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U.S. trademark prosecution: Online use may miss the mark

Establishing and maintaining federal trademark rights requires constant attention to detail in the way the mark is used

Trademark rights can last forever. Unlike copyrights and patents, there is no limit to the lifespan of a mark so long as it is being used in commerce. But, there is one tiny catch. The way the mark is used matters. To obtain and maintain a federal trademark registration, the owner must demonstrate use by submitting a specimen that meets the United States Patent and Trademark Office standards of acceptability. As discussed in the [second article](#) in this series, the mark in the application must match the mark in the example filed with the USPTO. Many times an intent to use application will be examined, published for opposition, allowed, and then run into trouble when the applicant submits a “specimen” or evidence of how the applicant is using the mark, because the specimen does not establish use of the mark in a manner acceptable to the USPTO.

The Internet is a boon to applicants in the sense that webpages can readily be edited to conform to the rules, whereas print advertising, labels and tags – the more traditional types of specimens – are not so easily fixed. While webpages are commonly used as specimens for both services and

goods, simply displaying a mark on the company’s website will not necessarily result in unacceptable evidence of use. For instance, if the only use of a mark on a webpage is in the URL, the specimen will be rejected as not demonstrating use of the mark.

Different standards apply to the acceptability of website specimens for services and goods. To demonstrate use of a mark for a service, the webpage must show a direct association between the services and the mark. If it does not think that the public viewing the specimen would regard the mark as a source-identifier, then the USPTO will refuse registration; slapping the SM symbol on the mark will not solve the problem.

The direct association between a service mark and the service is sometimes difficult to achieve. The applicant’s services were identified as manufacturing and assembling certain products, as well as consulting services in connection with the design of the specified products in *In re Multi-Fineline Electronix, Inc.* As its specimen of use, the applicant submitted a slide presentation that the applicant characterized as an “electronic brochure”

used to advertise its SMARTLINK technology and related services. The mark SMARTLINK appeared above the wording “Business Overview Products and Applications,” and the slides discussed “design options” and product management, but the Trademark Trial and Appeal Board (TTAB) sided with the examiner and affirmed the refusal of registration because there was no direct association between the mark and the services evident on the specimen.

The “direct association” requirement is entirely in the eye of the beholder, and predicting what the eyes of the examiner or the TTAB will behold is challenging to say the least. In a very recent case, *In re Phoenix Intangibles Holding Company*, the applicant submitted a specimen for supermarket services that showed a photograph of beer caps arranged to look like a snowman. The bold text of the advertisement discussed only beer, and the only reference to supermarket services was use of the words “market district” in much smaller print at the bottom of the advertisement. Based on the rationale underlying the *Multi-Fineline Electronix* decision and others, one would predict that

the TTAB would affirm the examiner's rejection of the specimen. Instead, the Board bought the applicant's argument that everyone knows that supermarkets sell beer, saying, "We find that the advertisement at issue shows direct use of the mark in connection with the rendering of services and the context within which the specimen is used creates an association between the mark and the supermarket services in the minds of purchasers."

Trademark use for products can also be proven with webpages because, in addition to product tags and labels, "displays associated with the goods" are acceptable evidence of trademark use. Websites that function like a catalog or point of purchase display are thus acceptable. In general, website screen grabs qualify only if they also contain ordering information or capability. For example, in *In re DV Int'l, Inc.*, a webpage showing the applicant's tagline superimposed over a photo of the product was deemed advertising and not a display that would qualify as evidence of use of the mark because it lacked ordering information.

An examiner denied an application (*In re Rogowski*) to register a mark for "audio recordings featuring music"

because the specimen, a screenshot of a page from YouTube, did not demonstrate clearly enough that music could be downloaded from the applicant's YouTube channel. In affirming the refusal, the Board acknowledged "the trend of music being offered in downloadable formats," but found the absence of a "download" link was dispositive and analogous to a page advertising goods but not providing a means for ordering them.

The Board rejected a website specimen for software for management of public works and utilities in *In re Azteca Sys, Inc.* The software was described on the applicant's first attempted webpage specimen, but only one of the words of the mark was mentioned in the narrative on the page, and the design mark for which Azteca sought registration appeared in a lower corner of the page. A substitute specimen page showed a contact link for sales and marketing information but no description of the goods, so it was disregarded. The Board decided that the first page was not a "display associated with the goods," because there were distractions from the association between the mark and the goods on the page: the distance between the mark and the description of the software, the inclusion of a

number of different logos not specifically for the goods, and the presence of links to articles about applicant's business and users of the subject software.

The obligation to submit an acceptable specimen of use arises at the application stage, again between the fifth and sixth years following registration, and at the renewal of each ten year term. Establishing and maintaining federal trademark rights requires constant attention to detail in the way the mark is used. There is a significant reward for vigilance, however: ownership of intellectual property with the capacity to endure forever.

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