

Trademark Use in the U.S.

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Demystifying What Constitutes an Acceptable Specimen of Use

Evidence of use is, in most circumstances, essential to securing and maintaining a U.S. trademark registration. Subject to certain limited exceptions involving foreign trademarks, the U.S. Trademark Office will not issue a U.S. trademark registration without appropriate proof of use. Similarly, to maintain a U.S. trademark registration, a registrant must submit adequate proof of use to the Trademark Office. While this sounds straightforward, in practice, it can sometimes be very difficult to find evidence of use that the Trademark Office will accept.

According to the Trademark Manual of Examining Procedure, § 904, specimens “are required because they show the manner in which the mark is seen by the public.” Acceptable specimens can be labels and tags affixed to goods or the containers for goods (but not mockups), stampings on products, commercial packaging, screenshots from a computer program or a frame of a movie or video, a website from which software can be downloaded, point of sale displays, catalogs with ordering information, websites from which products can be ordered, and manuals. TMEP §§ 904.03 (a) through 904.03 (k). On the other hand, printer’s proofs, mockups, renderings, and advertising materials are generally not acceptable as evidence of use. TMEP §§ 904.03 (a) through 904.03 (k).

Once evidence of use is submitted, the Trademark Office will examine it carefully. If it is not accepted, an Office Action will be issued, after which one will have the ability to submit a substitute specimen that was in use as of the pertinent date (usually the date on which the original specimen was submitted). TMEP § 904.05.

Obtaining an acceptable specimen is often one of the most difficult parts of preparing a trademark application or a maintenance filing. This is in part because the Trademark Office examines them so carefully but also partly because there is a desire to avoid the expense of repeated filings with the Trademark Office. Indeed, failure to submit an acceptable specimen can lead to the refusal of an application, as demonstrated by a recent case.

Hi-Tech Pharmaceuticals, Inc. sought to register EXPERIMENTAL AND APPLIED SCIENCES as a trademark for use in connection with dietary and nutritional supplements. As evidence of use, it submitted an original specimen and a substitute specimen. The original specimen was five pages long, consisting of a screen capture of a web page showing five different products. The proposed mark did not appear on the first page, but it did appear on close-ups of two supplement bottles that were part of the specimen. The close-ups showed the proposed mark on the lower back portion of the label, on one line of a four-line group. All four lines were the same color, appeared in the same font size and style, and had the same justification. The proposed mark appeared at the end of the following sentence: “Developed and exclusively manufactured by Experimental And Applied Sciences”; because of its positioning, the proposed mark was on the second line. The next line had the applicant’s address, and the following line had the applicant’s phone number and website address.

The Examining Attorney refused registration of the mark, taking the position that the evidence of use showed the proposed mark being used as a trade name, not as a trademark (the submitted evidence did not show the proposed mark anywhere else on the bottle). The Trademark Trial and Appeal Board affirmed on appeal, agreeing with the Examining Attorney that the “applicant would be hard-put to present the term in a **less** prominent manner.” (emphasis in original). The TTAB explained that the proposed mark appeared as part of a visual unit and that, as a result, the impression was that the proposed mark should be read in the context of the lines around it. Therefore, registration was refused. An acceptable specimen would have led to a different result.

While the Hi-Tech Pharmaceuticals case was in the context of seeking registration of a mark, it applies with equal force to maintenance filings—an improper specimen can lead to the cancellation of a registration mark. Thus, in either context, it is important to work with experienced counsel to make sure that a mark is being used in a manner that demonstrates trademark use and that will be accepted by the Trademark Office. If there is any doubt about whether the Trademark Office will accept use, please contact me (preferably well in advance of any deadlines).