

IP Practice specializing in trademark and copyright law; IP counseling; domestic and international maintenance and protection of IP portfolios; internet issues; IP audits and strategies relating to IP portfolios; drafting and negotiating IP and IT-related agreements

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Hold Onto Those Trademark Specimens

As the holiday season approaches, take a moment to notice the placement of trademarks on or in connection with the goods or services being offered in the stores or on the websites where you shop. This could prove helpful to you when you file a trademark application with the U.S. Patent and Trademark Office (PTO). It might also be helpful when the time comes to file a Statement of Use for your trademark, because in both cases, you may need to submit examples of your trademark use (also known as specimens) to the PTO.

The PTO requires trademark specimens so that applicants can demonstrate that the mark is being actively used in interstate commerce. A specimen is required at different points in the process, depending on the type of application you file.

If a trademark applicant is already using the mark, the PTO requires a trademark specimen along with the trademark application, reflecting the mark's use on or in connection with all the goods or services for which registration is sought. If the applicant has an "intent to use" the mark, but has not yet started to use it in commerce at the time the trademark application is filed, no specimen is required. However, before registration will issue, the PTO requires submission of a

specimen demonstrating the mark's use along with a "Statement of Use" specifying the date of first use of the mark in commerce.* The Statement of Use and specimen must be filed within six months to three years (with extensions) from when the PTO issues a "Notice of Allowance" for the mark.

The PTO is very particular in its specimen requirements. If multiple classes of goods or services are included in a trademark application, then the applicant must submit one specimen for each class of goods or services claimed in the application. For goods, a label on the goods, such as a clothing tag, or a label affixed to containers or commercial packaging is acceptable. A product display of the goods can also be an appropriate specimen for a trademark, if the displays are essentially point-of-sale materials. The PTO will accept a website page as a display associated with the goods, if the page also provides a means for ordering the goods. Advertising materials alone will not show use of a trademark on goods. However, with services, the PTO permits specimens that show the

*Note that the PTO's rules differ for U.S. applications based on foreign applications or registrations, but that is beyond the scope of this *Dunner Law Dicta*.

mark as it is used in the sale of or advertising of services directed at potential purchasers. These could include brochures, menus, website screenshots, or other business documents (like letterhead and invoices as long as these documents reference the trademark and services offered).

So, if “Santa’s Bakery” wanted to place its trademark on goods such as cupcakes and pies,** it could submit to the PTO a

specimen (in the form of a .pdf or .jpg file) of the boxes or packages in which the cupcakes and pies are sold. If “Santa’s Bakery” wanted to protect the “Santa’s Bakery” name for catering services, it could submit a specimen of its catering menu or advertising brochure.

Now when you are shopping this season, you will look at trademarks very differently. You will realize that trademarks are placed strategically on or in

connection with goods and services not only for marketing purposes, but also because the PTO is very picky about proper trademark use. Because you want to maintain the strength and protectability of your trademarks, you need to be picky too.

** After Santa reads *Dunner Law Dicta*, Vol 4, Issue 4 on Clearing Marks.



*Happy Holidays
from
Dunner Law!*

