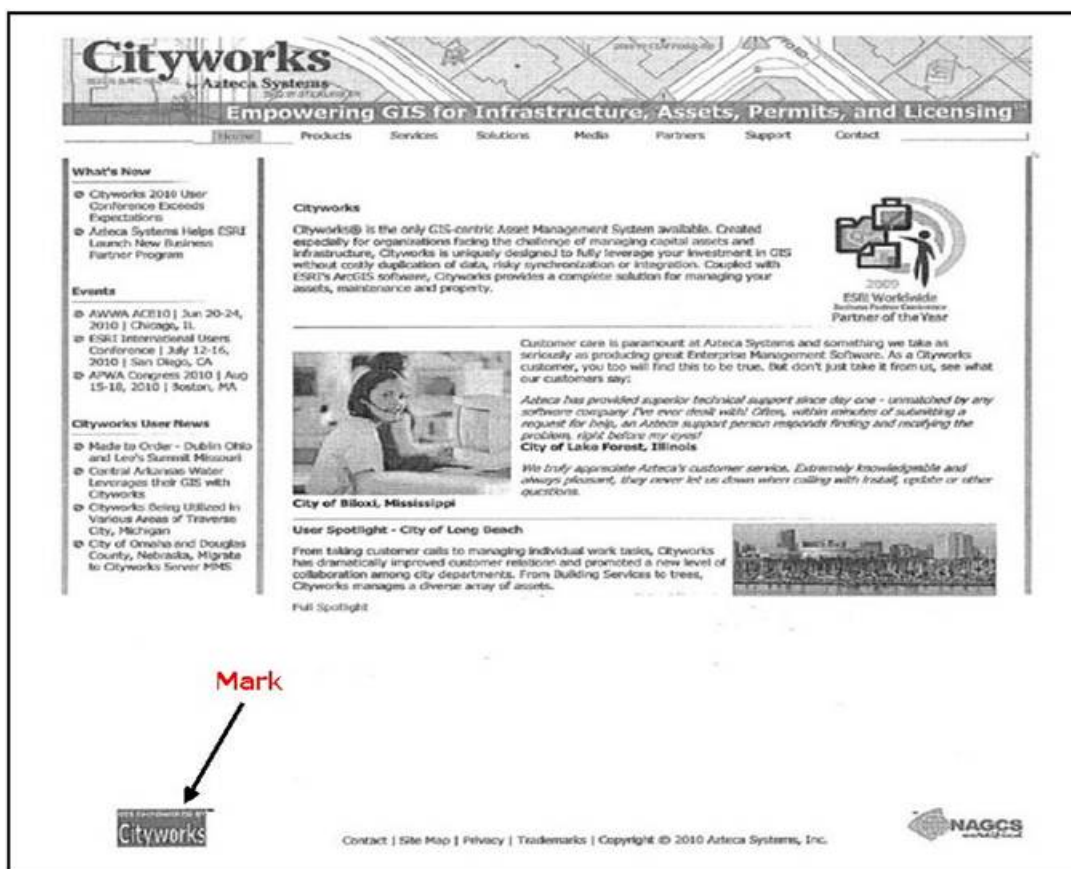
See [TMEP §904.03\(i\)\(A\)–\(i\)\(C\)\(3\)](#) for further discussion of the various factors for assessing whether a web-page display is an acceptable specimen.

904.03(i)(A) Picture or Description of the Goods

In order for a display to be associated with the goods, something on the web page must show or describe the goods for the consumer, that is, a picture or description of the goods. See *In re Sones*, 590 F.3d 1282, 1288-89, 93 USPQ2d 1118, 1123-24 (Fed. Cir. 2009). A description will suffice if “the actual features or inherent characteristics of the goods are recognizable from the textual description.” *Id.* at 1289, 93 USPQ2d at 1124. The level of detail required depends on the type of goods at issue. *Id.* Standard products (e.g., television sets, baseball gloves, or pet food) typically will not require a comprehensive description for the consumer to know what the goods are. Complicated or sophisticated products (e.g., computer products, medical devices, or industrial machinery) may require a more detailed description, in the absence of a picture of the goods.

904.03(i)(B) Show the Mark in Association with the Goods

A web-page display specimen “must in some way evince that the mark is ‘associated’ with the goods and serves as an indicator of source.” *In re Sones*, 590 F.3d 1282, 1288, 93 USPQ2d 1118, 1123 (Fed. Cir. 2009). Assessing the “mark-goods” association on a web page involves many variables, including the prominence and placement of the mark, the content and layout of the web page, and the overall impression the web page creates. Web-page content and layout may sometimes distract consumers and prevent them from making the necessary connection between the mark and the identified goods. *In re Azteca Sys., Inc.*, 102 USPQ2d 1955, 1958 (TTAB 2012). Factors such as the proximity of the mark to the goods, the presence of other marks, intervening text between the mark and the goods, and the inclusion of other material that is unrelated or marginally related to the identified goods, tend to disrupt purchasers from making the mark-goods association, as shown in Example 2. *Id.*



Example 2: Applied-for mark is not associated with the goods.

Mark: GIS EMPOWERED BY CITYWORKS

Goods: Computer software for management of public works and utilities assets

The applied-for mark is distant from the description of the software, and is separated from the description by more than fifteen lines of text concerning marginally related topics;
 Due to the appearance of a number of other marks on the web page, it is unclear whether any particular mark is associated and used in connection with the identified goods;
 The left sidebar includes links to articles and news about applicant's business and is not limited to the software goods.

The following features of a specimen particularly influence the mark-goods association analysis.

904.03(i)(B)(1) Prominence of Mark

When determining whether a web-page display specimen shows the mark in association with the identified goods, the examining attorney may consider the prominence of the mark. *See In re Osterberg*, 83 USPQ2d 1220, 1223 (TTAB 2007) (“Another factor in the analysis of whether a specimen is an acceptable display used in association with the goods is whether the mark is displayed in a such a way that the customer can easily associate the mark with the goods.” (citing 83 USPQ2d 1220, 1223 (TTAB 2007) (“Another factor in the analysis of whether a specimen is an acceptable display used in association with the goods is whether the mark is displayed in a such a way that the customer can easily associate the mark with the goods.” (citing *In re Dell Inc.*, 71 USPQ2d 1725, 1728 (TTAB 2004)).

The more prominently an applied-for mark appears on a web page, the more likely the mark will be perceived as a trademark. A mark may appear more prominent when the specimen:

- presents the mark in larger font size or different stylization or color than the surrounding text;
- places the mark at the beginning of a line or sentence;
- positions the mark next to a picture or description of the goods; or
- uses the “TM” designation with the applied-for mark (however, the designation alone does not transform a mark into a trademark if other considerations indicate it does not function as a trademark).

Compare In re Quantum Foods, Inc., 94 USPQ2d 1375, 1378 (TTAB 2010) (describing an applied-for mark as “prominently displayed” on the specimen when the mark appeared by itself above pictures relating to applicant’s goods in relatively large font and in a different color than some of the other text on the page), *with In re Osterberg*, 83 USPQ2d at 1223 (finding the applied-for mark not so prominently displayed that customers would easily associate the mark with the goods, because it was buried in the middle of text describing the goods and, while the mark was shown in bold font, so was other matter). *See In re Sones*, 590 F.3d 1282, 1289, 93 USPQ2d 1118, 1124 (Fed. Cir. 2009) (“Though not dispositive, the ‘use of the designation “TM” . . . lends a degree of visual prominence to the term.’” (quoting *In re Dell Inc.*, 71 USPQ2d at 1729)); *In re Quantum Foods, Inc.*, 94 USPQ2d at 1378-79 (concluding that applicant’s specimen did not show use of the applied-for mark as a trademark for the goods, despite the mark’s “TM” designation); *In re Osterberg*, 83 USPQ2d 1220 at 1224, n.4 (“The mere use of a superscript ‘tm’ cannot transform a nontrademark term into a trademark.” (citing *In re Brass-Craft Mfg. Co.*, 49 USPQ2d 1849, 1853 (TTAB 1998)).

These factors are not dispositive, and the web page as a whole must be assessed to determine whether the applied-for mark functions as a trademark for the identified goods. Alternatively, a mark may appear less prominent and less likely to be perceived as a trademark if it is:

- shown in the same font size, stylization, or color as the surrounding text;
- buried in a sentence; or
- encompassed within descriptive text such that the commercial impression of the mark is that of a descriptive term for the goods and not as a trademark.

See In re Osterberg, 83 USPQ2d at 1223.

904.03(i)(B)(2) Placement of Mark and Proximity to the Goods

Appearance in Website and E-mail Addresses. When a mark appears in the computer browser area as part of the URL, Internet address, or domain name of the website that houses the web page, consumers generally do not recognize this as trademark use. Instead, this use merely identifies the Internet location of the website where business is conducted and goods or services are offered. *See, e.g., In re Roberts*, 87 USPQ2d 1474, 1479-80 (TTAB 2008) (concluding that the mark IRESTMYCASE, which appeared as part of a website address, www.irestmycase.com, on applicant's specimens, merely served as a contact address to reach the applicant and failed to function as a service mark for applicant's services); *In re Supply Guys, Inc.*, 86 USPQ2d 1488, 1493 (TTAB 2008) (“[A]pplicant's use of the term LEADING EDGE TONERS as part of the internet address, www.leadingedgetoners.com, . . . identifies the website where applicant conducts its retail sales services. Obviously, a website can be used for multiple purposes and the simple fact that a term is used as part of the internet address does not mean that it is a trademark for the goods sold on the website.”); *In re Eilberg*, 49 USPQ2d 1955, 1956 (TTAB 1998) (finding that the mark WWW.EILBERG.COM, when displayed in relatively small and subdued typeface below other contact information on applicant's letterhead, merely indicated the Internet location of applicant's website rather than functioning as a service mark for applicant's legal services). Similarly, the use of the mark embedded in an e-mail address would be viewed as part of the website address where applicant may be contacted, rather than as a trademark.

Placement in a Location Typical for a Retail-Store Service Mark. A mark may be displayed at the top of a web page, separated from the relevant goods by the website navigation tabs, which may direct consumers to information about the goods, the applicant, and the website. Since it is customary for retailers to place their store marks in this location, such use of the applied-for mark is likely to be recognized as an online retail-store service mark, as shown in Example 3.



Example 3: Mark is associated with the services, but the specimen would not be acceptable as evidence of use of the mark as a trademark for the goods shown.

Mark: MACYS.COM

Services: Electronic retail department-store services

The web page is not acceptable as evidence of use of the mark as a trademark for the goods shown because the mark is serving only as a service mark for retail store services featuring the goods of others (e.g., “Cuisinart” or “Polo by Ralph Lauren”).

The mark is located in the upper-left corner where retail service marks usually appear and is adjacent to the greeting “Welcome to macys.com.”

Other trademarks for various goods appear on the web page, such as “Cuisinart,” “Club Room,” “Charter Club,” and “Polo by Ralph Lauren,” which appear to be more directly associated with the goods.

Retail store services indicia appear, such as “departments” on the right and “expresscheckout sign-in,” “bridal registry,” and “want a card? get one here” on the left.

The mark may also include wording (e.g., “market,” “store,” or “depot”) that indicates use as a service mark. Nevertheless, a mark appearing in a location where service marks normally appear may qualify as a trademark if the web page demonstrates an association between the applied-for mark and the identified goods, and otherwise meets the elements of an acceptable display specimen, as shown in Example 4. *See In re Supply Guys, Inc.*, 86 USPQ2d at 1495-96 (noting that “a mark may serve both as a trademark and service mark” and that one “must look to the perception of the ordinary customer to determine whether the term functions as a trademark”).



Example 4: Mark is associated with the goods, goods are pictured and described, and ordering information is provided.

Mark: HAPPY SOCKS

Goods: Clothes, namely, socks

The mark is shown prominently in the upper-left corner of the web page, is followed by the “TM” designation, is placed in close proximity to the goods, and appears to be the only mark on the web page associated with the goods.

The reference to “our socks” under “Add to cart” button reinforces trademark use of the mark because it conveys that the socks sold on the web page are produced by HAPPY SOCKS.

The web page contains sufficient product details to make the decision to purchase the goods, including picture and description; size, color, and quantity options; price; and material content of the goods. The ordering information is in the form of an “Add to cart” button adjacent to the picture and description of goods.

Furthermore, if a mark appears on a web page in a location where trademarks normally are not placed, a “substantially larger and more prominent” placement of the mark thereon could result in acceptable trademark use, when the only products on the web page are the identified goods, the placement of the mark is such that the mark-goods association is evident, and the web page otherwise meets the elements of an acceptable display specimen. *See Examples 5 and 6.*



Example 5: Mark is associated with the goods, goods are pictured and described, and ordering information is provided.

Mark: COLE HAAN

Goods: Eyeglasses, sunglasses, cases for spectacles and sunglasses

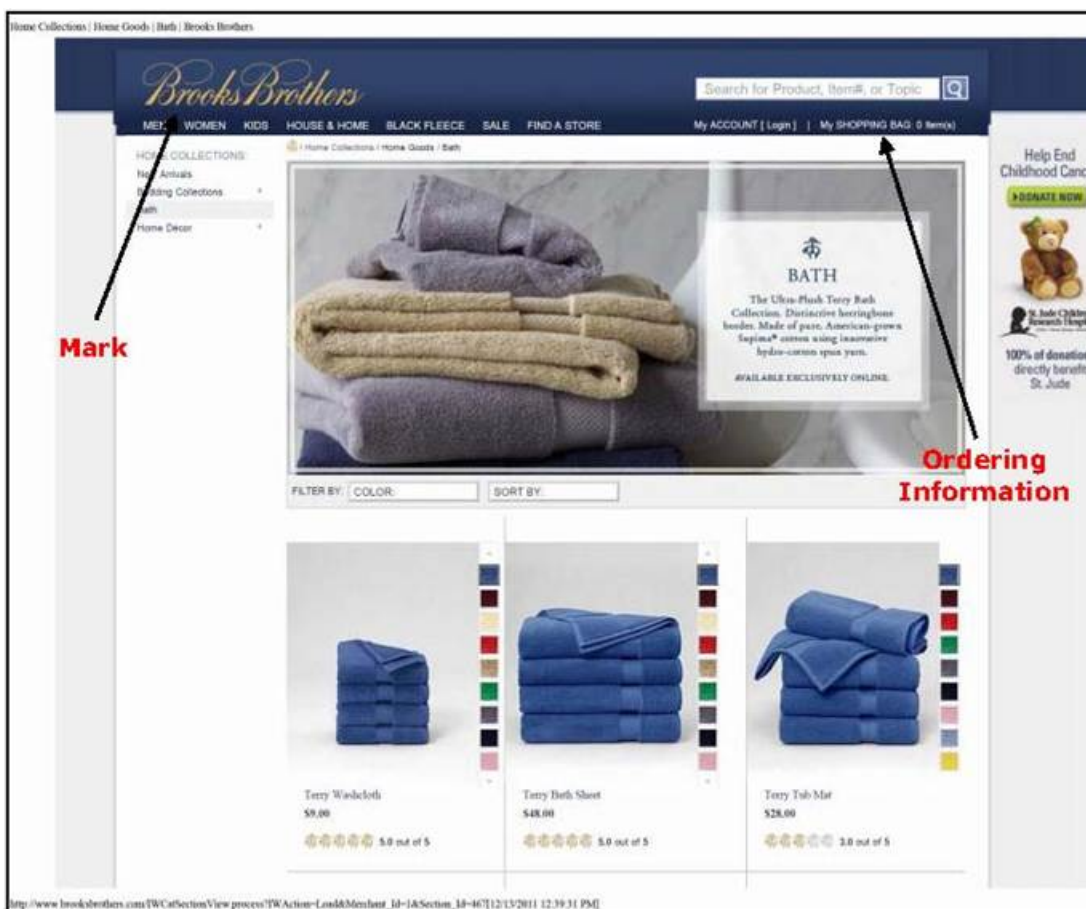
The mark is located in the upper-left corner of the web page and is prominently displayed.

The mark is somewhat physically distant from the goods, but it appears to be the only mark on the web page associated with the goods, and the only products shown are the identified goods.

Although the menu on the left, under “COLLECTIONS,” does include other marks, these marks do not appear to be used in connection with the goods (i.e., the other marks are not placed directly next to the pictures and descriptions of the goods) and the menu simply appears to inform consumers that they may also purchase from other brand-name “collections” on the website.

Ordering information in the form of a “SHOPPING BAG” is included near the top of the web page.

The mark may also function as a service mark for retail store services since the menu on the left of the web page contains various categories of goods sold in the store, identifies other brand names carried by the store, and provides a “STORES” link on the bottom for locating physical stores.



Example 6: Mark is associated with the goods, goods are pictured and described, and ordering information is provided.

Mark: BROOKS BROTHERS

Goods: Bed sheets, dust ruffles, duvet covers, pillow cases, pillow shams, bed shams, bed spreads, towels, and wash cloths

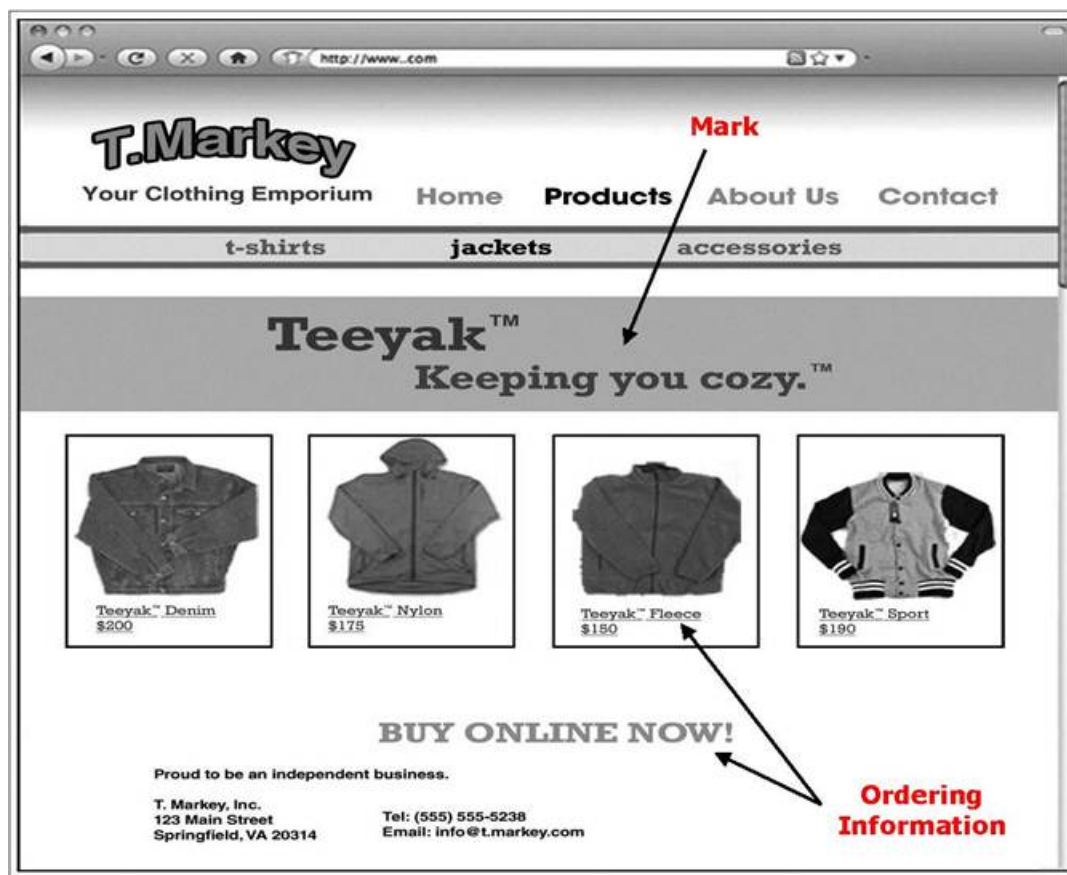
The mark is displayed prominently in large font and placed above the pictures of the goods. No other marks appear to be used in connection with the identified goods apart from the sheep design placed near the goods, which is also associated with the goods.

The web page contains pictures and descriptions of the goods, size and color selections, and price information.

The web page would also be an acceptable specimen if the mark were for retail store services because the mark is located where retail service marks are typically placed and the “FIND A STORE” tab indicates the presence of physical stores, thus reinforcing service mark usage.

Displayed in or Near Corporate Contact Information. A mark that appears on a web page only in conjunction with the corporate address, telephone number, and website and e-mail addresses, and/or is placed on the web page near boilerplate and standard information about the applicant or the website (e.g., “Home” and “About Us” links, legal notices, or technical requirements of the website) is less likely to be seen as a trademark and more likely to be perceived as a trade name under which the applicant conducts business. *See In re Walker Process Equip. Inc.*, 233 F.2d 329, 331-32, 110 USPQ 41, 43 (C.C.P.A. 1956) (indicating that the placement of the applied-for mark WALKER PROCESS EQUIPMENT INC. above wording denoting applicant’s location suggested that the mark was not used as a trademark, but as a trade name)..., 233 F.2d 329, 331-32, 110 USPQ 41, 43 (C.C.P.A. 1956) (indicating that the placement of the applied-for mark WALKER PROCESS EQUIPMENT INC. above wording denoting applicant’s location suggested that the mark was not used as a trademark, but as a trade name).

Presence of Other Marks. In some instances, the appearance of more than one mark (whether word or design marks) on the web page may distract consumers and make it less likely that they will perceive an association between the applied-for mark and the relevant goods. *See In re Azteca Sys., Inc.*, 102 USPQ2d 1955, 1958 (TTAB 2012). The placement of each mark, particularly the applied-for mark, in relation to the identified goods may affect whether it is associated with the goods and functions as a trademark (see Example 7) or, instead, serves as a service mark or trade name.



Example 7: Mark is associated with the goods, goods are pictured and described, and ordering information is provided.

Mark: KEEPING YOU COZY.

Goods: Jackets

The mark is placed below the website navigation tabs and is prominently displayed in large font followed by the “TM” designation.

The mark is physically close to the goods and would be perceived to be associated with them.

The web page features product information in the form of pictures and descriptions of the goods along with prices.

The links under each product combined with the “BUY ONLINE NOW!” instruction indicate that direct ordering is possible.

If the proposed mark were “T. Markey Your Clothing Emporium” (as it appears in the upper-left corner), the web page would not be acceptable for goods because it is located where service marks are commonly placed and seems to function as a retail store service mark, there is other matter separating the mark from the goods, and there are other marks placed closer to the goods and better associated with the goods.

The nature of the wording and design elements of each mark on the specimen and the appearance of the same or similar elements in the various marks may also influence whether the applied-for mark would be perceived as a trademark for the relevant goods, as in Example 8.



Example 8: Mark is associated with the goods, goods are pictured and described, and ordering information is provided.

Mark: T.MARKEY YOUR CLOTHING EMPORIUM

Goods: Shirts

The mark is located on the top of the web page and is prominently displayed.

Although the mark is placed above the website navigation tabs and appears in conjunction with a slogan that refers to retail store services (i.e., “Your Clothing Emporium”), the mark still appears to be associated with the goods because the goods are shown immediately below the navigation tabs and the identified goods are the only products displayed.

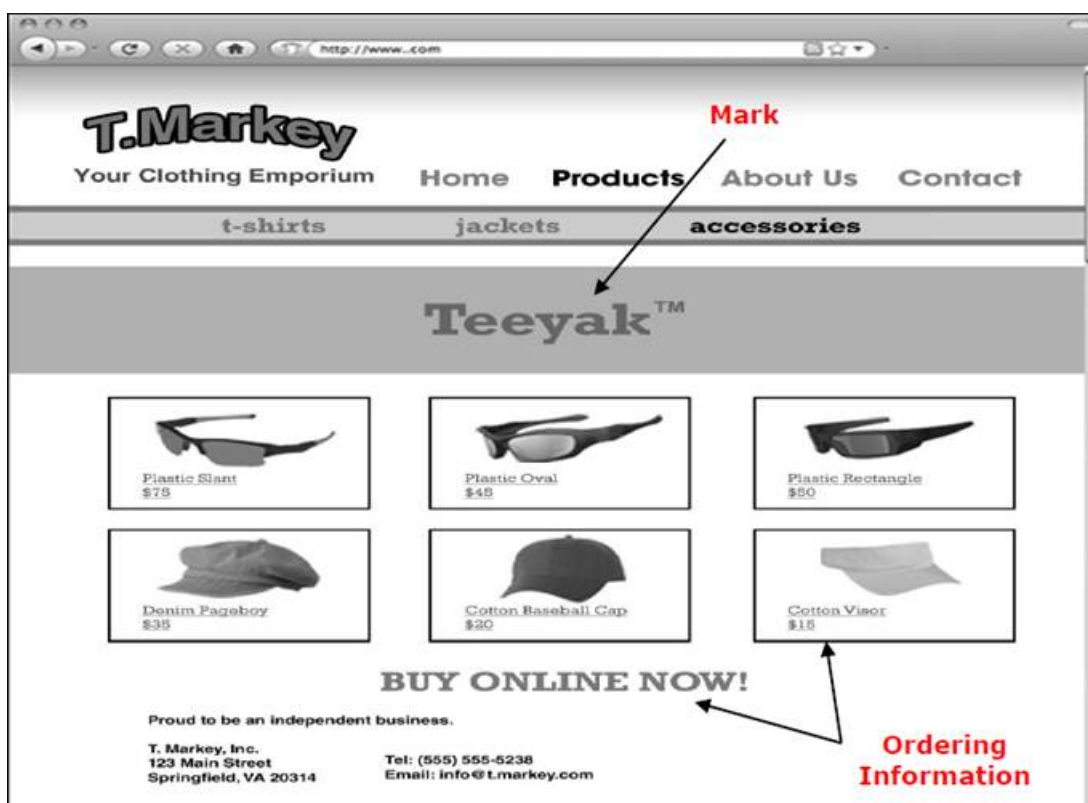
Another mark appears to be used in connection with the goods (i.e., “Let T.Markey Bundle You Up.” and design). However, multiple marks may function as a source indicator for the same goods. Here, both marks contain the same term “T.Markey,” suggesting the marks indicate the same source, and both are placed near and in association with the goods.

The web page provides product information in the form of pictures and descriptions of the goods, prices, and size options.

The telephone number is an acceptable means of ordering, even though it is not accompanied with special ordering instructions, because there is sufficient product information to make the decision to purchase the goods and the telephone number is prominently displayed and positioned in close proximity to the product information, implying that the goods may be ordered by calling the telephone

number. If the telephone number had been listed near or as part of applicant's address, it would not be sufficient ordering information since it would be perceived as part of the corporate contact information and not as a means for purchasing the goods.

Association is more likely when the applied-for mark is physically near the goods and no other marks appear to be used in connection with the goods, as in Example 9.



Example 9: Mark is associated with the goods, goods are pictured and described, and ordering information is provided.

Mark: TEEYAK

Goods: Sunglasses and hats

The mark appears below the website navigation tabs and is prominently displayed in large font followed by the "TM" designation.

The mark is physically close to the goods and is directly associated with them.

Although another mark (i.e., "T.Markey Your Clothing Emporium") appears on the web page, it seems to function as a retail store service mark since it is located where service marks are commonly

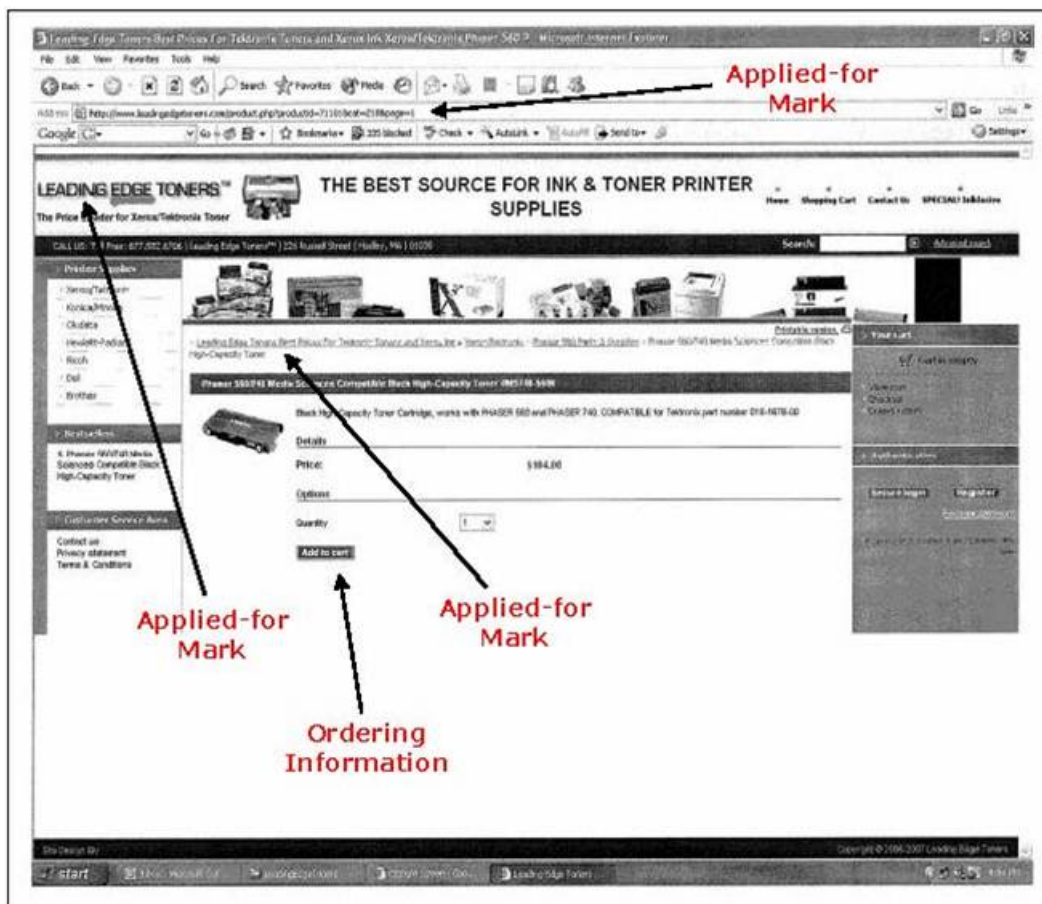
placed, there is other matter separating the mark from the goods, and there is another mark placed closer to the goods and better associated with them.

Product information is provided in the form of pictures and descriptions of the goods along with prices.

The links under each product combined with the “BUY ONLINE NOW!” instruction indicate that direct ordering is possible.

In the absence of links and the “BUY ONLINE NOW!” instruction, the telephone number would not be acceptable ordering information because it appears to be part of corporate contact information provided to obtain information about the product or the company and not intended as a means of placing or accepting orders.

Association becomes less likely if other marks are used in connection with the goods and appear to be trademarks for those goods, as in Example 10.



Example 10: Applied-for mark does not function as a trademark.

Mark: LEADING EDGE TONERS

Goods: Numerous goods including toner, toner cartridges, ink sticks, components for laser toner cartridges, and printer parts

Use of the applied-for mark in the URL identifies the website where applicant's retail services are conducted and does not show trademark use.

The applied-for mark functions as a service mark for retail store or distributorship services, rather than as a trademark, because it appears in the upper-left corner of the web page where service marks normally appear and there are other marks that appear to be used in connection with the goods.

The use of the applied-for mark in phrases containing third-party trademarks that are used to identify goods of third parties (e.g., "Leading Edge Toners Best Prices for Tektronix Toners" or "The Price Leader for Xerox/Tektronix Toner.") does not constitute trademark use and, instead, signifies that the applicant is a retail store or distributorship that sells the goods of others.

904.03(i)(C) Ordering Information

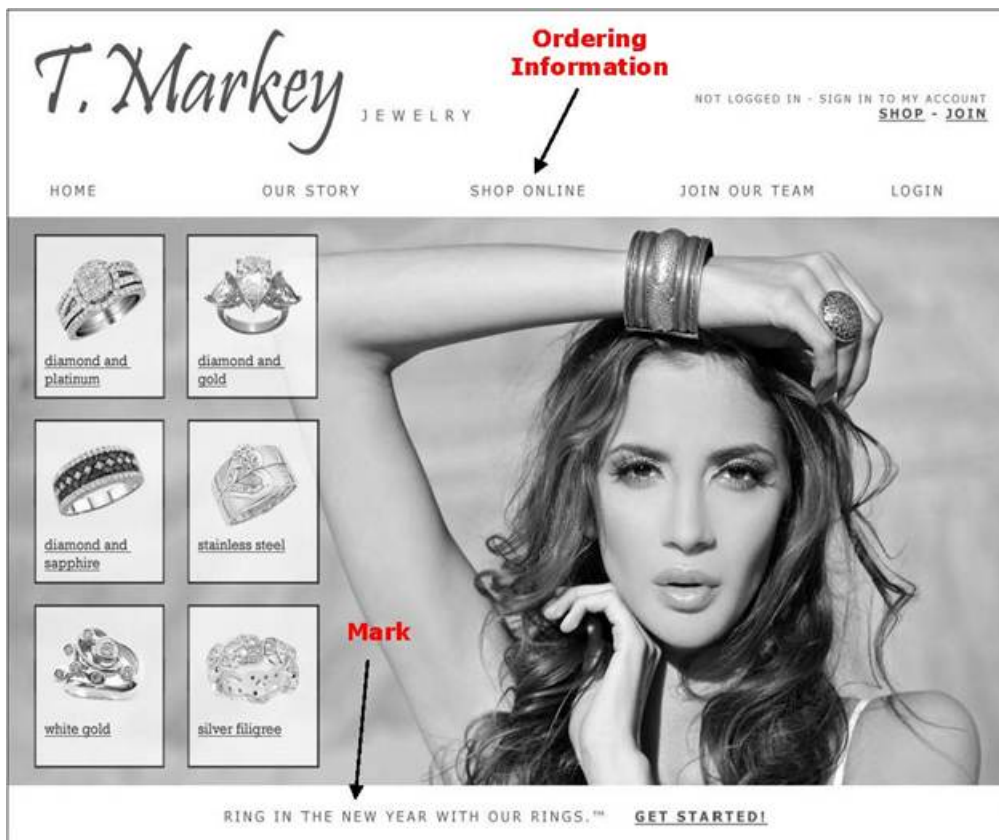
A point-of-sale web-page display must provide a means of ordering the goods, either directly from the web page itself (e.g., web page contains a "shop online" button or link) or from information gleaned from the web page (e.g., web page lists a telephone number designated for ordering). See *In re Quantum Foods, Inc.*, 94 USPQ2d 1375, 1378-79 (TTAB 2010); *In re Osterberg*, 83 USPQ2d 1220, 1224 (TTAB 2007). If the web page offers no way to purchase the goods, the web page is merely an advertisement and not a display associated with the goods. See *In re Quantum Foods, Inc.*, 94 USPQ2d at 1378-80; *In re Osterberg*, 83 USPQ2d at 1224; *In re Genitope Corp.*, 78 USPQ2d 1819, 1822 (TTAB 2006).

Indicators of the ability to buy the goods via the web page may include:

- a sales order form to place an order, an online process to accept an order, such as "shopping cart" functionality, or special instructions on how to order;
- information on minimum quantities;
- indication of methods of payment;
- information about shipment of the goods; and/or
- means of contacting the applicant to place an order.

See *In re Anpath Grp.*, 95 USPQ2d 1377, 1381 (TTAB 2010); *In re Quantum Foods, Inc.*, 94 USPQ2d at 1379.

Determining the sufficiency of ordering information is a nuanced analysis requiring an examination of the web page content and layout in terms of the level of detail provided about both the goods and the means for ordering them. The more specific and clear the means of immediately and directly ordering the goods on the web page (e.g., "shopping cart" or "Call 1-800-xxx-xxxx to Order Now"), the less detailed the information about the product features and specifications needs to be (e.g., price, size, color, or style), as shown in Example 11.



Example 11: Mark is associated with the goods, goods are pictured and described, and ordering information is provided.

Mark: RING IN THE NEW YEAR WITH OUR RINGS

Goods: Rings

The mark is placed on the bottom of the web page and is followed by the “TM” designation. The mark is close to the picture of the goods and contains the term “RINGS” which references the goods.

The “SHOP ONLINE” tab and the “SHOP” link indicate direct ordering via the web page.

Web page is also acceptable for goods if the proposed mark were “T.Markey Jewelry” (in upper-left corner) because it is located close to the picture of the goods and both the proposed mark and the “T.Markey Jewelry” mark indicate common origin since it can be inferred that the wording “OUR RINGS” in the proposed mark refers to rings by T.Markey Jewelry.

Conversely, the more detailed the product information is on the web page, the less detailed the ordering information needs to be (e.g., providing a telephone number without specifically stating that it be used to

place orders). See Example 8 at [TMEP §904.03\(i\)\(B\)\(2\)](#). Although pricing information is normally associated with ordering goods, the presence or absence of pricing on its own is not determinative of whether the web page provides sufficient ordering information. Compare *In re Dell Inc.*, 71 USPQ2d 1725, 1728-29 (TTAB 2004) (concluding that a web-page specimen used in connection with applicant's computer hardware, which provided information about the goods but did not show the price of the goods, met the requirements for a display associated with the goods), and [TMEP §904.03\(h\)](#) (indicating that it is not necessary for a catalog specimen to list the price of the goods in order to meet the criteria for a display associated with the goods), with *In re Quantum Foods, Inc.*, 94 USPQ2d at 1379 (listing pricing information as information normally associated with ordering goods and noting the absence of pricing or other ordering information on the applicant's web page specimen to purchase the goods), and *In re MediaShare Corp.*, 43 USPQ2d 1304, 1305 (TTAB 1997) (concluding that applicant's specimen was merely advertising material because it lacked the price of the goods and other information normally associated with ordering goods). If the goods can be ordered via the information contained on the web page, then, presumably, the price will be presented at some point before the order is completed.

See [TMEP §§904.03\(i\)\(C\)\(1\)-904.03\(i\)\(C\)\(3\)](#) for a discussion of the common features of websites and the issues to consider when determining whether these features constitute sufficient means of ordering the goods.

904.03(i)(C)(1) “Shopping Cart” and “Shopping Bag” Buttons and Links

Frequently used methods of ordering goods online include buttons and links identified as “shopping cart,” “shopping bag,” “add to cart,” and “buy” that permit a consumer to directly purchase the goods. See Example 3 at [TMEP §904.03\(i\)\(B\)\(2\)](#). The presence of these features conveys the web page's point-of-sale character. For intangible goods, such as downloadable computer software programs, buttons and links for downloading, buying, or ordering goods should be considered sufficient ordering information. See [TMEP §904.03\(e\)](#).

“Where to buy” buttons and links are usually unacceptable since they typically provide only contact information for the retailers, wholesalers, or distributors of the goods instead of functioning as a means of directly ordering the goods, as shown in Example 12. See *In re Osterberg*, 83 USPQ2d 1220, 1224 (TTAB 2007) (finding a “Where to Buy” link insufficient ordering information since the record contained no information about what the link included and applicant's explanation in the appeal brief indicated that the link provided consumers a list of distributors and their websites from whom goods may be purchased).



Example 12: Web page specimen is not acceptable because, among other things, it lacks ordering information.

Mark: CONDOMTOY CONDOM

Goods: Condoms

The web page provides no means of ordering goods. While there is a "Where to Buy" button at the top, the record does not contain the underlying page the button would lead consumers to. While the applicant explained in the appeal brief that the link connects shoppers with distributors of the goods, the TTAB found this to be insufficient because consumers were not able to immediately and directly purchase the goods.

The applied-for mark is not associated with the goods because (1) the packaging for the goods shown on the web page shows the trademark "Inspiral" and not the applied-for mark, (2) the applied-for mark is not prominently displayed since it is buried in text and is not the first word of a sentence, and (3) while the applied-for mark is shown in bold font, the web page contains other descriptive terms that also appear in bold font.

The applicant submitted a declaration that lacked sufficient detail or explanation of how the web page is used at the point of sale.

904.03(i)(C)(2) Telephone Numbers and E-mail Addresses

In most cases, telephone numbers and e-mail addresses alone will not transform mere advertising into point-of-sale displays even though it is common to sell products on-line or over the telephone. *See In re Anpath Grp.*, 95 USPQ2d 1377, 1382 (TTAB 2010) . However, they may suffice if accompanied by special instructions for placing or accepting orders, such as “call now to buy” or “e-mail your order.” If no ordering instructions appear, telephone numbers and e-mail addresses may be sufficient if: (1) the web page contains enough product and ordering information to enable the consumer to buy the goods (e.g., the web page shows the goods; offers size, color, or quantity selections; price; identifies credit card payment options; or states shipping methods); (2) the record contains an explanation or evidence that clearly supports the conclusion that the telephone number or e-mail address can be used for ordering, rather than merely for obtaining information about the goods or the ordering process; or (3) the telephone number or e-mail address is prominently placed close to the goods, indicating it as a means of ordering (see Example 8). *See In re Valenite Inc.*, 84 USPQ2d 1346, 1349 (TTAB 2007) ; *In re Osterberg*, 83 USPQ2d at 1224 (indicating that applicant’s web-page specimen might have met the ordering information requirement for a point-of-purchase display if the web page had contained a telephone number or online process for ordering the goods, or if the record otherwise showed that “a purchase [could] be made directly from the webpage or from information provided in the webpage”).

However, even where a web page provides sufficient product information for the consumer to make the decision to purchase the goods, a telephone number or e-mail address may not show the requisite means of ordering if it only appears with applicant’s corporate contact information, as shown in Example 13. *See In re Genitope Corp.*, 78 USPQ2d 1819, 1822 (TTAB 2006) (concluding that the company name, address, and phone number appearing at the end of applicant’s web page “indicate[d] only location information about applicant; it [did] not constitute a means to order goods through the mail or by telephone, in the way that a catalog sales form provides a means for one to fill out a sales form or call in a purchase by phone”).

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Phase 3 Clinical Trial Update:
Study Closed to Patient Registration
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Insufficient Ordering Information

MyVax®
Dedicated to treating cancer one patient at a time™
Personalized Immunotherapy

Mark

Product Overview - MyVax® Personalized Immunotherapy

Our lead product candidate, MyVax® Personalized Immunotherapy (previously referred to as GTOP-99), is an investigational treatment based on the unique genetic makeup of a patient's tumor and is designed to activate a patient's immune system to identify and attack cancer cells. As such, MyVax® Personalized Immunotherapy is commonly referred to as a patient-specific or personalized immunotherapy, an active idotype immunotherapy, or a patient-specific or personalized cancer vaccine. This type of immunotherapy is intended to stimulate an active and durable immune response specifically against an individual patient's malignant cells. Each therapy is also tumor-specific, so that in theory, cells other than those of the tumor should not be affected. These are important differences compared to passive immunotherapies for non-Hodgkin's lymphoma (NHL), such as monoclonal antibodies that, while in circulation, target cell surface markers present on both malignant and non-malignant cells in every patient.

MyVax® Personalized Immunotherapy combines a protein derived from the patient's own tumor with an immunologic carrier protein and is administered with an immunologic adjuvant. The tumor-derived protein that is unique to each patient is the antibody expressed by the tumor cells. Each antibody has unique portions, collectively known as the idotype, which can be recognized by the immune system. The antibody that is unique to a given patient's tumor is often referred to as the idotype protein. Genitope's immunotherapy consists of the idotype protein and a foreign carrier protein administered with an adjuvant to enhance the immune response.

Immunologic carrier proteins are themselves strong antigens and are used to increase the immunogenicity of the patient-specific idotype. Adjuvants are molecules that attract and activate immune system cells at the site of immunization, which enhances the immune response. Currently, Genitope uses keyhole limpet hemocyanin, or (KLH), as a carrier protein for the idotype protein and granulocyte macrophage-colony stimulating factor, or GM-CSF, as an adjuvant.

Active immunotherapies, similar to MyVax® Personalized Immunotherapy, for the treatment of NHL have been studied in clinical trials since the late 1980's. Results from these trials suggest that active immunotherapy may induce long-term remission and may improve survival of NHL patients. Despite these results, further development of this immunotherapeutic approach has been limited by manufacturing difficulties. We have developed a proprietary manufacturing process that overcomes many of these historical manufacturing limitations. MyVax® Personalized Immunotherapy is currently in a pivotal Phase 3 trial and additional Phase 2 trials for the treatment of B-cell non-Hodgkin's lymphoma.

For more information on personalized immunotherapy and our product, please see the Patient Backgrounder in the Patient Resources section of our website.

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525 Penobscot Drive, Redwood City, CA 94063
(650) 482-2000 Fax (650) 482-2002 www.genitope.com

Insufficient Ordering Information

Example 13: Web-page specimen is not acceptable because it lacks ordering information.

Mark: Design of “fingerprint man”

Goods: Biopharmaceutical preparations used to treat cancer in humans, namely, individualized cancer treatments prepared specifically for each individual patient from whom tumor tissue has been received.

The web page provides no actual means of ordering goods since it states that the study is closed to patient registration and provides a link to “click here for more information” about the product instead of to order the product, and the page to which the link leads is not of record.

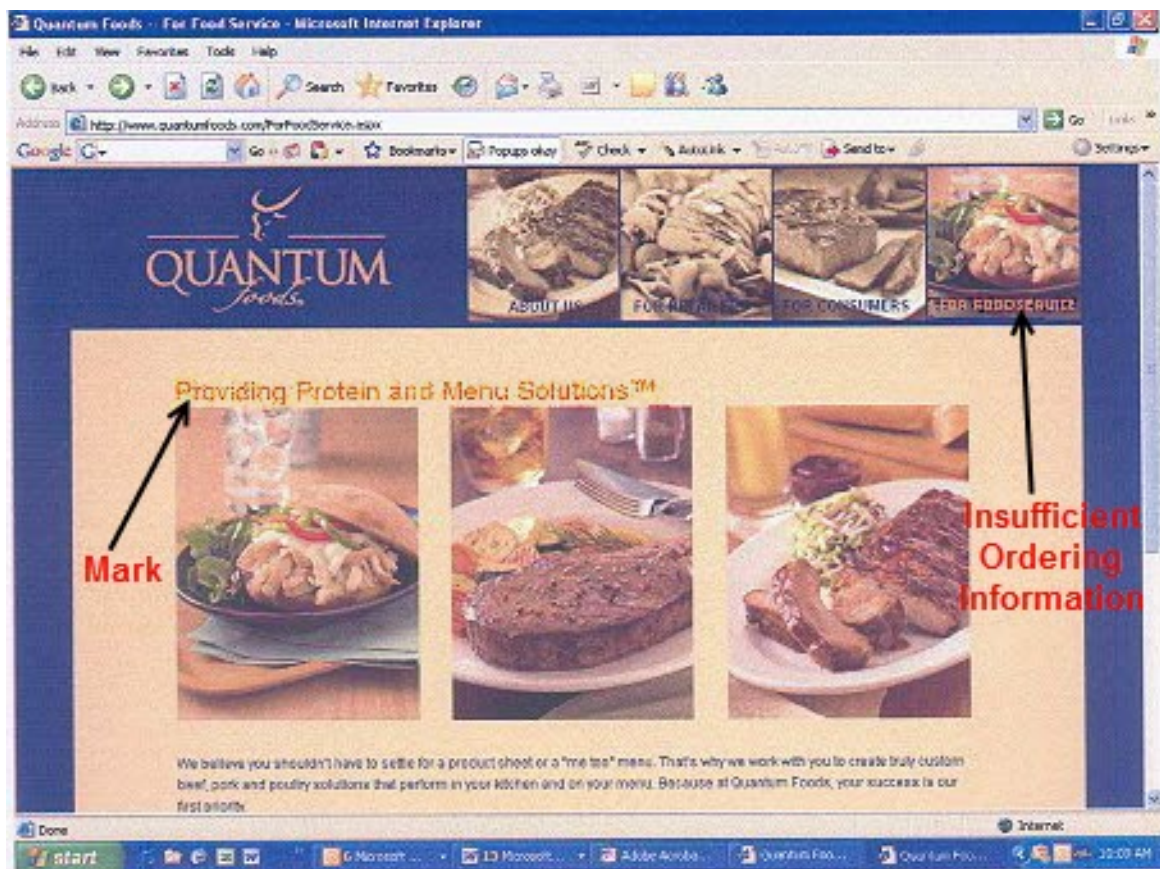
The company name, address, and telephone number at the bottom is only information about applicant's location and not a means of ordering goods.

By contrast, an e-mail address may be an acceptable means of ordering if the address itself indicates that orders may be placed or are accepted via e-mail (e.g., order@t.markey.com).

The rare case of specialized industrial goods or similarly complex or sophisticated goods for which technical assistance is required in selecting the product or determining the product specifications may present a special situation as to a telephone number showing the requisite ability to order. In such a special situation, the telephone number would suffice if product information is available on the web page or website and the evidentiary record adequately explains the specialized nature of the goods, the industry practice for ordering them, and the need to consult with sales staff over the telephone to place customized orders. In the case *In re Valenite Inc.*, the Board found a web page containing a link to an online catalog, along with a toll-free number and links to customer service and technical support, to be an acceptable specimen, where the goods (industrial tools) were specialized industrial goods, and the record contained declaration evidence that purchase of the goods requires careful calculation and technical knowledge, and that the phone numbers were in fact used to order the goods. *In re Valenite Inc.*, 84 USPQ2d at 1349-50 (“[A]pplicant’s website, in addition to showing pictures of the goods, provides an on-line catalog, technical information apparently intended to further the prospective purchaser’s determination of which particular product to consider, an online calculator and both a link to, and phone number for, customer service representatives. Therefore, applicant’s website provides the prospective purchaser with sufficient information that the customer can select a product and call customer service to confirm the correctness of the selection and place an order.”); *cf. In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002, 2007 (TTAB 2014) (stating that “where it is asserted that the nature of the goods and the consumers . . . require more involved means for ordering products, it is critical that the examining attorney be provided with detailed information about the means for ordering goods, and that such information be corroborated by sufficient evidentiary support.”). The *Valenite* decision should not be interpreted as a broad-reaching change in USPTO practice regarding the determination of whether a website page constitutes a display associated with the goods. If it appears that the web page merely provides information about the goods, but does not provide a means of ordering the goods directly from the applicant’s web page, it should be viewed as promotional material and a refusal should be issued. *Id.* at 2009 (finding that specimens did not contain adequate information for making a decision to purchase the goods and placing an order and, therefore, were advertisements). Given the narrow range of scenarios to which this decision applies, examining attorneys generally should avoid suggesting reliance on *Valenite* to overcome a specimen refusal.

904.03(i)(C)(3) “Contact Us,” “Customize,” or “Configure” Buttons and Links

“Contact Us” buttons and links usually are not acceptable because they generally do not enable direct ordering of the goods. These buttons and links typically route consumers to a different web page that offers only an invitation to obtain more information about the goods, or about the retailers, wholesalers, or distributors who actually sell the goods, as shown in Example 14. *See, e.g., In re Quantum Foods, Inc.*, 94 USPQ2d 1375, 1379 (TTAB 2010) (noting that the “contact us” link on applicant’s web-page specimen did not take customers to an order form, but instead routed to a web page with applicant’s e-mail address and telephone number); *cf. In re Genitope Corp.*, 78 USPQ2d 1819, 1822 (TTAB 2006) (stating that the web page did not provide a link to order the goods or explain how to order them, where the web page contained a link for “click here for more information” and provided links for “Patient Backgrounder” and “Patient Resources” for “more information on personalized immunotherapy and our products”).



Example 14: Web-page specimen is not acceptable because it lacks ordering information.

Mark: PROVIDING PROTEIN AND MENU SOLUTIONS

Goods: Processed meats, beef, pork, poultry and seafood sold in portions; fully cooked entrees consisting primarily of meat, beef, pork, poultry or seafood

The web page provides no means of ordering goods (e.g., no sales form, pricing, offers to accept orders, special instructions for ordering, or opportunity and means to order online) and the minimal product information makes it unclear what the goods are.

The TTAB found insufficient applicant's claims that placing the cursor over "FOODSERVICE" reveals a drop-down menu from which the "contact us" link is selected, which brings up a web page containing an e-mail address and telephone number for applicant's customer service department for ordering the goods.

Simply providing a "contact us" link does not convert advertising into a display and, in fact, the "contact us" link here does not even enable ordering, but only leads to applicant's contact information. While the "Contact Us" web page was rejected as untimely, the TTAB stated that, although it may

ultimately result in a sale, the “Contact Us” web page “appears to be no more calculated to do so than any corporate contact e-mail address or phone number that would result in the call or e-mail being referred to the sales office.” *In re Quantum Foods, Inc.*, 94 USPQ2d 1375, 1377 n.2 (TTAB 2010) .

By analogy, a seller’s contact information that often appears in advertisements does not provide a sufficient means of ordering, in contrast to a telephone number on a sales form designated to accept orders. *In re Genitope Corp.*, 78 USPQ2d at 1822.

Similarly, “Customize” and “Configure” buttons and links that allow customers to configure the goods generally are insufficient by themselves, since such features only enable personalization and not necessarily purchase of the goods. For these buttons and links to be deemed adequate means of ordering, the record must contain evidence that they permit customers to actually buy the goods. *See In re Dell Inc.*, 71 USPQ2d 1725, 1727 (TTAB 2004) (finding that a “Customize It” link was sufficient ordering means when the information on the website clearly indicated that the goods could be bought online via the link).

904.03(i)(D) Beta Websites

In some cases a specimen may consist of an excerpt from a website labeled as “beta.” This term is commonly used to describe a preliminary version of a product or service. Although some beta websites may not be accessible to consumers, others are. Thus, the use of this term in connection with an apparently functioning website shown in a specimen does not, by itself, necessarily mean that the relevant goods or services shown on the website are not in actual use in commerce or that the specimen is unacceptable. However, if examination of the specimen indicates that the beta version is not in actual use in commerce, the examining attorney must refuse registration under §§1 and 45 of the Trademark Act because applicant has not provided evidence of use of the applied-for mark in commerce. [15 U.S.C. §§1051, 1127](#). See [TMEP §1301.03\(a\)](#) regarding service mark specimens containing the term “beta.”

904.03(j) Manuals

If printed matter included with the goods functions as a part of the goods, such as a manual that is part of a kit for assembling the product, then placement of the mark on that printed matter does show use on the goods. *In re Ultraflight Inc.*, 221 USPQ 903, 906 (TTAB 1984) (“We believe the instruction manual is as much a part of applicant’s goods as are the various parts that are used to build the gliders. Application of the mark to the manual of assembly instructions, then, must be considered affixation to the goods.”).

904.03(k) Specimens for Marks that are Impracticable to Place on Goods, Packaging, or Displays

The USPTO may accept another document related to the goods or the sale of the goods when it is impracticable to place the mark on the goods, packaging, or displays associated with the goods. [15 U.S.C. §1127](#) (definition of “use in commerce”); [37 C.F.R. §2.56\(b\)\(1\)](#). This provision is not intended as a general alternative to submitting labels, tags, containers, or displays associated with the goods; it applies *only* to situations when the nature of the goods makes use on these items impracticable. For example, in rare circumstances it may be impracticable to place the mark on the goods or packaging for the goods if the goods are natural gas, grain that is sold in bulk, or chemicals that are transported only in tanker cars. In such instances, an acceptable specimen might be an invoice, a bill of lading, or a shipping document that shows the mark for the goods.

A mere assertion of impracticability does not suffice to establish that traditional trademark use is impracticable. Rather, the record must indicate that the goods are, in fact, of such a nature. In *In re Settec, Inc.*, 80 USPQ2d 1185 (TTAB 2006), the applicant asserted that placing the mark on the goods or on displays associated with the goods in the traditional manner was impracticable because the purpose of the goods was to provide digital media copy protection to media content providers, and placing the mark on the final product available to the ultimate end-user would impair the value of the goods, because the end-user would thereby be armed with an additional piece of the encryption puzzle. The Board rejected this contention, finding that there were a variety of ways in which applicant could use its mark in the traditional manner without making it available to the end-user.

904.03(l) Specimens for Motion Marks

To show that a motion mark actually identifies and distinguishes the goods/services and indicates their source, an applicant must submit a specimen that depicts the motion sufficiently to show how the mark is used on or in connection with the goods/services, and that matches the required description of the mark.

Although the drawing for a motion mark may depict a single point in the movement, or up to five freeze frames showing various points in the movement, an acceptable specimen should show the entire repetitive motion in order to depict the commercial impression conveyed by the mark (e.g., a video clip, a series of still photos, or a series of screen shots).

For TEAS applications under § 1(a), as well as response, statement of use/amendment to allege use, petition, and registration maintenance/renewal forms, the specimen can be attached to the TEAS form and must be an electronic file in .wav, .wmv, .wma, .mp3, .mpg, or .avi format. Audio files should not exceed 5 MB in size and video files should not exceed 30 MB because TEAS cannot accommodate larger files.

See [TMEP §807.11](#) regarding drawings for motion marks and [TMEP §904.02\(a\)](#) regarding specimens filed electronically.

904.03(m) Specimens for Scent and Flavor Marks

To show that the specimen for a scent or flavor mark actually identifies and distinguishes the goods and indicates their source, an applicant must submit a specimen that contains the scent or flavor and that matches the required description of the scent or flavor. In most cases, the specimen will consist of the actual goods themselves because the examining attorney must be able to smell or taste the scent or flavor in order to determine whether the specimen shows use of the mark in connection with the goods. When submitting such a specimen, the applicant should clearly indicate on the specimen itself that it is a specimen for a scent or flavor mark application so that the USPTO will properly route the actual specimen to the examining attorney.

A “scratch and sniff” sticker for a scent mark is an acceptable specimen, provided that it is part of the packaging for the goods or is used in such a manner as to identify the goods and indicate their source.

See also [TMEP §§807.09](#) and [1202.13](#) regarding scent and flavor marks.

904.04 Material Not Appropriate as Specimens for Trademarks

904.04(a) Drawing or “Picture” of the Mark; Digitally Created Specimen

A photocopy of the drawing required by 37 C.F.R. §2.51 is not a proper specimen. [37 C.F.R. §2.56\(c\)](#). Similarly, the specimen may not be a “picture” of the mark, such as an artist’s drawing, a printer’s proof, a computer graphic that merely illustrates what the mark looks like, or an image of the goods or advertising matter for services that has been digitally created or altered to include the mark. Such items 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 Act. [15 U.S.C §§1051](#) and [1127](#). See *In re Chica*, 84 USPQ2d 1845, 1848 (TTAB 2007) (holding that “a mere drawing of the goods with an illustration of how the mark may be displayed” was not an acceptable specimen because it did not show actual use in commerce); *In re The Signal Cos.*, 228 USPQ 956, 957-58 n.4 (TTAB 1986) (noting that a printer’s proof of an advertisement would not be an acceptable specimen because it does not show actual use in commerce). See [TMEP §904.07\(a\)](#) for further discussion of “use-in-commerce” refusals.

904.04(b) Advertising Material

Advertising material is generally not acceptable as a specimen for goods. Any material whose function is merely to tell the prospective purchaser about the goods, or to promote the sale of the goods, is unacceptable to support trademark use. Similarly, informational inserts are generally not acceptable to show trademark use. *In re MediaShare Corp.*, 43 USPQ2d 1304 (TTAB 1997); *In re Schiapparelli Searle*, 26 USPQ2d 1520 (TTAB 1993); *In re Drilco Indus. Inc.*, 15 USPQ2d 1671 (TTAB 1990); *In re ITT Rayonier Inc.*, 208 USPQ 86 (TTAB 1980); *In re Bright of Am., Inc.*, 205 USPQ 63 (TTAB 1979). However, an instruction sheet may be an acceptable specimen. See *In re Ultraflight Inc.*, 221 USPQ 903 (TTAB 1984). See [TMEP §904.03\(j\)](#) regarding manuals and [TMEP §904.04\(c\)](#) regarding package inserts.

The following types of items are generally considered advertising, and unless they comprise point-of-sale material, are not acceptable as specimens of use on goods: advertising circulars and brochures; price lists; announcements; press releases; listings in trade directories; business cards; and online advertising banners appearing on search-engine results pages or in social media. Moreover, material used by the applicant to conduct its internal business is unacceptable as a specimen of use on goods. These materials include all documents whose sole function is to carry out the applicant’s business dealings, such as invoices, bill heads, waybills, warranties, and business stationery. See *In re Chicago Rawhide Mfg. Co.*, 455 F.2d 563, 173 USPQ 8 (C.C.P.A. 1972); *In re Bright of Am.*, 205 USPQ at 65; *Upco Co. v. Speed Crete of La., Inc.*, 154 USPQ 555 (TTAB 1967); *Dynacolor Corp. v. Beckman & Whitley, Inc.*, 134 USPQ 410 (TTAB 1962); *Pendleton Woolen Mills v. Eloesser-Heynemann Co.*, 133 USPQ 211 (TTAB 1962); *Varian Assocs. v. IMAC Corp.*, 160 USPQ 283 (N.D. Ill. 1968); *Boss Co. v. Homemaker Rugs, Inc.*, 117 USPQ 255 (N.D. Ill. 1958).

Material that would otherwise be considered mere advertising may be acceptable as a specimen of use for goods if it includes a photograph of the applied-for mark appearing on the goods or on packaging for the goods. See [TMEP §§904.02\(b\)](#), [904.03](#), [904.03\(b\)](#), [904.03\(c\)](#).

As to display of trademarks on company uniforms, see *In re McDonald’s Corp.*, 199 USPQ 702 (TTAB 1978); *Toro Mfg. Corp. v. John B. Stetson Co.*, 161 USPQ 749 (TTAB 1969).

Bags and other packaging materials bearing the name of a retail store and used by the store merely for packaging items of sold merchandise are not acceptable to show trademark use of the store name for the

products sold by the store (e.g., bags at cash register). When used in this manner, the name merely identifies the store. *See In re The Pa. Fashion Factory, Inc.*, 198 USPQ 568 (TTAB 1978), *aff'd*, 588 F.2d 1343, 200 USPQ 140 (C.C.P.A. 1978).

904.04(c) Package Inserts

If material inserted in a package with the goods is merely advertising material, then it is not acceptable as a specimen of use on or in connection with the goods. Material that is only advertising does not necessarily cease to be advertising because it is placed inside a package.

Package inserts such as invoices, announcements, order forms, bills of lading, leaflets, brochures, printed advertising material, circulars, press releases, and the like are not acceptable specimens to show use on goods. *See In re Bright of Am., Inc.*, 205 USPQ 63 (TTAB 1979).

904.05 Affidavit Supporting Substitute Specimens

If the examining attorney determines that the specimen is not acceptable, the examining attorney will require the applicant to submit a substitute specimen. Generally, when submitting a substitute specimen, the applicant must include an affidavit or declaration under [37 C.F.R. §2.20](#) verifying that the substitute specimen was in use in commerce at least as early as the filing date of the application. [37 C.F.R. §2.59\(a\)](#). Similarly, when submitting an additional specimen in support of a multiple-class application that is not identical to the specimen originally filed, the applicant must include an affidavit or declaration under [37 C.F.R. §2.20](#) verifying that the new specimen was in use in commerce as of the pertinent date indicated in this section. *See* C.F.R. §§2.59, 2.86(a)(3), (b)(3). The affidavit or declaration must be signed by someone properly authorized to verify facts on behalf of the applicant under [37 C.F.R. §2.193\(e\)\(1\)](#). [37 C.F.R. §2.59\(a\)](#).

In an application under §1(a) of the Trademark Act, the affidavit or declaration must state that the substitute or additional specimen was in use in commerce at least as early as the application filing date. [37 C.F.R. §2.59\(a\)](#). If the applicant cannot provide an acceptable substitute specimen, supported by an affidavit or declaration of use in commerce as of the filing date of the application, the applicant may amend the basis to §1(b). *See* [37 C.F.R. §2.35\(b\)\(1\)](#). *See* [TMEP §806.03](#) regarding amendments to the basis.

In an application under §1(b) of the Act, an applicant who files a substitute or additional specimen after an amendment to allege use under §1(c) of the Act must include an affidavit or declaration under [37 C.F.R. §2.20](#) stating that the substitute or additional specimen was in use in commerce prior to filing the amendment to allege use. [37 C.F.R. §2.59\(b\)\(1\)](#). An applicant who files a substitute specimen after a statement of use under §1(d) of the Act must verify that the substitute or additional specimen was in use in commerce before the expiration of the deadline for filing the statement of use (i.e., within six months of the issuance date of the notice of allowance or before the expiration of an extension of time for filing a statement of use). [37 C.F.R. §2.59\(b\)\(2\)](#).

If the dates of use change as the result of the submission of new specimen(s), the applicant must file an amendment of the dates of use, supported by an affidavit or declaration under [37 C.F.R. §2.20](#). *See* [37 C.F.R. §2.71\(c\)](#); [TMEP §903.04](#).

In some situations, however, an affidavit or declaration of use of substitute specimens is not necessary. For instance, if the specimen originally filed is cut from a larger object, it is not necessary to provide an affidavit or declaration when a sample (or a photograph) of the complete object is submitted to corroborate the original

specimen. In these circumstances, the additional specimen is supplemental, and the examining attorney may consider the original specimens to have been satisfactory.

904.06 Translation of Matter on Specimens

If there is matter printed on a specimen that is not in English and that is necessary to permit proper examination, the examining attorney must either include a translation of this matter in the record or require that the applicant submit a translation of this matter. *See* [37 C.F.R. §2.61\(b\)](#). If the examining attorney determines that an English translation is necessary, he or she should limit the requirement in an appropriate manner to avoid placing an unnecessary burden on the applicant.

904.07 Requirements for Substitute Specimens and Statutory Refusals

904.07(a) Whether the Specimen Shows the Mark Used in Commerce

A §1(a) application for registration or an allegation of use submitted in a §1(b) application for a trademark or service mark must include one specimen per class, showing the applied-for mark in use in commerce on or in connection with the goods, or in the sale or advertising of the services. [15 U.S.C. §§1051\(a\)\(1\), \(c\), \(d\)\(1\), 1127](#); [37 C.F.R. §§2.34\(a\)\(1\)\(iv\), 2.56\(a\)-\(b\)\(2\), 2.76\(b\)\(2\), 2.88\(b\)\(2\)](#). Initially, the examining attorney must review the specimen to determine whether the applied-for mark appears on the specimen, the specimen shows use for the specific goods/services identified, and the specimen otherwise shows the applied-for mark in “use in commerce.”

The following non-exhaustive list reflects examples of “use-in-commerce” problems that may be raised on initial review of specimens:

- No specimen is submitted;
- The applied-for mark does not appear on the specimen;
- The specimen does not show use of the applied-for mark on or in connection with any of the relevant goods or in the sale or advertising of the services;
- The specimen is a printer’s proof of an advertisement for services;
- The specimen is a digitally created or altered image of the goods;
- The specimen is altered/mutilated/unprintable or illegible;
- The specimen is merely advertising material for goods;
- The specimen is merely a picture or drawing of the mark;
- The specimen is a photocopy of the drawing;
- The specimen is an electronic display associated with the goods (e.g., an online catalog, or web page display for goods), and fails to include ordering information or pricing;
- The specimen is a non-electronic point of sale display and fails to show use of the mark as a “display associated with the goods.”

In an Office action addressing such specimen issues, the examining attorney must indicate that registration is refused because the applicant has not provided evidence of use of the applied-for mark in commerce. The statutory bases for refusal are §§1 and 45 of the Trademark Act, [15 U.S.C. §§1051](#) and [1127](#). The examining attorney must also require the applicant to submit a substitute specimen and, if necessary, a supporting affidavit or declaration under [37 C.F.R. §2.20](#). *See* [37 C.F.R. §2.59](#). If the refusal is made because the specimen is altered, mutilated, or illegible, the applicant may respond by submitting a true, unaltered copy of the originally submitted specimen that is clear and readable, with a statement by the person who transmitted it that it is a true copy of the specimen that was originally submitted. [TMEP §904.02\(a\)](#); *see* [TMEP §904.02\(b\)](#).

This specimen refusal, based on an applicant's not providing the required evidence of use of the applied-for mark in commerce, also applies to specimens for collective and certification mark applications. A §1(a) application for registration or an allegation of use for a collective or certification mark must include one specimen per class, showing the applied-for mark in use in commerce on or in connection with an applicant's member's or authorized user's goods or in the sale or advertising of the services by an applicant's member or authorized user, for a collective trademark, collective service mark, or certification mark specimen, or to indicate membership in a collective membership organization, for a collective membership mark specimen. [15 U.S.C. §§1051\(a\)\(1\), \(c\), \(d\)\(1\), 1054, 1127](#); [37 C.F.R. §§2.44\(a\)\(4\)\(i\)\(C\), 2.45\(a\)\(4\)\(i\)\(E\), 2.56\(a\), \(b\)\(3\)-\(b\)\(5\), 2.76\(b\)\(2\), 2.88\(b\)\(2\)](#). If the specimen submitted does not show the applied-for mark in use in commerce, the examining attorney must refuse registration because the applicant has not provided evidence of use of the applied-for mark in commerce. The statutory bases for refusal are §§1, 4, and 45 of the Trademark Act, [15 U.S.C. §§1051, 1127](#). The examining attorney must also require the applicant to submit a substitute specimen and, if necessary, a supporting affidavit or declaration under [37 C.F.R. §2.20](#). See [37 C.F.R. §2.59](#). If the refusal is made because the specimen is altered, mutilated, or illegible, the applicant may respond by submitting a true, unaltered copy of the originally submitted specimen that is clear and readable, with a statement by the person who transmitted it that it is a true copy of the specimen that was originally submitted. [TMEP §904.02\(a\)](#); see [TMEP §904.02\(b\)](#).

For more information regarding specimens for collective trademarks and collective service marks see [TMEP §1303.01\(a\)\(i\)\(C\)](#), for collective membership marks see [TMEP §1304.02\(a\)\(i\)\(C\)](#), and for certification marks see [TMEP §§1306.02\(a\)\(i\)\(B\), 1306.04\(c\)-\(d\)](#).

904.07(a)(i) Action After Submission of Substitute Specimen

If the applicant responds to the Office action refusing registration by submitting a substitute specimen that does not show use of the mark in commerce for the same or a different “use-in-commerce” reason, such as the examples listed above, the examining attorney must issue a final refusal because the substitute specimen does not present a new issue. For example, if the original specimen was a photocopy of the drawing, and the applicant submits, in a response to the refusal, a substitute specimen that comprises advertising for its goods, this does not present a new issue. However, if the applicant responds to the refusal by submitting a substitute specimen that fails to show the applied-for mark functioning as a trademark or service mark (e.g., shows the mark is merely ornamental), this presents a new issue that requires issuance of a new nonfinal Office action. See [TMEP §904.07\(b\)](#) for a contrasting list of substantive reasons, relating to failure to function as a mark, that might present a new issue. Therefore, the examining attorney must issue a new refusal as to the substitute specimen, and must maintain the prior refusal as to the original specimen and indicate that the substitute specimen did not obviate the initial refusal.

If the applicant responds to the “use-in-commerce” refusal by submitting a substitute specimen, and unlike in the original specimen, the mark on the substitute specimen now does not agree with the mark on the drawing (see [TMEP §807.12](#)), but the specimen would otherwise be acceptable to show use in commerce, the examining attorney may allow the applicant to amend the drawing if such an amendment would not constitute a material alteration of the mark. If any remaining issues can be handled by examiner's amendment, and the mark is a standard character mark, the examining attorney may give the applicant the option to amend the drawing by examiner's amendment. If not, the examining attorney must issue a final refusal that also gives the applicant the option to overcome the refusal by submitting a substitute drawing.

If an amendment of the drawing would be a material alteration, the examining attorney must issue a final refusal (assuming the application is otherwise in condition for final refusal) because the substitute specimen does not present a new issue.

See [TMPEP §714.05](#) regarding new issues requiring issuance of nonfinal action.

904.07(b) Whether the Specimen Shows the Applied-for Mark Functioning as a Mark

In a §1(a) application for registration or an allegation of use submitted in a §1(b) application for a trademark or service mark, the examining attorney must also evaluate the specimen to determine whether the applied-for mark is used in a way that shows that: (1) the applied-for mark identifies the goods/services of the applicant and distinguishes them from the goods/services of others; and (2) the applied-for mark indicates the source of those goods/services. See [15 U.S.C. §1127](#). If use on the specimen fails in either regard, the record lacks the requisite evidence that the applied-for mark functions as a mark. The following non-exhaustive list reflects examples where review of the specimen would indicate a failure to function as a mark:

- Applied-for mark is used solely as a trade name (see [TMPEP §1202.01](#))
- Applied-for mark is mere ornamentation (see [TMPEP §1202.03](#));
- Applied-for mark is merely informational matter (see [TMPEP §§1202.04, 1301.02\(a\)](#));
- Applied-for mark identifies the name or pseudonym of a performing artist or author (see [TMPEP §1202.09\(a\)](#));
- Applied-for mark identifies the title of a single creative work (see [TMPEP §1202.08](#));
- Applied-for mark identifies a model number or grade designation (see [TMPEP §1202.16](#));
- Applied-for mark is merely a background design or shape that does not create a commercial impression separable from the entire mark (see [TMPEP §1202.11](#));
- Applied-for mark identifies a process, system, or method (see [TMPEP §1301.02\(e\)](#));
- Applied-for mark is used to refer to activities that are not considered “services” (see [TMPEP §§1301.01 et seq.](#));
- Applied-for mark is used solely as a domain name (see [TMPEP §1215.02](#));
- Applied-for mark is used solely to identify a character (see [TMPEP §1301.02\(b\)](#)).

If the deficiency in a specimen amounts to failure to demonstrate use of the applied-for mark as a trademark and/or service mark, the examining attorney must issue a “failure-to-function” refusal of registration on the ground that the applied-for mark does not function as a trademark or service mark, in addition to advising the applicant of the appropriate response options, which may include requiring the applicant to submit a substitute specimen. The statutory bases for refusal are §§1, 2, and 45 of the Trademark Act, [15 U.S.C. §§1051, 1052, 1127](#), for trademarks, or §§1, 2, 3, and 45 of the Trademark Act, [15 U.S.C. §§1051, 1052, 1053, 1127](#), for service marks. See *In re Osmotica Holdings Corp.*, 95 USPQ2d 1666 (TTAB 2010) ; *In re Supply Guys, Inc.*, 86 USPQ2d 1488 (TTAB 2008); *In re wTe Corp.*, 87 USPQ2d 1536 (TTAB 2008) ; *In re DSM Pharms., Inc.*, 87 USPQ2d 1623 (TTAB 2008). Generally, when initially refusing registration on the ground that the subject matter does not function as a trademark or service mark, the examining attorney should advise the applicant that the refusal will be reconsidered if the applicant submits a substitute specimen showing proper use of the applied-for mark as a trademark or service mark and, if necessary, a supporting affidavit or declaration. See [TMPEP §904.05](#) regarding affidavits supporting new specimens. However, in instances where the nature of the mark, such as with informational marks, indicates that consumers would never perceive the mark as source indicating, regardless of the manner of use, no such advisory need be given.

This “failure-to-function” specimen refusal also applies to specimens for collective and certification mark applications. If the deficiency in a specimen amounts to failure to demonstrate use of the applied-for mark as a collective or certification mark, the examining attorney must issue a “failure-to-function” refusal of registration on the ground that the applied-for mark does not function as a collective or certification mark and advise the applicant of the appropriate response options, which may include requiring the applicant to

submit a substitute specimen. The statutory bases for refusal are §§1, 2, 4, and 45 of the Trademark Act, [15 U.S.C. §§1051, 1052, 1053, 1127](#). See *In re Int'l Inst. of Valuers*, 223 USPQ 350 (TTAB 1984) ; *In re Mountain Fuel Supply Co.*, 154 USPQ 384 (TTAB 1967) ; *Ex parte Van Winkle*, 117 USPQ 450 (Comm'r Pats. 1958). Generally, when initially refusing registration on the ground that the subject matter does not function as a collective or certification mark, the examining attorney should advise the applicant that the refusal will be reconsidered if the applicant submits a substitute specimen showing proper use of the applied-for mark as a collective or certification mark and, if necessary, a supporting affidavit or declaration. See [TMEP §904.05](#) regarding affidavits supporting new specimens. However, in instances where the nature of the mark, such as with informational marks, indicates that consumers would never perceive the mark as source indicating, regardless of the manner of use, no such advisory need be given.

For additional specimen refusals for collective and certification marks and more information regarding whether the specimen shows the applied-for mark functioning as a collective or certification mark, see [TMEP §1303.01\(a\)\(i\)\(C\)](#) for collective trademark and collective service mark specimens, see [TMEP §1304.03\(b\)](#) for collective membership mark specimens, and see [TMEP §1306.04\(c\)-\(d\)](#) for certification mark specimens.

904.07(b)(i) Action After Submission of Substitute Specimen

Because the examining attorney has advised the applicant of the appropriate response options, which may include the general requirements for a substitute specimen, if the applicant responds to the failure-to-function refusal by submitting a specimen that does not show the mark in use in commerce for a reason such as those set out in [TMEP §904.07\(a\)](#), the examining attorney must issue a final refusal, as no new issue is presented. For example, if the original specimen was refused as ornamental and the substitute specimen does not show the applied-for mark, the examining attorney may issue a final refusal. By contrast, if the applicant responds to the Office action refusing registration by submitting a substitute specimen that reflects failure to function as a mark for a different substantive reason, such as the examples listed in [TMEP §904.07\(b\)](#), the examining attorney must issue a new nonfinal Office action because the substitute specimen presents a new issue. For example, if the original specimen shows the mark used merely as a domain name, and the applicant submits a substitute specimen that shows the mark used in an ornamental manner, this presents a new issue. Therefore, the examining attorney must issue a new refusal as to the substitute specimen, and must maintain the prior failure-to-function refusal as to the original specimen and indicate that the substitute specimen did not obviate the initial refusal. If the applicant responds to the refusal by submitting a substitute specimen that fails to show the applied-for mark functioning as a trademark or service mark for the same reason as the original specimen (e.g., the original specimen was refused as ornamental and the substitute specimen also reflects ornamental use), this does not present a new issue and the examining attorney must issue a final Office action.

If the applicant responds to the failure-to-function refusal by submitting a substitute specimen, and unlike in the original specimen, the mark on the substitute specimen now does not agree with the mark on the drawing (see [TMEP §807.12](#)), but the specimen would otherwise be acceptable to identify the goods/services of the applicant and indicate the source of those goods/services, the examining attorney may allow the applicant to amend the drawing if such an amendment would not constitute a material alteration of the mark.

If any remaining issues can be handled by examiner's amendment, and the mark is a standard character mark, the examining attorney may give the applicant the option to amend the drawing by examiner's amendment. If not, the examining attorney should issue a final refusal that also gives the applicant the option to overcome the refusal by submitting a substitute drawing.

If an amendment of the drawing would be a material alteration, the examining attorney must issue a final refusal (assuming the application is otherwise in condition for final refusal), because the substitute specimen does not present a new issue. See [TMEP §714.05](#).

See [TMEP §714.05](#) regarding new issues requiring issuance of nonfinal action, [§§1202](#) *et seq.* regarding matter that does not function as a trademark, and [TMEP §§1301.02](#) *et seq.* regarding matter that does not function as a service mark.

905 Method of Use

The applicant is not required to specify the method or intended method of use of a mark. However, the examining attorney has the discretion under [37 C.F.R. §2.61\(b\)](#) to inquire as to the method or intended method of use of the mark if this information is needed to properly examine the application. See [TMEP §814](#); see also *In re Page*, 51 USPQ2d 1660, 1665 (TTAB 1999).

906 Federal Registration Notice

The owner of a mark registered in the United States Patent and Trademark Office may give notice that the mark is registered by displaying with the mark the words “Registered in United States Patent and Trademark Office,” the abbreviation “Reg. U.S. Pat. & Tm. Off.,” or the letter R enclosed within a circle, ®. [15 U.S.C. §1111](#).

The registration symbol should be used only on or in connection with the goods/services/collective membership organization listed in the registration.

The federal registration symbol may not be used with marks that are not actually registered in the USPTO. Even if an application is pending, the registration symbol may not be used until the mark is registered.

Registration in a state of the United States does not entitle a person to use the federal registration notice. *Du-Dad Lure Co. v. Creme Lure Co.*, 143 USPQ 358 (TTAB 1964) .

A party may use terms such as “trademark,” “trademark applied for,” “TM” and “SM” regardless of whether a mark is registered. These are not official or statutory symbols of federal registration.

906.01 Foreign Countries That Use Registration Symbol ®

In addition to the United States, several countries recognize use of the symbol ® to designate registration. When a foreign applicant’s use of the symbol on the specimens is based on a registration in a foreign country, the use is appropriate.

The following foreign countries use the ® symbol to indicate that a mark is registered in their country:

- Belgium
- China (People’s Republic)
- Costa Rica
- Denmark
- Ecuador
- Germany

- Guatemala
- Hungary
- Luxembourg
- Netherlands
- Nicaragua
- Poland
- Sweden

906.02 Improper Use of Registration Symbol

Improper use of the federal registration symbol that is deliberate and intended to deceive or mislead the public is fraud. *See* [TMEP §906.04](#). However, misunderstandings about use of federal registration symbols are more frequent than occurrences of actual fraudulent intent. Common reasons for improper use of the federal registration symbol that do not indicate fraud are:

- Mistake as to the requirements for giving notice (confusion often occurs between notice of *trademark* registration, which may not be given until after registration, and notice of claim of *copyright*, which must be given before publication by placing the notice © on material when it is first published);
- Inadvertence in not giving instructions (or adequate instructions) to the printer, or misunderstanding or voluntary action by the printer;
- The mistaken belief that registration in a state or foreign country gives a right to use the registration symbol (*see Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752 (TTAB 2009) ; *Du-Dad Lure Co. v. Creme Lure Co.*, 143 USPQ 358 (TTAB 1964));
- Registration of a portion of the mark (*see Coca-Cola Co. v. Victor Syrup Corp.*, 218 F.2d 596, 104 USPQ 275 (C.C.P.A. 1954));
- Registration of the mark for other goods (*see Duffy-Mott Co. v. Cumberland Packing Co.*, 424 F.2d 1095, 165 USPQ 422 (C.C.P.A. 1970) , *aff'd* 154 USPQ 498 (TTAB 1967); *Meditron Co. v. Meditronic, Inc.*, 137 USPQ 157 (TTAB 1963));
- A recently expired or cancelled registration of the subject mark (*see Rieser Co. v. Munsingwear, Inc.*, 128 USPQ 452 (TTAB 1961));
- Another mark to which the symbol relates on the same label (*see S.C. Johnson & Son, Inc. v. Gold Seal Co.*, 90 USPQ 373 (Comm'r Pats. 1951)).

See also Sauquoit Paper Co. v. Weistock, 46 F.2d 586, 8 USPQ 349 (C.C.P.A. 1931); *Dunleavy Co. v. Koepfel Metal Furniture Corp.*, 134 USPQ 450 (TTAB 1962) , *aff'd*, 328 F.2d 939, 140 USPQ 582 (C.C.P.A. 1964); *Radiant Mfg. Corp. v. Da-Lite Screen Co.*, 128 USPQ 132 (TTAB 1961) ; *Tobacco By-Products & Chem. Corp. v. Smith*, 106 USPQ 293 (Comm'r Pats. 1955), *modified* 243 F.2d 188, 113 USPQ 339 (C.C.P.A. 1957).

906.03 Informing Applicant of Apparent Improper Use

If a specimen in an application shows the federal registration symbol used with the mark that is the subject of the application, or with any portion of this mark, the examining attorney must determine from USPTO records whether or not such matter is registered. If it is not, and if the symbol does not appear to indicate registration in a foreign country (*see* [TMEP §906.01](#)), the examining attorney must point out to the applicant that the records of the USPTO do not show that the mark with which the symbol is used on the specimens is registered, and that the registration symbol may not be used until a mark is registered in the USPTO. The examining attorney should not require any explanation or comment from the applicant concerning the use of the symbol in relation to the mark.

906.04 Fraud

Improper use of the federal registration symbol, ®, that is deliberate and intends to deceive or mislead the public or the USPTO is fraud. *See Copelands' Enters. Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); *Wells Fargo & Co. v. Lundeen & Assocs.*, 20 USPQ2d 1156 (TTAB 1991) .

The examining attorney may not issue a refusal of registration based on fraud. If it appears to the examining attorney that fraud on the USPTO has been committed, the examining attorney must follow the procedures outlined in [TMEP §720](#).

907 Compliance with Other Statutes

37 CFR §2.69 Compliance with other laws.

When the sale or transportation of any product for which registration of a trademark is sought is regulated under an Act of Congress, the Patent and Trademark Office may make appropriate inquiry as to compliance with such Act for the sole purpose of determining lawfulness of the commerce recited in the application.

Use of a mark in commerce must be lawful use to be the basis for federal registration of the mark. *Gray v. Daffy Dan's Bargaintown* , 823 F.2d 522, 526, 3 USPQ2d 1306, 1308 (Fed. Cir. 1987); *see* [15 U.S.C. §§1051, 1127](#); [37 C.F.R. §2.69](#); *In re Midwest Tennis & Track Co.*, 29 USPQ2d 1386, 1386 n.2 (TTAB 1993) ; *In re Stellar Int'l, Inc.*, 159 USPQ 48, 50-51 (TTAB 1968) . Thus, the goods or services to which the mark is applied, and the mark itself, must comply with all applicable federal laws. *See In re Pepcom Indus., Inc.*, 192 USPQ 400, 401 (TTAB 1976) (“In order for [an] application to have a valid basis that could properly result in a registration, the use of the mark [has] to be lawful, i.e., the sale or shipment of the product under the mark [has] to comply with all applicable laws and regulations. If this test is not met, the use of the mark fails to create any rights that can be recognized by a Federal registration.”). In addition, “the fact that the provision of a product or service may be lawful within a state is irrelevant to the question of federal registration when it is unlawful under federal law.” *In re Brown*, 119 USPQ2d 1350, 1351 (TTAB2016) .

Generally, the USPTO presumes that an applicant's use of the mark in commerce is lawful. Thus, registration will not be refused based on the absence of lawful use in commerce unless “either (1) a violation of federal law is indicated by the application record or other evidence, such as when a court or a federal agency responsible for overseeing activity in which the applicant is involved, and which activity is relevant to its application, has issued a finding of noncompliance under the relevant statute or regulation, or (2) when the applicant's application-relevant activities involve a *per se* violation of a federal law.” *In re Brown*, 119 USPQ2d at 1351; *see also Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2047 (TTAB 1988) .

If the record in an application based on Trademark Act Section 1(a) indicates that the mark itself or the identified goods or services violate federal law, registration must be refused under Trademark Act Sections 1 and 45, based on the absence of lawful use of the mark in commerce. *See* [15 U.S.C. §§1051, 1127](#); [37 C.F.R. §2.69](#); *In re Stellar Int'l, Inc.*, 159 USPQ 48, 50-51 (TTAB 1968) .

For applications based on Trademark Act Section 1(b), 44, or 66(a), if the record indicates that the mark or the identified goods or services are unlawful, actual lawful use in commerce is not possible. *See In re JJ206, LLC*, 120 USPQ2d 1568, 1569 (TTAB 2016); *John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1948 (TTAB 2010). Thus, a refusal under Trademark Act Sections 1 and 45 is also appropriate for these non-use-based applications, because the applicant does not have a bona fide intent to lawfully use the mark in commerce. *See* [15 U.S.C. §§1051, 1127](#); *In re JJ206, LLC*, 120 USPQ2d at 1569; *John W. Carson Found.*, 94 USPQ2d at 1948.

Under Trademark Rules 2.61(b) and 2.69, [37 C.F.R. §§2.61\(b\)](#) and [2.69](#), examining attorneys may require additional information about the goods or services and inquire about compliance with federal laws to support a refusal or otherwise facilitate proper examination. See [TMEP §814](#). Before issuing an inquiry or refusal pertaining to the lawfulness of goods or services, examining attorneys must obtain approval from their managing attorney or senior attorney, who may seek additional guidance from the Administrator for Trademark Policy and Procedure.

For the purpose of determining whether to issue an inquiry or refusal, the USPTO will not regard apparent technical violations, such as labeling irregularities on specimens, as violations. For example, if a package fails to show all required labeling information, the examining attorney should not take any action. Likewise, the USPTO does not routinely solicit information regarding label approval under the Federal Alcohol Administration Act or similar acts. However, if the record indicates that the mark itself or the goods or services violate federal law, an inquiry or refusal must be made. For example, evidence indicating that the identified goods or services involve the sale or transportation of a controlled substance or drug paraphernalia in violation of the Controlled Substances Act (“CSA”), 21 U.S.C. §§801-971, would be a basis for issuing an inquiry or refusal. See *In re JJ206, LLC*, 120 USPQ2d at 1569-70; *In re Brown*, 119 USPQ2d at 1351-53. Subject to certain limited statutory exceptions, the CSA makes it unlawful to manufacture, distribute, or dispense a controlled substance; possess a Schedule I controlled substance; or sell, offer for sale, or use any facility of interstate commerce to transport drug paraphernalia. See 21 U.S.C. §§ 812(b)(1)(B), 841(a)(1), 844(a), 863. Note that, regardless of state law, marijuana and its psychoactive component, THC, remain Schedule I controlled substances under federal law and are subject to the CSA’s prohibitions. 21 C.F.R. §1308.11; see U.S. Const. Art. VI. Cl. 2; *Gonzales v. Raich*, 545 U.S. 1, 27, 29 (2005); *United States v. Oakland Cannabis Buyers’ Coop.*, 532 U.S. 483, 491 (2001); *In re JJ206, LLC*, 120 USPQ2d at 1571; *In re Brown*, 119 USPQ2d at 1352.

When refusing registration, the examining attorney must indicate the particular law that is violated by the mark or the identified goods or services.

If, in response to a requirement for information or a refusal, the applicant indicates that the relevant goods or services comply with federal law, but there is extrinsic evidence indicating that the goods or services do not, in fact, comply with federal law, the examining attorney must refuse registration (or maintain the prior refusal), citing the relevant extrinsic evidence.

See [TMEP §1205](#) regarding refusal of registration of matter that is protected by a statute or convention.