

The Trademark

Issue 2 2024

GLOBAL REACH, LOCAL KNOWLEDGE

www.trademarklawyermagazine.com

Lawyer

Welcome to Atlanta!


IP TrendMonitor



Celebrating INTA's 2024 Annual Meeting with our special bumper edition!

**An interview
with PepsiCo**

Page 10



**Post-Sale Confusion
Doctrine**

Page 24



**Ultimate brand
protection play**

Page 60



Jurisdictional Briefing, US: specimen requirements of the United States Patent and Trademark Office

Nancy Kennedy and Farzad Panjshiri of Cantor Colburn detail the requirements for goods and services alongside the rules for submitting specimens at the USPTO to protect trademarks and service marks.

The United States Patent and Trademark Office (USPTO) requires evidence that a mark is "used in commerce" to obtain and maintain a trademark registration in the United States. Applications based on foreign registration or Madrid Filings are an exception and must provide such proof of use only five years after registration. All post-registration maintenance filings (after five years and every 10 years) must contain proper specimens with the Declaration of Continuing Use.

A "specimen" is evidence proving that a mark is used in US commerce. This article provides general requirements for specimens, but numerous exceptions exist - including industry standards, the type of the mark, and the particular goods and services - that can impact these general specimen rules.

Specimen requirements for goods

The Lanham Act indicates that a mark is used in connection with goods in International Classes 1 to 34 if "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." See 15 U.S.C. § 1127.

This means the specimen must show the mark affixed to the goods, namely on the product itself, on a label/tag attached to the product, on the packaging or container of the product, on a website where the goods can be purchased, or on a display in a store presented with the



Nancy Kennedy



Farzad Panjshiri

physical products.

Specimen requirements for services

According to the Lanham Act, a mark is used in connection with services in International Classes 35 to 45 if "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 commerce." See 15 U.S.C. § 1127.

This means the specimen must show the service mark on any advertisement, brochures, websites, business signs, invoices, vehicles, or any other promotional material where the services are advertised, sold, or rendered. The specimen must present the service mark in "direct association" with the services.

USPTO's rules for submitting specimens

Specimens submitted to the USPTO should follow these guidelines:

- At least one specimen per International Class must be provided.
- Do not submit physical evidence to the USPTO, a copy or picture of the evidence is sufficient.
- The mark on the specimen must be a "substantially exact" representation of the application/registration.

- The specimen must demonstrate a real marketplace example and use of the mark in commerce (not digitally created or altered, and no mock-up).
- The mark must be prominently visible on the specimen to function as a mark and have source-indicating properties.
- The specimen must show the applicant's or a licensee's use of the mark.
- The mark on the specimen should be in close proximity to the goods/services.
- Specimens consisting of website screenshots must show the URL and the date accessed on the specimen.
- Lastly, the appropriate type of specimen must be chosen for goods or services, as discussed above.

The comprehension of the above rules and guidelines is essential to navigate US trademark law and this unique creature of "specimens." Knowledge of specimen requirements will help attorneys guide trademark owners in obtaining, maintaining, and enforcing a US trademark or service mark.

Résumés

Nancy Kennedy, Partner

Nancy manages domestic and international trademark, copyright, trade dress, domain name, and other cyberlaw matters. She concentrates her practice on conducting trademark clearance searches and rendering opinions on availability and registrability; prosecuting applications for registration at the US Patent and Trademark Office and the US Copyright Office; recording registrations with the US Department of Homeland Security Office of Customs and Border Protection; and representing clients in disputes before the Trademark Trial and Appeal Board.

Author email: nkennedy@cantorcolburn.com

Farzad Panjshiri, Associate

Farzad is an experienced trademark and copyright attorney who fights passionately for the intellectual property rights of his clients. He has extensive experience in trademarks, copyrights, and other intellectual property rights, emphasized by his Master of Laws (LLM) degree in US Intellectual Property Law, his German Law degree, as well as his international and domestic legal experience. Farzad concentrates his practice on all areas of trademark prosecution, enforcement, and litigation before the US Patent and Trademark Office. He has been counseling individuals, small and midsize businesses, as well as large multinational companies, on trademark and copyright matters.

Author email: fpanjshiri@cantorcolburn.com

Contact

Cantor Colburn LLP

20 Church Street, 22nd Floor, Hartford,
CT 06103-3207 USA

Tel: +1 860 286 2929

contact@cantorcolburn.com

www.cantorcolburn.com

