

Trademark Rule Clarified: Pictures of Goods Not Required for Website Specimen of Use

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The Federal Circuit recently issued a decision that will be of interest to any business hoping to register a mark used online to promote and sell a product, and anyone who does U.S. trademark prosecution and maintenance work, particularly those involved in the process of gathering or identifying evidence of use in U.S. trademark applications or registrations.

In the recent *In re Sones*, 93 U.S.P.Q.2d 1118 (Fed. Cir. 2009) decision, the Federal Circuit determined that evidence of use from the Internet does not have to include actual pictures of the product, as long as the evidence depicts the mark placed in any manner to show that it is associated with the goods claimed in the application, and that it serves as an indicator of source. This holding is notable because it expands the types of evidence that qualifies to prove use to support a U.S. registration and is inconsistent with current *Trademark Manual of Examining Procedure* (TMEP) provisions that an examining attorney “may accept any catalog or similar specimen as a display associated with the goods, provided that it: (1) includes a picture of the relevant goods; (2) shows the mark sufficiently near the picture of the goods to associate the mark with the goods; and (3) includes the information necessary to order the goods.”

In *In re Sones*, an applicant submitted evidence of use for charity bracelets showing only a textual description of the bracelets next to the trademark but no pictures. Following the TMEP and its interpretation of *Land’s End, Inc. v. Manbeck*, 797 F. Supp. 511 (E.D. Va. 1992), the U.S. Patent and Trademark Office (PTO) rejected the evidence of use and subsequently refused to register the mark. The applicant appealed. Ultimately, the court in *In re Sones* analogized web catalogs and online retail sites to “brick and mortar” stores where pictures of goods were not required (labels, containers, or displays sufficed). “[T]he ubiquity of Internet commerce does not prove that customers always need product pictures to associate trademarks with goods.” 93 U.S.P.Q.2d at 1123. While pictures are still recognized as one method to show this association, the *In re Sones* decision establishes that they are not required. In addition to pictures, other relevant factors the court mentioned were “whether . . . [the] webpages have a point of sale nature, and whether the actual features or inherent characteristics of the goods are recognizable from the textual description, given that the more standard the product is, the less comprehensive the textual description need be.” *Id.* at 1124.

The PTO eventually will update the TMEP to reflect this holding. In the meantime, practitioners and trademark owners should consider this holding before concluding that adequate evidence does not exist to support a particular trademark application or registration, and when considering the types of use that can be implemented in the future to establish the requisite use in commerce for a U.S. registration.

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