

## Trademark Law Alert – How Your Webpage Can Be a Specimen of Trademark Use

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If your trademark appears only on your website, can a copy of a webpage displaying the mark be an acceptable specimen of use for a U.S. trademark application for goods?

The U.S. Trademark Act states that a mark is in use in commerce on goods when:

- (A) It is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto [unless that is impracticable], and
- (B) The goods are sold or transported in commerce.

Note that merely using a trademark to **advertise goods** is not sufficient. (This contrasts with the use of a service mark to **advertise services**, which is sufficient.) The trademark must be used on or with the goods, or on a display associated with the goods. The U.S. Patent and Trademark Office has interpreted the necessary display as being a point-of-sale display, and has adopted rules for acceptable webpages that are somewhat detailed.

### A Case in Point

Siny Corp. applied to register CASALANA as a trademark for a textile fabric. The specimen of use was a webpage that did not provide a means for ordering the goods, but merely displayed the mark in connection with one choice among eleven fabrics and described some features and benefits. Near the bottom of the webpage, it said “For sales information” followed by a phone number and email address. The Examining Attorney rejected this specimen.



## Trademark Trial and Appeal Board (TTAB) Decision

The Applicant appealed to the TTAB, arguing that the goods were commercial textile products sold to manufacturers, not finished products sold to consumers; that any purchaser of the goods would require the assistance of a salesperson to assist in selecting the product or in determining the product's specifications; and that a phone number would connect the purchaser with such a salesperson.

The TTAB, in a split decision, affirmed the Examining Attorney's position because the specimen webpage did not include information essential to a purchasing decision—

- price or range of prices
- the weight or thickness of the fabric
- the dimensions of a bolt of the fabric
- minimum quantities for an order
- how payment might be made
- how the goods would be shipped.

Given these deficiencies, the TTAB said that the webpage did not function as a point of sale display. [\*In re Siny Corp., Serial No. 86754400 \(T.T.A.B. August 18, 2017\).\*](#)

## U.S. Court of Appeals for the Federal Circuit (CAFC) Decision.

The Applicant appealed to the CAFC, which affirmed the TTAB decision. It noted the TTAB's finding that "if virtually all important aspects of the transaction must be determined from information extraneous to the web page, then the web page is not a point of sale." While agreeing with the Applicant that the CAFC had cautioned against bright-line rules in this context, the CAFC concluded that the TTAB had carefully considered the record before it and that the CAFC could not say that the TTAB's decision lacked substantial evidence. [\*In re: Siny Corp., 2018-1077 \(C.A.F.C. April 10, 2019\).\*](#)

**Author's Note:** The lesson to be learned is that a webpage will be considered a point-of-sale display, rather than an advertisement, only if it shows a picture or description of the goods in association with the mark and provides a means for ordering them. Providing a phone number, email address or even a shopping cart for ordering purposes are important for this purpose, but only if the webpage also provides purchasers with the basic information essential to a sale of the goods, such as the price, delivery and any other material information about the goods. "Contact us" and the like usually are not acceptable as an ordering mechanism.

A webpage frequently is the most readily available specimen of use, and it even can be from a third-party vendor. But instead of submitting a webpage, you could submit a specimen showing the mark as applied to packaging for the goods, or as it appears on a label or hang tag routinely affixed to the goods, or as displayed on a user manual that accompanies the goods when they are shipped to a customer, or even as it appears on a counter sign or nearby wall sign if the sign clearly relates to the goods offered for sale under that mark in that location.