

# Chapter 900

## Use in Commerce

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#### **901 Use in Commerce**

In an application based on use in commerce under 15 U.S.C. §1051(a) or “intent-to-use” under 15 U.S.C. §1051(b), the applicant must actually use the mark in commerce on or in connection with all of the specified goods and/or services prior to registration. *See* 37 C.F.R. §§2.34(a)(1)(i), 2.76(b)(1)(ii) and 2.88(b)(1)(ii).

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In a §1(a) application, the applicant must use the mark in commerce on or in connection with all the goods and services listed in the application on or before the filing date of the application. The application must include a verified statement (*i.e.*, a statement supported by an affidavit or declaration under 37 C.F.R. §2.20) that the mark is in use in commerce. If the verification is not filed with the original application, the verified statement must 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 a §1(b) application, the applicant typically begins use in commerce after the filing date. *See* TMEP §902.

The use requirement applies when in addition to asserting use under §1(a) or a bona fide intent to use under §1(b), the applicant also asserts the benefit of a foreign application under §44(d), or a foreign registration under §44(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 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.

### 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

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- (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.

Some factors that may be important in 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.

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).

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### 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. 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, the United States Virgin Islands) or between the United States and a territory of the United States.

A 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, 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).

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), *cert. denied*, 525 U.S. 834 (1998).

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).

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. Impresa Perosa S.R.L.*, 139 F.3d 98, 45 USPQ2d 1985 (2d Cir. 1998); *Mother’s Restaurants Inc. v.*

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*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).

### **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."

If, however, 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 §903.06 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 registration, the applicant must 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).

*See* TMEP §§1104 *et seq.* regarding amendments to allege use, TMEP §§1109 *et seq.* regarding statements of use, and TMEP §§1108 *et seq.* regarding requests for extensions of time to file a statement of use.

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### 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 amendment to allege use or statement 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 amendment to allege use under §1(c) or statement of use under §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 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 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 §903.03 regarding types of commerce.

A date of first use in commerce is not 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 in commerce, the examining attorney will require that the applicant state the date of first use in commerce, supported by an affidavit or declaration under 37 C.F.R. §2.20. 37 C.F.R. §§2.34(a)(1)(iii) and 2.71(c).

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.

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

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### 903.03 Type of Commerce

Types of commerce that may be regulated by the United States Congress are interstate, territorial, and commerce between the United States and a foreign country. *See* TMEP §901.03.

An applicant is not required to specify the type of commerce in which the mark is used in an application based on §1(a) of the Act, or an amendment to allege use or statement of use in an application under §1(b). The Office 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.

If the applicant's statement regarding use indicates use in a type of commerce that cannot be regulated by Congress (*e.g.*, "intrastate commerce" or "foreign commerce"), 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).

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 would not have the power to regulate it.

### 903.04 Relation Between the Two Dates of Use

The application or allegation of use must contain a statement of 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 will 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).



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### 903.05 Amending Dates of Use

Any amendment of the dates must be supported by an affidavit, or by a declaration under 37 C.F.R. §2.20, by the applicant. 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. §2.33(a). *See* TMEP §804.04.

In an application under §1(a) of the Trademark Act, 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 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) of the Act in which an amendment to allege use is filed, the applicant may not amend the dates of use to recite dates of use that are subsequent to the filing of the amendment to allege use. However, the applicant may withdraw the amendment to allege use. 37 C.F.R. §2.76(h).

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 subsequent to the expiration of the statutory deadline for filing a statement of use (*i.e.*, within six months of the mailing 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 multi-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. A supporting affidavit or declaration is not necessary if the dates of use alleged in the original application or in an earlier-filed amendment to allege use or statement of use apply to all classes.

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 should inquire as to whether the dates of use apply to all classes and require an amendment, if necessary.

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, first 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

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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 first 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 Office construes the information when an applicant provides only the month and year (*i.e.*, as indicating the last day of the month - *see* TMEP §903.07 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.

### **903.06 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.

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

### 903.07 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 Office 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. Instead, the Office prints a presumed date that is determined in the following manner.

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

- (1) “Prior to January 1, 1955” is treated as December 31, 1954.
- (2) “Before February 1961” is treated as January 31, 1961.
- (3) “On or about June 18, 1987” is treated as June 18, 1987.
- (4) “1990” is treated as December 31, 1990.
- (5) “In November 1991” is treated as November 30, 1991.
- (6) “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 Office 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 should contact the applicant by telephone, if appropriate, for authorization to amend the date of first

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use anywhere to the same date as the date of the first use in commerce. As noted in TMEP §903.05, 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.

In an *inter partes* proceeding, a date of use must be established by appropriate evidence unless the party to the proceeding is entitled to rely on a date by virtue of ownership of a registration or filing of an application. 37 C.F.R. §2.122(b)(2); TBMP §704.

See TMEP §903.07(a) regarding apparent discrepancies between dates of use and execution dates.

### **903.07(a) Apparent Discrepancies Between Dates of Use and Date of Execution**

If an application, amendment to allege use under 15 U.S.C. §1051(c), or statement of use under 15 U.S.C. §1051(d) specifies a date only by the year, or by the month and the year, and the date would be interpreted under TMEP §903.07 as later than the date on which the application or allegation of use was *signed*, the Office will presume that the date specified is the date of the signing of the application or allegation of use. In this case, it is not necessary to amend the application to indicate the date of signature more specifically. Amendment is still required, however, if the date specified would be interpreted as later than the *filing date* of the application or allegation of use.

### **903.08 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.

### **903.09 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 (PO Ex. Ch. 1955); *Ex parte Wayne Pump Co.*, 88 USPQ 437 (PO Ex. Ch. 1951).

There must be at least one specified item in a class to which the specified dates 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 all items, the particular item to which they do pertain should be designated.

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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 §903.05 regarding amendments to dates of use.

If more than one item of goods or services is specified in a particular class, the Office 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* or, if the registration issues, on the certificate of registration.

### **904 Specimens**

Specimens provide part of the basis for examination 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 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); 37 C.F.R. §2.56(a). If an application under §1(a) is filed without a specimen, the examining attorney will require that the applicant 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.

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 registration the applicant must file an amendment to allege use or statement of use of the mark in commerce that includes one specimen showing use of the mark on or in connection with the goods, or in the sale or advertising of the services in commerce. 37 C.F.R. §§2.56(a), 2.76(b)(2), and 2.88(b)(2).

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

A specimen showing use of the mark is not required in an application based solely on §44 of the Trademark Act, 15 U.S.C. §1126. While a §44 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.

#### **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 amendment to allege use or statement of use in an application under

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§1(b) of the Act. An applicant may choose to submit more than one specimen per class, but this is not required.

The Office previously required three specimens so that an interested party, such as a potential opposer, could permanently remove a specimen from an application file, yet not leave the file without a specimen. However, multiple copies of specimens are not necessary, because the public may make photocopies of the specimen. The Office no longer permits specimens to be removed from files. 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).

### **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 an application in one class, it is usually not necessary to have a specimen for each product or service. However, if the range of items is very 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 regarded as two or more individual applications placed in one file wrapper. Accordingly, there must be one specimen of the mark for each class.

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

### **904.02 Physical Form of Specimens**

#### *Electronically Filed Specimens*

In an electronically filed application, the applicant must submit a digitized image (*e.g.*, .gif or .jpg) of the specimen with the application so the Office may generate a copy of the specimen(s). 37 C.F.R. §2.56(d)(4).

Sometimes there is no specimen in the file due to a technical problem in printing the specimen. In this situation, the examining attorney should ask the applicant to submit by mail or fax: (1) the specimen (or a facsimile of the specimen) that was attached to the original electronically filed application, and (2) a statement by the person who transmitted the application to the Office that the specimen being submitted by mail or fax is a true copy of the specimen submitted with the electronically filed application. This statement does not have to be verified.

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This also applies to specimens filed with electronically filed amendments to allege use under 15 U.S.C. §1051(c), statements of use under 15 U.S.C. §1051(d), and affidavits of continued use under 15 U.S.C. §1058 of the Trademark Act.

If the nature of an electronically filed specimen is unclear, the applicant should explain what it is and how it is used.

### *Paper Specimens*

A specimen of use 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). These requirements provide for a specimen that will fit inside the application file wrapper. The file wrapper is 9 by 14 inches in size and will conveniently expand to about one inch in thickness.

When the applicant cannot supply an actual specimen meeting these size requirements due to the nature or manner of use of the mark, the applicant should file a photograph or other acceptable reproduction that is a suitable size and clearly shows how the mark is used. *See* TMEP §904.08 regarding facsimiles as specimens.

Specimens of value should not be filed.

Once filed, specimens remain part of the record and will not be returned to the applicant. 37 C.F.R. §2.25.

### **904.02(a) Specimens for Marks Comprising Color**

If color is a feature of the mark, the specimen must show use of the color. 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 §904.09 regarding substitute specimens.

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

### **904.02(b) 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 Office 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 reasonably believes it is necessary for the proper examination. For example, a copy of the publication might be necessary to determine whether a mark is merely descriptive of the goods.

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### 904.03 Bulky Specimens

A specimen of use 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). If an applicant submits a specimen that exceeds these size requirements (a “bulky specimen”), the Office will create a facsimile of the specimen that meets the size requirements of the rule, put it in the application file wrapper, and destroy the original bulky specimen. 37 C.F.R. §2.56(d)(2).

If the copy of the specimen created by the Office 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 §904.09 regarding affidavits supporting substitute specimens.

In the absence of non-bulky alternatives, the Office will continue to accept specimens consisting of videotapes, audiotapes, compact discs, computer diskettes, and similar materials if there are no non-bulky alternatives, and the submission is the only means available for showing use of the mark. 37 C.F.R. §2.56(d)(3). Equipment for viewing or listening to these materials is available in the Office.

During examination, an examining attorney has the discretion to request additional information in the form of bulky materials, under 37 C.F.R. §2.61(b). 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(b) regarding marks used on publications.

In specific cases, when the examining attorney has required bulky materials, or where the applicant has submitted bulky exhibits during an interview, these bulky materials may be entered into the record. However, the examining attorney should encourage the applicant to submit a photograph of the bulky specimens or evidence for the record.

### 904.04 Material Appropriate as Specimens for Trademarks

For a trademark application under §1(a) of the Trademark Act or an amendment to allege use or statement of use in an application under §1(b) of the 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).

The Office may accept another document related to the goods or the sale of the goods when it is not possible 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. A mere assertion of impracticability may not suffice



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to establish that such use is impracticable; rather, the record must indicate that the goods are in fact of such a nature. For example, 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.

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 TMEP §§1301.04 *et seq.* regarding service mark specimens, TMEP §1304.09(c) regarding collective membership mark specimens, TMEP §1303.02(b) regarding collective mark specimens, and TMEP §1306.06(c) regarding certification mark specimens.

### **904.04(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. *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 under 37 C.F.R. §2.61(b) in order to properly examine the application. A response to the inquiry may include additional specimens if labels of a more permanent nature have by that time been adopted. *House of Worsted-Tex, Inc. v. Deering Milliken & Co., Inc.*, 102 USPQ 446 (Comm’r Pats. 1954), *aff’d*, 233 F.2d 333, 110 USPQ 44 (C.C.P.A. 1956).

### **904.04(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.

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When a trademark is used in this manner, facsimiles comprising sheets of paper or other materials on which impressions of the trademark are stamped or stencilled are normally acceptable as specimens (*see* TMEP §904.08 regarding facsimile specimens).

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

### **904.04(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).

### **904.04(d) Specimens for Trademarks Identifying Computer Programs, Movies or Video Tapes [R-1]**

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

An acceptable specimen might be a photograph 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, so 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, the applicant may submit a specimen that shows use of the mark on an Internet website. However, such a specimen is acceptable only if the specimen itself indicates that the user can download the software from the website (*e.g.*, if the specimen shows a download button). If the website simply advertises the software without providing a way to download it, the specimen is unacceptable.

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### 904.05 Material Not Appropriate as Specimens for Trademarks

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 §904.07 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; publicity 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 papers 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 Manufacturing 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 Pennsylvania Fashion Factory, Inc.*, 198 USPQ 568 (TTAB 1978), *aff'd*, 588 F.2d 1343, 200 USPQ 140 (C.C.P.A. 1978).

### 904.06 Displays as Specimens for Trademarks

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 predominantly display the trademark in question and associate it with, or relate it to, the goods. The display must be

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related to the sale of the goods so 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 and brochures 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. *See In re Ancha Electronics Inc.*, 1 USPQ2d 1318 (TTAB 1986); *In re Columbia Chase Corp.*, 215 USPQ 478 (TTAB 1982). *See* TMEP §904.06(a) regarding the criteria by which a catalog or other advertising may constitute a display associated with the goods.

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).

### **904.06(a) Catalogs as Specimens for Trademarks**

In appropriate cases, catalog specimens are acceptable specimens of trademark use. *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 should accept any catalog or similar specimen as a display associated with the goods, provided: (1) it includes a picture of the relevant goods; (2) it shows the mark sufficiently near the picture of the goods to associate the mark with the goods; and (3) it includes the information necessary to order the goods, (e.g., a phone

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number, mailing address, or e-mail address). Any form of advertising that satisfies these criteria should be construed as a display associated with the goods. It is not necessary that the specimen list the price of the goods.

### **904.07 Package Inserts as Specimens for Trademarks**

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.

Materials such as invoices, announcements, order forms, bills of lading, leaflets, brochures, printed advertising material, catalogs, catalog sheets, circulars, publicity 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).

However, 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.”).

### **904.08 Facsimiles as Specimens**

Actual specimens are preferred if they are available and not “bulky” (*see* TMEP 904.03 regarding bulky specimens). However, a photograph, photocopy or other reproduction of a specimen of the mark as used on or in connection with the goods, or in the sale or advertising of the services, is acceptable. 37 C.F.R. §2.56(c). The applicant should submit facsimiles if actual specimens are too bulky to fit in the file.

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. 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.

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(a).

Product photographs appearing on folders or brochures that show the trademark on the goods are acceptable facsimiles.

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

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

### 904.09 Affidavit Supporting Substitute Specimens [R-1]

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.

In an application under §1(a) of the Trademark Act, the affidavit or declaration must state that the substitute 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, a substitute specimen filed after an amendment to allege use under §1(c) of the Act must be supported by an affidavit or declaration under 37 C.F.R. §2.20 stating that applicant used the substitute specimen in commerce on or in connection with the goods and/or services prior to filing the amendment to allege use. 37 C.F.R. §2.59(b)(1). When a substitute specimen is filed after a statement of use under §1(d) of the Act, the applicant must verify that the substitute 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 mailing 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 specimens, the applicant must amend the dates of use with a proper affidavit or declaration under 37 C.F.R. §2.20. *See* 37 C.F.R. §2.71(c); TMEP §903.05.

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. Similarly, if the applicant submits a specimen that is temporary in nature (*see* TMEP §904.04(a)), no verification is necessary if the applicant submits a more permanent specimen.

If the record shows that the application as filed included a specimen, but that the specimen was mislaid within the Office, the examining attorney should require the applicant to submit a duplicate specimen and a statement by the person who transmitted the application to the Office that the duplicate specimen is a true copy of the specimen originally filed. This statement does not have to be verified. However, an affidavit or declaration of use is required if the applicant chooses to submit a different specimen rather than a duplicate of the original specimen.

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### 904.10 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.

### 904.11 Requirements for Substitute Specimens and Statutory Refusals

If the deficiency in a specimen amounts to failure to use the subject matter as a trademark and/or service mark, the examining attorney should 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, 1053 and 1127 for service marks. *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, in an application under §1(a) or §1(b) of the Act, or in an allegation of use under §1(c) or §1(d) of the Act. 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 Office 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 United States Patent and Trademark Office. 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).

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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 ®

Several countries in addition to the United States 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 a 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 are not regarded as indicating fraud are:

- (1) 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);
- (2) Inadvertence in not giving instructions (or adequate instructions) to the printer, or misunderstanding or voluntary action by the printer;
- (3) The mistaken belief that a state registration gives a right to use a registration symbol specified in the Trademark Act (*see Du-Dad Lure Co. v. Creme Lure Co.*, 143 USPQ 358 (TTAB 1964));



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- (4) 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));
- (5) 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));
- (6) A recently expired or cancelled registration of the subject mark (*see Rieser Co., Inc. v. Munsingwear, Inc.*, 128 USPQ 452 (TTAB 1961));
- (7) 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. Koepfel 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 a federal registration symbol used with the mark that is the subject of the application, or with any portion of this mark, the examining attorney should determine from the Office 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 should point out to the applicant that the records of the Office 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 Office. 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 Office 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 shall not issue a refusal of registration based on fraud. If it appears to the examining attorney that fraud on the Office has been committed, the examining attorney should follow the procedures outlined in TMEP §719.

### 907 Compliance with Other Statutes

37 C.F.R. §2.69. *Compliance with other laws. When the sale or transportation of any product*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*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 Office may inquire about compliance with federal laws to confirm that the applicant's use of the mark in commerce is lawful. However, the Office 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 Office presumes that an applicant's use of the mark in commerce is lawful.

The examining attorney should 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. *Cf. 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 Office 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 Office 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.