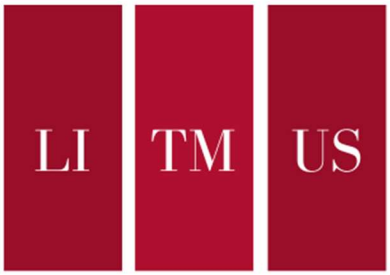

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Proper Specimens for the USPTO

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LI TM US

U.S. TRADEMARK SPECIMENS

What Is a Specimen?

Proof of use of a mark in the U.S. is required to obtain a registration (unless there is a home country or Madrid registration basis) and to maintain *any* U.S. trademark registrations (when filing the Declaration of Continued Use during the sixth year of registration and at renewal at each 10-year anniversary). This proof of use is known as a "specimen." Specimens show how the mark is seen by the public. A mere copy of the mark is not an acceptable specimen; the specimen must show the mark EXACTLY as registered, *as actually used* on or in connection with the goods or in connection with the offering or promotion of the services claimed in an application or registration. A specimen is required for each class of goods or services recited in the application or registration. Although only one specimen per class is required, it is advisable to submit specimens for a number of the listed goods/services, if possible, especially where recitations are lengthy.[1] The same specimen may be used for more than one class of services, if appropriate. A statement verifying that the mark is used on **all** goods and/or services claimed must be filed with the specimen(s). U.S. trademark law requires that any goods/services not in use in the U.S. be deleted when a Statement of Use, Declaration of Continued Use, or Renewal is filed.

> **Pro Tip**: The USPTO examines specimens of use (whether filed during prosecution of an application or with a Declaration of Continued Use) very strictly, and Examiners may request additional information and/or additional specimens if they believe specimens are not genuine and/or do not show the mark as actually used in U.S. commerce. The USPTO's stringent specimen requirements, intended to prevent the use of fraudulent and/or digitally altered specimens, can be onerous, especially for applications/registrations reciting long lists of goods/services. When Declarations of Use are examined, the USPTO may require additional specimens for specific goods. For example, Examiners have rejected specimens that show goods on a white background, on the grounds that they "appear to be merely digital renderings" rather than photographs of the actual goods. It is recommended that photographic specimens show the goods in a physical setting such as in a room or on a desk or tabletop, so it is obvious and clear to the Examiner that they are photographs of the actual goods rather than just digital images.

A specimen must show the mark as it is *currently* being used in the U.S.

If a mark includes a design element, the specimen must show the design; if color(s) is/are claimed, the specimen must show use of the color(s). (If there are no specimens available that show the

[1] Recitations that include more than four goods or services are more likely to be targeted for an audit by the USPTO which can be time consuming and expensive. Having multiple specimens where there are lengthy recitations may help avoid an audit. See below.

mark precisely as it appears in the application/registration, it may be possible to use, "substantially exact" specimens. These specimens must show the mark in a form that is not materially different from the mark in the application/registration.)

Acceptable Specimens for <u>Goods</u> include:

- Photographs that show use of the mark placed (e.g., printed, stamped, embossed, etched) on the goods, or on labels or tags *affixed to the goods.* A tag or label alone is not sufficient; the tag or label must be shown affixed to the goods. If not affixed, a tag/label *may* be acceptable if it clearly shows the mark in actual use in commerce. To clearly show actual use in commerce, the tag or label would, in addition to showing the mark, include informational matter that typically appears on a label in use in commerce for the relevant types of goods (such as net weight, volume, UPC bar codes, lists of contents or ingredients, or other information that is not part of the mark but provides information about the goods).
- Photographs of the mark on a container or packaging where the goods are visible through the packaging or it is clear what the goods are (such as goods packaged in clear plastic or multiple pictures to show the packaging and then the packaging open with the goods).
- A display associated with the goods (such as such as banners, shelf-talkers, window displays, menus). The display must be associated directly with the goods offered for sale and must bear the trademark prominently.
- Catalogs, web page printouts or screen shots that show the mark being used in connection with the goods at their point of sale in a manner that directly associates the mark with the goods. Web page printouts must show the URL and the access or print date as well as showing the mark associated with the goods and must include relevant ordering information (such as price) in addition to a means of ordering/purchasing the goods. Catalogs must provide information sufficient to make a purchase and a means of ordering the product. NOTE: Web site excerpts (unless they are point-of-purchase as discussed above), advertising, promotional materials and the like (such as brochures, print ads) will NOT be accepted by the USPTO as specimens for goods. "Contact Us" buttons and links (alone) usually are not acceptable because they generally do not enable direct ordering of the goods.
- For computer software: a screen shot or printout of the software in use, showing the mark while the software is running and the download screen shot (if downloadable).
- Instruction and installation manuals may be acceptable, if they must be distributed with the goods.

If goods (such as chemicals) do not have labels or tags, cannot be seen through their packaging, and cannot be removed from their containers and photographed, an explanation and additional information (such as a Material Safety Data Sheet (MSDS) evidencing commercial presence) must be submitted along with a photograph of the container/label showing the mark.

Some examples of acceptable specimens for goods are shown below.

Advertising or promotional material, invoices, order forms, bills of lading, leaflets, brochures, circulars, press releases, and the like are generally not acceptable specimens for *goods*.

> **Pro Tip**: In some cases, such as when a small label is affixed to a large product, it may be necessary to submit more than one specimen for the same goods – for example, a close-up photograph of the label on the goods that clearly shows the mark, and a photograph from a greater distance that clearly shows what the goods are as well as the placement of the label. If goods do not have labels or tags, or cannot be seen through their packaging, the goods can be removed from their packaging and photographed next to the container/packaging showing the mark.

Acceptable Specimens for Services include:

- Copies of advertising, such as brochures or flyers, where the mark is used in a manner that directly associates the mark with the services.
- Photographs of billboards.
- Photographs of business signage where it is clear what the business offers.
- Photographs of the mark on service vehicles which are used in connection with the offering of the services.
- Screenshots or website printouts *showing the URL and date of printing* where the mark is used in the actual sale or advertising of the services.
- Business documents such as letterhead and invoices *may* be acceptable service mark specimens if they show the mark and refer to the relevant services.

The specimen must show an association between the mark and the services. A specimen that shows only the mark, with no reference to the services, is not sufficient to show service mark usage.

Press releases that are publicly available (e.g., on the trademark owner's website) can be acceptable specimens. However, press releases sent exclusively to news media, or printed articles resulting from such press releases, are not acceptable because they do not show use of the mark by the applicant.

Some examples of acceptable specimens for services are shown below.

Specimens for Sound, Motion or Sensory Marks

Specimens for sound or motion marks can be submitted as electronic files. For sensory marks (such as scent or flavor), the specimen will usually 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.

When Must Specimens Be Filed?

If an application is filed claiming **use** in the U.S., the specimen should be filed with the application.

If an application is filed based on "intent to use" the mark in the U.S., proof of use in the U.S. must be filed before the application can proceed to registration. The specimen(s) and Statement of Use must be filed within three years from the date a Notice of Allowance is issued. (Extension requests must be filed at six-month intervals after the Notice of Allowance is issued.)

For an application based upon a home country registration or an extension of an International Registration, no use is required in the U.S. prior to registration.

Specimens of use must be filed for all U.S. registrations (including extensions of International Registrations) between the fifth and sixth year of registration and during each tenth anniversary of registration.

Audit Process for Maintenance Documents

When a Declaration of Continued Use is examined, the USPTO can issue an "audit" notice (a type of Office Action) requiring additional specimens for any specific goods/services that were included in the maintenance filing. Audits are especially likely when numerous goods/services are recited (particularly when there are more than four items in a single class). Any goods or services not in use in the U.S. must be deleted from the registration when a Declaration of Use is filed. Responding to an "audit" Office Action can be time-consuming and costly, and failure to respond will result in cancellation of the registration. Further, if specimens required by the Examiner are not available, the Registrant must then submit specimens for EVERY good/service to be maintained in the registration There are additional government fees if any goods/services are deleted from the registration during the audit process.

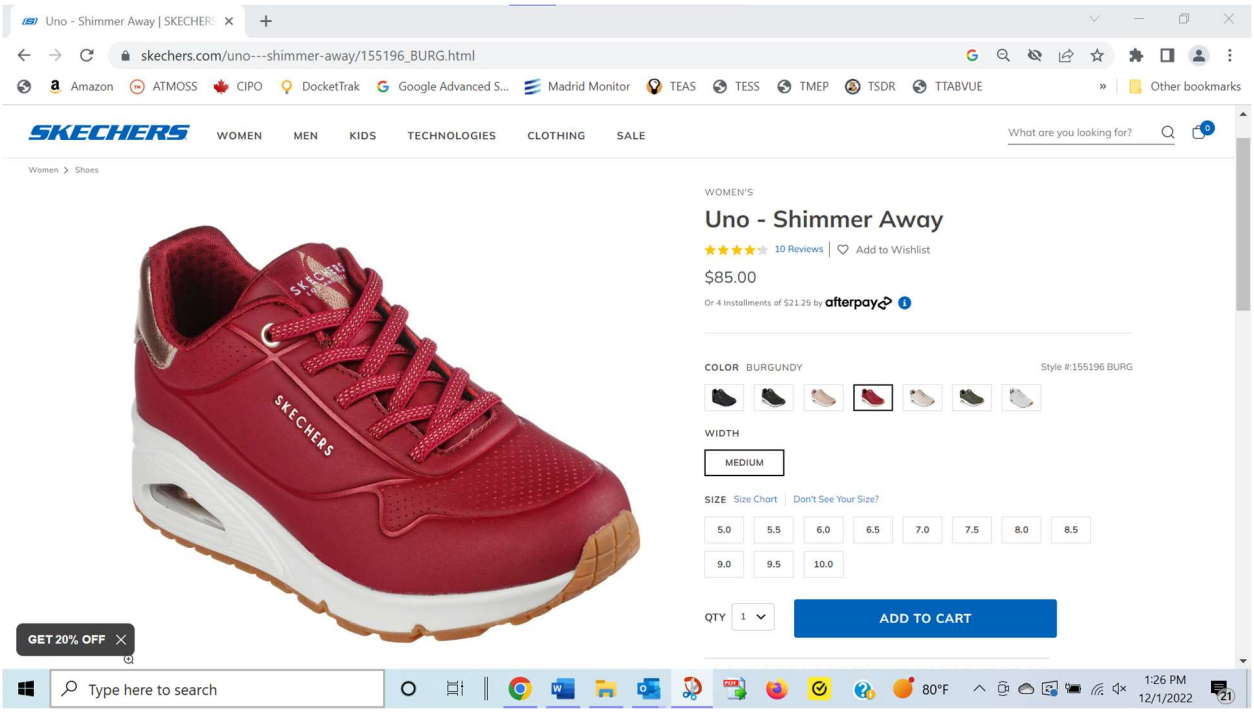
U.S. Trademark Office specimen requirements can be extremely onerous, and care must be taken to ensure that proof of use can be provided for any goods/services claimed in a Statement of Use, Declaration of Use, or renewal application.

Examples of Acceptable Specimens for Goods

Specimen for STOLICHNAYA (word mark and script version) vodka (label on bottle)

Specimen for HP computer (mark imprinted on goods)

Web Page Specimen for SKECHERS (and likely for UNO or SHIMMER AWAY) sneakers
(includes URL, date accessed/printed, mark, information/picture for goods, price, means of ordering/purchasing, "cart" button)



Specimen for KEDS sneakers (tag on product)

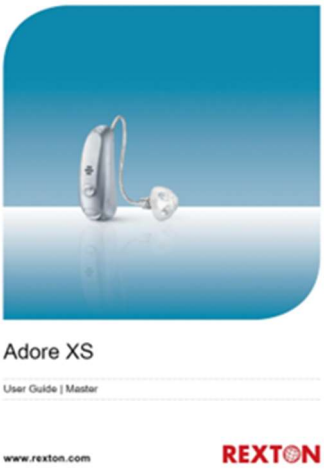
Specimen for BARILLA pasta
(product visible through packaging)

Gift pack packaging
STOLI vodka or ginger beer
(or possibly for The Mule Pack)

Bottle necker
AMERICA'S ORIGINAL
CRAFT VODKA

Shelf talker
MIRA'S HOMEMADE

User guide for ADORE hearing aids (first page and representative pages)

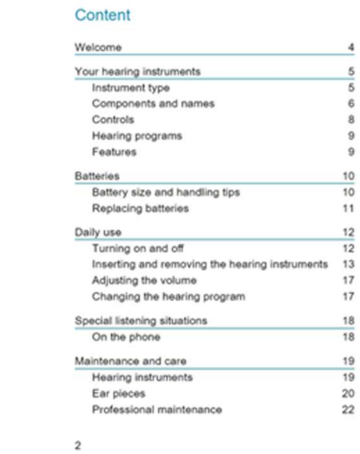


Adore XS

User Guide | Master

www.rexton.com

REXTON



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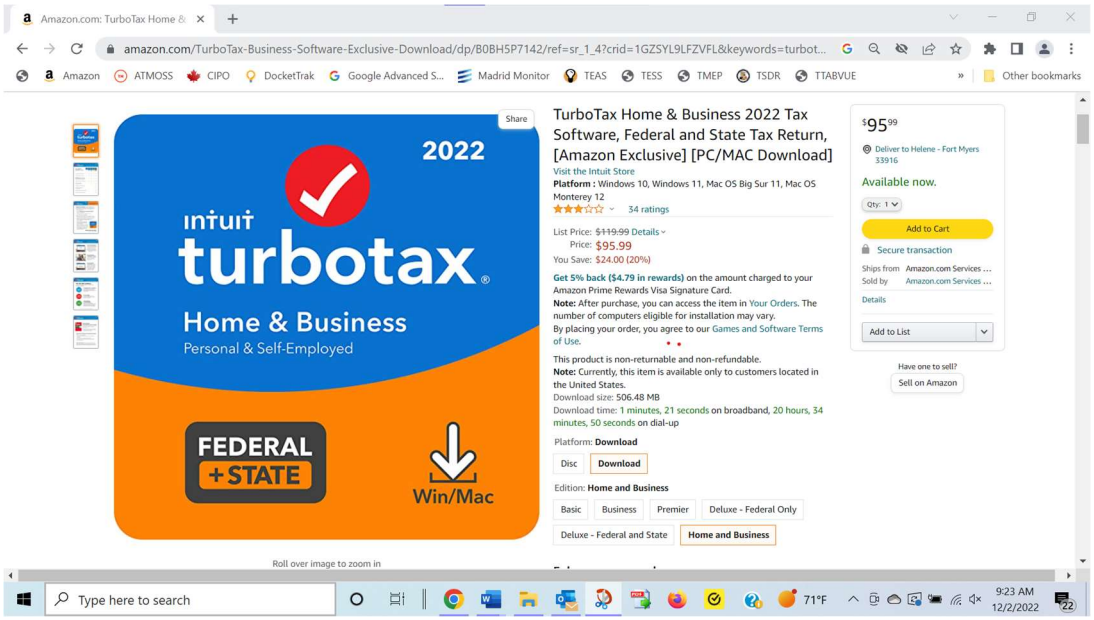
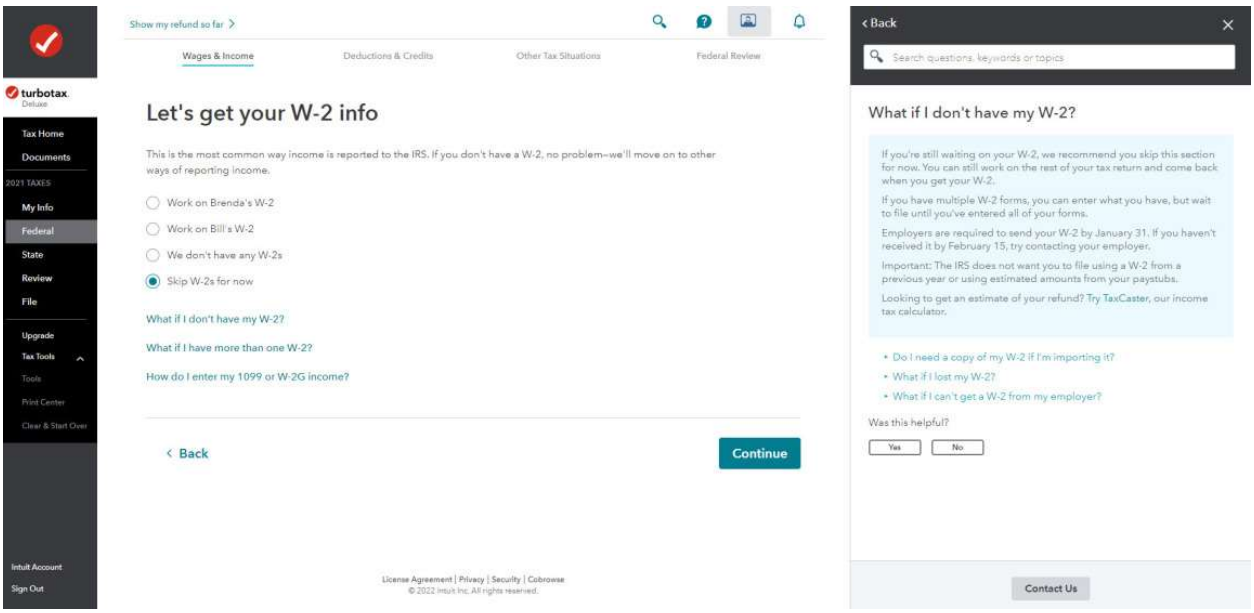
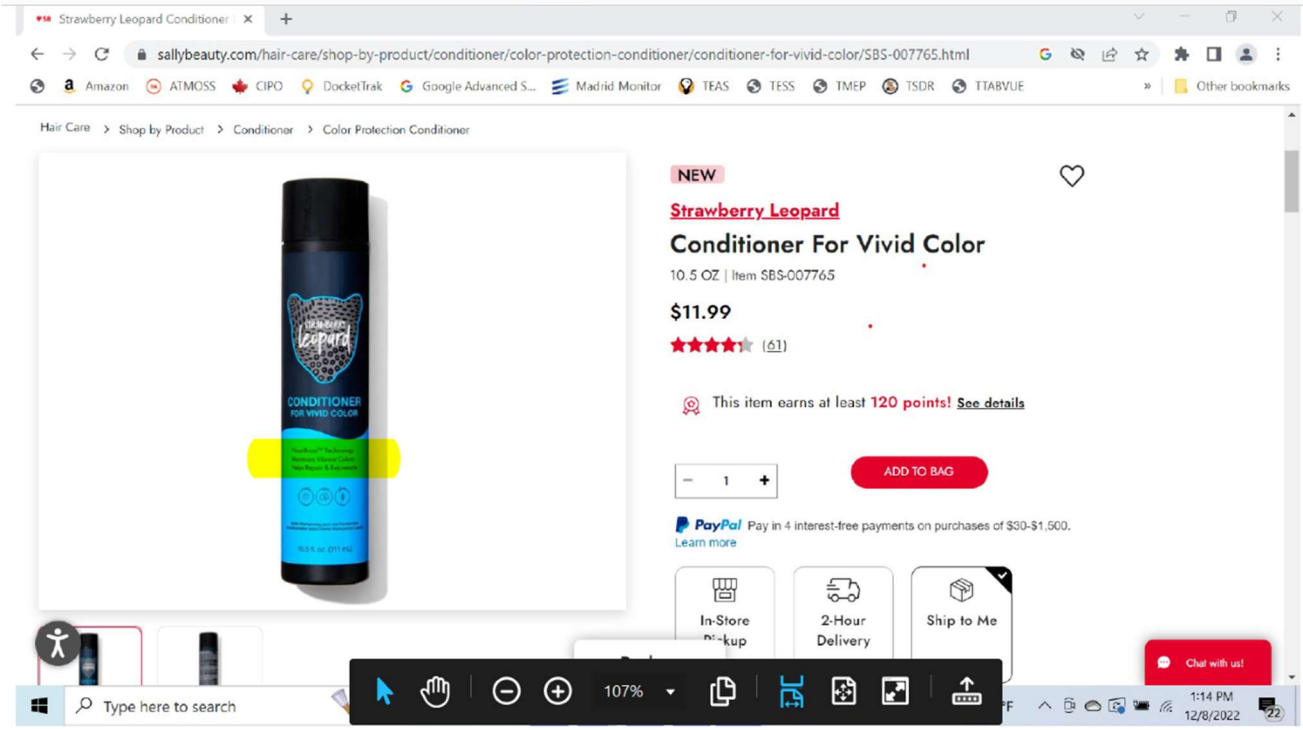
Specimen for INTUIT or TURBOTAX downloadable software
(provides sufficient information to download or purchase the software- electronic point of purchase display)



Specimen for TURBOTAX downloadable (goods) or non-downloadable software (services)
(screenshot)



Specimen for NOURIBOND for ingredient/component- may be acceptable (photo of mark on label and electronic point of purchase display)



Specimen for PFALTZGRAFF on mugs

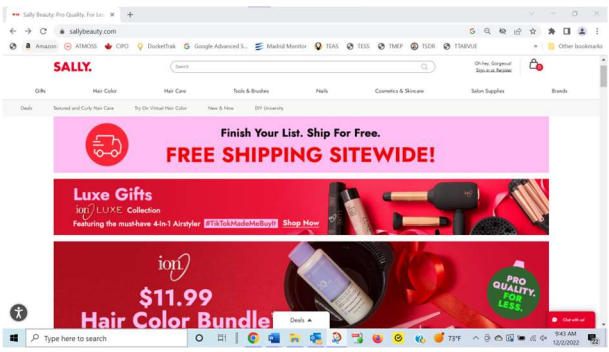
Specimen for COCA-COLA for soft drinks (in plain letters or stylized script) (imprinted on packaging and on label for goods)

Specimen for MAGGI and/or ROYALE and/or TASTE THE ADVENTURE for noodle dishes (point-of-purchase display)

Examples of Acceptable Specimens for Services

Specimen for SALLY
(likely) or SALLY BEAUTY SUPPLY
retail services (photos where services are offered)

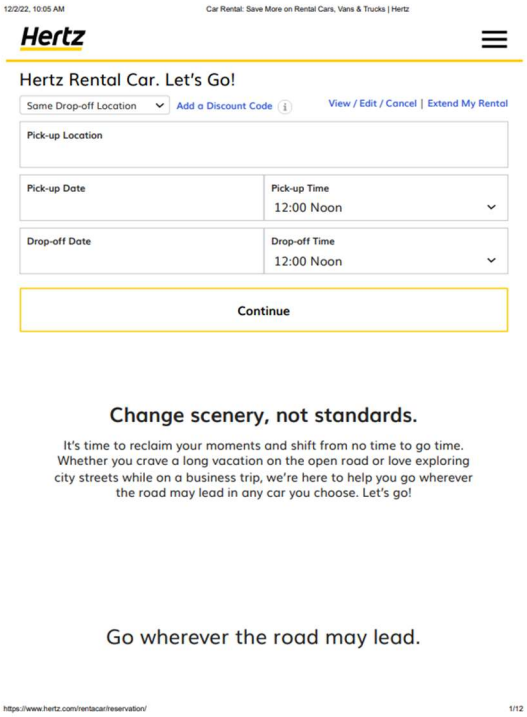
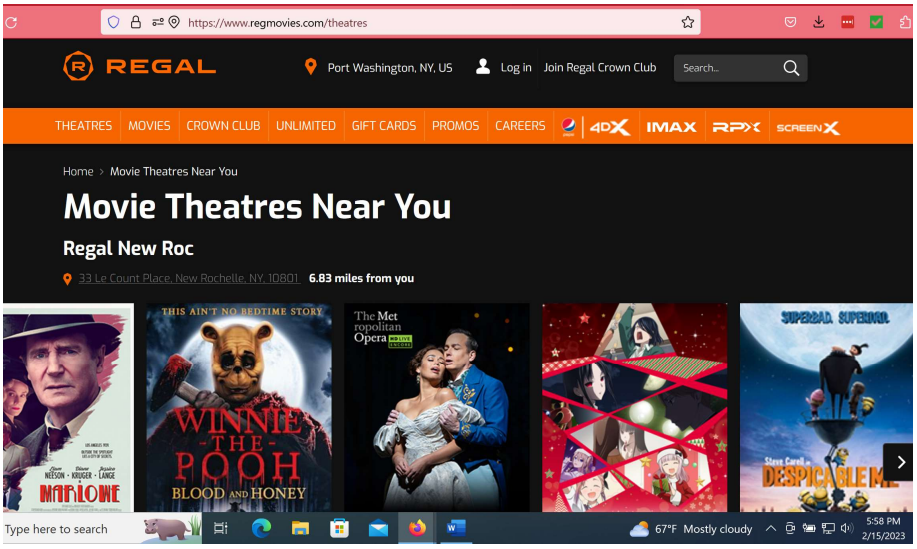
Specimen for SALLY.
online retail services (web site excerpt)



Specimens for BONEFISH GRILL restaurant services (pictures of menu and storefront)

Specimen for PENSKE truck rental services (promotional material)

Specimen for HERTZ and GO WHEREVER THE ROAD MAY LEAD car rental services (offering of services)



Specimen for REGAL and R logo (promotional materials)