

Using your Webpage as a Trademark Specimen for Goods

By [Kevin Spexarth](#) and [Benjamin Imhoff](#)

A trademark is any word, symbol, or device used to identify and distinguish a source of goods in the minds of consumers. The United States recognizes common law trademark rights, but a Federal Trademark Registration from the United States Patent and Trademark Office (USPTO) confers particular benefits and advantages to the owner, including constructive nationwide use.

After the legal requirements for a trademark registration have been met, such as distinctiveness and no likelihood of confusion, evidence of use must be submitted and accepted. The evidence of use includes a specimen of use for each class in which the trademark is sought to be registered, and a declaration that the trademark is in use on every good and/or service listed in the application. The same evidence of use requirements must be met when the trademark has been registered for six years and at the time of each renewal of the Registration (every ten years).

There are several ways in which a trademark may be used to satisfy these requirements. A trademark may be affixed to the goods themselves, on the packaging of the goods, or on displays at the point-of-sale of the goods. Trademarks associated with the offer of a service may use a specimen advertising an offer of the service. However, advertisements alone are not acceptable specimens of use for goods.

Trademarks are commonly used on-line; however, specific requirements must be met when a trademark is associated with goods so that on-line use qualifies as a display at the point of sale (acceptable as a specimen of evidence of use) and not merely advertising (not acceptable as use).

The USPTO has outlined the requirements for acceptable on-line specimens of use in the Trademark Manual of Examination Procedure (TMEP). These requirements are:

1. A picture or a description of the goods

The goods must be adequately described. The description can be a picture or a textual description. If text is used to

describe the goods, the actual features or inherent characteristics of the goods must be recognizable from the text. For instance, a simple description is often sufficient if the product is relatively standard. However, complex products may require a complex description. A picture and text combination may also be used and often provides a strong description of the goods.

2. Association between the mark and the goods

To be an acceptable webpage specimen, the overall impression of the webpage must necessarily create a connection between the mark and the goods in the minds of consumers. When evaluating a webpage specimen for this necessary connection, the USPTO considers (a) the prominence of the trademark and (b) the placement of the trademark and proximity of the trademark to the goods.

(a) Prominence of the trademark

A prominent mark is often in a large font, and stylized (e.g. bold or italics) or otherwise distinguished, compared to surrounding text. The beginning of a sentence is also a more prominent position than the middle or end. Prominent marks may further be labeled with TM or ® designations (note that ® can only be used with a registered trademark, otherwise use TM).

(b) Placement of the trademark.

The placement of the trademark directly next to or in the description of the goods associates the trademark with the goods. Location of the trademark elsewhere on the webpage may detract from the required connection between the marks and the goods. Some locations on webpages may give rise to other competing interpretations by consumers. Use of the trademark in a domain name is interpreted as an internet address and not generally recognized as trademark use. Furthermore, a trademark displayed at the top of the page and separated from the goods is often interpreted as a service mark indicating an offer of a service (such as retail services). Also, when

(Continued on page 2)

(Continued from page 1)

more than one trademark is used on the same webpage, the commercial impression created by each different mark may be diminished, distracting the consumer from connecting a specific mark to the goods. On the other hand, when the webpage uses few or no other marks, and only the identified goods are shown and/or described, a wider range of mark placements may still support the required connection by consumers.

3. Ordering information

An acceptable webpage specimen must also allow the consumer to purchase the goods. If there is no way to order the goods, the webpage is an advertisement. The inclusion of a “shopping cart” feature, “call 1-800-xxx-xxx to order”, or other means to directly and immediately order the goods is given strong weight that the webpage specimen bearing the trademark induces the consumer to buy the goods. Simple “contact us” language or telephone numbers without specific directions to call to place an order are generally not enough to induce a consumer to purchase the goods.

Trademarks are often and increasingly used online. With attention to the standards applied by the USPTO, this use can be sufficient to support a new trademark application or renewal of a registration for a long-standing mark. The following changes may improve a webpage’s acceptability as a trademark specimen.

- Include a description of the goods (a picture and/or text).
- Make the trademark stand out from the surrounding webpage or text.
- Place the trademark in close proximity to goods it is identifying.
- Included specific and simple ordering information or instructions.

FIRM NEWS

Christopher Scherer Appointed to Steering Committee of AIPPI-US - Andrus Attorney Christopher Scherer was recently appointed to a two-year term on the Steering Committee of the AIPPI-US Division of the American Intellectual Property Law Association. Chris was one of eight U.S. attorneys appointed to the Steering Committee, which controls and manages the affairs of AIPPI-US. The mission of AIPPI-US is to promote understanding of the degree of intellectual property protection afforded through U.S. laws and international arrangements, to assist in the protection of intellectual property, to promote research regarding the protection of intellectual property, and to cooperate with the International Association for the Protection of Intellectual Property (AIPPI) in the protection of intellectual property worldwide.

George Solveson Elected a Fellow of the Wisconsin Law Foundation - On October 8, 2014, George H. Solveson was honored to be elected as a Fellow of the Wisconsin Law Foundation, an honorary program recognizing members of the legal profession in Wisconsin known by their peers for high achievements in their profession and outstanding contributions for the advancement and improvement of the administration of justice in the State of Wisconsin. Membership in the Fellows is considered a professional honor and evidence of professional distinction. Fellows membership is limited to 2.5% of the State Bar's total members. Fellows must be lawyers, judges, or teachers of law who are members of the State Bar of Wisconsin in good standing, and are recognized in the legal profession for outstanding attainment in professional, public, or private careers for devotion to the welfare of their community, state, and nation and the advancement of the legal profession.

Benjamin Imhoff Named Up and Coming Lawyer - Benjamin R. Imhoff was honored to be named an Up and Coming Lawyer by the Wisconsin Law Journal in 2014. The annual award recognizes attorneys who have shown themselves to be on the rise. With eight years or less of experience, honorees have handled challenging legal issues, given themselves to their communities, and proven themselves to be leaders in their fields.

Sharon Czysh Recognized as Unsung Hero in the Legal Community - Andrus Office Manager Sharon Czysh was honored as an Unsung Hero in the legal community by the Wisconsin Law Journal in 2014. Sharon was recognized as one of twenty-four “behind the scenes” heroes in the state. Sharon was nominated and awarded the recognition based on over 25 years of dedicated service to Andrus.