



Federal Circuit Overturns Patent and Trademark Office Requirement That Applicant Provide a Picture of a Good Sold Over the Internet as a Specimen Supporting A Trademark Application

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An applicant for federal registration of a trademark in the United States eventually must submit a specimen to the Patent and Trademark Office (the “Office”) showing use of the trademark in connection with the applied-for goods or services. For many years, the Office has required applicants who submit a web page showing the mark in connection with the sale of the goods over the Internet to include a picture of the goods themselves. In *In Re Sones*, 93 U.S.P.Q.2d 1118 (Fed. Cir. 2009), the Federal Circuit overturned this bright-line rule to conform web page specimens to traditional requirements that a trademark applicant merely must show that the mark has been “placed in any manner on the goods or... the displays associated therewith.” 15 U.S.C. § 1227. The specific test the Federal Circuit announced to determine the sufficiency of a web page specimen is whether the specimen shows evidence to “sufficiently associate[]” the mark with the goods so as to “identify and distinguish the goods.” *Sones* at 1123 (citation omitted).

The Federal Circuit’s test does nothing more than place web page specimens on equal footing with brick and mortar specimens of use, where a picture of the good is not required. As a practical matter, providing a picture of the good on the same web page as the mark may still be the most efficient means of showing use of the mark to sufficiently associate it with the good. However, eliminating the burden of having a picture of the goods when the specimen of use is submitted should help web-based start-ups protect their on-line brands. Branding being crucial to the success of a web-based business, it is no small thing to have protection come easier in the form of a federal trademark registration. In particular, the requirement of having a picture is difficult to meet for start-up web businesses that do not have inventory on hand when they go live – as appears to have been the case here.



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The Federal Circuit does mention some factors that could make a web page specimen of use sufficient, such as the nature of the web site (point-of-sale helps), whether the features or characteristics of the goods are apparent from the textual description on the web page and the use of "TM" in connection with the mark. *Sones* at 1124. The question on remand is whether *Sones'* specimen for his ONE NATION UNDER GOD mark for use in connection with charity bracelets was sufficient to meet this test. You be the judge. See below.

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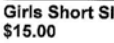


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