

**TIPS ON PROPER SPECIMENS OF USE
FOR U.S. CASES**

We are offering these guidelines to assist in an understanding of the requirements for appropriate specimens of use to adequately support applications for registration, as well as applications for renewal and declarations of use. Acceptable specimens of use are essential in U.S. practice whenever the owner of a Trademark or Service Mark wishes to demonstrate proper use of the Mark as applied for or as registered. Perhaps even more important is that proper use of a Mark is also essential to establishing and maintaining protection of that Mark as a unique indication of source, origin or sponsorship of the goods or services for which the Mark is used. Because problems often arise with specimens provided to support use of Marks in commerce, we have prepared these guidelines which we hope will be of assistance to our clients.

Trademarks and Service Marks (“Marks”) are adjectives and should be followed by a noun naming the goods or services whenever the Mark is used in any form of communication to the public. That is, a Mark should never be allowed to be used in a form which indicates that it is anything other than an arbitrary descriptor for the source of the goods or services; another way of putting this is that a Mark should never be used in any fashion which might indicate it is a generic name for any of the goods or services identified by the Mark.

The same is true for acceptable specimens of use. Not every appearance of a Mark is a “proper specimen of use.” Often the use of a Mark in the proposed specimen is such that it will not in fact support proof of use of the Mark as a Trademark or Service Mark for the particular goods or services.

On the following pages, we have summarized examples of acceptable specimens for U.S. Trademarks and Services Marks. If you have any questions or would like further information, please feel free to contact us.

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SPECIMENS OF USE FOR TRADEMARKS

A “Trademark” is a Mark used on goods sold in commerce or used in close connection with the sale or offering for sale of goods in commerce. “Commerce” means commerce regulated by the United States Congress and includes interstate commerce (commerce between one or more states of the United States), commerce between a foreign country and a state or territory of the United States, or territorial commerce (commerce within a territory of the United States).

A specimen of use of a Trademark should show the Mark exactly as it appears in the drawing of the application or in the registration. If the owner has registered or applied to register the Mark with a design, color or special lettering, the Mark must be used in that manner to support use of the Mark and to continue to provide for protection for the Mark.

Warning: It is improper to use the federal registration symbol ® adjacent to a Mark which has not yet been registered by the U.S. Patent and Trademark Office.

In our experience, the following examples illustrate acceptable **Trademark** specimens:

- **TAGS bearing the mark** - for example, tags sewn or otherwise physically affixed directly to the goods, such as cloth tags for clothing, rugs, towels; hanging tags for purses; metal plates affixed to merchandise such as tools, vehicles, construction supplies;
- **LABELS bearing the mark** – for example, an adhesive-backed label affixed to merchandise such as vases, appliances, picture frames, beverage bottles;
- **CONTAINERS of the goods bearing the mark** – for example, shoe boxes, cookie tins, tea and coffee bags, make-up bottles, gasoline pumps, furniture cartons;
- **DISPLAYS associated directly with the goods at point of sale** – for example, banners, shelf boards, window displays, counter cards. The display should be intended to catch the attention of purchasers at the point of sale, prominently present the mark and associate it or relate it to the specific goods;
- **CATALOGS OR WEB PAGES** – these forms of a display are acceptable if (1) the goods are pictured and (2) the Mark is used sufficiently near the picture to associate it with the goods, and (3) information necessary to order the goods is included;
- **INSTRUCTIONAL SHEETS, MANUALS OR BOOKLETS** – in some instances, affixing the Mark directly to goods or containers of the goods is not as practical as using the Mark on printed matter included in the packaging of the goods to instruct the customer on use of the goods; examples might include planting instructions, kit assembly instructions, application instructions and so forth, but the printed matter must show proper use of the mark and must accompany the goods when sold or offered for sale in commerce;
- **FACSIMILES** – the Mark is physically applied directly to the goods, such as embossed or stamped on jewelry; stencilled or stamped on kit components; Mark for magazine or periodical printed on the cover;
- **PHOTOGRAPHS** – a photograph of goods bearing a Mark may be acceptable if the photograph clearly shows the Mark as it is applied to or used with the sale of the goods, such as a photograph of a tractor, potting shed, commercial show displays;
- **COMPUTER PROGRAMS, MOVIES, VIDEO TAPES** – screen prints showing the Mark or a photograph of a frame of a movie or video tape showing the mark

SPECIMENS OF USE FOR SERVICE MARKS

A “Service Mark” is a Mark used with the sale, offer for sale or rendering in commerce of services (as distinguished from a Trademark used on or with goods, see previous page). “Commerce” means commerce regulated by the United States Congress and includes interstate commerce (commerce between one or more states of the United States), commerce between a foreign country and a state or territory of the United States, or territorial commerce (commerce within a territory of the United States).

All specimens of use of a Service Mark should show the Mark exactly in the fashion sought to be protected. If the owner has registered or applied to register the Mark with a design, color or special lettering, the Mark must be used in that manner to support use of the Mark and to continue to provide for protection for the Mark.

Warning: It is improper to use the federal registration symbol ® adjacent to a Mark which has not yet been registered by the U.S. Patent and Trademark Office.

In our experience, the following examples illustrate acceptable **Service Mark** specimens:

- **ADVERTISING MATERIALS** – advertisements depicting the mark exactly as it is registered or sought to be registered showing a clear offering of the services for sale;
- **PRINTED MATTER** – such as marketing brochures, advertisements in directories, and business cards;
- **BAGS OR PACKAGES** – use of a Service Mark on the bags or packages of a retail establishment, such as a department store, evidencing use of the mark for retail services;
- **PHOTOGRAPHS** – photographs clearly showing the Service Mark may be acceptable, for instance, a photograph of a print shop showing the Service Mark as the name of the shop offering printing services.

If the owner intends to alter a U.S. registered Mark, contact us so that we can advise whether the registration can be amended.