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United States: USPTO: Proving Use Of A Trademark In The United States Patent And Trademark Office

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The requirements for proving use of a trademark in applications, Section 8 or Section 71 use declarations, and renewal applications in the United States Patent and Trademark Office (USPTO) are very different from use requirements in other countries. Often, evidence of use that is sufficient in foreign trademark offices is not acceptable under the strict technical rules of the USPTO. Careful attention from the outset to the use requirements in the U.S. can avoid unnecessary delay and expense down the line, and also help avoid potential objections by third parties.

In order to prove use of a trademark in the USPTO, two entirely separate issues must be addressed. One is whether each of the specific goods and services named in the application or registration is currently sold and delivered to U.S. customers under the mark. The other is whether there is an acceptable specimen of use. General guidelines and practice points on each issue follow.

Type of Use

Under U.S. rules, use of the mark must be "in the ordinary course of trade, and not made merely to reserve a right in a mark." In order to support a claim of use, the use must be in connection with a real, commercial sale and delivery or free distribution of goods or services to arms' length customers in the U.S. The meaning of "in the ordinary course of trade" depends upon the particular industry. There is no threshold requirement for volume of sales. However, a one-time "token" use made right before a deadline only to support a claim of use is invalid. In order to be valid, the use must be a continuing, good-faith commercial use. It is not necessary for goods to be sold or services performed for money. Promotional distribution of goods or performance of services for free can be sufficient.

A mark is not in use in the U.S. absent sales or distribution in the U.S. merely because the products or services exist in foreign countries and can be viewed on a website. A mark is also not in use in the U.S. if only a mock-up of a product has been shipped to the U.S.

The use need not be widespread geographically in the U.S. So long as the use is genuine and commercial in nature, it can generally be limited to a small geographic area in the U.S., such as a single state or city, or even an overseas U.S. territory such as Puerto Rico, the U.S. Virgin Islands, or Guam.

Permissible small uses in various industries are described in detail in David Ehrlich's article "Maintaining U.S. Trademark Registrations: Small Uses By Foreign Owners Sufficient" (www.mondaq.com). For example, clinical trials of pharmaceuticals and sale of electronic downloads of old video games in the U.S. are sufficient to support claims of use.

For a use-based application, the mark must actually be in use in the U.S. for all of the claimed goods and services. An application may be deemed fraudulent if the owner claims that it is using the mark in the U.S. for goods/services A and B, when

it is only using the mark for good/service A.

For services, the trademark owner must actually be rendering all of the services in the U.S. to third parties in order to satisfy the use-in-commerce requirement. Merely offering or advertising the services to U.S. customers is not sufficient.

In order to keep a registration in force for the remainder of the initial ten-year term, both U.S. and foreign owners (regardless of the original filing basis) must file a declaration alleging continued use of the mark in the U.S. (a "Section 8 declaration" for national filings or a "Section 71 declaration" for registrations under the Madrid Protocol) between the fifth and sixth years after registration. Similar declarations of use are thereafter required to maintain the registration at ten-year intervals after registration. The purpose of these declarations is to clear the Register of so-called "dead wood." Goods and services not sold and delivered currently in the U.S. under the mark must be deleted from the registration at this point, unless excusable non-use can be proven. Claims of excusable non-use are dependent on the specific facts, and they can be very difficult to establish.

Use in the United States, for purposes of maintaining a registration, requires current sales and deliveries of the goods or services under the mark to U.S. customers, probably within one year of the USPTO filing. For marks with infrequent U.S. sales, it is necessary to determine when the most recent U.S. delivery took place. The U.S. attorney can then advise if that was sufficiently recent.

After production of goods has ceased, sales of remaining inventory by the trademark owner or by third parties in online stores can be a sufficient use, depending on the volume that is standard for the particular industry. Minimal sales of old inventory might not be sufficient, and a declaration could be challenged on the ground of inadequate sales. The resale of used goods or old inventory by third parties at auction (such as on Internet auction sites like eBay) is probably not valid use for registration maintenance purposes. Such sales probably do not support a claim of current use by the trademark owner.

A declaration to make a registration on the Principal Register "incontestable" under Section 15 of the U.S. Trademark Act (which makes the mark immune to certain kinds of legal challenges) may be filed at any time after the mark has been used in the U.S. continuously for five years after the registration date (provided that certain other legal requirements are met).

Specimens

Once it has been determined that there is a valid claim of use in U.S. commerce for the specific goods and services, the next step is to obtain evidence of use (a "specimen") showing how the mark is being used in this country. The USPTO's specimen requirements are quite strict.

One specimen is required per class of goods and/or services. (However, the mark must actually be in use for all of the goods and services claimed, and the filing contains a sworn declaration to that effect.) The specimen must be proof of current use in the United States, rather than of original or historical use.

For goods, proper specimens include product labels, tags, packaging, or photographs of the product that clearly show use of the mark on the packaging or on the product itself. The specimen cannot depict packaging that is used only in foreign countries.

Point-of-sale displays can be acceptable specimens if they associate the mark with the goods. The display must be related to the sale of the goods "such that an association of the two is inevitable," and the display must be an inducement to purchase the goods. Catalogs or webpages can serve as point-of-sale specimens provided that certain conditions are met: There must be a picture or a sufficient textual description of the goods, the mark must appear sufficiently near the goods such that consumers would associate the mark with the goods, and there must be information on how to order the goods (typically, a "buy" button on a webpage).

Use of the mark on shipping boxes (such as on a carton sticker or label) can be a sufficient specimen. It does not matter that the ultimate U.S. consumer would not see the mark on a shipping box.

Invoices, advertisements, brochures, and delivery notes generally are not acceptable specimens for goods (as opposed to services) under the USPTO's technical rules. Invoices and brochures are acceptable specimens for a mark for goods only in one unusual circumstance—that is, for goods sold only in bulk without any labels or packaging, such as industrial chemicals delivered in railway tank cars. Photographs taken from advertisements, webpages, brochures, or catalogs can serve as acceptable specimens for goods if they show use of the mark on the packaging or on the product itself.

Unlike for goods, it is not possible to affix a mark to services because of their intangible nature. For services, therefore, acceptable specimens include advertisements, website printouts, invoices, brochures, or other promotional materials that show the mark in connection with the services rendered in the U.S. The rules require that the specimen refer to the services, or show

the mark as actually used in the rendering or performing of the services. They do not require the specimen to detail how the services are provided.

The use of a company name as a trade name on a product label, as part of the name and address block, or as part of an IP rights notice, such as a copyright notice, is probably not an acceptable specimen for goods or services.

The USPTO will not inquire into the underlying validity of the use. However, third parties could challenge the claim of use (and any resulting registration or maintenance filing) in litigation. Therefore, when a trademark owner asks a U.S. attorney if use can be claimed to obtain or maintain a registration, the owner should both describe the actual use in the U.S., such as current sales to U.S. customers for all goods, and send a proposed specimen for review. Sending an acceptable specimen without a use description could produce extra correspondence and accompanying cost to explore the use or, worse, result in a filing with an invalid use claim that is subject to later attack.

The content of this article is intended to provide a general guide to the subject matter. Specialist advice should be sought about your specific circumstances.

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