

Fundamentals of Proving Trademark Use in the United States

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While many countries recognize trademark rights primarily through registration, the United States grants these Intellectual Property (IP) rights through actual use of a mark in commerce. Consequently, applicants before the United States Patent and Trademark Office (USPTO) – and registrants maintaining their registrations – must be prepared to demonstrate that their trademarks are genuinely being used in connection with the goods or services identified in their applications.

Failure to establish proper trademark use can result in refusal of an application, cancellation of a registration or leave the mark open to challenge from competitors. Consequently, understanding what constitutes acceptable trademark use and how to prove it is essential for organizations seeking to protect their brands.

Key regulations and definitions

The Lanham Act requires that a trademark be used in commerce before it can be federally registered via a use-based application filed under Section 1(a). Even applicants filing an intent-to-use application under Section 1(b) must eventually demonstrate actual use before a registration will be issued.

The USPTO defines this “use in commerce” differently for goods that are sold or transported by the trademark owner in U.S. commerce, being covered by Nice Classes 1–34, and services that are provided by the trademark owner in U.S. commerce, being covered by Nice Classes 35–45.

For goods, the trademark must appear on the products themselves, their packaging, labels, tags or associated displays. The goods must also be sold or transported in interstate commerce or in commerce that Congress can regulate.

For services, the trademark must be used in the sale or advertising of the same, and they must actually be rendered in commerce. Merely advertising a service that has not yet been performed is generally insufficient to establish trademark use.

Token use made solely to reserve rights in a trademark does not satisfy the statutory requirements, which call for a bona fide commercial use made in the ordinary course of trade.

Specimens of use

Demonstrative specimens of how the trademark is or will be used in commerce must be provided when filing a use-based or intent-to-use application, respectively. A specimen serves as real-world evidence that consumers encounter the trademark while purchasing or using the goods or services.

Sufficient evidence of use for goods

For goods, acceptable specimens commonly include:

- Photographs of the normal commercial packaging / shipping containers for the described goods showing the trademark on the packaging / shipping containers
- Photographs showing the trademark on product labels connected to the goods
- Photographs showing the trademark on hang tags connected to the goods
- Photographs of the goods bearing the mark
- Instruction manuals
- Point-of-sale webpages showing the trademark and providing a way to purchase the described goods directly from the website (e.g., webpages that display the trademark alongside the goods and include pricing and an “Add to Cart” or similar button)

The specimen should clearly associate the trademark with the goods being sold rather than function merely as advertising.

Evidence of use that is NOT sufficient for goods

Avoid the following specimens for goods:

- Advertising materials
- Invoices, bills of lading, brochures
- Webpages that are not point-of-sale

Sufficient evidence of use for services

On the other hand, acceptable specimens for service marks often include advertising that shows the trademark and references the described services. For example:

- Business websites and webpages describing the services
- Online advertisements
- Marketing brochures / promotional materials
- Presentations

In addition to advertising, another form of evidence for services is documents / photographs that show the trademark in the course of rendering or performing the described services. For instance, correspondence with customers regarding the described services and bearing the relevant service mark is acceptable.

Evidence of use that is NOT sufficient for services

The following specimens are not considered acceptable:

- Press releases sent exclusively to news media, or printed articles resulting from such releases
- Newspaper / magazine articles
- Instruction manuals (another notable contrast to goods)

Exceptions to evidence of use rules

Websites that provide a phone number for ordering goods / getting technical support can sometimes be sufficient if:

- The specialized, industrial nature of the goods is such that they cannot simply be ordered from a web page by adding the product to a “shopping cart” or similar checkout system;
- The practice in the industry is for customers to seek technical assistance prior to placing an order;
- The telephone number shown on the specimen is used by customers for customer service or technical support and to place orders.

In rare circumstances, it may be impracticable to place a trademark on goods or their packaging if they are, for example, natural gas, grain that is sold in bulk or chemicals that are transported only in tanker cars. In these circumstances, acceptable evidence of use might include invoices and / or bills of lading.

However, a mere assertion of impracticability is not enough – evidence must include proof that goods are, say, only sold in bulk.

Trademark maintenance

Owners of registered trademark are required to prove the continued use of their IP periodically. Between the fifth and sixth year after registration, owners generally must file a Declaration of Continued Use under Section 8 of the Lanham Act. Similar filings are required every ten years when renewing the registration.

These maintenance filings require the owner to submit updated specimens demonstrating current use of the trademark in connection with the registered goods or services. If certain goods or services are no longer offered under the mark, they should be deleted from the registration, as unsupported claims cannot be maintained.

Failing to file these documents or submitting inaccurate claims of use can result in cancellation of the registration.

Common problems with trademark use

Many trademark applicants encounter difficulties because they misunderstand what qualifies as acceptable use.

One common issue involves submitting mock-ups or digitally created images rather than photographs of actual products. The USPTO has increased its scrutiny of specimens and frequently refuses applications supported by altered or fabricated images.

Another frequent problem arises when applicants submit advertising for goods rather than proper point-of-sale displays. A brochure promoting a product without providing purchasing information will not qualify as an acceptable specimen for goods.

Organizations also sometimes claim use for an overly broad list of goods or services. While a company may currently sell one product, it may identify dozens of additional products in its application in anticipation of future expansion. Unless the trademark is actually being used for each identified item, those claims may be vulnerable to refusal or later cancellation.

Consequences of inadequate proof

Applicants and owners who do not establish genuine trademark use risk a host of negative repercussions.

During examination, the USPTO may refuse registration if the specimen is unacceptable or if the evidence falls short of demonstrating use in commerce.

Also, competitors may challenge a successful IP registration through administrative procedures such as Ex Parte Reexamination or Ex Parte Expungement Proceedings if the registrant cannot substantiate use for some or all of the identified goods or services.

Finally, in litigation, an inability to prove use may undermine enforcement efforts, limit available remedies or even result in cancellation of the registration.

Organizations, whether they be businesses or institutions, should therefore ensure that every claim of use submitted to the USPTO is accurate, truthful and supported by appropriate documentation. By understanding all these requirements and maintaining proper evidence, trademark owners can strengthen their registrations, reduce the risk of challenges and preserve the value of some of their most important IP assets.

Author



Jonathan Rixen is a Trademark and Design Attorney with expertise in trademark preparation and prosecution, trademark searching, contentious matters (e.g., oppositions), trademark watches and coexistence / consent agreements, all in both U.S. and international jurisdictions. Jonathan Rixen is also a Registered Patent Attorney (USPTO) with a background in design and utility patents for mechanical, mechanical-electrical, software and medical device technologies. A member of the Minnesota Intellectual Property Law Association, he is licensed to practice before the USPTO, the Supreme Court of Minnesota and the United States District Court for the District of Minnesota.

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