

United States

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The importance of correctly identifying goods and services

Trademark rights are acquired through use of a mark in commerce. Applicants must correctly identify the goods and services with which their mark is intended for registration or risk refusal or cancellation

Correctly identifying the goods and services in a US trademark application is essential for applicants to satisfy the ‘use in commerce’ requirement for registration. For applications filed under 15 USC §1051(b) (known as ‘Section 1(b)’) or §1051(a) (known as ‘Section 1(a)’), actual commercial use of the trademark in connection with the goods or services listed in the application must be established before a registration is issued. While proof of actual use is not required to obtain registration under Sections 44(e) or 66(a), the resulting registrations may be susceptible to cancellation if the applicant lacked the requisite intent to use the mark on all of the listed goods or services at the time of filing or ceases to use the mark in connection with all of the identified goods or services after the registration is issued. Regardless of the registration basis, continued use of a mark in connection with the goods or services identified is essential to maintaining the registration.

Application prosecution

Section 1(b) can be a valuable tool for US trademark applicants. Pursuant to Section 1(b), an application can be filed based on the *bona fide* intent to use the mark in the future – the mark need not be in use before filing. As such, the application filing date – rather than the date of first commercial use – becomes the priority date on issuance of the registration. As a result, a junior user will have priority over a senior user that began using its trademark after the junior user’s Section 1(b) filing date. The priority established by the filing date – combined with the fact that the applicant has up to 36 months from the date that a notice of allowance is issued by the US Patent and Trademark Office (USPTO) to establish use – can be a substantial benefit.

To take advantage of the benefits afforded by Section 1(b), the ‘intent to use’ application must be amended to seek registration pursuant to Section 1(a). This requires the applicant to submit proof that the mark is used commercially in connection with the goods or services identified in the application in order for the registration to be issued. Establishing the use necessary to complete the process depends on correctly identifying the intended goods or services. This is especially important when determining whether a mark is used in connection with software or services.

The distinction between software and services is critical because the nature of an acceptable specimen differs between the two. With regard to software, the specimen of use must show that the mark is used in connection with the goods in commerce. Therefore, an acceptable specimen should be a label, tag, container or display associated with the goods. A website can be considered a display associated with the goods, provided that it:

- contains a picture or textual description of the identified goods;
- shows the mark in association with the goods; and
- provides a means for ordering the identified goods.

Advertising material is not generally acceptable as a specimen for goods.

In contrast to goods, a specimen for services must show the mark being used in the sale of the services. This includes use in the course of rendering or advertising the services, which encompasses marketing and promotional materials. A ‘service’ must be a real activity performed to the order or for the benefit of a party other than the applicant. Acceptable specimens include newspaper and magazine advertisements, brochures, billboards, handbills, direct-mail leaflets, restaurant menus, publicly available press releases (eg, on the applicant’s website) and similar promotional materials. To be acceptable, the specimen must show that the trademark is used in a manner that demonstrates a direct association with the services.

Applicants that sell software but misidentify their goods as services will be unable to establish the commercial use necessary to complete the registration process. For example, assume that an applicant is selling computer application software for storing computer usernames, passwords and credit and debit card information. Rather than identifying the software in the application as Class 9 goods, the applicant incorrectly identifies



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registration susceptible to cancellation in whole or in part in proceedings before the Trademark Trial and Appeal Board. Non-use of the mark in connection with the goods or services for three years creates a presumption that it has been abandoned. Abandonment is a ground for parties to petition for cancellation.

When filing an application – whether under Sections 1(b), 44(d), 44(e) or 66(a) – applicants must declare that they have a *bona fide* intent to use the mark in commerce in the United States on or in connection with all of the goods and services listed. If an applicant lacks the requisite intent to use the mark in connection with all of the identified goods or services at the time of filing, the application can be opposed or the registration cancelled for fraud on the USPTO, provided that the other elements of fraud are met.

In the United States, commercial use of a mark is the foundation on which trademark rights are established. Federal registration creates no trademark rights, but rather confers benefits and protections in addition to the rights established through use in commerce. To acquire and maintain a US trademark registration, trademark owners must correctly identify the goods or services with which a mark is intended for use. Failure to do so will prevent them from establishing the commercial use necessary for registration and may jeopardise both the application during prosecution and the registration after it issues. **WTR**

the software as Class 42 services based on its function (eg, providing online, non-downloadable computer databases and encryption software for storing computer usernames, passwords and credit and debit card information). A screen shot of the trademark in an app store would be sufficient to show use of the mark for software, but it is insufficient to show use for the identified services. For this, the specimen must show that the mark is used in the sale or advertising of the services, which are offered or rendered to a third party. Before filing, applicants must determine whether they are in the business of selling software or rendering and being compensated for rendering services for others. Failure to do so can cause an applicant to lose the benefits otherwise available pursuant to Section 1(b).

Registration maintenance and third-party challenges

Regardless of whether a trademark is registered under Section 1(a), which requires proof of use, or Sections 44(e) or 66(a), neither of which require actual use of the mark before registration, it must be used in connection with the identified goods or services to maintain the registration. Between the fifth and sixth years after registration, the trademark owner must file an affidavit of continued use and submit a specimen to show use of the mark in connection with the goods and services in the registration. After 10 years, and every 10 years thereafter, the registrant must renew the registration and file another affidavit of continued use and specimen. Failure to do so will result in cancellation of the registration.

Failure to use the mark in connection with all of the listed goods may make the

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While advertising material cannot be used to support use in connection with software, acceptable specimens for services include newspaper and magazine advertisements, brochures, leaflets and similar promotional materials