

# Publications

## Client Alert: "Use" of a Mark in the U.S.A.

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William H. Oldach III

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CLIENT ALERT | 5.20.2013

“Use” of a trademark or service mark under U.S. trademark law is often misunderstood. Even the best-intended trademark owners encounter unexpected, sometimes fatal, barriers in their attempts to register their marks and maintain their registrations.

Unlike in most countries, trademark rights in the U.S. are based upon use of the mark in the United States. *All U.S. nationals* must prove that the mark is in use “in commerce” before their applications can register. *All applicants* must state an ultimate intention to use the mark in the U.S., and, with few exceptions, *all registrants* must prove use of a mark in order to maintain their registrations after the sixth anniversary of the registration. So the concept of “use,” as well as its proof, is extremely important for applicants and registrants of U.S. trademarks.

*Non-U.S. entities* can obtain registrations for marks that are not in use, provided they have a bona fide intent to use the mark in the U.S. and they base their applications on a home or international registration. [1] But even foreign registrants have to prove use by the sixth year of the registration.[2]

## What is “Use in Commerce” and how difficult is it to prove?

“Use in commerce” is **not** just the placement of a mark on any material or product. It means that the mark is displayed or used in connection with services that are available[3] or the goods bearing the mark have been sold or transported in interstate commerce.[4] The concept derives from the “Commerce Clause” of the U.S. Constitution and confers jurisdiction of the federal government over the use of trademarks in general, and registration in the U.S. Registry in particular. The product does not have to be sold in commerce, just transported, but the use must be *bona fide*. Sending goods to a trade show is a good example of *bona fide* use, if that use continues thereafter through sales.

It is helpful to note what is **not** considered to be use in commerce by the Trademark Office: it is not just using the mark in a corporate filing, for example, or in a business name registration or SEC filing, or communications with investors or potential business partners. Nor is it use in preparation for opening a business or preparing to selling a product, use when signing a contract or a lease. It is not “token use”<sup>[5]</sup>, nor, in general, is it use outside the U.S.

Acceptable examples of use<sup>[6]</sup> depend upon whether the mark is for **goods** or for **services**; services being somewhat easier to prove.

## Proof of Use for Services

Proof of use on services is relatively straightforward, although the mark must still be perceived as a trademark. The mark should be prominent and recognized as an identifier for the services provided by its owner, not buried in a sentence or overwhelmed by other text. Services are proven by presenting a mark in advertising or promotional material. A website accessible in the U.S. is the easiest example; a photo of signage or on menus (for restaurant services) are also acceptable.

## Proof of Use for Goods

Proof of use of a mark for goods is sometimes more difficult since the traditional requirement is that the mark must appear **on** the goods or their container as the goods travel in commerce.

Obviously, the type of goods will dictate where and how the mark is placed. Steel beams could have a mark etched into them, or the mark could appear on a hang tag. Clothing might have a mark on an interior label, hang tag, or on the clothing itself. Food will most likely be marked on its container. Liquids or chemicals could be marked on trucks or containers. Goods delivered by wholesalers could be marked with a stamp or label on the container in which they travel. Marks used on point of purchase promotional material (shelf or floor “talkers” and on displays of the products at retail locations) will also be accepted. But flyers, promotional material, or websites from which a product cannot be ordered *will not* be accepted for goods.

An exception to these rules has become known as the *Lands End* catalog exception for the case that determined the validity of this type of proof. In general, if a picture of the goods appears in a catalog (or by analogy, a website or promotional piece) together with the mark *and* a method to purchase the goods appears (such as a phone number or ecommerce site) then such a catalog, website or promotional material will be acceptable as proof of use, even if the mark is not otherwise on the product. Overall, this body of case law attempts to mimic traditional trademark use in that consumers will see the mark and associate it with the goods they are purchasing at the time they are making the purchasing decision. As e-commerce has become increasingly common, case law has continued to evolve. For instance, the Federal Circuit has determined that a textual description of the goods can suffice in place of an image.<sup>[7]</sup> Similarly, the TTAB has relaxed the rigid requirement for ordering information to appear on the website, determining that with certain technical products, the combination of product information and a phone number for customer services is sufficient.<sup>[8]</sup>

## General Considerations

It is also very important to focus on the appearance of the mark in the application or registration. If the mark in the application/registration is in a stylized format, if it appears in color or contains a design element, the use in the example submitted to the Trademark Office must be a “substantially exact” representation (in practice, this generally means that the mark must *match exactly*) the drawing of the mark in the application or registration. Variations may not be accepted, especially if words or extraneous design elements are integral to the mark. This is of particular concern when the declaration of use is filed before the sixth and then every tenth anniversary of registration, since a mark is often changed or “modernized” over the years, and the then current use might not match the original registration.

Depending upon the changes in the mark, it is sometimes possible to amend the existing registration, but this is not always possible. So, ideally, changes to the mark after an application is filed should be discussed with counsel before finalizing to attempt to minimize loss of registration rights.

Use must also be current – the declaration or affidavit that accompanies the filing requires the registrant to state that the example is a current one. So, the example must not indicate that the goods or services are “coming soon” or reflect a prior dated “close out.”

Lastly, each and every good or service listed in the application or registration must be in use at the time of the filing, otherwise the good(s) no longer sold or service(s) not offered must be *deleted* from the application or registration. However, unless requested by the Trademark Office, only one example per class needs to be submitted.<sup>[9]</sup>

## Summary

1. Applications filed by non-U.S. entities, based upon home or international registrations must state a *bona fide* intent to use the mark in commerce, but they do not have to prove use in order to achieve registration.
2. Use must be proved in the following situations:
  - Use-based applications (Section 1(a))
  - Intent to Use applications before registration (Section 1(b))
  - Sixth anniversary of all registrations<sup>[10]</sup> (Section 8 and 71)
  - Renewal of all registrations<sup>8</sup> (every tenth year anniversary of registration) (Section 9 and 71)
3. Use of a mark in connection with services is most often proved using websites, advertising, brochures, promotional material, menus or signage.
4. Use of a mark on goods is most often proved using: labels, tags, containers, photos of the mark on the goods themselves, catalogs or websites from which the product can be ordered.
5. Use must *exactly* match the drawing in the registration/application and the specimen must reflect at least one good or service in each class of the application or registration.
6. Goods/services not used at the time of proof must be deleted from registrations or deleted from, or divided out of, pending applications.

This article is not intended to substitute for legal advice. For more detailed information and to analyze specific situations, contact us at:

Cory M. Amron, Esq.  
202.467.8810  
cmamron@vorys.com

Joan C. Makley, Paralegal  
614.464.6424  
jcmakley@vorys.com

William H. Oldach, Esq.  
202.467.8880  
wholdach@vorys.com

Julia S. Piantanida, IP Coordinator  
202.467.8858  
jspiantanida@vorys.com

Christopher M. Ott, Esq.  
202.467.8909  
cmott@vorys.com

Bernice Hogue, IP Specialist  
202.467.8826  
behogue@vorys.com

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[1] These applications are based upon Section 44 or 71 of the US Trademark Law.

[2] The requirements to prove use in a pending use-based application, Statement of Use for a pending intent-to-use application, a sixth (6<sup>th</sup>) year Declaration of Use, or a Declaration of Use at the time of renewal, are identical and so we will discuss this requirement for all these situations by referring to the use requirements for a “pending application or registered mark”.

[3] Whether the services just have to be available, or whether at least one customer has to have availed itself of the services is the subject of some current debate, but at the very least, the services must be available before use is achieved.

[4] Interstate commerce is commerce between states in the U.S. or imported into, or exported from the U.S.

[5] Use must be actual and bona fide, not “mock-ups” or uses created or disseminated just for the purpose of sending them to the Trademark Office. Before the advent of intent-to-use (ITU) applications, “token use” was often accepted to satisfy use requirements, but these types of uses were clearly rendered invalid after ITU applications were allowed.

[6] The Trademark office calls the evidence of use that it requires to be submitted, “specimens,” but for many this word conjures up medical procedures. Others use the word “samples”, but this word could include mock up and uses that are not in actual commerce. So we will call these “examples.”

[7] *In re Sones*, 590 F.3d 1282 (Fed. Cir. 2009)

[8] *In re Valenite Inc.*, 84 USPQ2d 1346 (TTAB 2007)

[9] The Trademark Office may, at its discretion, request proof of use on all goods/services or additional proof for certain goods/services for selected applications and registration, in an attempt to determine the accuracy and integrity of the register, i.e., whether marks are actually used for all goods/services listed.

[10] It is possible to avoid the sixth or every tenth year proof of use requirement under an “excusable non-use” exception. This exception is unusual and rarely met, however. Acceptable excuses include inability to make the goods because of a boycott, war or other political situation beyond the control of the registrant. We have seen the Trademark Office accept as a *bona fide* excuse, for example, the recent death of the registrant’s principal. But economic conditions making it difficult to sell the product or make a profit, or difficulty getting or staying in the relevant market will not suffice.