Chapter 900
Use in Commerce

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901 Use in Commerce

In an application based on use in commerce under §1(a) of the Trademark Act, 15 U.S.C. §1051(a), the applicant must use the mark in commerce on or in connection with all the goods and services listed in the application as of the application filing date. *See* 37 C.F.R. §2.34(a)(1)(i). The application must include a statement that the mark is in use in commerce, verified in an affidavit or declaration under 37 C.F.R. §2.20. If the verification is not filed with the original application, it must also allege that the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date. 37 C.F.R. §2.34(a)(1)(i). *See* TMEP §§804 *et seq.* regarding verification.

In an application based on "intent-to-use" under §1(b) of the Trademark Act, 15 U.S.C. §1051(b), the applicant typically begins use in commerce after the filing date. The application must include a verified statement that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application as of the application filing date. Prior to registration, the applicant must actually use the mark in commerce on or in connection with all the goods or services specified in the application and file an allegation of use (i.e., either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d)). *See* TMEP §902.

A §1 applicant must use the mark in commerce even if the applicant asserts §44(d) or §44(e), 15 U.S.C. §1126(d) or §1126(e), as a second basis for filing. *See* TMEP §§806.02 *et seq*. regarding filing on more than one basis.

Applicants relying *solely* on a foreign registration as the basis for registration under §44(e) of the Trademark Act are not required to assert actual use of the mark prior to registration in the United States. TMEP §1009. *See Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909 (TTAB 1984). However, to retain a valid registration, the registrant must file an affidavit or declaration of use of the mark in commerce under 15 U.S.C. §1058 at the appropriate times, and establish use in commerce or excusable nonuse. *See* TMEP §§1604 *et seq.* regarding the affidavit or declaration of continued use or excusable nonuse.

Similarly, applicants requesting an extension of protection of an international registration to the United States under §66(a) of the Trademark Act are not required to assert actual use of the mark prior to registration in the United States. However, to retain a valid registration, the registrant must file an affidavit or declaration of use of the mark in commerce under 15 U.S.C. §1141k at the appropriate times, and establish use in commerce or excusable nonuse. *See* TMEP §1613.

901.01 Definitions

The power of the federal government to register marks comes from the commerce clause of the Constitution. Section 1 of the Trademark Act, 15 U.S.C. §1051, permits application for registration of "a trademark used in commerce" (15 U.S.C. §1051(a)) or of a trademark that a person has a bona fide intention to use in commerce (15 U.S.C. §1051(b)).

Section 45 of the Trademark Act, 15 U.S.C. §1127, defines "commerce" as "all commerce which may lawfully be regulated by Congress." Section 45 defines "use in commerce" as follows:

> The term "use in commerce" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this Act, a mark shall be deemed to be in use in commerce--
>
> (1) on goods when--
>
> (A) 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, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and
>
> (B) the goods are sold or transported in commerce, and

(2) on services when 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 more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

901.02 Bona Fide Use in the Ordinary Course of Trade

The definition of use in commerce (TMEP §901.01) was amended by the Trademark Law Revision Act of 1988 (TLRA), Public Law 100-667, 102 Stat. 3935, to add the phrase "the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark." The primary purpose of the amendment was to eliminate the practice of "token use," or use made solely to reserve rights in a mark.

The legislative history of the TLRA makes it clear that the meaning of "use in the ordinary course of trade" will vary from one industry to another. The report of the House Judiciary Committee stated that:

> While use made merely to reserve a right in a mark will not meet this standard, the Committee recognizes that "the ordinary course of trade" varies from industry to industry. Thus, for example, it might be in the ordinary course of trade for an industry that sells expensive or seasonal products to make infrequent sales. Similarly, a pharmaceutical company that markets a drug to treat a rare disease will make correspondingly few sales in the ordinary course of its trade; the company's shipment to clinical investigators during the Federal approval process will also be in its ordinary course of trade....

H.R. Rep. No. 1028, 100th Cong. 2d Sess. 15 (1988).

The report of the Senate Judiciary Committee stated:

> The committee intends that the revised definition of "use in commerce" be interpreted flexibly so as to encompass various genuine, but less traditional, trademark uses, such as those made in test markets, infrequent sales of large or expensive items, or ongoing shipments of a new drug to clinical investigators by a company awaiting FDA approval....

S. Rep. No. 515, 100th Cong. 2d Sess. 44-45 (1988). *See also Paramount Pictures Corp. v. White,* 31 USPQ2d 1768, 1774 n.8 (TTAB 1994), *aff'd,* 108 F.3d 1392 (Fed. Cir. 1997) (Table).

Therefore, some factors to consider when determining compliance with the statutory requirement for a "bona fide use of a mark in the ordinary course of

trade" are: (1) the amount of use; (2) the nature or quality of the transaction; and (3) what is typical use within a particular industry.

901.03 Commerce That May Be Lawfully Regulated By Congress

The scope of federal trademark jurisdiction is commerce that may be regulated by the United States Congress. The types of commerce encompassed in this definition are interstate, territorial, and between the United States and a foreign country.

"Territorial commerce" is commerce within a territory of the United States (e.g., Guam, Puerto Rico, American Samoa, or the United States Virgin Islands) or between the United States and a territory of the United States.

Purely intrastate use does not provide a basis for federal registration. However, if intrastate use directly affects a type of commerce that Congress may regulate, this constitutes use in commerce within the meaning of the Act. *See Larry Harmon Pictures Corp. v. Williams Restaurant Corp.,* 929 F.2d 662, 18 USPQ2d 1292 (Fed. Cir. 1991), *cert. denied* 502 U.S. 823 (1991) (mark used to identify restaurant services rendered at a single-location restaurant serving interstate travelers is in "use in commerce"); *In re Silenus Wines, Inc.,* 557 F.2d 806, 194 USPQ 261 (C.C.P.A. 1977) (intrastate sale of imported wines by importer constitutes "use in commerce," where goods bearing labels supplied by applicant were shipped to applicant in United States); *In re Gastown, Inc.*, 326 F.2d 780, 140 USPQ 216 (C.C.P.A. 1964) (automotive service station located in one state was rendering services "in commerce" because services were available to customers travelling interstate on federal highways); *U.S. Shoe Corp. v. J. Riggs West, Inc.,* 221 USPQ 1020, 1022 (TTAB 1984) (billiard parlor services satisfy the "use in commerce" requirements, where the record showed that applicant's billiard parlor services were advertised in both Kansas and New York); *In re G.J. Sherrard Co.,* 150 USPQ 311 (TTAB 1966) (hotel located in only one state has valid use of its service mark in commerce because it has out-of-state guests, has offices in many states, and advertises in national magazines); *In re Federated Department Stores, Inc.,* 137 USPQ 670 (TTAB 1963) (mark used to identify retail department store services located in one state was in use in commerce, where the mark was used on credit cards issued to out-of-state residents, and on catalogs and advertisements shipped to out-of-state customers).

In some cases, services such as restaurant and hotel services have been deemed to be rendered in commerce because they are activities that have been found to be within the scope of the 1964 Civil Rights Act, which, like the Trademark Act, is predicated on the commerce clause. *See In re Ponderosa Motor Inns, Inc.,* 156 USPQ 474 (TTAB 1968); *In re Smith Oil Corp.,* 156 USPQ 62 (TTAB 1967).

The term “foreign” is not acceptable to specify the type of commerce in which a mark is used, because it does not clearly indicate that the mark is in use in a type of commerce that Congress can lawfully regulate. Unless the “foreign commerce” involves the United States, Congress does not have the power to regulate it. Use of a mark in a foreign country does not give rise to rights in the United States if the goods or services are not sold or rendered in the United States. *Buti v. Impressa Perosa S.R.L.*, 139 F.3d 98, 45 USPQ2d 1985 (2nd Cir. 1998); *Mother’s Restaurants Inc. v. Mother’s Bakery, Inc.,* 498 F. Supp. 847, 210 USPQ 207 (W.D.N.Y. 1980); *Linville v. Rivard,* 41 USPQ2d 1731 (TTAB 1996), *aff’d,* 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *Aktieselskabet af 21.November 2001 v. Fame Jeans Inc.*, 77 USPQ2d 1861 (TTAB 2006). *See also Honda Motor Co., Ltd. v. Winkelmann*, 90 USPQ2d 1660 (TTAB 2009) (“[T]he evidence that applicant relies upon through its foreign registrations and Internet printouts does not demonstrate trademark use for the claimed goods. Further, these documents do not show that applicant has an intent to use the mark in the United States.”)

Offering services via the Internet has been held to constitute use in commerce, since the services are available to a national and international audience who must use interstate telephone lines to access a website. *See Planned Parenthood Federation of America, Inc. v. Bucci*, 42 USPQ2d 1430 (S.D.N.Y. 1997), *aff'd,* 152 F.3d 920 (2d Cir. 1998) (Table), *cert. denied*, 525 U.S. 834 (1998).

An applicant is not required to specify the type of commerce in which the mark is used. The USPTO presumes that an applicant who states that the mark is in use in commerce is stating that the mark is in use in a type of commerce that Congress can regulate, unless there is contradictory evidence in the record. *See* TMEP §901.04 regarding the circumstances where an examining attorney should inquire as to whether the mark is in use in commerce that can be regulated by Congress.

901.04 Inquiry Regarding Use in Commerce

It is the responsibility of the applicant and the applicant’s attorney to determine whether an assertion of use in commerce is supported by the relevant factual situation. The validity of an applicant’s assertion of use in commerce generally does not arise in ex parte examination. The examining attorney will normally accept the applicant’s verified claim of use in commerce without investigation into whether the use referred to constitutes “use in commerce.”

An applicant is not required to specify the type of commerce in which the mark is used. *See* TMEP §901.03. However, if the applicant specifically states that the mark is in use in commerce that cannot be regulated by Congress (e.g., “intrastate commerce” or “foreign commerce”), the applicant has not met the statutory requirement for a verified statement that the mark is

in use in commerce, and a specification of the date of first use in commerce, as defined in §45 of the Trademark Act. Accordingly, the examining attorney must advise the applicant that it appears that the mark is not in use in a type of commerce that can be regulated by Congress and must require that the applicant either submit a verified statement that "the mark is in use in commerce that can be regulated by Congress," or amend the basis of the application to a bona fide intention to use the mark in commerce under §1(b) of the Act, if permitted by 37 C.F.R. §2.35. *See* TMEP §806.03(c) regarding amendment of the basis from §1(a) to §1(b).

If the application record contains evidence or information indicating that the mark may not be in use in commerce that "may lawfully be regulated by Congress," the examining attorney must ask the applicant whether there is use in commerce that may lawfully be regulated by Congress and require a satisfactory explanation or showing of such use. When necessary, the examining attorney may also require additional product or sales literature concerning the use of the mark to permit full consideration of the issue. 37 C.F.R. §2.61(b); TMEP §814.

901.05 Use Only by Related Company

If the applicant is not itself using the mark in commerce but the mark is being used by one or more related companies whose use inures to the applicant's benefit (15 U.S.C. §§1055 and 1127), this must be stated in the application or allegation of use. 37 C.F.R. §2.38(b); TMEP §1201.03(a). *See* TMEP §903.05 regarding first use by a predecessor in title or related company.

See TMEP §§1201.03 *et seq*. regarding use by related companies.

902 Allegations of Use for §1(b) Applications

Section 1(b) of the Trademark Act permits the filing of an application to register a mark on the basis of the applicant's bona fide intention to use the mark in commerce for the identified goods or services. Before a registration can issue, however, the applicant must actually use the mark in commerce on or in connection with all the goods or services specified in the application and file an allegation of use of the mark in commerce (i.e., either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d)) that states that the applicant is using the mark in commerce on or in connection with the goods or services, includes dates of use for each class, and includes one specimen evidencing such use for each class.

See 37 C.F.R. §2.76 and TMEP §§1104 *et seq.* regarding amendments to allege use, and 37 C.F.R. §2.88 and TMEP §§1109 *et seq.* regarding statements of use.

903 Dates of Use

When asserting use of a mark in commerce, an applicant must specify the date of first use anywhere and the date of first use in commerce, either in an original application under §1(a) of the Trademark Act, or in an allegation of use in an application under §1(b). The dates of use must be verified, i.e., supported by an affidavit or declaration under 37 C.F.R. §2.20. *See* TMEP §§804 *et seq.* regarding verification.

An applicant filing under §1(b) is not required to state dates of use in the original application, but must include dates of use in an allegation of use under §1(c) or §1(d).

A §1(b) applicant may assert dates of use that are earlier than the filing date of the application in an amendment to allege use or statement of use.

903.01 Date of First Use Anywhere

The date of first use anywhere is the date when the goods were first sold or transported or the services were first rendered under the mark, if such use is bona fide and in the ordinary course of trade. *See* 15 U.S.C. §1127 (definition of "use" within the definition of "abandonment of mark"). For every applicant, whether foreign or domestic, the date of first use of a mark is the date of the first use anywhere, in the United States or elsewhere, regardless of whether the nature of the use was local or national, intrastate or interstate, or of another type.

903.02 Date of First Use in Commerce

The date of first use in commerce is the date when the goods were first sold or transported, or the services were first rendered, under the mark in a type of commerce that may be lawfully regulated by Congress, if such use is bona fide and in the ordinary course of trade. *See* TMEP §901.01 for definitions of "commerce" and "use in commerce," and TMEP §901.03 regarding types of commerce.

In a §1(a) application, the applicant may not specify a date of use that is later than the filing date of the application. If an applicant who filed under §1(a) did not use the mark in commerce before the application filing date, the applicant may amend the basis to §1(b). *See* TMEP §§806.03 *et seq*. regarding amendments to the basis.

Neither a date of first use nor a date of first use in commerce is required to receive a filing date in an application based on use in commerce under §1(a) of the Act. If the application does not include a date of first use and/or a date of first use in commerce, the examining attorney must require that the applicant state the date of first use and/or date of first use in commerce. The

dates must be supported by an affidavit or declaration under 37 C.F.R. §2.20. 37 C.F.R. §§2.34(a)(1) and 2.71(c).

An applicant may not file an application on the basis of use of a mark in commerce if such use has been discontinued.

903.03 Relation Between the Two Dates of Use

The application or allegation of use must specify both the date of first use anywhere and the date of first use in commerce. If the first use made by the applicant was in commerce that may be regulated by Congress, the date of first use and the date of first use in commerce will be the same date.

The date of first use anywhere will always be either earlier than or the same as the date of first use in commerce. If the date of first use anywhere specified in an application or allegation of use is later than the date of first use in commerce, the examining attorney must require clarification.

The requirement that an applicant specify the date of first use anywhere as well as the date of first use in commerce applies to foreign applicants as well as domestic applicants in applications under §§1(a) and 1(b) of the Act. *In re Sevi S.p.A.,* 1 USPQ2d 1671 (TTAB 1986).

903.04 Amending Dates of Use

Any amendment of the dates must be supported by an affidavit or declaration under 37 C.F.R. §2.20. 37 C.F.R. §2.71(c). The affidavit or declaration must be signed by someone properly authorized to sign on behalf of the applicant under 37 C.F.R. §2.193(e)(1). *See* TMEP §611.03(a).

In an application under §1(a) of the Trademark Act, the applicant may amend the dates of use to adopt a date of use that is later than the date originally stated, but before the application filing date. However, the applicant may not amend to specify a date of use that is later than the filing date of the application. 37 C.F.R. §2.71(c)(1). If an applicant who filed under §1(a) did not use the mark in commerce on or before the application filing date, the applicant may amend the basis to §1(b). *See* TMEP §§806.03 *et seq*. regarding amendments to the basis.

In an application under §1(b), after the applicant files an amendment to allege use, the applicant may not subsequently amend the dates of use to recite dates of use that are later than the filing of the amendment to allege use. If a §1(b) applicant did not use the mark in commerce before the filing date of the amendment to allege use, the applicant may withdraw the amendment to allege use before the application is approved for publication. 37 C.F.R. §2.76(h). *See* TMEP §§1104.09(d) and 1104.10.

In an application under §1(b), after the applicant files a statement of use, the applicant may not amend to recite dates of use that are later than the expiration of the statutory deadline for filing a statement of use (i.e., the amended dates must be within six months of the issuance date of the notice of allowance or before the expiration of an extension of time for filing a statement of use). 37 C.F.R. §2.71(c)(2). If a §1(b) applicant did not use the mark in commerce before the expiration of the deadline for filing a statement of use, the applicant may *not* withdraw the statement of use. 37 C.F.R. §2.88(g); TMEP §1109.17.

A multiple-class application must include dates of use for each class. If a single-class application containing dates of use is amended to a multiple-class application, the dates-of-use clause must be amended to reflect dates of use for each class. *See* 37 C.F.R. §2.86(a)(3); TMEP §1403.01. If a single-class application is amended to a multiple-class application, but the applicant does not set forth dates of use for the added classes, the examining attorney must inquire as to whether the dates of use apply to all classes and require an amendment, if necessary. A supporting affidavit or declaration is not necessary if the dates of use alleged in the original application or in an earlier-filed allegation of use apply to all classes.

A supporting affidavit or declaration is required for any *change* to the dates of use. 37 C.F.R. §2.71(c). However, if the applicant has properly verified the date of first use in commerce and, for whatever reason, seeks to amend the date of first use anywhere to the same date as the date of first use in commerce, a verified statement is not required if the originally specified date of first use anywhere is *earlier* than the date of first use in commerce. This is not considered a *change* to the dates of use, because the applicant has already sworn to a date of first use in commerce that necessarily requires, and logically includes, use of the mark “anywhere.” Thus, the applicant has, in fact, already verified in its original application or allegation of use that the date of first use of the mark anywhere is at least as early as the date of first use of the mark in commerce. Such an amendment may be entered by examiner’s amendment.

When the date of first use anywhere is *later* than the date of first use in commerce, an unverified amendment is inappropriate because the validity of the verification is called into question by the impossibility of first use anywhere being later than the first use in commerce.

Compare the following examples.

(1) First use anywhere: March 6, 1985

First use in commerce: February 10, 1985

An amendment of the date of first use anywhere to February 10, 1985, must be verified, because the validity of the date of first use

in commerce is called into question by the fact that the applicant has specified a later date of first use anywhere.

(2) First use anywhere: March 6, 1985

First use in commerce: April 10, 1985

An unverified amendment of the date of first use anywhere to April 10, 1985, is acceptable, because first use in commerce logically includes use anywhere.

(3) First use anywhere: March 1985

First use in commerce: March 10, 1985

An unverified amendment of the date of first use anywhere to March 10, 1985, is acceptable because the information in the record is not contradictory on its face. There is only an apparent contradiction resulting from the way in which the USPTO construes the information when an applicant provides only the month and year (i.e., as indicating the last day of the month - *see* TMEP §903.06 regarding indefinite dates of use).

This policy is not applicable to the converse. That is, an amendment to the date of first use in commerce to conform to the date of first use anywhere is a *change* (because first use anywhere does not necessarily include first use in commerce) and must be verified.

903.05 First Use by Predecessor or Related Company

If the first use anywhere or the first use in commerce was by a predecessor in title to the applicant, or by a related company of the applicant (*see* 15 U.S.C. §§1055 and 1127), the dates of use clause should state that the use on this date was by the applicant's predecessor in title, or by a related company of the applicant, as the case may be. *See* 37 C.F.R. §2.38(a). It is generally not necessary to give the name of the predecessor in title or the related company.

See TMEP §§901.05 and 1201.03 *et seq*. regarding current use by a party other than the applicant.

903.06 Indefinite Dates of Use

In specifying the dates of first use, the applicant should give dates that are as definite as possible.

The only date that will be recognized for USPTO proceedings is the latest definite date specified by the applicant. However, the applicant may use indefinite terms in describing dates if the applicant considers it necessary due to uncertainty as to the particular date. Although terms such as "at least as

early as," "prior to," "before," "on or about," and "in" are acceptable for the record, these terms are not printed in the *Official Gazette* or on the certificate of registration.

When a month and year are given without a specified day, the date presumed for purposes of examination is the last day of the month. When only a year is given, the date presumed for purposes of examination is the last day of the year. Some examples are as follows:

- "Prior to January 1, 1955" is treated as December 31, 1954.
- "Before February 1961" is treated as January 31, 1961.
- "On or about June 18, 1987" is treated as June 18, 1987.
- "1990" is treated as December 31, 1990.
- "In November 1991" is treated as November 30, 1991.
- "In the 1920s" is treated as December 31, 1929.

When an applicant alleges only a year prefaced by vague or ambiguous language such as "in the Spring of," the USPTO will construe the date as the last day of that year, unless the applicant amends to specify a particular date or a particular month of the specified year.

When an applicant's date of first use in commerce is more specific than its date of first use anywhere, the above presumption can result in an unacceptable dates-of-use clause in which the date of first use in commerce precedes the date of first use anywhere. For example:

First use anywhere: 1991
First use in commerce: January 15, 1991
Usual presumption of first use anywhere: December 31, 1991
(which results in a logical inconsistency).

Therefore, when the above presumption would be applicable, and the result is a date of first use in commerce that precedes the date of first use anywhere, the examining attorney must contact the applicant by telephone or e-mail, if appropriate, for authorization to amend the date of first use anywhere to the same date as the date of the first use in commerce. This may be done by examiner's amendment.

Indefinite phraseology of the type described above is not considered to be misleading, because it does give notice that, when called upon to do so, the applicant may undertake to prove a date earlier than the one stated.

The presumed dates discussed above are *not* entered into the automated records of the USPTO, or printed in the *Official Gazette* or on the certificate of registration. Instead, only the information provided by the applicant is printed.

Thus, if the applicant states that the mark was first used “at least as early as January of 1994,” the date printed is “1/0/1994.” If applicant states that the mark was first used “sometime in 1965,” the date printed is “0/0/1965.”

In an inter partes proceeding, a date of use must be established by appropriate evidence. A date of use set forth in an application or registration owned by applicant or registrant is not evidence on behalf of that applicant or registrant. 37 C.F.R. §2.122(b)(2); *Trademark Trial and Appeal Board Manual of Procedure* (“TBMP”) §704.04.

See TMEP §903.06(a) regarding apparent discrepancies between dates of use and execution dates.

903.06(a) Apparent Discrepancies Between Dates of Use and Date of Execution

If an application, or an allegation of use under §1(c) or §1(d), specifies a date of first use only by the year, or by the month and the year, and the date would be interpreted under TMEP §903.06 as later than the date on which the application or allegation of use was *signed*, the USPTO will presume that the date specified is the date on which applicant signed the application or allegation of use. In this case, it is not necessary to amend the application to indicate the date of use more specifically. However, if the date specified would be interpreted as later than the *filing date* of the application or allegation of use, then amendment of the date of use, supported by an affidavit or declaration under 37 C.F.R. §2.20, is still required.

If an application or allegation of use specifies the date of signature only by the year, or by the month and the year, and the date would be interpreted under TMEP §903.06 as later than the date(s) of first use, the USPTO will presume that the date of signature was on or after the date of first use.

903.07 Dates of Use in Another Form

If the mark in the application is a composite mark, the applicant may specify dates of first use of a separable element of the composite mark. These dates will be printed on the certificate of registration for general information. However, the applicant must also specify the dates of first use of the entire composite mark for which registration is being sought.

903.08 More than One Item of Goods or Services

If more than one item of goods or services is specified in a particular class, the date of first use anywhere and date of first use in commerce do not have to pertain to every item in the class. It might be that the mark, although in use on all of the items at the time the application or allegation of use was filed, was first used on various items on differing dates, so that it would be

cumbersome to designate the dates for all items individually. *See Sunshine Biscuits, Inc. v. Berke Bakeries, Inc.*, 106 USPQ 222 (PTO 1955); *Ex parte Wayne Pump Co.*, 88 USPQ 437 (PTO 1951).

There must be at least one specified item in a class to which the specified dates pertain. Where the dates of use do not pertain to all items, the applicant should designate the particular item(s) to which they do pertain. 37 C.F.R. §§2.34(a)(1)(v), 2.76(c), and 2.88(c).

Where the dates of use do not pertain to every item in the class, and the identification of goods or services is amended to delete the item(s) to which the dates of use pertain, the applicant must amend the dates-of-use clause to specify the dates that apply to an item that remains in the identification, and this item should be designated. *See* TMEP §903.04 regarding amendments to dates of use.

If more than one item of goods or services is specified in a particular class, the USPTO will presume that the dates of use apply to all the goods or services, unless the applicant states otherwise.

Where more than one date is specified for a particular class, the earliest date will be printed in the *Official Gazette* and, if a registration issues, on the certificate of registration. The *Official Gazette* and registration certificate will not indicate which item is specified.

904 Specimens

Specimens are required because they show the manner in which the mark is seen by the public. Specimens also provide supporting evidence of facts recited in the application.

An application for registration under §1(a) of the Trademark Act must include one specimen for each class, showing use of the mark on or in connection with the goods, or in the sale or advertising of the services, in commerce. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv) and 2.56(a). If an application under §1(a) is filed without a specimen, the examining attorney must issue an Office action requiring the applicant to submit one specimen for each class, with an affidavit or declaration under 37 C.F.R. §2.20 stating that the specimen was in use in commerce on the filing date of the application. The Office action must also indicate that, pending submission of an acceptable specimen, registration is refused because the applicant has not provided evidence of use of the mark in commerce. 15 U.S.C. §§1051(a)(1) and 1127; 37 C.F.R. §§2.34(a)(1)(iv) and 2.56(a).

In an application for registration under §1(b) of the Trademark Act, no specimen is required at the time the application is filed. However, before a registration will issue, the applicant must file an allegation of use that includes one specimen for each class, showing use of the mark in commerce on or in

connection with the goods or in the sale or advertising of the services. 37 C.F.R. §§2.56(a), 2.76(b)(2), and 2.88(b)(2).

No specimen showing use of the mark is required in an application based solely on §44 or §66(a) of the Trademark Act, 15 U.S.C. §1126 or §1141f(a). While a §44 or §66(a) applicant must assert a bona fide intent to use the mark in commerce, the applicant is not required to assert actual use in commerce prior to registration. *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909 (TTAB 1984); TMEP §§1009 and 1904.01(d).

If the nature of a specimen is unclear, the applicant must explain what it is and how it is used.

A copy or reproduction of the drawing is not an acceptable specimen. 37 C.F.R. §2.56(c).

Specimens of value should not be filed.

Interested parties, including potential opposers, may view and print images of the specimens in an application or registration file through the Trademark Document Retrieval ("TDR") portal on the USPTO website at http://www.uspto.gov. The USPTO does not permit specimens to be removed from the record. Furthermore, once filed, specimens remain part of the record and will not be returned to the applicant. 37 C.F.R. §2.25. This ensures that there is a complete record of the submissions made by the applicant. *See* notice at 64 Fed. Reg. 48900, 48901 (Sept. 8, 1999) and 1226 TMOG 103 (Sept. 28, 1999). *See also* TMEP §404.

904.01 Number of Specimens

One specimen for each class is required in an application for registration under §1(a) of the Trademark Act, or in an allegation of use in an application under §1(b). If a single specimen supports multiple classes, the applicant should indicate which classes are supported by the specimen. The examining attorney need not require multiple copies of the specimen. The examining attorney should make a note in the “Notes-to-the-File” section of the record indicating which class(es) the specimen supports.

904.01(a) More than One Item Specified in a Class

If more than one item of goods, or more than one service, is specified in one class in an application, it is usually not necessary to have a specimen for each product or service. However, if the range of items is wide or contains unrelated articles, the examining attorney may request additional specimen(s) under 37 C.F.R. §2.61(b). *See* TMEP §1402.03 regarding broad identifications, TMEP §1402.03(b) regarding house marks, and TMEP §1402.03(c) regarding marks for “a full line of” a genre of products.

904.01(b) In Combined or Multiple-Class Applications

A combined (or multiple-class) application is a request to register the same mark for goods and/or services in multiple classes in a single application. There must be one specimen of the mark for each class. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv) and 2.56(a). If a single specimen supports multiple classes, the applicant should indicate which classes are supported by the specimen. The examining attorney need not require multiple copies of the specimen. The examining attorney should make a note in the "Notes-to-the-File" section of the record indicating which classes the specimen supports.

See TMEP §§1403 *et seq.* regarding examination of multiple-class applications.

904.02 Physical Form of Specimens

904.02(a) Electronically Filed Specimens

In an electronically filed application, allegation of use, affidavit of use under 15 U.S.C. §1058 or §1141k of the Trademark Act ("§8 affidavit" or "§71 affidavit"), or response to an Office action, the specimen(s) must be in .jpg or .pdf format. 37 C.F.R. §§2.56(d)(4) and 2.161(g)(3). If the nature of the specimen is unclear, the applicant should explain what it is and how it is used. The USPTO prefers that applicants submit small files of less than two minutes in duration.

Sometimes, no visible specimen is in the record due to a technical problem during submission of the application. In this situation, the examining attorney should first send an e-mail to the TEAS mailbox to ask whether the problem can be fixed by uploading the file again. If it cannot, the examining attorney must ask the applicant to submit: (1) the specimen (or a facsimile) that was attached to the original TEAS submission; and (2) a statement by the person who transmitted the original TEAS submission that the specimen being submitted is a true copy of the specimen originally filed through TEAS. This statement does not have to be verified. Alternatively, the owner may submit a new specimen, together with an affidavit or declaration of use of the substitute specimen. *See* TMEP §904.05 regarding the requirements for an affidavit or declaration supporting use of substitute specimens.

The Office prefers that the specimen, whether a true copy of the original or a substitute, be submitted electronically via the Trademark Electronic Application System ("TEAS"). In TEAS, the Response to Office Action form can be accessed by clicking on the link entitled "Response Forms" at http://www.uspto.gov.

904.02(b) Paper-Filed Specimens

In a paper-filed application, allegation of use, affidavit of use under §8 or §71 of the Trademark Act, or response to Office action, the specimen(s) must be flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. 37 C.F.R. §2.56(d)(1). Actual specimens are preferred if they are available and do not exceed the size requirements. The USPTO may create a photocopy or facsimile for the official record and destroy the original.

When the applicant cannot supply an actual specimen meeting these size requirements due to the nature or manner of use of the mark, the application, allegation of use, affidavit of use, or response must include a facsimile, such as a photograph, photocopy, or other acceptable reproduction, that is a suitable size and clearly shows how the mark is used on or in connection with the goods or in the sale or advertising of the services.

Facsimiles should show the whole article to which the mark is applied, or enough of the article so that the nature of the article can be identified. The mark and all other pertinent written matter on the article should be clear and legible. For example, product photographs appearing on folders or brochures that show the trademark on the goods are acceptable facsimiles. It is permissible to show the complete article in one photograph and the written matter in another, so that the written matter will be legible, or to show different views of an article either in a single photograph or in separate photographs.

A copy or reproduction of the drawing is not an acceptable specimen or facsimile. 37 C.F.R. §2.56(c).

If color is a feature of the mark, the applicant should submit facsimiles made by color photography, or by any process that reproduces in color. *See* TMEP §904.02(c)(ii).

If an applicant does submit a specimen that exceeds the size requirements (a "bulky specimen"), the USPTO will create a facsimile of the specimen that meets the size requirements of the rule and destroy the original specimen. 37 C.F.R. §2.56(d)(2). If the copy of the specimen created by the USPTO does not adequately depict the mark, the examining attorney will require a substitute specimen that meets the size requirements of the rule and an affidavit or declaration verifying the use of the substitute specimen. *See* TMEP §904.05 regarding affidavits supporting substitute specimens.

If necessary, the examining attorney may require one actual specimen for examination purposes, under 37 C.F.R. §2.61(b).

904.02(c) Additional Requirements

904.02(c)(i) Other Materials Required for Examination

During examination, an examining attorney also has the discretion to request additional materials, under 37 C.F.R. §2.61(b), if necessary for proper examination of the mark. TMEP §814. For example, if the mark is a configuration of the goods or of the container for the goods, the examining attorney may require one actual product or container. Or the examining attorney might require a complete copy of a publication in order to determine whether a mark is merely descriptive of the goods. *See* TMEP §904.02(c)(iii) regarding marks used on publications.

In specific cases, such as when an applicant submits additional materials in response to a requirement made by the examining attorney, and the materials do not meet the size parameters identified above, the USPTO may create facsimiles of these materials to be entered into the record and destroy the originals. However, the examining attorney should encourage the applicant to submit a photograph of the specimen(s) or evidence for the record.

904.02(c)(ii) Specimens for Marks Comprising Color

If color is a feature of the mark, or if the mark consists solely of color, the specimen must show use of the color. 37 C.F.R. §2.51; TMEP §807.12. *Note:* In an application filed on or after November 2, 2003, if an applicant submits a color drawing, or a description of the mark that indicates the use of color on the mark, the applicant must claim color as a feature of the mark. 37 C.F.R. §2.52(b)(1); TMEP §807.07(a)(i).

If the applicant submits a specimen that is not in color or not in the appropriate color, the examining attorney will require the applicant to file a substitute specimen that shows use of the appropriate color(s). *See* TMEP §904.05 regarding substitute specimens.

See also TMEP §1202.05(f) regarding specimens showing use of marks that consist *solely* of color.

904.02(c)(iii) Specimens for Marks Used on Publications

An application for registration of a mark for publications is treated the same as any other application with respect to specimen requirements. The USPTO does not require a complete copy of the publication or a title page in every case. However, the examining attorney may require a copy of the publication under 37 C.F.R. §2.61(b) if he or she believes it is necessary for proper examination. For example, a copy of the publication might be necessary to determine whether a mark is merely descriptive of the goods.

904.03 Material Appropriate as Specimens for Trademarks

For a trademark application under §1(a), allegation of use in an application under §1(b), or affidavit of use under §8 or §71 of the Trademark Act, the specimen must show the mark as used on or in connection with the goods in commerce. A trademark specimen should be a label, tag, or container for the goods, or a display associated with the goods. 37 C.F.R. §2.56(b)(1). A photocopy or other reproduction of a specimen of the mark as actually used on or in connection with the goods is acceptable. 37 C.F.R. §2.56(c).

See TMEP §§1301.04 *et seq*. regarding service mark specimens, TMEP §1304.08(e) regarding collective membership mark specimens, TMEP §1303.02(b) regarding collective mark specimens, and TMEP §1306.06(b) regarding certification mark specimens.

904.03(a) Labels and Tags

In most cases, where the trademark is applied to the goods or the containers for the goods by means of labels, a label is an acceptable specimen.

Shipping or mailing labels may be accepted if they are affixed to the goods or to the containers for the goods and if proper trademark usage is shown. *Electronic Communications, Inc. v. Electronic Components for Industry Co.*, 443 F.2d 487, 170 USPQ 118 (8th Cir. 1971), *cert. denied* 404 U.S. 833 (1971); *In re A.S. Beck Shoe Corp.*, 161 USPQ 168 (TTAB 1969). They are not acceptable if the mark as shown is merely used as a trade name and not as a trademark. An example of this is the use of the term solely as a return address. *In re Supply Guys, Inc.*, 86 USPQ2d 1488 (TTAB 2008); *Bookbinder's Sea Food House, Inc. v. Bookbinder's Restaurant, Inc.*, 118 USPQ 318 (Comm'r Pats. 1958); *I. & B. Cohen Bomzon & Co., Inc. v. Biltmore Industries, Inc.*, 22 USPQ 257 (Comm'r Pats. 1934). *See* TMEP §1202.01 regarding trade name refusals.

In connection with labels whose appearance suggests that they are only for temporary use, the examining attorney may consider it necessary to make further inquiry as to how the specimen is used, under 37 C.F.R. §2.61(b), in order to properly examine the application. A response to the inquiry may include an additional specimen(s) if labels of a more permanent nature have by that time been adopted. However, nothing prohibits the registration of a mark in an application that contains only "temporary" specimens, provided that the specimens were actually used in commerce. *See In re Chica*, 84 USPQ2d 1845 (TTAB 2007) (specimen deemed unacceptable not because it was temporary but because it comprised a mere drawing of the goods with an illustration of how the mark may be displayed and not an actual specimen that applicant used in commerce).

904.03(b) Stampings

Stamping a trademark on the goods, on the container, or on tags or labels attached to the goods or containers, is a proper method of trademark affixation. *See In re Crucible Steel Co. of America,* 150 USPQ 757 (TTAB 1966). The trademark may be imprinted in the body of the goods, as with metal stamping; it may be applied by a rubber stamp; or it may be inked on by using a stencil or template.

When a trademark is used in this manner, photographs or facsimiles showing the actual stamping or stenciling are acceptable as specimens.

When the specimen consists of a stamp on paper, the applicant must explain the nature of the specimen and how it is used.

904.03(c) Commercial Packaging

The terminology "applied to the containers for the goods" means applied to any type of commercial packaging that is normal for the particular goods as they move in trade. Thus, a showing of the trademark on the normal commercial package for the particular goods is an acceptable specimen. For example, gasoline pumps are normal containers or "packaging" for gasoline.

A specimen showing use of the trademark on a vehicle in which the goods are marketed to the relevant purchasers may constitute use of the mark on a container for the goods, if this is the normal mode of use of a mark for the particular goods. *In re E.A. Miller & Sons Packing Co., Inc.*, 225 USPQ 592 (TTAB 1985). *But see In re Lyndale Farm,* 186 F.2d 723, 88 USPQ 377 (C.C.P.A. 1951).

904.03(d) Electronic and Digital Media Attachments to Paper Filings

In the absence of alternative specimens, the USPTO will accept specimens consisting of compact discs ("CDs"), digital video discs ("DVDs"), videotapes, and audiotapes. *See* 37 C.F.R. §2.56(d)(3). Equipment for viewing or listening to these materials is available in the USPTO.

Compact discs, DVDs, audiotapes, and videotapes may contain files in .jpg, .pdf, .wav, .wmv, .wma, .mp3, .mpg, or .avi format. The USPTO is unable to review files in any other format. The USPTO prefers that the applicant submit small files of less than two minutes in duration. Only one specimen should be included on each tape or disc; however, in a multiple-class application, the applicant may include more than one specimen on the same disc or tape. If the nature of the specimen is unclear, the applicant should explain what it is and how it is used.

This section pertains only to CDs, DVDs, audiotapes, and videotapes attached to *paper* filings. Attachments to TEAS filings must be in .jpg or .pdf format. *See* 37 C.F.R. §2.56(d)(4); TMEP §904.02(a).

See TMEP §904.03(f) regarding specimens for sound marks, and TMEP §904.03(l) regarding specimens for motion marks. *See also* 37 C.F.R. §§2.56(d)(1) and (2) and TMEP §904.02(b) regarding the size requirements for specimens attached to paper filings, and the procedures for handling specimens that exceed these requirements.

904.03(e) Specimens for Trademarks Identifying Computer Programs, Movies, or Video Tapes

The computer program, video tape, and movie industries have adopted the practice of applying trademarks that are visible only when the goods, that is, programs or movies, are displayed on a screen (e.g., on the first several frames of a movie).

An acceptable specimen might be a photograph or printout of a display screen projecting the identifying trademark of a computer program, or a photograph of a frame(s) of a movie or video tape bearing the mark. It is not necessary that purchasers see the mark prior to purchasing the goods, as long as the mark is applied to the goods or their containers, or to a display associated with the goods, and the goods are sold or transported in commerce. *In re Brown Jordan Co.*, 219 USPQ 375 (TTAB 1983) (stamping the mark after purchase of the goods, on a tag attached to the goods that are later transported in commerce, held sufficient).

For downloadable computer software, an applicant may submit a specimen that shows use of the mark on an Internet website. Such a specimen is acceptable only if it provides sufficient information to enable the user to download or purchase the software from the website. If the website simply advertises the software without providing a way to download it, the specimen is unacceptable. *In re Osterberg*, 83 USPQ2d 1220 (TTAB 2007); *In re Dell Inc*., 71 USPQ2d 1725 (TTAB 2004). *See* TMEP §904.03(i) regarding electronic displays as specimens for trademarks.

904.03(f) Specimens for Sound Marks

To show that a sound mark actually identifies and distinguishes the goods/services and indicates their source, an applicant must submit a specimen that contains a sufficient portion of the audio or video content to show how the mark is used on or in connection with the goods/services.

For paper filings, specimens for sound marks must be submitted on CDs, DVDs, videotapes, and audiotapes. 37 C.F.R. §2.56(d)(3). *See* TMEP §904.03(d). For TEAS filings, the specimen must be an electronic file in .wav, .wmv, .wma, .mp3, .mpg, or .avi format. However, TEAS does not permit

direct attachment of these types of electronic files. Therefore, the electronic specimen must be sent *after* the TEAS document is transmitted, as an attachment to an e-mail message directed to TEAS@uspto.gov, with clear instructions that the electronic specimen should be associated with "the application filed under Serial No. <specify assigned serial number>."

Additionally, for any filing where a specimen is required, the TEAS form only validates if there is an attachment in the "Specimen" field. Therefore, in conjunction with the workaround described above, the applicant should create a .jpg or .pdf file that states that an electronic specimen will be sent to TEAS@uspto.gov, and attach the .jpg or .pdf file to the TEAS document in the "Specimen" field. *See* TMEP §904.02(a) regarding specimens filed electronically.

See also TMEP §§807.09 and 1202.15 regarding sound marks.

904.03(g) Displays Associated with Goods

A display must be associated directly with the goods offered for sale. It must bear the trademark prominently. However, it is not necessary that the display be in close proximity to the goods. *See In re Marriott Corp.*, 459 F.2d 525, 173 USPQ 799 (C.C.P.A. 1972); *Lands' End Inc. v. Manbeck*, 797 F. Supp. 511, 24 USPQ2d 1314 (E.D. Va. 1992).

Displays associated with the goods essentially comprise point-of-sale material such as banners, shelf-talkers, window displays, menus, and similar devices.

These items must be designed to catch the attention of purchasers and prospective purchasers as an inducement to make a sale. Further, the display must prominently display the trademark in question and associate it with, or relate it to, the goods. *In re Osterberg*, 83 USPQ2d 1220 (TTAB 2007); *In re Morganroth*, 208 USPQ 284 (TTAB 1980) (purported mark was so obfuscated on the specimen that it was not likely to make any impression on the reader). The display must be related to the sale of the goods such that an association of the two is inevitable. *See In re Bright of America, Inc.,* 205 USPQ 63 (TTAB 1979), and cases cited therein. *See also In re ITT Rayonier Inc.,* 208 USPQ 86 (TTAB 1980). *Cf. In re Shipley Co. Inc.*, 230 USPQ 691 (TTAB 1986); *In re Jones,* 216 USPQ 328 (TTAB 1982).

Folders, brochures, or other materials that describe goods and their characteristics or serve as advertising literature are not per se "displays." *In re Schiapparelli Searle,* 26 USPQ2d 1520 (TTAB 1993); *In re Drilco Industrial Inc.,* 15 USPQ2d 1671 (TTAB 1990). In order to rely on such materials as specimens, an applicant must submit evidence of point-of-sale presentation. Such evidence must consist of more than an applicant's statement that copies of the material were distributed at sales presentations or tradeshows. A mere statement that advertising and promotional materials are used in connection with sales presentations is not sufficient, in and of itself, to transform

advertising and promotional materials into displays used in association with the goods. *Osterberg*, 83 USPQ2d 1220, 1224 ("Applicant's declaration lacks sufficient detail to transform the web page from advertising into a display used in association with the goods. For example, there is no discussion regarding how the applicant used the web page at sales presentations to make an association between the mark and the products or whether consumers, in fact, associated the mark with the products. The use of advertising material in connection with the sales of a product does not ipso facto make it a display used in association with the goods sufficient to support technical trademark use for registration."); *see also In re Anpath Group, Inc.,* 95 USPQ2d 1137 (TTAB 2010) (holding that pamphlet and flyer listing the URL of applicant's website and/or a telephone number for contacting sales representatives does not create the same point-of-sale situation as a detailed catalogue, a detailed web page, or a situation where there is the option of placing an order based upon detailed information from the specimen); *In re Ancha Electronics Inc.*, 1 USPQ2d 1318 (TTAB 1986); (holding that a photograph showing an informational flyer or leaflet clearly depicting the mark and presented on the goods at a trade show exhibit was an acceptable display associated with the goods); *In re Columbia Chase Corp.*, 215 USPQ 478 (TTAB 1982) (holding that folders and brochures describing goods and their characteristics or serving as advertising literature are not displays, and the appearance of marks and product photographs in such literature does not per se amount to use of a mark on displays without evidence of point-of-sale presentation).

An infomercial was held to be a display associated with the goods, where the goods were shown either immediately before or immediately after the trademark was displayed, and the information on how to order the goods was given within a reasonable time after the goods were shown. The Board found that the infomercial created an association between the trademark and the goods, and the test for constituting a display associated with the goods was, therefore, satisfied. *In re Hydron Technologies, Inc.*, 51 USPQ2d 1531 (TTAB 1999).

See TMEP §904.03(i) regarding electronic displays.

904.03(h) Catalogs

In appropriate cases, catalogs are acceptable specimens of trademark use. *See Lands' End Inc. v. Manbeck*, 797 F. Supp. 511, 24 USPQ2d 1314 (E.D. Va. 1992). In that case, the applicant had applied to register "KETCH" for purses. The specimen was a catalog page that included a picture of the goods and, below the picture, the mark and a description of the goods. The Court stated, "The alleged trademark 'KETCH' appears prominently in large bold lettering on the display of purses in the Lands' End specimen in a manner which closely associates the term with the purses." 24 USPQ2d at 1315.

The Court determined that the catalog was not mere advertising and that it met the relevant criteria for displays associated with the goods. The Court evaluated the catalog specimen as follows:

> A customer can identify a listing and make a decision to purchase by filling out the sales form and sending it in or by calling in a purchase by phone. A customer can easily associate the product with the word "KETCH" in the display.... The point of sale nature of this display, when combined with the prominent display of the alleged mark with the product, leads this court to conclude that this mark constitutes a display associated with the goods.

24 USPQ2d at 1316.

Accordingly, examining attorneys may accept any catalog or similar specimen as a display associated with the goods, provided that it: (1) includes a picture or a sufficient textual description of the relevant goods; (2) shows the mark sufficiently near the picture or textual description of the goods to associate the mark with the goods; *and* (3) includes the information necessary to order the goods (e.g., an order form or a phone number, mailing address, or e-mail address for placing orders).

However, the mere inclusion of a phone number, Internet address, and/or mailing address on an advertisement describing the product is not in itself sufficient to meet the criteria for a display associated with the goods. There must be an offer to accept orders or instructions on how to place an order. *In re MediaShare Corp.*, 43 USPQ2d 1304 (TTAB 1997) (fact sheet brochures held not to qualify as a catalog under *Lands' End,* where the specimen included no information as to how to order the goods). It is not necessary that the specimen list the price of the goods.

904.03(i) Electronic Displays

A website page that displays a product, and provides a means of ordering the product, can constitute a "display associated with the goods," as long as the mark appears on the web page in a manner in which the mark is associated with the goods, and the web page provides a means for ordering the goods. *See In re Sones,* 590 F.3d 1282, 93 USPQ2d 1118 (Fed. Cir. 2009). Web pages that display the trademarks in association with a picture of the goods or a sufficient description of them to understand what they are, and provide for online ordering of such goods are, in fact, electronic displays associated with the goods. In *Sones*, the Federal Circuit held that although a visual depiction of the goods "is an important consideration in determining whether a submitted specimen sufficiently associates a mark with the source of the goods," a picture of the goods on the web page is not mandatory. *Id*. at 590 F.3d at 1288, 93 USPQ2d at 1123. A textual description may suffice where "the actual features or inherent characteristics of the goods are recognizable from the textual description, given that the more standard the product is, the

less comprehensive the textual description need be." *Id.* at 590 F.3d at 1289, 93 USPQ2d at 1124.

Such web pages are not merely advertising, because in addition to showing or describing the goods, they provide a link for ordering the goods. In effect, the website is an electronic retail store, and the web page is a shelf-talker or banner which encourages the consumer to buy the product. A consumer using the link on the web page to purchase the goods is the equivalent of a consumer seeing a shelf-talker and taking the item to the cashier in a store to purchase it. The web page is, thus, a point-of-sale display by which an actual sale is made. *In re Dell Inc*., 71 USPQ2d 1725 (TTAB 2004).

However, an Internet web page that merely provides information about the goods, but does not provide a means of ordering them, is viewed as promotional material, which is not acceptable to show trademark use on goods. *See In re Genitope Corp.,* 78 USPQ2d 1819,1822 (TTAB 2006) ("[T]he company name, address and phone number that appears at the end of the web page indicates only location information about applicant; it does not constitute a means to order goods through the mail or by telephone, in the way that a catalog sales form provides a means for one to fill out a sales form or call in a purchase by phone."). Merely providing a link to the websites of online distributors is not sufficient. There must be a means of ordering the goods directly from the applicant's web page, such as a telephone number for placing orders or an online ordering process. *In re Osterberg*, 83 USPQ2d 1220 (TTAB 2007).

The mark must also be displayed on the web page in a manner in which customers will easily recognize it as a mark. *In re Morganroth*, 208 USPQ 284 (TTAB 1980). In *Osterberg, supra*, the Board found that CONDOMTOY CONDOM was not displayed so prominently that consumers would recognize it as a trademark for condoms.

It is important to consider whether the goods are specialized in nature when determining whether web page specimens constitute a display associated with the goods. The Board found a web page containing a link to an online catalog, along with a toll free number and links to customer service and technical support, to be an acceptable specimen, where the goods (industrial tools) were specialized industrial goods, and the record contained declaration evidence that purchase of the goods requires careful calculation and technical knowledge, and that the online phone numbers were in fact used to order the goods. *In re Valenite Inc*., 84 USPQ2d 1346, 1349 (TTAB 2007) ("[A]pplicant's website, in addition to showing pictures of the goods, provides an on-line catalog, technical information apparently intended to further the prospective purchaser's determination of which particular product to consider, an online calculator and both a link to, and phone number for, customer service representatives. Therefore, applicant's website provides the prospective purchaser with sufficient information that the customer can select

a product and call customer service to confirm the correctness of the selection and place an order.”).

The *Valenite* decision should not be interpreted as a broad-reaching change in USPTO practice regarding the determination of whether a website page constitutes a “display associated with the goods.” If it appears that the web page merely provides information about the goods, but does not provide a means of ordering the goods directly from the applicant’s web page, it should be viewed as promotional material and a refusal should be issued. Pursuant to *Valenite*, the applicant may overcome the refusal by submitting additional extrinsic evidence that: (1) the specialized, industrial nature of the goods is such that they cannot simply be ordered from a web page by adding the product to a “shopping cart;” (2) the practice in the industry is for customers to seek technical assistance prior to placing an order; and (3) the telephone number shown on the specimen is used by customers for customer service or technical support and to place orders. However, given the narrow range of scenarios to which this decision applies, examining attorneys generally should avoid suggesting reliance on *Valenite* to overcome a specimen refusal.

904.03(j) Manuals

If printed matter included with the goods functions as a part of the goods, such as a manual that is part of a kit for assembling the product, then placement of the mark on that printed matter does show use on the goods. *In re Ultraflight Inc.*, 221 USPQ 903, 906 (TTAB 1984) (“We believe the instruction manual is as much a part of applicant’s goods as are the various parts that are used to build the gliders. Application of the mark to the manual of assembly instructions, then, must be considered affixation to the goods.”).

904.03(k) Specimens for Marks that are Impracticable to Place on Goods, Packaging, or Displays

The USPTO may accept another document related to the goods or the sale of the goods when it is impracticable to place the mark on the goods, packaging, or displays associated with the goods. 15 U.S.C. §1127 (definition of “use in commerce”); 37 C.F.R. §2.56(b)(1). This provision is not intended as a general alternative to submitting labels, tags, containers, or displays associated with the goods; it applies *only* to situations when the nature of the goods makes use on these items impracticable. For example, in rare circumstances it may be impracticable to place the mark on the goods or packaging for the goods if the goods are natural gas, grain that is sold in bulk, or chemicals that are transported only in tanker cars. In such instances, an acceptable specimen might be an invoice, a bill of lading, or a shipping document that shows the mark for the goods.

A mere assertion of impracticability does not suffice to establish that traditional trademark use is impracticable. Rather, the record must indicate that the goods are, in fact, of such a nature. In *In re Settec, Inc.,* 80 USPQ2d 1185 (TTAB 2006), the applicant asserted that placing the mark on the goods or on displays associated with the goods in the traditional manner was impracticable because the purpose of the goods was to provide digital media copy protection to media content providers, and placing the mark on the final product available to the ultimate end-user would impair the value of the goods, because the end-user would thereby be armed with an additional piece of the encryption puzzle. The Board rejected this contention, finding that there were a variety of ways in which applicant could use its mark in the traditional manner without making it available to the end-user.

904.03(l) Specimens for Motion Marks

To show that a motion mark actually identifies and distinguishes the goods/services and indicates their source, an applicant must submit a specimen that depicts the motion sufficiently to show how the mark is used on or in connection with the goods/services, and that matches the required description of the mark. Although the drawing for a motion mark may depict a single point in the movement, or up to five freeze frames showing various points in the movement, an acceptable specimen should show the entire repetitive motion in order to depict the commercial impression conveyed by the mark (e.g., a video clip, a series of still photos, or a series of screen shots).

For TEAS filings in which the specimen is an electronic file in .wav, .mp3, .mpg, or .avi format, TEAS does not permit direct attachment of these types of electronic files. Therefore, the electronic specimen must be sent *after* the TEAS document is transmitted, as an attachment to an e-mail message directed to TEAS@uspto.gov, with clear instructions that the electronic specimen should be associated with "the application filed under Serial No. <specify assigned serial number>."

Additionally, for any filing where a specimen is required, the TEAS form only validates if there is an attachment in the "Specimen" field. Therefore, in conjunction with the workaround described above, the applicant should create a .jpg or .pdf file that states that an electronic specimen will be sent to TEAS@uspto.gov, and attach the .jpg or .pdf file to the TEAS document in the "Specimen" field. *See* TMEP §904.02(a) regarding specimens filed electronically.

See also TMEP §807.11 regarding drawings for motion marks.

904.03(m) Specimens for Scent and Flavor Marks

To show that the specimen for a scent or flavor mark actually identifies and distinguishes the goods and indicates their source, an applicant must submit a specimen that contains the scent or flavor and that matches the required description of the scent or flavor. In most cases, the specimen will 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 in connection with the goods. When submitting such a specimen, the applicant should clearly indicate on the specimen itself that it is a specimen for a scent or flavor mark application so that the USPTO will properly route the actual specimen to the examining attorney.

A "scratch and sniff" sticker for a scent mark is an acceptable specimen, provided that it is part of the packaging for the goods or is used in such a manner as to identify the goods and indicate their source.

See also TMEP §§807.09 and 1202.13 regarding scent and flavor marks.

904.04 Material Not Appropriate as Specimens for Trademarks

904.04(a) Drawing or "Picture" of the Mark

A photocopy of the drawing required by 37 C.F.R. §2.51 is not a proper specimen. 37 C.F.R. §2.56(c). Similarly, the specimen may not be a "picture" of the mark, such as an artist's drawing or a printer's proof that merely illustrates what the mark looks like and is not actually used on or in connection with the goods in commerce. *See In re Chica*, 84 USPQ2d 1845 (TTAB 2007) (specimen deemed unacceptable because it comprised a mere drawing of the goods with an illustration of how the mark may be displayed and not an actual specimen that applicant used in commerce).

904.04(b) Advertising Material

Advertising material is generally not acceptable as a specimen for goods. Any material whose function is merely to tell the prospective purchaser about the goods, or to promote the sale of the goods, is unacceptable to support trademark use. Similarly, informational inserts are generally not acceptable to show trademark use. *In re MediaShare Corp.*, 43 USPQ2d 1304 (TTAB 1997); *In re Schiapparelli Searle,* 26 USPQ2d 1520 (TTAB 1993); *In re Drilco Industrial Inc.,* 15 USPQ2d 1671 (TTAB 1990); *In re ITT Rayonier Inc.*, 208 USPQ 86 (TTAB 1980); *In re Bright of America, Inc.*, 205 USPQ 63 (TTAB 1979). However, an instruction sheet may be an acceptable specimen. *In re Ultraflight Inc.,* 221 USPQ 903 (TTAB 1984). *See* TMEP §904.03(j) regarding manuals and TMEP §904.04(c) regarding package inserts.

The following types of items are generally considered advertising, and unless they comprise point-of-sale material, are not acceptable as specimens of use on goods: advertising circulars and brochures; price lists; announcements; press releases; listings in trade directories; and business cards. Moreover, material used by the applicant to conduct its internal business is unacceptable as a specimen of use on goods. These materials include all documents whose sole function is to carry out the applicant's business dealings, such as invoices, bill heads, waybills, warranties, and business stationery. *See In re Chicago Rawhide Mfg. Co.,* 455 F.2d 563, 173 USPQ 8 (C.C.P.A. 1972); *In re Bright of America, supra; Varian Associates v. IMAC Corp.*, 160 USPQ 283 (N.D. Ill. 1968); *Upco Co. v. Speed Crete of La., Inc.*, 154 USPQ 555 (TTAB 1967); *Dynacolor Corp. v. Beckman & Whitley, Inc.*, 134 USPQ 410 (TTAB 1962); *Pendleton Woolen Mills v. Eloesser-Heynemann Co.,* 133 USPQ 211 (TTAB 1962); *Boss Co. v. Homemaker Rugs, Inc.*, 117 USPQ 255 (N.D. Ill. 1958).

As to display of trademarks on company uniforms, *see In re McDonald's Corp.*, 199 USPQ 702 (TTAB 1978); *Toro Mfg. Corp. v. John B. Stetson Co.*, 161 USPQ 749 (TTAB 1969).

Bags and other packaging materials bearing the name of a retail store and used by the store merely for packaging items of sold merchandise are not acceptable to show trademark use of the store name for the products sold by the store (e.g., bags at cash register). When used in this manner, the name merely identifies the store. *See In re The Pennsylvania Fashion Factory, Inc.,* 198 USPQ 568 (TTAB 1978), *aff'd,* 588 F.2d 1343, 200 USPQ 140 (C.C.P.A. 1978).

904.04(c) Package Inserts

If material inserted in a package with the goods is merely advertising material, then it is not acceptable as a specimen of use on or in connection with the goods. Material that is only advertising does not necessarily cease to be advertising because it is placed inside a package.

Package inserts such as invoices, announcements, order forms, bills of lading, leaflets, brochures, printed advertising material, circulars, press releases, and the like are not acceptable specimens to show use on goods. *See In re Bright of America, Inc.*, 205 USPQ 63 (TTAB 1979).

904.05 Affidavit Supporting Substitute Specimens

If the specimen is unacceptable, the examining attorney will require a substitute specimen. Generally, when submitting a substitute specimen, the applicant must include an affidavit or declaration under 37 C.F.R. §2.20 verifying that the substitute specimen is in use in commerce. Similarly, when submitting an additional specimen in support of a multiple-class application

that is not identical to the specimen originally filed, the applicant must include an affidavit or declaration under 37 C.F.R. §2.20 verifying that the new specimen was in use in commerce as of the pertinent date indicated in this section. The affidavit or declaration must be signed by someone properly authorized to verify facts on behalf of the applicant under 37 C.F.R. §2.193(e)(1). 37 C.F.R. §2.59.

In an application under §1(a) of the Trademark Act, the affidavit or declaration must state that the substitute or additional specimen was in use in commerce at least as early as the application filing date. 37 C.F.R. §2.59(a). If the applicant cannot provide an acceptable substitute specimen, supported by an affidavit or declaration of use in commerce as of the filing date of the application, the applicant may amend the basis to §1(b). *See* TMEP §§806.03 *et seq.* regarding amendments to the basis.

In an application under §1(b) of the Act, an applicant who files a substitute or additional specimen after an amendment to allege use under §1(c) of the Act must include an affidavit or declaration stating that applicant used the substitute or additional specimen in commerce on or in connection with the goods/services prior to filing the amendment to allege use. 37 C.F.R. §2.59(b)(1). An applicant who files a substitute specimen after a statement of use under §1(d) of the Act must verify that the substitute or additional specimen was in use in commerce before the expiration of the deadline for filing a statement of use (i.e., within six months of the issuance date of the notice of allowance or before the expiration of an extension of time for filing a statement of use). 37 C.F.R. §2.59(b)(2).

If the dates of use change as the result of the submission of new specimen(s), the applicant must file an amendment of the dates of use, supported by an affidavit or declaration under 37 C.F.R. §2.20. *See* 37 C.F.R. §2.71(c); TMEP §903.04.

In some situations, however, an affidavit or declaration of use of substitute specimens is not necessary. For instance, if the specimen originally filed is cut from a larger object, it is not necessary to provide an affidavit or declaration when a sample (or a photograph) of the complete object is submitted to corroborate the original specimen. In these circumstances, the additional specimen is supplemental, and the examining attorney may consider the original specimens to have been satisfactory.

904.06 Translation of Matter on Specimens

If there is matter printed on a specimen that is not in English, the examining attorney may require that the applicant submit a translation of this matter to permit proper examination. 37 C.F.R. §2.61(b). If the examining attorney determines that a translation is necessary, he or she should limit the requirement in an appropriate manner to avoid placing an unnecessary burden on the applicant.

904.07 Requirements for Substitute Specimens and Statutory Refusals

904.07(a) Whether the Specimen Shows the Mark Used in Commerce

An application for registration under §1(a) of the Trademark Act or an allegation of use in an application under §1(b) of the Act must include one specimen per class showing use of the mark as used on or in connection with the goods, or in the sale or advertising of the services in commerce. 15 U.S.C. §§1051(a)(1), 1051(c) and 1051(d)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), 2.76(b) and 2.88(b). Initially, the examining attorney must review the specimen to determine whether: (1) the applied-for mark appears on the specimen; (2) the specimen shows that the applied-for mark is in "use in commerce;" and (3) the specimen shows use for the specific goods/services identified.

The following non-exhaustive list reflects examples of problems that may be raised on initial review of specimens:

- No specimen is submitted;
- The applied-for mark does not appear on the specimen;
- The specimen does not show use of the applied-for mark on or in connection with any of the relevant goods or in the sale or advertising of the services;
- The specimen is not in "use in commerce" (e.g., a printer's proof of an advertisement for services);
- The specimen is altered/mutilated/unprintable or illegible;
- The specimen is merely advertising material for goods;
- The specimen is merely a picture or drawing of the mark;
- The specimen is an electronic display associated with the goods (15 U.S.C. §, a printed or web catalog, or web page display for goods), and fails to include ordering information or pricing;
- The specimen is a non-electronic point of sale display and fails to show use of the mark in a display.

In an Office action addressing such specimen issues, the examining attorney must require a substitute specimen and, if necessary, a supporting affidavit or declaration under 37 C.F.R. §2.20. The Office action must also indicate that *pending a proper response to the requirement*, registration is refused because applicant has not provided evidence of use of the applied-for mark in commerce. The statutory basis for refusal is 15 U.S.C. §§1051 and 1127.

If the applicant responds by submitting a substitute specimen, and unlike in the original specimen, the mark on the substitute specimen now does not agree with the mark on the drawing (*see* TMEP §807.12), but the specimen would otherwise be acceptable to use in connection with the goods/services, the examining attorney may allow the applicant to amend the drawing if such an amendment would not constitute a material alteration of the mark. If any remaining issues can be handled by examiner's amendment, and the mark is a standard character mark, the examining attorney may give the applicant the option to amend the drawing by examiner's amendment. If not, the examining attorney should issue a final refusal that also gives the applicant the option to overcome the refusal by submitting a substitute drawing.

If an amendment of the drawing would be a material alteration, the examining attorney must issue a final refusal (assuming the application is otherwise in condition for final refusal), because the substitute specimen does not present a new issue. The underlying basis for refusal, i.e., that the applicant has not provided evidence of use of the applied-for mark in commerce, remains the same. *See* TMEP §714.05.

904.07(b) Whether the Specimen Shows the Applied-for Mark Functioning as a Mark

The examining attorney must also evaluate the specimen to determine whether the applied-for mark is used in a way that shows that: (1) it identifies the goods/services of the applicant and distinguishes them from the goods/services of others; and (2) it indicates the source of those goods/services. If use on the specimen fails in either regard, the record lacks the requisite evidence that the applied-for mark functions as a mark. The following non-exhaustive list reflects examples where review of the specimen would indicate a failure to function as a mark:

- Applied-for mark is used solely as a trade name (TMEP §1202.01);
- Applied-for mark is mere ornamentation (TMEP §1202.03);
- Applied-for mark is merely informational matter (TMEP §§1202.04 and 1301.02(a));
- Applied-for mark identifies the name or pseudonym of a performing artist or author (TMEP §1202.09(a));
- Applied-for mark identifies a model number or grade designation (TMEP §1202.16);
- Applied-for mark is merely a background design or shape and is not separable from the entire mark (TMEP §1202.11);

- Applied-for mark identifies a process, system, or method (TMEP §1301.02(e));
- Applied-for mark is used to refer to activities that are not considered "services" (TMEP §§1301.01 *et seq*.);
- Applied-for mark is used solely as a domain name (TMEP §1215.02);
- Applied-for mark is used solely to identify a character (TMEP §1301.02(b)).

If the deficiency in a specimen amounts to failure to demonstrate use of the subject matter as a trademark and/or service mark, the examining attorney must issue a refusal of registration on the ground that the subject matter does not function as a mark, in addition to requiring a substitute specimen. The statutory basis for refusal is 15 U.S.C. §§1051, 1052, and 1127 for trademarks, or 15 U.S.C. §§1051, 1052, 1053, and 1127 for service marks. *See In re Osmotica Holdings Corp.,* 95 USPQ2d 1666 (TTAB 2010); *In re Supply Guys, Inc.,* 86 USPQ2d 1488 (TTAB 2008); *In re wTe Corp*., 87 USPQ2d 1536 (TTAB 2008); *In re DSM Pharmaceuticals, Inc.*, 87 USPQ2d 1623 (TTAB 2008). Generally, when initially refusing registration on the ground that the subject matter does not function as a mark, the examining attorney should advise the applicant that the refusal will be reconsidered if the applicant submits a substitute specimen showing proper use of the applied-for mark as a trademark or service mark and, if necessary, a supporting affidavit or declaration. *See* TMEP §904.05 regarding affidavits supporting new specimens. However, in instances where the nature of the mark, such as with informational marks, indicates that consumers would never perceive the mark as source indicating, regardless of the manner of use, no such advisory need be given.

If the applicant responds by submitting a substitute specimen, and unlike in the original specimen, the mark on the substitute specimen now does not agree with the mark on the drawing (*see* TMEP §807.12), but the specimen would otherwise be acceptable to identify the goods/services of the applicant and indicate the source of those goods/services, the examining attorney may allow the applicant to amend the drawing if such an amendment would not constitute a material alteration of the mark. If any remaining issues can be handled by examiner's amendment, and the mark is a standard character mark, the examining attorney may give the applicant the option to amend the drawing by examiner's amendment. If not, the examining attorney should issue a final refusal that also gives the applicant the option to overcome the refusal by submitting a substitute drawing.

If an amendment of the drawing would be a material alteration, the examining attorney must issue a final refusal (assuming the application is otherwise in condition for final refusal), because the substitute specimen does not present a new issue. The underlying basis for refusal, i.e., that the applicant has not

provided evidence of use of the applied-for mark as a trademark or service mark, remains the same. *See* TMEP §714.05.

See TMEP §§1202 *et seq.* regarding matter that does not function as a trademark, and TMEP §§1301.02 *et seq.* regarding matter that does not function as a service mark.

905 Method of Use

The applicant is not required to specify the method or intended method of use of a mark. However, the examining attorney has the discretion under 37 C.F.R. §2.61(b) to inquire as to the method or intended method of use of the mark if this information is needed to properly examine the application. *See* TMEP §814. *See also In re Page*, 51 USPQ2d 1660, 1665 (TTAB 1999).

906 Federal Registration Notice

The owner of a mark registered in the United States Patent and Trademark USPTO may give notice that the mark is registered by displaying with the mark the words "Registered in United States Patent and Trademark Office," the abbreviation "Reg. U.S. Pat. & Tm. Off.," or the letter R enclosed within a circle, ®. 15 U.S.C. §1111.

The registration symbol should be used only on or in connection with the goods or services that are listed in the registration.

The federal registration symbol may not be used with marks that are not actually registered in the USPTO. Even if an application is pending, the registration symbol may not be used until the mark is registered.

Registration in a state of the United States does not entitle a person to use the federal registration notice. *Du-Dad Lure Co. v. Creme Lure Co.,* 143 USPQ 358 (TTAB 1964).

A party may use terms such as "trademark," "trademark applied for," "TM" and "SM" regardless of whether a mark is registered. These are not official or statutory symbols of federal registration.

906.01 Foreign Countries That Use Registration Symbol ®

In addition to the United States, several countries recognize use of the symbol ® to designate registration. When a foreign applicant's use of the symbol on the specimens is based on a registration in a foreign country, the use is appropriate.

The following foreign countries use the ® symbol to indicate that a mark is registered in their country:

- Belgium
- China (People's Republic)
- Costa Rica
- Denmark
- Ecuador
- Germany
- Guatemala
- Hungary
- Luxembourg
- Netherlands
- Nicaragua
- Poland
- Sweden

906.02 Improper Use of Registration Symbol

Improper use of the federal registration symbol that is deliberate and intended to deceive or mislead the public is fraud. *See* TMEP §906.04. However, misunderstandings about use of federal registration symbols are more frequent than occurrences of actual fraudulent intent. Common reasons for improper use of the federal registration symbol that do not indicate fraud are:

- Mistake as to the requirements for giving notice (confusion often occurs between notice of *trademark* registration, which may not be given until after registration, and notice of claim of *copyright*, which must be given before publication by placing the notice © on material when it is first published);
- Inadvertence in not giving instructions (or adequate instructions) to the printer, or misunderstanding or voluntary action by the printer;
- The mistaken belief that registration in a state or foreign country gives a right to use the registration symbol (*see Brown Shoe Co., Inc. v. Robbins,* 90 USPQ2d 1752 (TTAB 2009)*; Du-Dad Lure Co. v. Creme Lure Co.*, 143 USPQ 358 (TTAB 1964));

- Registration of a portion of the mark (*see Coca-Cola Co. v. Victor Syrup Corp.*, 218 F.2d 596, 104 USPQ 275 (C.C.P.A. 1954));

- Registration of the mark for other goods (*see Duffy-Mott Co., Inc. v. Cumberland Packing Co.*, 424 F.2d 1095, 165 USPQ 422 (C.C.P.A. 1970), *aff'g* 154 USPQ 498 (TTAB 1967); *Meditron Co. v. Meditronic, Inc.*, 137 USPQ 157 (TTAB 1963));

- A recently expired or cancelled registration of the subject mark (*see Rieser Co., Inc. v. Munsingwear, Inc*., 128 USPQ 452 (TTAB 1961));

- Another mark to which the symbol relates on the same label (*see S.C. Johnson & Son, Inc. v. Gold Seal Co.*, 90 USPQ 373 (Comm'r Pats. 1951)).

See also Sauquoit Paper Co., Inc. v. Weistock, 46 F.2d 586, 8 USPQ 349 (C.C.P.A. 1931); *Dunleavy Co. v. Koeppel Metal Furniture Corp.*, 134 USPQ 450 (TTAB 1962), *aff'd,* 328 F.2d 939, 140 USPQ 582 (C.C.P.A. 1964); *Radiant Mfg. Corp. v. Da-Lite Screen Co.*, 128 USPQ 132 (TTAB 1961); *Tobacco By-Products & Chemical Corp. v. Smith*, 106 USPQ 293 (Comm'r Pats. 1955), *modified* 243 F.2d 188, 113 USPQ 339 (C.C.P.A. 1957).

906.03 Informing Applicant of Apparent Improper Use

If a specimen in an application shows the federal registration symbol used with the mark that is the subject of the application, or with any portion of this mark, the examining attorney must determine from USPTO records whether or not such matter is registered. If it is not, and if the symbol does not appear to indicate registration in a foreign country (*see* TMEP §906.01), the examining attorney must point out to the applicant that the records of the USPTO do not show that the mark with which the symbol is used on the specimens is registered, and that the registration symbol may not be used until a mark is registered in the USPTO. The examining attorney should not require any explanation or comment from the applicant concerning the use of the symbol in relation to the mark.

906.04 Fraud

Improper use of the federal registration symbol, ®, that is deliberate and intends to deceive or mislead the public or the USPTO is fraud. *See Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); *Wells Fargo & Co. v. Lundeen & Associates*, 20 USPQ2d 1156 (TTAB 1991).

The examining attorney may not issue a refusal of registration based on fraud. If it appears to the examining attorney that fraud on the USPTO has been committed, the examining attorney must follow the procedures outlined in TMEP §720.

907 Compliance with Other Statutes

37 C.F.R. §2.69. Compliance with other laws. When the sale or transportation of any product for which registration of a trademark is sought is regulated under an Act of Congress, the Patent and Trademark Office may make appropriate inquiry as to compliance with such Act for the sole purpose of determining lawfulness of the commerce recited in the application.

Use of a mark in commerce must be lawful use to be the basis for federal registration of the mark. Under 37 C.F.R. §2.69, the USPTO may inquire about compliance with federal laws to confirm that the applicant's use of the mark in commerce is lawful. However, the USPTO does not inquire whether use in commerce is lawful unless the record shows a clear violation of law, such as the sale or transportation of a controlled substance. The USPTO presumes that an applicant's use of the mark in commerce is lawful.

The examining attorney must inquire about compliance with federal laws or refuse registration based on the absence of lawful use in commerce when a court or the responsible federal agency has issued a finding of noncompliance under the relevant statute or where there has been a per se violation of the relevant statute. *Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045 (TTAB 1988); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80 (TTAB 1984).

For the purpose of determining whether to issue an inquiry, the USPTO will not regard apparent technical violations, such as labeling irregularities on specimens, as violations. For example, if a package fails to show all required labeling information, the examining attorney should not take any action. Likewise, the USPTO does not routinely solicit information regarding label approval under the Federal Alcohol Administration Act or similar acts.

See TMEP §1205 regarding refusal of registration of matter that is protected by a statute or convention.