

Examination Guide 3-19

Examination of Specimens for Use in Commerce: Digitally Created/Altered or Mockup Specimens

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I. INTRODUCTION

The ongoing issue of applicants submitting specimens that are digitally created/altere d, or are mockups, has resulted in the need for the USPTO to focus more attention on whether submitted specimens are actually used in commerce as required by the Trademark Act. Identifying and refusing suspicious specimens, and requiring additional information about them and the applicant's claimed use of the mark, is important to maintaining the accuracy and integrity of the federal Trademark Register. This Examination Guide supplements existing guidance on examination of specimens to provide additional guidance regarding specimens that appear not to be in use in commerce because they are digitally created/altere d or otherwise mocked up.

II. DEFINING DIGITALLY CREATED OR ALTERED AND MOCKUP SPECIMENS

A digitally created/altere d or mockup specimen consists of an image created for the purpose of showing how the mark might be used in connection with the goods or services. Such specimens do not evidence actual use of the mark on goods sold or transported in commerce, or in the case of services, displayed in connection with services actually rendered in commerce, all in the ordinary course of trade, as required by 15 U.S.C. §1127.

- A *digitally created specimen* comprises a digital drawing of the goods or packaging on which the mark appears.

- A *digitally altered specimen* includes a digital alteration of an existing image of goods or packaging for goods, a display associated with goods, or an advertisement or website that purports to show the mark used on the goods or in the sale, performance, or rendering of services.
- A *mockup specimen* comprises a digital or non-digital rendering of what a mark would look like on a product, display, or website; these may be created solely for submission with the application.

III. IDENTIFYING DIGITALLY CREATED/ALTERED AND MOCKUP SPECIMENS

Digitally created/altered and mockup specimens range from those that are clearly manipulated to those that are more difficult to identify. The following characteristics may indicate a digitally created/altered or mockup specimen.

- The depiction of the product looks like a digital rendering rather than a real product.
- The product, label, or packaging is missing information typically included in the trade.
- The mark appears to float over the product or container.
- Features of the item disappear near or around the mark.
- The image includes pixelization around the mark.
- The mark is not applied to the product in a manner consistent with the material composition of the product.
- The mark appears on goods known to be marketed under a third-party mark.
- The website screenshot showing the mark includes placeholder text indicating that the website was not in use.
- The website screenshot showing the mark is missing important information such as a URL or browser tab, and is displayed in a way that suggests it is not published (e.g., within other software).
- Identical images display different marks or do not display any marks.
- Features of the goods suggest that the goods are used while the tag or label to which the mark is applied appears new.
- The labeling appears to be crudely applied to containers or plain boxes.
- The mark appears superimposed onto signage or other advertising or marketing materials for services.
- A webpage for an online marketplace, submitted as a display associated with the goods, includes indicia indicating that the mark is not in use in U.S. commerce or was not in use on the dates of use indicated in the application (e.g., language, currency, price, first available date, ship-to destination).

This list is not exhaustive; other characteristics not listed above also may indicate a specimen does not show use of the mark in commerce.

IV. GENERAL EXAMINATION CONSIDERATIONS FOR DIGITALLY CREATED/ALTERED OR MOCKUP SPECIMENS

Examining attorneys must carefully evaluate each specimen for signs indicating that it may have been digitally created/altered or is a mockup. Descriptions of the specimens should be taken into consideration. However, if facts in the record contradict the accuracy of the description of the specimen, these must be considered when determining the acceptability of the specimen.

A. Retouched Images

Where the specimen is an image of a product bearing the mark and the image appears to be a retouched image, the examining attorney may conduct research to confirm that a product depicted in the specimen exists. If the examining attorney is able to confirm that the product depicted in the specimen exists and shows use of the mark in commerce, the examining attorney may accept the specimen. In that case, the examining attorney must enter a Note to the File that indicates what resources were checked without including any statements or legal conclusions regarding the use of the mark. The Note to the File may be "checked applicant's website at [URL of page checked]" or "checked Amazon.com at [URL of page checked]." In instances where the examining attorney confirms that a product exists bearing the mark, but the content of the listing or page where the product is found is suspicious for other reasons that indicate it is unlikely that products or services offered under the mark have actually been sold or rendered in commerce, the examining attorney may issue requests for information (RFIs) concerning the applicant's use of the mark. 37 C.F.R. §2.61(b).

B. Digitally Created/Altered or Mockup Specimens

If a specimen appears to be digitally created/altered or otherwise mocked up, the examining attorney must issue a refusal under Trademark Act Sections 1 and 45 on the ground that the specimen does not appear to show actual use of the applied-for mark in commerce. 15 U.S.C. §§1051, 1127; TMEP §904.04(a). The refusal must include an explanation of the reasons the specimen appears to be digitally altered or created.

When issuing a refusal based on the specimen not appearing to show actual use of the mark in commerce, the examining attorney must also issue an RFI under 37 C.F.R. §2.61(b) requiring the applicant to provide detailed information about the submitted specimen and other information and documents relevant to aiding a determination as to whether the mark is actually in use in commerce.

A §2.61(b) request may require information regarding one or more of the following: (1) the goods or services for which the specimen was submitted; (2) whether the specimen was created for submission with the application and if so, when; (3) the source of the image depicting goods; (4) how the mark is used on goods in the actual sales environment or in the rendering or performing the services, including representative examples showing such use and URLs and publication dates for web pages; (5) when the goods or services were first available for purchase and whether they are still for sale; (6) proof of sales in commerce with or within the United States for the goods in the specimen, redacting personal or private information of buyers as necessary; (7) proof of use for additional goods or services identified in the application; and (8) any other information relevant to a determination regarding actual use of the mark in commerce on or in connection with the identified goods/services. However, an examining attorney must ensure that the RFI is tailored to the particular facts of an application and generally should not seek information that already exists in the record.

An applicant's response options to the refusal are to: (1) submit a verified substitute specimen showing actual use in commerce; (2) amend the filing basis to Section 1(b) and submit an acceptable specimen with an amendment to allege use or a statement of use; or (3) argue that the original specimen shows actual use in commerce. If the applicant submits an acceptable substitute specimen or amends the filing basis to Section 1(b), the RFI will be withdrawn.

In most cases, the examining attorney will issue a refusal of registration under Sections 1 and 45 for failure to show use in commerce is being made. Only in very limited circumstances where the examining attorney cannot point to indicia on the specimen itself to support a refusal but there is something suspicious about the contents or display of the specimen that suggests that the mark is not in actual use in commerce, and the examining attorney needs more information for proper examination of the issue, may an examining attorney issue an RFI without also issuing a refusal.

In every case, the examining attorney must also include all other relevant specimen-based grounds in the refusal under Sections 1 and 45. For example, applications containing digitally created/altered or mockup specimens may not show use of the mark with any of an applicant's goods or services listed in the application. Likewise, a digitally created website or advertisement also may not show a direct association between the mark and the goods or services. Additionally, if the specimen fails to show the mark functioning as a mark (e.g., the mark is merely informational or is used in an ornamental manner) the examining attorney must also issue a refusal under Sections 1, 2, and 45 or Sections 1, 2, 3, and 45, as appropriate. See TMEP §§904.07(a), (b).

V. EVALUATING RESPONSES

If the applicant satisfactorily responds to all RFIs and the original specimen does not contradict those responses, the specimen must be accepted. If the applicant does not respond to the RFI, but provides an acceptable substitute specimen, the issue is resolved and the examining attorney need not maintain the requirement for information. However, if the applicant does not provide an acceptable substitute specimen and fails to respond or provides incomplete or unsatisfactory responses to the RFI, the examining attorney must issue a final refusal under Sections 1 and 45 and a final requirement under §2.61(b).

VI. GATHERING EVIDENCE

Generally, extrinsic evidence is not required to support a first-action refusal for a digitally created/altered or mockup specimen because the specimen itself provides the evidence why it cannot be accepted. Nevertheless, the examining attorney should conduct a search for an image if the examining attorney recognizes the image as appropriated or if there are other signs that the specimen is digitally created/altered or a mockup. Such evidence should be provided to create a more comprehensive record in a final refusal.

The examining attorney may use free image search and analysis tools available online, such as Google[®]. When making Google[®] evidence part of the record, the examining attorney must both (1) provide complete information as to the date the evidence was published or accessed from the Internet and its source (e.g., the complete URL address of the website), and (2) download and attach the evidence to the Office action. TMEP §710.01(b).

Other sources of evidence the examining attorney may consider are Office records such as an X-search record for a registration for the trade dress associated with an appropriated image or a copy of the specimen from the file of the registered mark associated with an appropriated image.