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USPTO Provides Guidance on Webpages as Acceptable Specimens for Trademarks

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As part of the process of registration and renewal of trademarks with the United States Patent and Trademark Office (USPTO), a specimen of use of the mark in commerce must be provided. Back in September 2007, Vedder Price first reported an important shift in the law; the Trademark Trial and Appeal Board (TTAB) found that in some limited instances, a printout of a webpage is an acceptable specimen of use for goods.[1] Many questions remained open; for example, is a webpage an acceptable specimen in relation to the offer of services for sale?

On December 17, 2012, more than five years after the change, the USPTO finally issued guidelines on an acceptable webpage specimen for goods only.[2] While the Trademark Act does not explicitly define a "webpage specimen" category, case law has described displays as comprising "point-of-sale material such as banners, shelf-talkers, window displays, menus, or similar devices which are designed to catch the attention of purchasers and prospective purchasers as an inducement to consummate a sale and which prominently display the mark in question and associate it or relate it to the goods."[3] Displays associated with the goods also exist in an electronic or online environment in the form of webpages. These "electronic displays" perform the same function as traditional displays and so must meet the same standards for an acceptable specimen as traditional displays must meet.[4]

While a Point-of-Sale[5] Display Associated with the Goods Is an Acceptable Specimen for Goods, Mere Advertising Material Is Not.[6]

A point of sale is a location at which consumers can view the mark in connection with the goods and immediately purchase them at the same time.[7] A webpage specimen is acceptable as a display associated with the goods if it:

1. contains a picture or textual description of the identified goods;
2. shows the mark sufficiently near the picture or description of the identified goods so that the mark is associated with the goods; and
3. provides information necessary to order the identified goods.[8]

As part of prong 2 above, the mark must be prominently displayed and not merely used within a sentence; this is referred to as the "prominence" requirement. Case law informs us that a mark may

appear more prominent when the specimen:

- presents the mark in a larger font size or different stylization or color than the surrounding text;[9]
- places the mark at the beginning of a line or sentence;[10]
- positions the mark next to a picture or description of the goods;[11] or
- uses the “TM” designation with the applied-for mark (however, this designation alone does not transform a mark into a trademark if other considerations indicate that it does not function as a trademark).[12]

In the past, we have successfully entered webpage specimens for services as long as the three elements were found on the page (i.e., a description of the service, mark used in association with the service, and cost/ordering information of the service). For example, a webpage specimen for banking services may be evidenced by a page on which a new online account may be set up by a client. However, we must warn against the temptation of publishing a webpage meeting these requirements before goods or services are actually available for sale. A precarious webpage specimen would be improper and could result in invalidation of the mark.

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[1] *In re Valenite Inc.*, Serial No. 76/482,852, July 31, 2007 (citable as a precedent).

[2] Examination Guide 1-13 (*Webpage Specimens as Displays Associated with the Goods*) (Dec. 2012).

[3] *In re Bright of Am.*, Inc., 205 USPQ 63, 71 (TTAB 1979) (emphasis added); *see also* TMEP § 904.03(g).

[4] *In re Sones*, 590 F.3d 1282, 1288, 93 USPQ2d 1118, 1123 (Fed. Cir. 2009).

[5] The terms “point-of-sale” and “point-of-purchase” are used interchangeably. *See, e.g., In re Anpath Grp.*, 95 USPQ2d 1377, 1380 (TTAB 2010); *In re Osterberg*, 83 USPQ2d 1220, 1224 (TTAB 2007); *In re Dell, Inc.*, 71 USPQ2d 1727 (TTAB 2006).

[6] *In re Anpath Grp.*, 95 USPQ2d at 1380; *In re Quantum Foods, Inc.*, 94 USPQ2d 1375, 1379 (TTAB 2010); *In re MediaShare Corp.*, 43 USPQ2d 1304, 1307 (TTAB 1997).

[7] *In re Osterberg*, 83 USPQ2d at 1222-23.

[8] *In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118 (Fed. Cir. 2009).

[9] *Compare In re Quantum Foods, Inc.*, 94 USPQ2d 1375, 1378 *with In re Osterberg*, 83 USPQ2d at 1220, 1223.

[10] *In re Dell, Inc.*, 71 USPQ2d at 1725, 1729 (TTAB 2004).

[11] *In re Quantum Foods, Inc.*, 94 USPQ2d at 1378.

[12] *In re Sones*, 590 F.3d at 1289, 93 USPQ2d at 1124.

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