

Examination Guide 3-14  
Service-Mark Specimens  
August 2014

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This examination guide reviews the requirements for service-mark specimens; discusses issues that frequently arise and explains the relevant potential refusals; addresses the common types of specimens submitted in connection with modern technology-related services; and provides examples. While the guide focuses on service marks for computer technology services in terms of discussion and examples, the stated specimen examination principles generally apply to all service-mark specimens.

I. BACKGROUND

A. Purpose of Service Marks and Requirement for a Specimen

A service mark identifies and distinguishes the services of one party from those of another and indicates their source.<sup>1</sup> To obtain registration of a service mark under Section 1 of the Trademark Act, an applicant must submit a specimen showing the mark as used in commerce.<sup>2</sup> Under Section 45, a mark is deemed to be in “use in commerce” on services “when it is used or displayed in the sale or advertising of services.”<sup>3</sup>

B. Types of Service-Mark Specimens

“[B]ecause by its very nature a service mark can be used in a wide variety of ways, the types of specimens which may be submitted as evidence of use are varied.”<sup>4</sup> Whatever type of specimen is submitted, it must show proper use in commerce, which may be established by (1) showing the mark used or displayed as a service mark in the sale of the services,<sup>5</sup>

which includes use in the course of rendering or performing the services;<sup>6</sup> or (2) showing the mark used or displayed in advertising the services,<sup>7</sup> which encompasses marketing and promotional materials.<sup>8</sup> For purposes of clarity and simplicity, this examination guide uses the term “rendering” when discussing specimens that show use of the mark in the sale, performance, or rendering of the services.

The type of specimen submitted will often be apparent without the need for additional information regarding how the mark is used on the specimen. A specimen description submitted by the applicant typically helps clarify the manner in which the mark is used in commerce, and the more explanation the applicant provides initially, the more helpful it is to the examining attorney’s analysis. Thus, applicants are encouraged to provide a specimen description and explain how the applicant renders or provides the services and, if relevant, how marks are commonly used in the particular industry for such services. For instance, a description stating that a specimen comprises a title screen bearing the mark and showing the mark used in rendering the identified services is helpful when examining the nature and acceptability of the specimen.

If it is not readily apparent that the specimen meets the criteria for an advertisement or rendering type of specimen, and any specimen description does not clarify the issue, the specimen must be refused for failing to show the mark in use in commerce.<sup>9</sup> See Part III regarding the grounds for refusal. If clarification regarding the nature of the specimen or the manner in which the mark is used may easily overcome the refusal (e.g., the applicant explains that the specimen is a title screen displaying the mark at the start of the provision of the identified services), an advisory to that effect may be included with the refusal.<sup>10</sup>

### C. Other Specimen Considerations and Issues

Regardless of whether the submitted specimen shows the mark used in advertising or rendering the services, the examining attorney should consider the following when determining whether a service-mark specimen is acceptable.

**Whether the Specimen Shows the Mark as Actually Used by the Applicant in Commerce in the Sale or Advertising of the Services:** The specimen must show the mark as actually used by the applicant in selling or advertising the services.<sup>11</sup> Therefore, materials such as news articles and mock-ups of advertisements are not acceptable because they do not demonstrate the required use of the mark by the applicant.<sup>12</sup> In some instances, a specimen or the specimen description may indicate that the specimen is not yet in use in commerce by inclusion of wording such as “internal only,” “printer’s proof,” “website coming soon,” or “under construction.”

**Whether the Identified Services Are Registrable Services:** A service-mark specimen must show the mark used or displayed in connection with a registrable service offered for the benefit of others. For information regarding activities that constitute registrable services, see TMEP §§1301.01–1301.01(b)(v).

**Whether the Specimen Shows Use in Connection with All Classes in a Multiple-class Application:** The same specimen may be acceptable for multiple classes if the specimen shows direct association between the mark and at least one of the identified services in each class. See Part II.B below. If the applicant intends for a submitted specimen to support multiple classes, the applicant should include a statement to that effect and indicate the classes supported by the specimen,<sup>13</sup> but the applicant need not submit multiple copies of the same specimen.<sup>14</sup>

Whether the Applied-for Mark Is Used in Connection With the Identified Services: The specimen must demonstrate the applied-for mark serving as a source indicator for the identified services. Therefore, registration must be refused if the specimen shows the mark is used only to promote goods rather than the identified services, or the mark is used as a service mark but not for the identified services (i.e., the applicant misidentified the services).<sup>15</sup> See Part III.A regarding failure to show use in commerce and Part IV.A regarding misidentified services.

Whether the Applied-for Mark Functions as a Service Mark: The applied-for mark must actually function as a source-indicating service mark. Thus, registration must be refused if, for example, the specimen shows the mark serves solely as a trade name, only as the name of a computer software program or application, exclusively as the name of a method, process, or system, or merely as informational or ornamental matter.<sup>16</sup> That the software or process may actually be used in providing the identified services neither transforms that software or process into the identified services, nor associates the name of that software or process as the name of the identified services.<sup>17</sup> However, the specimen may be acceptable if it also shows that the mark serves as a service mark for the identified services.<sup>18</sup> See Part III.B regarding failure to function as a service mark. The use of the “SM” symbol with the mark does not, by itself, transform a designation into a service mark if other indicia suggest that it does not function as a service mark.<sup>19</sup>

## II. ELEMENTS OF AN ACCEPTABLE SERVICE-MARK SPECIMEN

To be acceptable, a service-mark specimen must show the mark sought to be registered used in a manner that demonstrates direct association between the mark and the services. Essentially, the mark must be shown “in a manner that would be perceived by potential purchasers as identifying the applicant’s services and indicating their source.”<sup>20</sup>

The acceptability of a specimen is determined based on the facts and evidence of record, and viewed in the context of the relevant commercial environment.<sup>21</sup> Thus, the information provided by the specimen itself, any explanations offered by the applicant clarifying the nature, content, or context of use of the specimen, and any other information in the record should be considered in the analysis.<sup>22</sup>

When the identified services involve newer technology, the examining attorney must follow the appropriate examination policies and procedures, but also should employ a practical approach in analyzing the submitted specimen.<sup>23</sup> This may entail reviewing all the information of record to understand both how the mark is used and how it will be perceived by consumers.<sup>24</sup> Additionally, if the examining attorney elects to conduct research regarding the mark, the services, or practices in the particular industry, it may be helpful to consider any information uncovered regarding how the applicant and others in the industry typically advertise and render the identified services in the relevant marketplace, as well as the manner in which service marks are normally used in connection with those services. See Section IV below for a discussion of issues surrounding technology-related services.

### A. Show the Mark

The mark on the drawing must be a substantially exact representation of the mark shown on the specimen.<sup>25</sup> Furthermore, the designation must appear sufficiently prominent on the specimen (e.g., placement, size, or stylization) so that it will be perceived by consumers as a mark.<sup>26</sup> For instance, if shown in the same font, size, and color as the surrounding text on the specimen, the designation may not be perceived as a source indicator.<sup>27</sup>

## B. Associate the Mark with the Identified Services

The specimen must show the mark used in a manner that creates in the minds of potential consumers direct association between the mark and the services.<sup>28</sup> Direct association is the minimum the specimen must show,<sup>29</sup> and it may be established textually, contextually, or logically. What is necessary to establish direct association differs depending on the type of specimen submitted; i.e., whether it is an advertising specimen or a rendering specimen.

**Mark Used in Advertising:** For specimens showing the mark used in advertising the identified services, the specimen must explicitly reference the services to establish the requisite direct association.<sup>30</sup> While the services need not be stated word for word, a “sufficient reference”<sup>31</sup> to the services themselves or a general reference to the trade, industry, or field of use is required (e.g., use of the word “design” is a sufficient reference to “commercial art design” services).<sup>32</sup> However, if the alleged reference to the services is so vague that the services cannot be discerned, the specimen will not be acceptable.<sup>33</sup> See [Example 20](#) (IOBIT).

**Mark Used in Rendering:** For specimens showing the mark used in rendering the identified services, the services need not be explicitly referenced to establish the requisite direct association.<sup>34</sup> Rather, direct association may be indicated by the context or environment in which the services are rendered, or may be inferred based on the consumer’s general knowledge of how certain services are provided or from the consumer’s prior experience in receiving the services.<sup>35</sup> In other words, the context in which the services are provided and consumer knowledge and experience create an inference of the services without an explicit textual reference to the services. See [Example 17](#) (CASHFLOW UNITS).

The applicant may respond to a specimen refusal for failing to show direct association by explaining the nature of the mark’s use or the manner in which the services are advertised or rendered.<sup>36</sup> With respect to a particular industry’s typical use of marks in relation to specific services, it may also be helpful for the applicant to provide an explanation regarding industry practice concerning the use of the mark during the rendering of such services and how the applicant’s use comports with such practice. See [Example 19](#) (design of speech bubbles).

The mere fact that the mark is displayed and the services are explicitly referenced or can be inferred from the context of the specimen does not automatically result in direct association between them.<sup>37</sup> The specimen must associate the mark with the services such that the mark serves as a source identifier for those particular services.<sup>38</sup> See [Example 17](#) (CASHFLOW UNITS) and [Example 18](#) (RIDE 411).

Thus, a specimen is unacceptable if it fails to convey a “proper nexus” between the mark and the services, or if the services are “too attenuated from the proposed mark,”<sup>39</sup> either in terms of proximity or logical connection. The mere fact that wording from the identification of services appears somewhere on the specimen may not necessarily suffice for the mark-services association or nexus, if there is nothing else to connect that wording to the mark, such as proximity or additional text that establishes the connection.

When examining for the mark-services association, the examining attorney should consider the specimen’s content, layout, and overall look and feel, as well as any description of the specimen and industry practice relating to service-mark usage in advertising and rendering the services.

### III. GROUNDS FOR REFUSAL

#### A. Failure to Show the Mark Used in Commerce

Trademark Act Sections 1 and 45 are the statutory bases for refusing a specimen that does not meet the requirements of an acceptable service-mark specimen; such specimen is not acceptable because it does not show the mark in “use in commerce.” For instance, if the mark does not appear on the specimen or the specimen shows use of the mark in connection with goods rather than the identified services, the specimen must be refused for failure to show service-mark use in commerce in connection with the identified services.

The applicant’s response options include submitting an acceptable substitute specimen or, if appropriate, amending the application to a Section 1(b) filing basis.<sup>40</sup> In some cases, the applicant may respond by providing clarification of the nature of the original specimen submitted, or an explanation of the content of the original specimen, to justify its acceptability.

The examining attorney may consider any of the following facts and evidence properly made of record:

- declarations from persons with firsthand knowledge of the facts, with a sufficiently detailed explanation of how the mark is used in advertising or rendering the services or how the services are advertised or rendered;
- clarification of the specimen of record, such as an explanation of the nature, content, or context of use of the specimen (this explanation need not be verified with a declaration);
- evidence, such as declarations or industry-related periodicals, regarding industry practice with respect to how marks and services are promoted in advertising or how the services are rendered;
- additional background materials, such as printouts showing information on subsequent webpages from the applicant’s website or subsequent screenshots of an electronic device on which the services may be accessed, rendered, and experienced (this matter generally need not be verified with a declaration); and/or
- responses to any Trademark Rule 2.61(b) request for information.

If the specimen of record, the specimen description, the applicant’s response and explanations, and any additional proffered evidence are unpersuasive, a final refusal must issue, if the application is otherwise in condition for final.<sup>41</sup>

#### B. Failure to Show the Mark Functioning as a Service Mark

A specimen may show the mark used as something other than a service mark for the identified services. For instance, it may show the mark used solely as a trade name, only as the name of a computer software program or application, exclusively as the name of a method, process, or system, or merely as informational or ornamental matter.<sup>42</sup> See [Example 21](#) (LEADING EDGE TONERS). In such cases, the mark does not function as a service mark to identify and distinguish the applicant’s services and indicate their source. Thus, a failure-to-function refusal should issue under Trademark Act Sections 1, 2, 3, and 45.<sup>43</sup>

#### IV. CONSIDERATIONS AND COMMON ISSUES WHEN EXAMINING A SPECIMEN FOR TECHNOLOGY-RELATED SERVICES

##### A. Understanding the Identified Services

Proper specimen analysis requires consideration of the nature of the identified services. Modern computer and technology-related services present special challenges because these services, and the terminology used to describe them, are continually evolving. In addition, any online activity entails the use of computer software, making it difficult to differentiate the various services provided online from the underlying technology used to provide them. As the Board has noted, “[a]lthough it may well be software that is generating the [services], in today’s commercial context if a customer goes to a company’s website and accesses the company’s software to conduct some type of business, the company may be rendering a service, even though the service utilizes software.”<sup>44</sup>

It may be unclear, based on the submitted specimen, whether the applicant is providing non-software services in a given field or subject matter (e.g., “financial consulting in the field of retirement planning” in Class 36), or offering computer software or application services involving that same field or subject matter (e.g., “providing temporary use of non-downloadable software for retirement planning” in Class 42), or both. Sometimes, an applicant that is actually providing non-downloadable software services (e.g., “providing temporary use of non-downloadable software for medical billing” in Class 42) misidentifies the services as the underlying function of the software (e.g., “medical billing” in Class 35). Similarly, the applicant may be using social networking websites to advertise non-social networking services (e.g., operating a pet store) and communicate with customers, leading the applicant to misidentify the services as “online social networking services.”

Thus, a primary consideration in these instances is whether the specimen indicates that the applicant is actually performing the relevant service activities for others, or, for instance, merely providing software that allows users of the software to perform those activities themselves, or only offering an online game that is accessed via a social networking website. See [Example 5](#) (ATHENACOORDINATOR), [Example 7](#) (CLINICANYWHERE), and [Example 14](#) (OUTERNAUTS).

Furthermore, some traditional services, and the associated terminology, may require fresh understanding and broader interpretation in the modern commercial environment. More and more traditional services are now offered online and, increasingly, multiple services are seamlessly integrated, creating difficulty in distinguishing the source of the services. For instance, television programs that were once provided only by broadcast television and cable outlets are now also accessible via streaming services like Netflix®, Hulu®, or YouTube®. Thus, typical service identification terms like “broadcasting,” “distribution,” and “transmission” have taken on new meaning in the modern marketplace. Thinking of traditional and other services more broadly and being cognizant of the current marketplace realities will also help the examining attorney determine whether the specimen properly shows use of the mark in association with the identified services.

##### B. Resources for Determining the Nature of the Services

When the nature of the services is not readily apparent from the information of record, such as the identification and specimen, the examining attorney may consult several resources for research and guidance, including: the notices and notes in the U.S. Acceptable Identification of Goods and Services Manual (ID Manual); the applicant’s and third-party websites; telephone or e-mail communication with the applicant or applicant’s attorney;

technology dictionaries, encyclopedias, and trade and industry publications;<sup>45</sup> and the Office of Trademark Classification Policy & Practice (i.e., ID/Class). In addition, the Trademark Law Library is available to assist examining attorneys with research. Finally, the examining attorney may require the applicant to provide further information about the services, pursuant to Trademark Rule 2.61(b).<sup>46</sup>

### C. Common Forms of Specimens for Modern Technology-related Services

As noted above, an applicant may submit a specimen that shows the mark as used in rendering the services. These specimens are often submitted in connection with modern technology-related services and are discussed below.

Again, for specimens showing use of the mark in rendering the services, an explicit, textual reference to the services or their trade, industry, or field of use is not necessary, but an indication of the services sufficient to establish direct association between the mark and the services is required. The examining attorney must refuse the specimen if neither the specimen itself nor the description of the specimen provides sufficient information to decipher the nature of the services, determine the manner of use, and assess whether the necessary mark-services association exists. See Part III.A above.

#### 1. Sign-in Screens

Applicants often submit screenshots of sign-in screens as specimens for online services, such as non-downloadable software services and application-service-provider services. Sign-in screens show that the services are available and the context indicates that they are accessed by inputting credentials, which is a generally known and accepted means of accessing many online services.<sup>47</sup>

Some sign-in screens may include a reference to the services and effectively function as an advertisement. See [Example 6](#) (MYFITAGE). Other sign-in screens may contain no reference to the services, but may nonetheless be acceptable if the overall content of the specimen sufficiently indicates the services. Or, the specimen description may explain the context of the services by stating the specimen is a sign-in screen for accessing the services and that applicant is offering the type of services being applied for. Such an explanation may provide a sufficient basis for accepting the sign-in screen specimen, as long as there is no contradictory information in the record indicating that the mark is not associated with the identified services. See [Example 4](#) (STAFFTAP).

#### 2. Title or Launch Screens

A title or launch screen is an on-screen graphic that is typically displayed at the beginning of entertainment content, such as video games or ongoing television programs, often with other information about the content featured. For services such as Class 41 entertainment services involving the provision, production, or distribution of entertainment content, screenshots of title or launch screens from the content may create the requisite direct association between the mark and the services. Thus, title or launch screens may be acceptable specimens as long as the nature of the specimen is clear either from the overall look and feel of the specimen or from the applicant's description of the specimen.

While showing the title or launch screen being displayed on any particular electronic device (e.g., television, computer, or smartphone) is not required, a specimen showing an electronic device bearing the title or launch screen may be acceptable without further explanation because it places the mark in the context of how the services are rendered.

See [Example 14](#) (OUTERNAUTS). A title or launch-screen specimen showing only the mark but not the electronic device, with no specimen description or an insufficient description, may require a specimen description identifying the specimen as a title or launch screen and placing the mark in the context of the services. See [Example 13](#) (DELICIOSO).

While title or launch-screen specimens may be acceptable to show service-mark use, the mark must be refused if the specimen shows that the applied-for mark is the title of a single creative work (e.g., the title or name of one episode of a television or radio program, one movie, or one show presented as a single event).<sup>48</sup>

### 3. Webpages

Webpages from an applicant's or a third-party's website are routinely submitted as advertising and are acceptable if they show the mark used as a service mark, explicitly/textually reference the identified services, and associate the mark with those services.

Webpages lacking a reference to the services may be acceptable if they show use of the mark in rendering the services. See [Example 14](#) (OUTERNAUTS).

Webpages from social networking websites should be scrutinized to ensure that the mark is properly associated with the identified services. Some applicants may mistakenly mischaracterize their services as "social networking" because they assume that advertising or promoting their non-social networking services via a social networking website means they are providing social networking services. For instance, an applicant may mistakenly file an application for "online social networking services" and provide a Facebook® webpage as a specimen when, in fact, they operate a pet store and are only using the Facebook® website to advertise the pet store and communicate information to and messages with actual and potential customers. Such a specimen is not acceptable for the social networking services since it does not demonstrate that the applicant is providing these services.

### 4. Software Applications ("Apps")

Software applications ("apps") for smartphones and computer tablets are now commonly used to provide online services. Apps are simply the interface that enables the providers of the services to reach the users and render the services, and the users to access those services. Common specimens for such apps are usually screenshots of electronic devices demonstrating the apps delivering the services. Such a specimen may not always depict proper service-mark use of the mark in connection with the identified services, but it may be acceptable if the displayed screenshot clearly and legibly shows the mark associated with the identified services as the services are rendered or performed via the app. See [Example 15](#) (KURBKARMA).

## APPENDIX X – EXAMPLES OF SERVICE-MARK SPECIMENS

### I. ACCEPTABLE SERVICE-MARK SPECIMENS\*

#### A. Cloud-Computing Services:

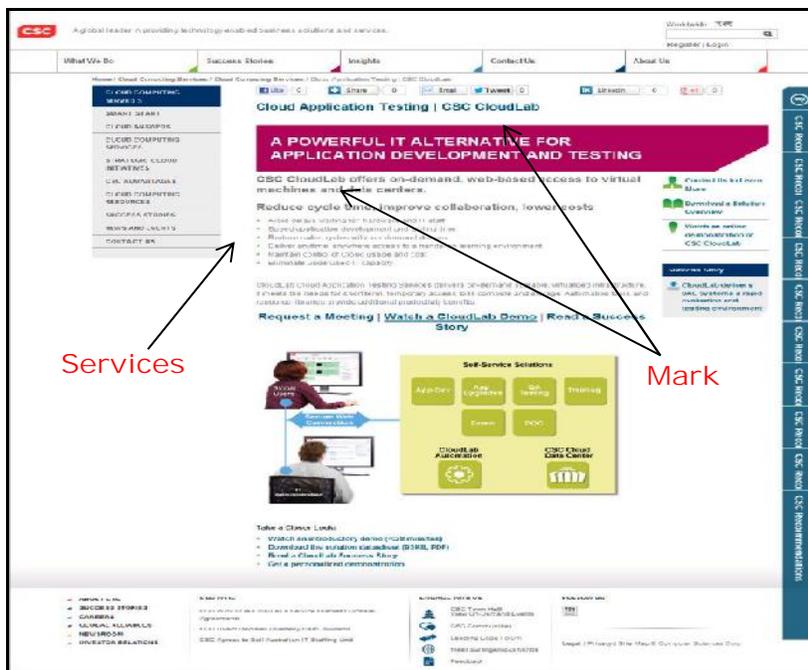
Example 1: Reg. No. 4318006 (Apr. 9, 2013)

Mark: CSC CLOUDLAB

Relevant Services: Infrastructure as a Service (IAAS) services, namely, providing web-based use of virtualized computer hardware, networking, and storage equipment on a utility computing basis, namely, providing virtual computer systems and virtual computer environments through cloud computing, in Class 42

Analysis:

- Specimen is described as “web page screenshot” and appears to be advertising.
- Mark is displayed near the top center of the webpage in large, color font, and in the middle center of the webpage at the beginning of a statement shown in bold font.
- Services are referenced in the following statements:
  - “CSC CloudLab offers on-demand, web-based access to virtual machines and data centers.”
  - “CloudLab Cloud Application Testing Services delivers on-demand scalable, virtualized infrastructure.”
- Mark-services association is present because the mark is used directly in connection with the services in textual statements describing the services, and is placed immediately above explicit/textual references to the services.



\* Enlargeable specimen images are accessible via the Trademark Image Capture and Retrieval System (TICRS) available to the USPTO staff or via the Trademark Status and Document Retrieval (TSDR) portal available to the public.

Example 2: Reg. No. 4246965 (Nov. 20, 2012)

Mark: PARSE

Services: Platform as a service (PAAS) featuring computer software platforms offering server-side functionality to provide backend services, namely, data storage, push notifications and user management, all for mobile applications, in Class 42

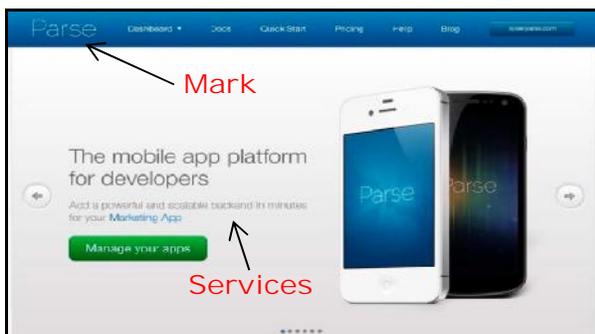
Analysis:

- Original specimen is described as “website offering purchase and download of Parse software”; the substitute specimen is described as “website advertising.”
- On the substitute specimen, the mark is presented in large font on the top of the webpage and on the screen of an electronic device.
- Original specimen was refused because the specimen and its description indicated the mark is used in association with software goods rather than PAAS services.
- Substitute specimen is acceptable due to the following statements referencing the services and the following indicia of the context in which the services are rendered:
  - The wording “The mobile app platform for developers” and “Add a powerful and scalable backend in minutes for your Marketing App” describes the nature of the services.
  - The “Manage your apps” button indicating that the services are accessed by clicking on the button.
- Mark-services association is present because it is customary to display service marks near the top of the webpages on which the services are advertised or through which they are accessed, rendered, and experienced. Here, the mark is in close proximity to explicit textual references to the services and the “Manage your apps” button, thus creating the mark-services connection.

Original specimen:



Substitute specimen:



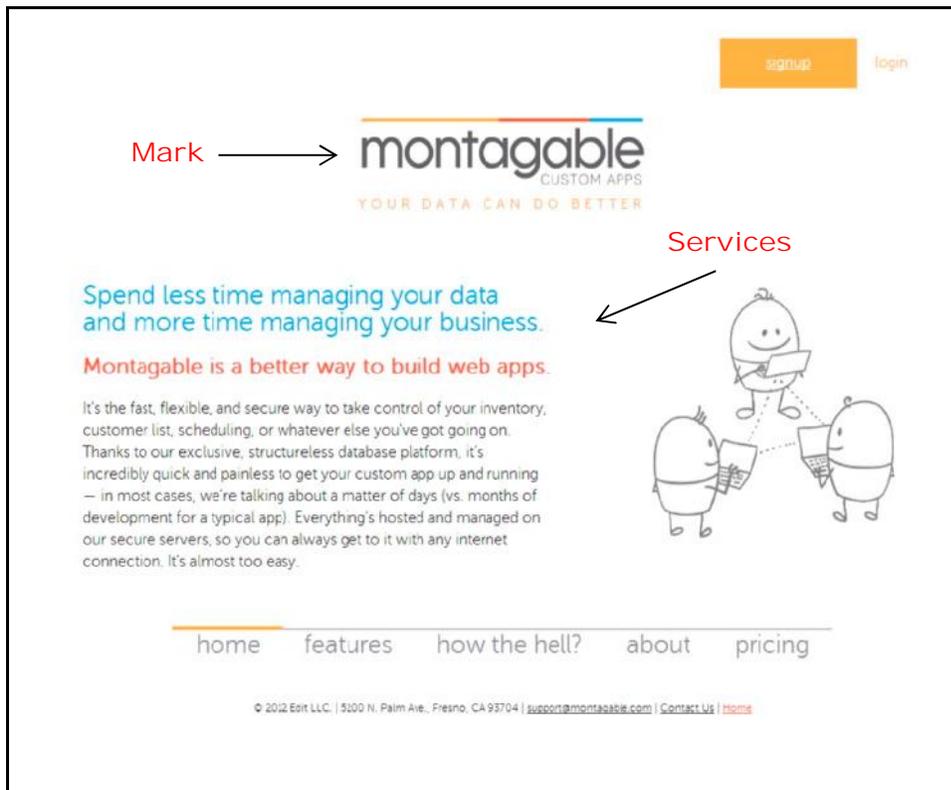
Example 3: Reg. No. 4308488 (Mar. 26, 2013)

Mark: MONTAGABLE

Services: Computer software platform as a service (PAAS) featuring computer software platforms for application building, in Class 42

Analysis:

- Specimen is described as “screenshots” from applicant’s website and appears to be advertising.
- Mark is prominently shown in large font on the top of the webpage.
- Services are referenced in the following statements:
  - “Montagable is a better way to build web apps.”
  - “Thanks to our exclusive, structureless database platform, it’s incredibly quick and painless to get your custom app up and running . . . .”
  - “Everything’s hosted and managed on our secure services, so you can always get to it with any internet connection.”
- Mark-services association is present because the mark is used directly in connection with the services in textual statements describing the services, and is placed immediately above explicit textual references to the services as well as in statements referencing the services.



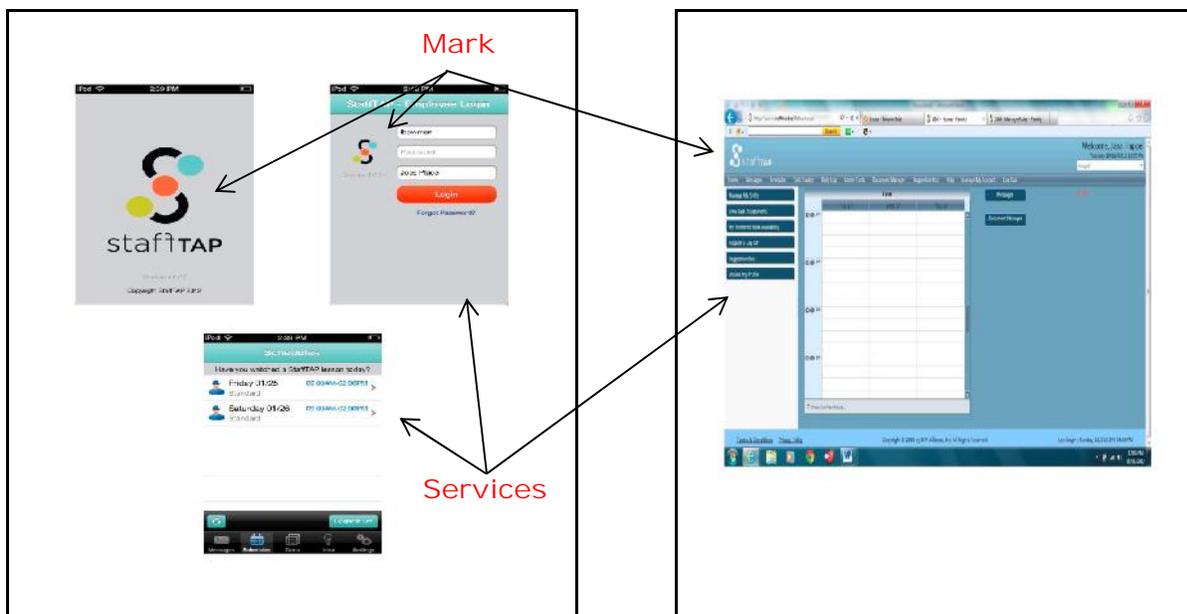
Example 4: Reg. No. 4318095 (Apr. 9, 2013)

Mark: STAFFTAP

Services: Software as a service (SAAS) services featuring software for use in staff management and related scheduling tasks, in Class 42

Analysis:

- Specimen is described as “screenshot capture of a representative online portal” and appears to show the mark used in rendering the services.
- Mark appears prominently in large font on a launch screen, on the sign-in screen, and on the top of a screen displaying the software services in use.
- Services are indicated by the context in which they are rendered, as follows:
  - A launch screen with the wording “Version 1.0.27” indicates the version of the online software services being rendered.
  - The “Employee Login” screen indicates that one must log in to access the software services and the subsequent screen shows the schedule for Friday and Saturday.
  - A screen showing a date and time grid for scheduling tasks and the menu on the left containing options, including “Manage My Shifts” and “View Task Assignments,” indicates the staff management functions of the software services.
- Mark-services association is present because the mark appears on the launch screen where it is customary in such industry to place the mark under which the services are offered and such placement is recognized as the introduction of the online services; and the mark also appears on the sign-in screen where it is customary to input credentials to gain access to online services. The context in which the mark is used, i.e., on the title and sign-in screens, creates the mark-services connection (since using such screens is common practice for rendering such services) and implies that the services are available and rendered once the user initiates access to the services by logging in. The launch screen alone is acceptable because it is generally known that such screens are used to initiate the start up of or access to online services. The sign-in screen is also acceptable on its own since it is a generally known means of accessing online services. The mark is also displayed on another screen which shows the mark while the services are being performed and, thus, the proximity of the mark to the services conveys a connection.



Example 5: Reg. No. 4153526 (June 5, 2012)

Mark: ATHENACOORDINATOR

Services: Physician order support services and medical practice management services relating to medical tests and procedures, namely, verifying patient eligibility and benefits, handling scheduling requests, obtaining insurance pre-certifications, handling patient pre-registrations, and collecting self-pay balances from patients, in Class 35; and Software as a service (SAAS) services featuring software for use in communications between physicians and other participants in the health care system with respect to orders for medical tests and procedures, in Class 42

Analysis:

- Specimen is described as a “brochure” and appears to be advertising.
- Mark appears prominently in large font on the top of the brochure.
- Class 35 services are referenced in the following statements:
  - “Through software and service, we deploy critical knowledge to support effective and efficient care coordination.”
  - “A dedicated team of remote specialists with essential clinical and payer knowledge verifies eligibility and benefits. They also obtain required insurance pre-certifications to ensure claims get paid the first time.”
  - “A dedicated team of specialists delivers pre-registration services to ensure order fulfillment, registering patients in the hospital system and collecting self-pay balances. Patients and physicians benefit from an efficient registration process.”
- Class 42 services are referenced in the following statements:
  - “Through software and service, we deploy critical knowledge to support effective and efficient care coordination.”
  - “The web-based platform facilitates easy order entry and status for physician, enables our pre-certification and pre-registration services and delivers a “clean” order to the hospital.”
- Mark-services association is present because the mark is used directly in connection with the services in textual statements describing the services, and is placed immediately above explicit textual references to the services.



B. Non-Downloadable Software Services:

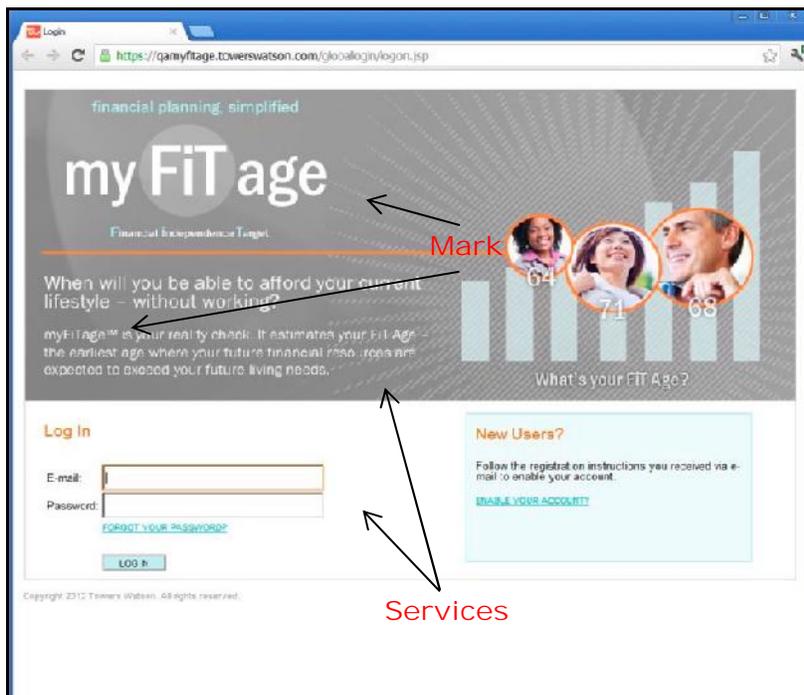
Example 6: Reg. No. 4222705 (Oct. 9, 2012)

Mark: MYFITAGE

Services: Providing temporary use of non-downloadable computer software for retirement planning, in Class 42

Analysis:

- Specimen is described as “web printout” and appears to show the mark used in rendering the services.
- Mark is shown in large font at the top of the webpage and in the middle of the webpage.
- Services are referenced in the following statements and indicated by the context in which they are rendered, as follows:
  - The wording “financial planning simplified” appears above the mark.
  - The wording “Financial Independence Target” appears below the mark.
  - “myFiTage is your reality check. It estimates your FiT Age – the earliest age where your future financial resources are expected to exceed your future living needs.”
  - “Log in” fields are provided for accessing the non-downloadable software.
- Mark-services association is present because the mark appears on the sign-in screen where it is customary in such industry to input credentials to gain access to online services. The context in which the mark is used, i.e., during the sign-in process, creates the connection with the services since sign-in screens are common practice and imply that the services are available and rendered once the user logs in. Additionally, the mark is used directly in connection with the services in textual statements describing the services, and is placed above and below statements referencing the services, further conveying the mark-services connection. The sign-in screen alone would also be acceptable even if the services were not textually referenced since it is a generally known means of accessing online services. The specimen is acceptable both as an advertisement and as showing the mark in rendering the services.



Example 7: Reg. No. 4453195 (Dec. 24, 2013)

Mark: **Clinic)Anywhere**  
Services: Medical Billing Support, in Class 35; and  
Providing on-line, non-downloadable, Internet-based software application for medical billing for physicians and health care institutions, in Class 42

Analysis:

- Specimen is described as an advertisement.
- Mark is prominently displayed in large, color font in the middle of the advertisement.
- Class 35 services are referenced in the following statement:
  - "Top-notch Medical Billing Services."
- Class 42 services are referenced in the following statements:
  - "Cloud-based Practice Management and EHR Solutions."
  - "Any device. Any time. Anywhere.....ClinicAnywhere."
- Mark-services association is present because the mark is used directly in connection with the services in textual statements describing the services, and is placed immediately below explicit textual references to the services.

**Leading the Way**  
*How Mercy is raising the national bar on telemedicine*

By LYNNE JETER

The groundwork was laid at community roundtables, held in various Mercy markets in the Greater St. Louis area and beyond. Over the last few years, and reinforced at monthly field roundtables, residents in rural areas voiced a consensus: they wanted to stay close to home to receive care from specialists and subspecialists in larger communities for their families. With feedback in hand, hospital administrators made the decision early on: even if reimbursement wasn't forthcoming, Mercy would invest heavily in telemedicine.

"It started with an thoughtfully looking around to ask 'who can Mercy do for you?' and then to see if we were in a position to match what we were able to do with what residents wanted," said Timothy Smith, MD, vice president of research for Mercy's Center for Innovative Care (CIC), who also treats migraine patients via telemedicine from the Mercy Clinic Headache Center in St. Louis. "Telemedicine is an obvious solution, and a range of options became an automatic success story for us."

Smith helmed Mercy, which serves 3 million people annually, to land roughly \$2.5 million in grants to launch the telemedicine pilot project, with the bulk coming from FDA's Distance Learning and Telemedicine grants for Mercy's more rural communities in Arkansas, Kansas, Missouri and Oklahoma.

"Mercy is the ideal health system for employing telemedicine technology because we have a large geographic footprint and an interesting mix of large metro hospitals with subspecialties and rural health clinics and small critical care hospitals in remote areas," said Smith.

SafeWatch, an electronic ICU (e-ICU) monitoring program, started in 2006, is Mercy's most mature telemedicine operation. From one center, 440 ICU beds are monitored throughout four states.

"It wasn't the first program of its kind, but it's the largest in the country," said Smith.

Mercy now operates 72 distinct telemedicine pilot programs, projects and fully developed operations. Among them: cardiology, dermatology, neonatology, ophthalmology, pathology/pulmonology, psychiatry, radiology, and stroke.

"And we haven't even built the Virtual Care Center yet," said Smith. "That's how ambitious this project is ... to improve service delivery through telemedicine."

**Difference-Maker**  
Tom Hale, MD, director of Mercy's CIC, pointed to the early and sustained success of SafeWatch for the impetus of hospital leaders deciding to invest heavily in telemedicine.

"The real testament to the program's success is that we're 12 percent below the anticipated APACHE (Acute Physiology and Chronic Health Evaluation) score for hospital mortality for critically ill patients by putting this program in place," he said.

Hale also noted that Massachusetts, which enacted its own healthcare reform law in 2006, has experienced such positive response for its e-ICU monitoring pilot programs that the state plans to expand it statewide.

"It's not there yet, but our hope is that this type of program will expand significantly," Hale said.

**Challenges and Benefits**  
Sufficient bandwidth remains one of few limitations to aggressive expansion of telemedicine.

"We'd like to see how many limits on what we can deliver," said Smith. "For example, we want to extend mental health services to our rural ..."

Cloud-based Practice Management and EHR Solution.  
Top-notch Medical Billing Services. ← **Services**

Any device. Any time.  
Anywhere.....ClinicAnywhere.

**Clinic)Anywhere**  
POWERED BY ETG

CALL US TODAY AT  
888-275-9406  
OR email bmoore@clinicanywhere.com ← **Mark**

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C. Application-Service-Provider (ASP) Services:

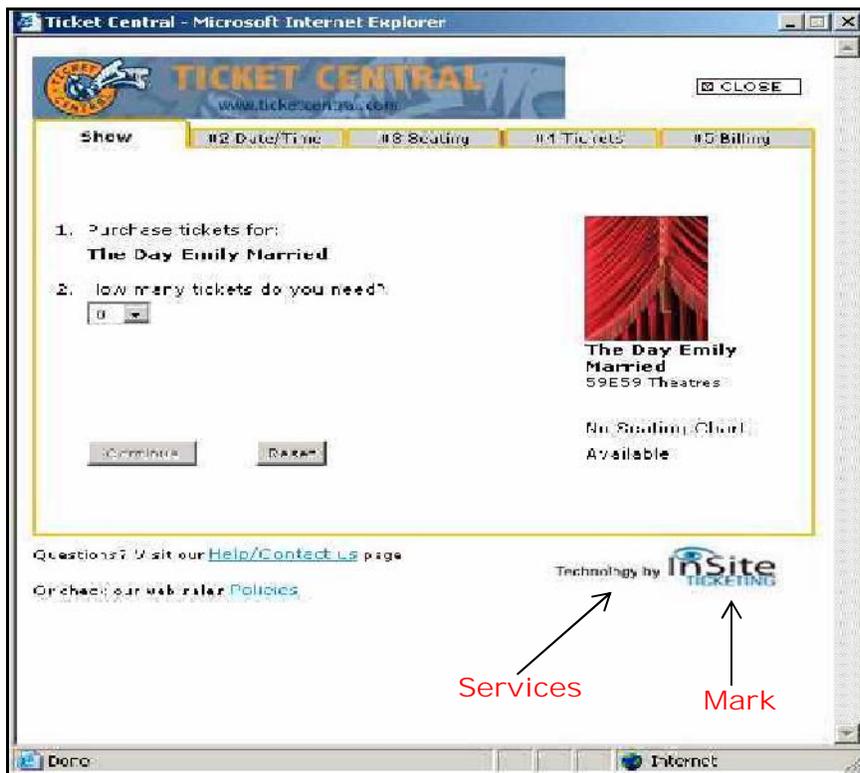
Example 8: Reg. No. 3001514 (Sept. 27, 2005)

Mark: INSITE TICKETING

Services: Application service provider (ASP), namely, hosting computer software applications for others in the field of ticketing and related ticketing services, in Class 42

Analysis:

- Specimen is described as a “screen shot” and appears to show the mark used in rendering the services.
- Mark is prominently displayed on the bottom of the screenshot.
- Services are indicated by the context in which they are rendered, as follows:
  - The mark is displayed directly below the area where customers purchase tickets, thereby indicating that the ASP hosting or providing the software services is INSITE TICKETING.
  - The wording “Technology by” placed next to the mark, implies that the software technology services that are operating the website are provided by the applicant.
- Mark-services association is present because the mark is displayed on the screen where the services are rendered and experienced. While another mark, “Ticket Central,” is shown on the top left of the webpage, it appears to be associated only with ticket-purchasing services, not ASP services, and thus does not detract from associating the applied-for mark with the identified services.



D. Telecommunication Services:

Example 9: Reg. No. 4307737 (Mar. 26, 2013)

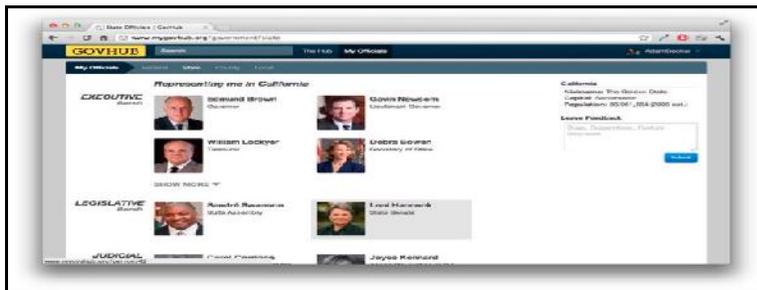
Mark: GOVHUB

Services: Providing on-line forums for transmission of messages among computer users, in Class 38

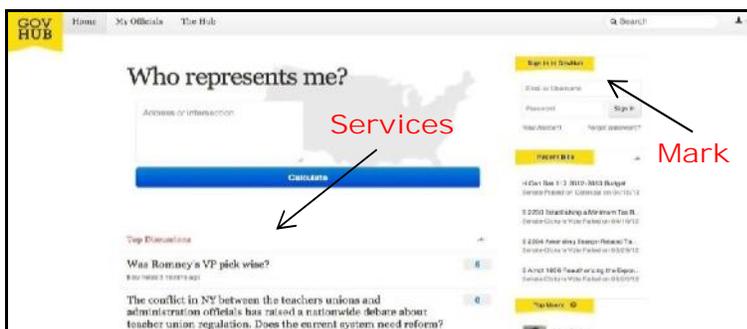
Analysis:

- Original specimen is described as “website screen-shot” and the substitute specimen is described as “screenshot of the homepage of the website.”
- Mark is presented on the substitute specimen at the top right of the webpage.
- Original specimen was refused because it failed to reference the services.
- Substitute specimen is acceptable because the services are indicated by the following:
  - “Sign in to GovHub” indicates that a user may log in to use the services, i.e., read and send messages.
  - “Top Discussions” shows two discussion topics in progress, and the “5” and “0” shown in the color blue specify that there are 5 messages posted for the first discussion and 0 for the second discussion, indicating that the services involve on-line forums for transmission of messages.
- Mark-services association is present on the substitute specimen because it is customary to display service marks near the top of the webpage on which the services are advertised or through which they are accessed, rendered, and experienced. Here, the mark is in proximity to indicia implying the services and no other marks appear to negate the mark-services connection. While the services are not explicitly textually referenced, when viewing the heading “Top Discussions,” the two discussion topics below it, and the “5” and “0” messages posted about the discussion topics – all these factors together indicate that applicant is offering online forum services.

Original specimen:



Substitute specimen:



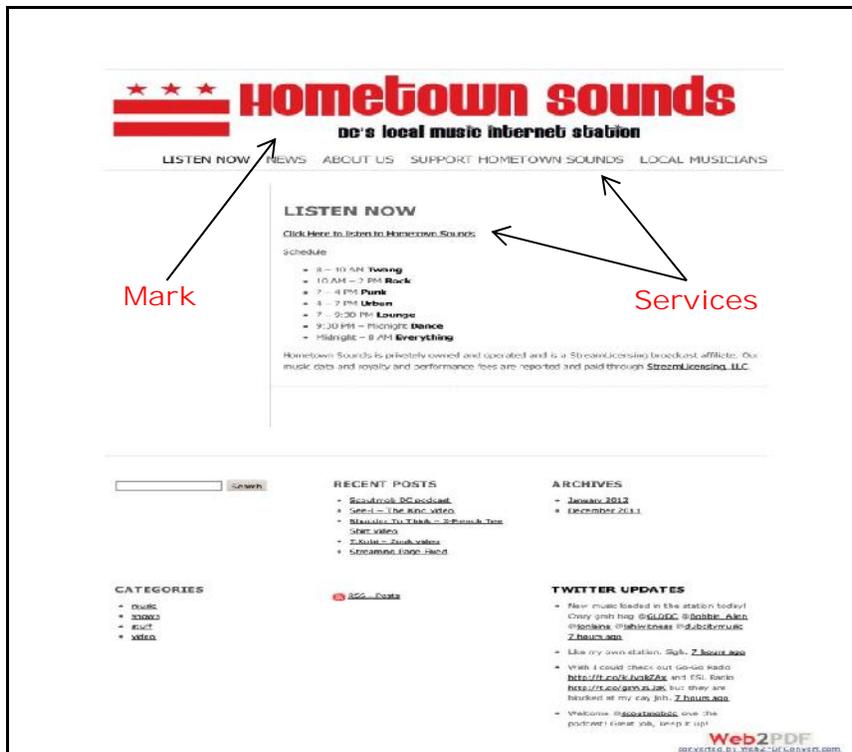
Example 10: Reg. No. 4303786 (Mar. 19, 2013)

Mark: HOMETOWN SOUNDS

Services: Electronic transmission and streaming of digital media content for others via global and local computer networks; Streaming of audio material on the Internet; Transmission services via the Internet, featuring MP3 files and music videos, in Class 38

Analysis:

- Specimen is described as “website for Hometown Sounds” and appears to show the mark used in rendering the services.
- Mark is presented in large font on the top of the webpage.
- Services are referenced in the following statements and indicated by the context in which they are rendered, as follows:
  - The wording “DC’s local music internet station” describes the services.
  - The wording “Listen Now” indicates that the website may be used to stream audio content.
  - The link “Click Here to listen to Hometown Sounds” indicates that the services are accessed by clicking on the link.
- Mark-services association is present because it is customary to display service marks near the top of the webpage on which the services are advertised or through which they are accessed, rendered, and experienced. Here, the mark is physically close to indicia implying the services and no other marks appear to negate the mark-services connection. The mark appears above textual references to the services as well as in textual instructions for accessing the services, which further conveys the mark-services connection. The specimen is acceptable both as an advertisement and as showing the mark in rendering the services.



Example 11: Reg. No. 4306455 (Mar. 19, 2013)

Mark:  **HooplaHa**

Services: Broadcasting of video and audio programming over the Internet, in Class 38  
Analysis:

- Specimen is described as “web page” and appears to show the mark used in rendering the services.
- Mark is shown in large font on the top of the webpage.
- Services are indicated by the following:
  - A freeze-frame of a video featuring a play button is displayed, indicating the services are accessed by clicking the play button.
  - The wording “Join Now! Get the latest feel-good videos, news and events” conveys the different content that is available for broadcast.
  - The wording “Latest Videos” and the images of several videos appear near the bottom, implying that other videos are available for broadcast.
- Mark-services association is present because it is customary to display service marks near the top of the webpages on which the services are advertised or through which they are accessed, rendered, and experienced. Here, the mark is sufficiently near indicia implying the services and no other marks appear to negate the mark-services connection. While the nature of the services is not explicitly textually referenced, the display of the play button and “Latest Videos” indicate that applicant is offering broadcasting services.



E. Entertainment Services:

Example 12: Reg. No. 4298664 (Mar. 5, 2013)

Mark: CINEMAX

Services: Entertainment services in the nature of providing entertainment programming and content, namely, on-going television programs, and related clips and graphics and information relating to television programming and content in the fields of comedy, drama, action, adventure via television, cable and satellite systems, the Internet, electronic communications networks, computer networks and wireless communications networks, in Class 41

Analysis:

- Specimen is described as “mark as used in commerce on specified goods and services” and appears to be a webpage advertising some of the identified services and rendering other identified services.
- Mark is displayed prominently at the top of the webpage.
- Services are referenced in the following wording and statements:
  - The navigation tabs at the top “VIDEOS,” “SCHEDULE,” “ORIGINAL SERIES,” “MOVIES,” and “AFTER DARK” indicate the entertainment content available.
  - The play button next to “WATCH PREVIEW” indicates that a clip of the show “ASYLUM BLACKOUT” may be viewed.
  - The reference to “BANSHEE” states “From the creator of ‘True Blood’ comes a Cinemax original series about a small town where nothing is as it seems . . .,” advertising another on-going television program.
- Mark-services association is present because it is customary to display service marks near the top of the webpage on which the services are advertised or through which they are accessed, rendered, and experienced. Here, the mark is sufficiently near textual references to the services, thus indicating the mark-services connection.



Example 13: Reg. No. 4337921 (May 21, 2013)

Mark: DELICIOSO

Services: Entertainment and education services, namely, ongoing television program concerning cooking and nutrition, in Class 41

Analysis:

- Specimen is described as a “photo of opening title of applicant’s television program” and appears to show the mark used in rendering the services.
- Mark is prominently shown in large font on the title screen of an electronic device that is displaying the ongoing television program.
- Mark-services association is present because the mark appears on the title screen where it is customary in such industry to place the mark under which the services are promoted. It is common practice for a title screen bearing the mark to appear at the start of entertainment content and indicate the launch of the services. While the nature of the services is not textually referenced, it is sufficient that the overall content of the specimen implies that applicant is offering entertainment services.
- The specimen would be unacceptable without the specimen description, which clarifies that the specimen is an “opening title” and places the mark in the context of providing the services. Since the specimen could possibly be print advertising, a specimen description is necessary to clarify the nature of the specimen. The top right corner of the specimen shows some wording that suggests that the title screen is displayed on an electronic device. However, since that wording is not legible and the context of the title screen is not visible, the nature of the specimen is unclear and, thus, a specimen description is required clarifying that it is a title screen.



Example 14: Reg. No. 4255257 (Dec. 4, 2012)

Mark: OUTERNAUTS

Services: Entertainment services, namely, providing online video games, in Class 41

Analysis:

- Specimen is described as a “screenshot of the page on Facebook.com, an Internet website, from which the services are provided to users” and appears to show the mark used in rendering the services.
- Mark is prominently shown in large font near the top of the webpage.
- Services are referenced in the following statements and indicated by the following:
  - The mark appears near video game information “Get Star Gems,” “Leaderboard,” and “loading Outernauts.”
  - The mark appears near the word “Games,” generally referencing the services.
- Mark-services association is present because it is customary to display service marks near the top of the webpage on which the services are advertised or through which they are accessed, rendered, and experienced. Here, the mark is near indicia implying the services and other marks appear to cloud the mark-services connection. While the specimen shows the webpage is from a third-party website, i.e., Facebook®, this does not diminish the requisite association due to the proximity of the applied-for mark to the matter indicating the online services, which appear to be directly launched from the website. The screenshot also appears to be of the title or launch screen of the online video game, where it is common practice in such industry to place the mark under which the services are promoted and where such placement is recognized as the introduction of the online services. The screenshot here implies, and it is generally known, that access to and performance of the services begins with this screen. The specimen description combined with the wording “loading Outernauts” further supports the mark-services connection. The specimen is also acceptable as an advertisement since the word “Games” appears on the lower left corner as part of a third-party mark “Insomniac Games.” It may be inferred that the combination of the applied-for mark OUTERNAUTS with the reference to “Games” and to “EA” sufficiently and textually references the online video game services.



F. Miscellaneous Services:

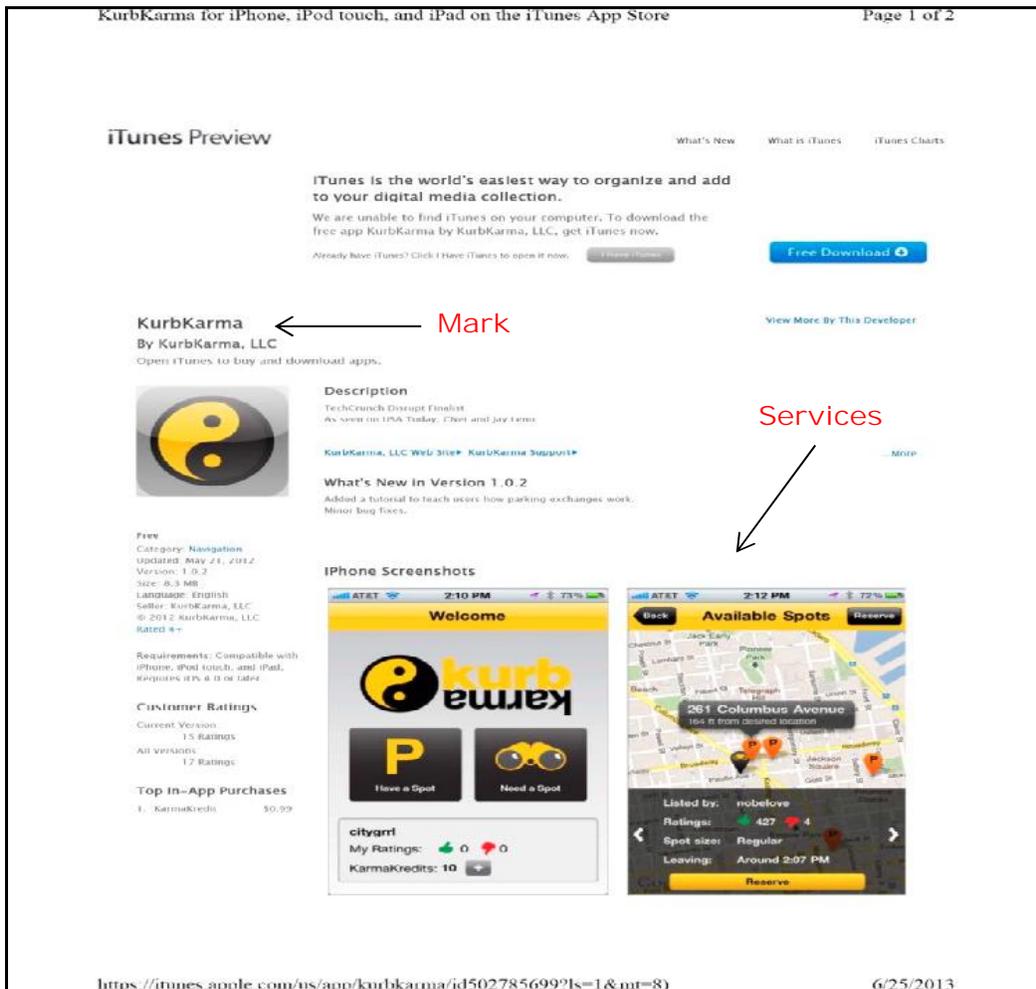
Example 15: Reg. No. 4392992 (Aug. 27, 2013)

Mark: KURBKARMA

Services: On-line matching services for connecting automobile drivers with other drivers who are, respectively, searching for or departing from parking spaces accessible via a mobile application, in Class 35

Analysis:

- Specimen is described as “screenshot of the iTunes store which features Applicant’s mark and describes Applicant’s services.”
- Mark is displayed in bold font in the middle left of the webpage.
- Services are indicated by the following:
  - The iPhone® screen images clearly and legibly show the wording “Have a Spot,” “Need a Spot,” and “Available Spots,” indicating the services being performed by the applicant via the app.
- Mark-services association is present because the mark is placed in sufficiently close proximity to the iPhone® screenshots, which show the services as they are accessed and rendered via the device.



Example 16: Reg. No. 3841358 (Aug. 31, 2010)

Mark: VTECH DIRECT

Services: Providing a web site for online business-to-business store services featuring wireline telephony products and wireless fidelity streaming music devices; online business-to-business store featuring wireline telephony products and wireless fidelity streaming music devices, in Class 35

Analysis:

- Specimen is described as “pages from website” and appears to show the mark being used in both the advertising and rendering of the services.
- Mark is displayed prominently in bold font on the top left of each webpage.
- Services are referenced and indicated by the following:
  - “Sign In” fields are provided for accessing the online business-to-business store services, indicating that one may access the services by logging in.
  - “Tune in over 11,000 stations around the globe using wireless Internet access. Listen to music, sports, talk radio and more.”
  - Image of an electronic streaming music device described as “IS9181 – (80-6569-02) Stream internet radio stations Stream digital music files stored on your PC or Mac Connect to your MP3 or CD player.”
- Mark-services association is present because it is customary to display service marks near the top of the webpage on which the services are advertised or through which they are accessed, rendered, and experienced. Here, the mark is near explicit textual references to the services, thus conveying the mark-services connection. The webpage showing the sign-in fields is an acceptable specimen since signing-in is a generally known means of accessing online services. Thus, the specimen is acceptable both as an advertisement and as showing the mark in rendering of the services.

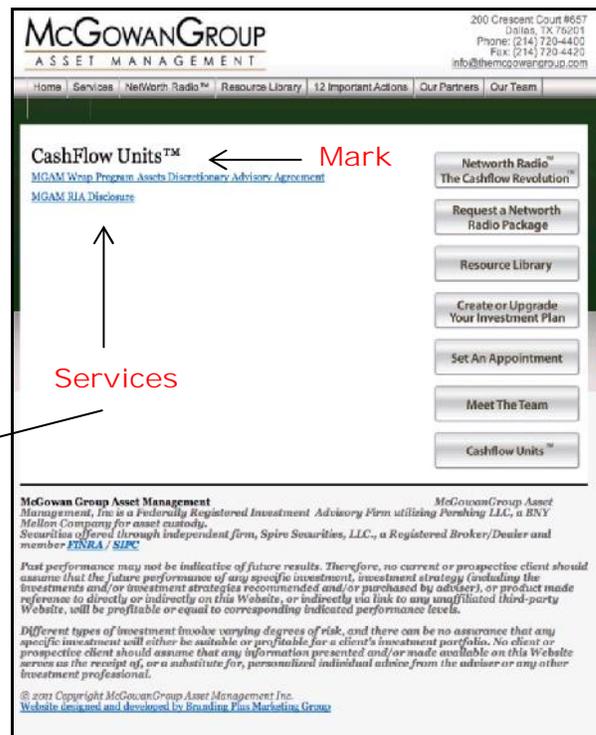


Example 17: In re McGowan Publ'g Co., Ser. No. 77582970, 2013 TTAB LEXIS 364 (June 27, 2013)

\*\*For illustrative purposes only and not intended as precedential authority.\*\*

Mark: CASHFLOW UNITS  
 Services: Investment products, namely, wealth management and performance tracking, and providing financial advisory and financial portfolio management services, in Class 36  
 Decision: Specimen is acceptable because it shows mark-services association  
 TTAB Noted:

- Specimens are described as “webpages.”
- Mark is placed below “the McGowanGroup Asset Management banner.”
- The Board held the specimen acceptable as showing use of the mark in rendering the services based on the following findings:
  - “The disclosures at the bottom of one webpage inform the viewer that applicant is a ‘Federally Registered Investment Advisory Firm.’”
  - The mark “appears under the McGowanGroup Asset Management banner, thus informing the viewer that CASHFLOW UNITS are part of an asset management service.”
  - Directly below the mark are links to two documents: (1) the “MGAM Wrap Program Assets Discretionary Advisory Agreement”; and (2) the “MGAM RIA Disclosure”. The Board noted that the first document is the applicant’s contract and an offer to enter into an agreement for advisory services, and the second document is the applicant’s notice of compliance with the conflict of interest rules.
  - The mark on the webpage is placed “in close proximity to links for documents used by applicant in rendering those services” and “the links to these documents create an association between the mark and the offered service activity.”



Example 18: Reg. No. 4147512 (May 22, 2012)

Mark: RIDE 411

Relevant Services: Providing an online search engine service for new and used automobile listings and automobile related information; Providing specific information as requested by customers via the Internet; Provision of Internet search engines; Provision of search engines for the Internet, in Class 42

Analysis:

- Specimen is described as “screen shot of our website” and appears to be a webpage advertising some of the identified services and rendering other identified services.
- Mark is displayed in large, color font on the top of the webpage.
- Services are referenced in the following statements and indicated by the context in which they are rendered, as follows:
  - “Simply type any keyword(s) into our search engine to find a group of suppliers for exactly what you are looking for, or select from a category and drill down from there.”
  - The wording “Your destination for hard to find classic car parts, services, events & more” and “FIND ... How can I find hard to locate parts for my classic car?” indicates the nature of the services provided.
  - Hyperlinks appear under “Locate Parts,” “Locate Services,” and “Search By Category.”
- Services are provided primarily for the benefit of others, i.e., the users are able to view the search results from a variety of sources from the Internet in one list.
- Mark-services association is present because it is customary to display service marks near the top of the webpage on which the services are advertised or through which they are accessed, rendered, and experienced. Here, the mark is near textual references to the services, thus indicating the mark-services connection. The mark is also near indicia of the services, i.e., searchable links and categories for locating automobile parts and services, which is also sufficient to show a mark-services association. Thus, the specimen is acceptable both as an advertisement and as showing the mark in rendering the services.



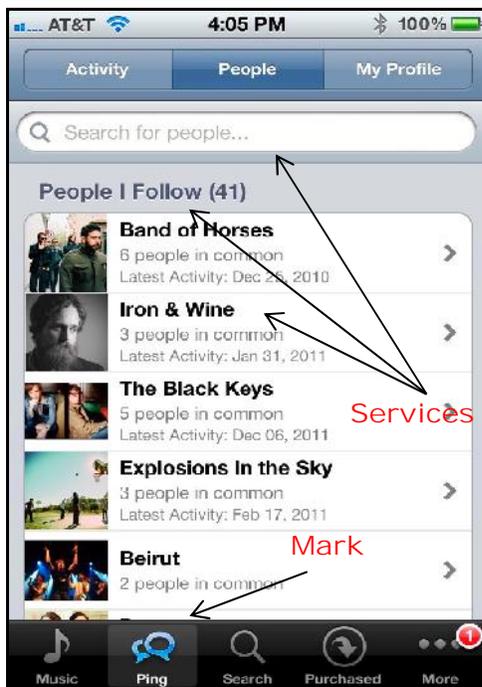
Example 19: Reg. No. 4335349 (May 14, 2013)

Mark:  (stylized speech bubbles)

Services: Online social networking services, in Class 45

Analysis:

- Specimen is described as “screenshot of applicant’s software” and appears to show the mark used in rendering the services.
- Mark is displayed in the color blue at the bottom of the screen of an electronic device.
- Services are indicated by the following:
  - A highlighted “People” tab appears at the top of the screen, as does a search bar containing the wording “Search for people.”
  - The wording “People I Follow (41)” indicates that the user follows 41 people and the screen shows a list of people being followed, each specifying the number of “people in common.”
- Applicant explained that the specimen is a screenshot from an Apple® handheld mobile device showing the mark used in rendering the services.
- Mark-services association is present because the mark appears on the screen of an electronic device via which the online services are accessed, rendered, and experienced. Additionally, the mark is displayed on the screen below indicia implying the services as well as showing the services as they are accessed and rendered via the device. The context in which the mark is used, i.e., while the services are being performed and experienced, creates the association with the services. The presence of a third-party mark (AT&T®) displayed on the top left of the screenshot does not detract from the applicant’s mark being associated with the services. The AT&T® mark denotes the telecommunication company that provides the connection to the Internet, but it appears that the applicant’s services enable online social networking.



## II. UNACCEPTABLE SERVICE-MARK SPECIMENS

Example 20: In re Chengdu AOBI Info. Tech. Co., Ser. No. 77723547, 2011 TTAB LEXIS 188 (May 31, 2011)

\*\*For illustrative purposes only and not intended as precedential authority.\*\*

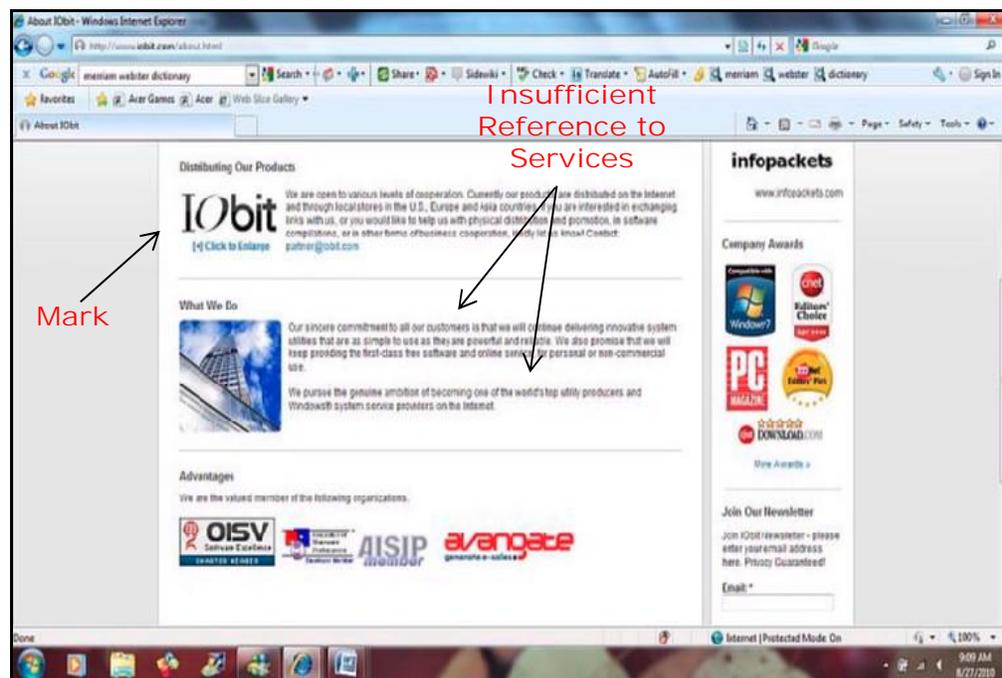
Mark: IOBIT

Services: Computer programming; Computer software design; Conversion of data or documents from physical to electronic media; Data conversion of computer programs and data, not physical conversion; Duplication of computer programs; Hosting of web sites; Installation of computer software; Maintenance of computer software; Research and development for new products for others; Research and development of computer software; Updating and maintenance of computer software, in Class 42

Decision: Specimen is not acceptable because it lacks mark-services association

TTAB Noted:

- Specimen is a “screenshot from applicant’s website.”
- The Board found the following statements were vague and did not sufficiently reference the services:
  - “Our sincere commitment to all our customers is that we will continue delivering innovative system utilities that are as simple to use as they are powerful and reliable. We also promise that we will keep providing the first-class free software and online service, for personal or non-commercial use.”
  - “We pursue the genuine ambition of becoming one of the world’s top utility producers and Windows system service providers on the Internet.”
- It is unclear whether the reference to “online service” is to a separate service or part of the free software goods. The textual reference to becoming a top utility producer and Windows system service provider is not sufficient to indicate being a provider of the identified services.



Example 21: In re Supply Guys Inc., 86 USPO2d 1488 (Mar. 6, 2008)\*

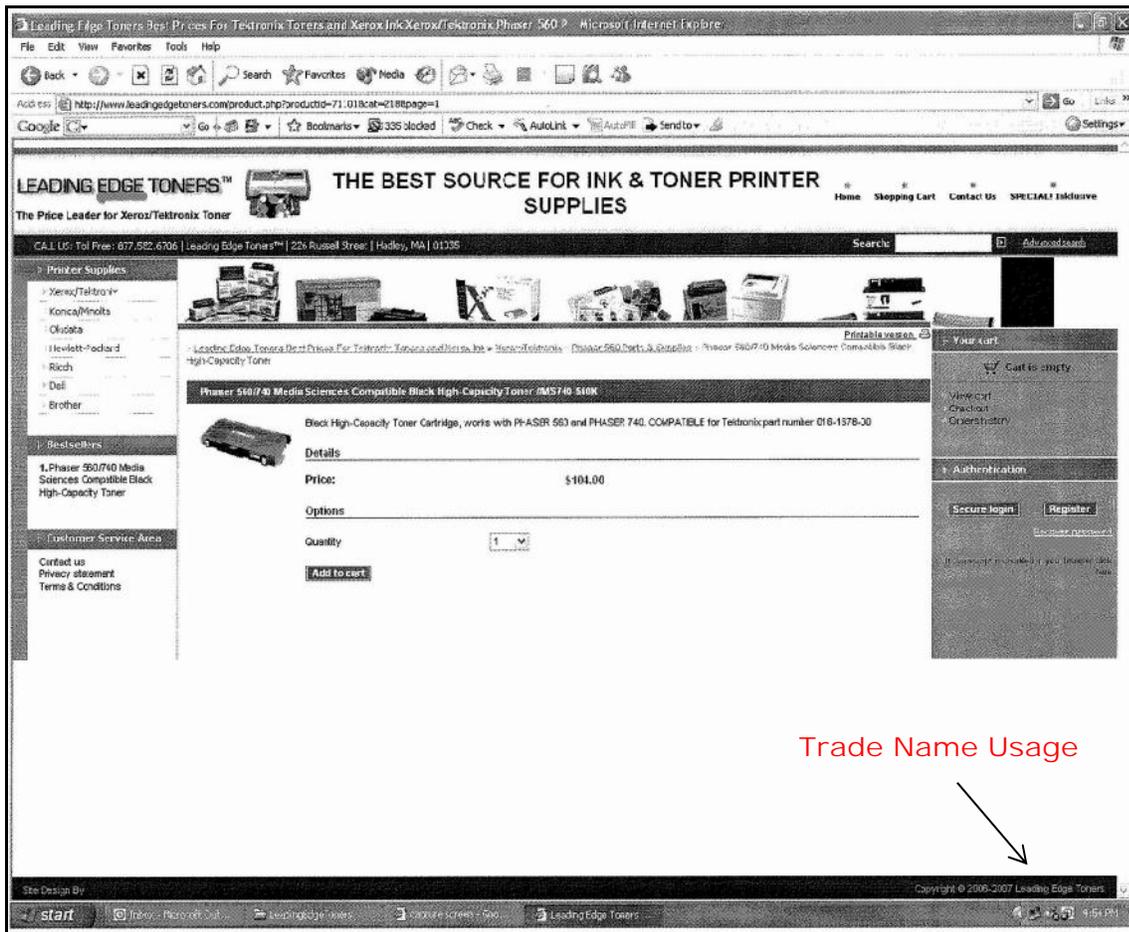
Mark: LEADING EDGE TONERS

Goods: Numerous goods including:  
toner; toner cartridges, in Class 2;  
components for laser toner cartridges; and printer parts, in Class 9; and  
Ink sticks, in Class 16

Decision: Mark does not function as a trademark

TTAB Noted:

- Specimen is described as a “web page.”
- Mark is displayed in several places, including at the bottom right corner next to the copyright notice.
- The Board noted that “where the mark is used with the copyright notice . . . , applicant assumed ‘without admitting’ that the use was solely as a trade name.”
- While the specimen is not acceptable for the identified goods, had the mark been used in connection with retail store or distributorship services, the specimen would likely have been acceptable due to the placement of the mark on the upper left corner of the webpage where service marks normally appear.



\* While this case involved specimens for goods, it is being included as an example of trade name usage, an issue that may arise in examination of specimens for goods or services.

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<sup>1</sup> 15 U.S.C. §1127.

<sup>2</sup> 15 U.S.C. §1051(a)(1); 37 C.F.R. §2.56(a); Trademark Manual of Examining Procedure (TMEP) §1301.04 (Apr. 2014).

<sup>3</sup> 15 U.S.C. §1127.

<sup>4</sup> In re Metriplex, Inc., 23 USPQ2d 1315, 1316 (TTAB 1992).

<sup>5</sup> See 37 C.F.R. §2.56(b)(2); TMEP §1301.04.

<sup>6</sup> See In re Metriplex, Inc., 23 USPQ2d at 1316 (indicating that a specimen that does not explicitly refer to the services may be acceptable if it “show[s] use of the mark in the rendering, i.e., sale, of the services”); In re Red Robin Enters., 222 USPQ 911, 914 (TTAB 1984) (stating that “rendition” of services is properly viewed as an element of the “sale” of services); TMEP §1301.04(b); see also On-Line Careline, Inc. v. Am. Online, Inc., 229 F.3d 1080, 1088, 56 USPQ2d 1471, 1476-77 (Fed. Cir. 2000) (indicating that an online menu item bearing the mark ONLINE TODAY was proper service mark use in connection with “providing access to online computer services offering computer-industry news, commentary and product reviews” because, inter alia, the “menu items are the mechanisms by which users obtained access to a particular online service”).

<sup>7</sup> See 37 C.F.R. §2.56(b)(2); TMEP §1301.04.

<sup>8</sup> See TMEP §§1301.04–1301.04(d).

<sup>9</sup> See 15 U.S.C. §1127.

<sup>10</sup> As always, under Trademark Rule 2.61(b), 37 C.F.R. §2.61(b), an examining attorney may also require the applicant to submit additional information about the specimen or the mark’s manner of use.

<sup>11</sup> See 37 C.F.R. §2.56(b)(2); TMEP §1301.04.

<sup>12</sup> TMEP §1301.04.

<sup>13</sup> See TMEP §904.01(b).

<sup>14</sup> See id.

<sup>15</sup> See TMEP §§1301.02(a), 1301.02(e)–1301.02(f).

<sup>16</sup> See In re Universal Oil Prods. Co., 476 F.2d 653, 655, 177 USPQ 456, 457 (C.C.P.A. 1973) (“The requirement that a mark must be ‘used in the sale or advertising of services’ to be registered as a service mark is clear and specific. We think it is not met by evidence which only shows use of the mark as the name of a process and that the company is in the business of rendering services generally, even though the advertising of the services appears in the same brochure in which the name of the process is used. The minimum requirement is some direct association between the offer of services and the mark sought to be registered therefor.”); In re Osmotica Holdings Corp., 95 USPQ2d 1666, 1669 (TTAB 2010) (finding that, although the submitted specimens referenced the identified consulting services, the applied-for mark, as used on the specimens, would be perceived by the relevant public as identifying only applicant’s drug technology and thus the specimens failed to establish the required association between the mark and the identified services); In re DSM Pharm., Inc., 87 USPQ2d 1623, 1625-26 (TTAB 2008) (finding the submitted specimen unacceptable evidence of use of the mark in connection with custom manufacturing services because it did not show an association between the mark and the services, but instead the mark was used only to refer to computer software); TMEP §§1202.01, 1202.03–1202.04, 1301.02(a), 1301.02(e)–1301.02(f). Compare In re LaBellarte, Ser. No. 76526520, 2009 TTAB LEXIS 399, at \*7-9 (May 29, 2009) (finding the submitted specimens were unacceptable since they showed the mark being used only to identify a proprietary principle used in developing the applicant’s services and, thus, did not create the required association between the mark and the services), with In re Casino Data Sys., Ser. No. 74622053, 1999 TTAB LEXIS 117, at \*7-8 (Mar. 31, 1999) (finding that the submitted specimen was acceptable evidence of service-mark use for computer programming services because it indicated that applicant provides a comprehensive slot accounting, player marketing, and analysis system that involves customized computer programming for each casino customer; noting that “[i]t is not necessary that applicant spell out in the brochure that it offers computer programming services”).

<sup>17</sup> See In re HSB Solomon Assocs., LLC, 102 USPQ2d 1269, 1274 (TTAB 2012) (finding no direct association between the mark, CEI, and the identified technical consultation services because the submitted specimens showed the mark being used only to identify a metric, index, equivalency factor, standard, or performance measure and never to identify the identified services; noting that, even if the CEI metric, index, equivalency factor, standard, or performance measure is used by applicant in performing the identified services, that “does not transform that metric into a technical consulting service or associate the term CEI with the technical consulting service such that it serves as a source identifier rather than simply the name of a process”); In re Walker Research, Inc., 228 USPQ 691, 692 (TTAB 1986) (finding the submitted specimen unacceptable since SEGMENTOR referred only to the computer software used in performing the services and not to identify and distinguish the services themselves; noting that “[t]he fact that applicant does not sell the ‘SegMentor’ software and may not use ‘SegMentor’ in a technical trademark case in connection with the software does not . . . warrant a finding that ‘SegMentor’ must therefore function as a service mark”); TMEP §1301.02(f).

<sup>18</sup> See TMEP §§1301.02(e)–1301.02(f).

<sup>19</sup> See TMEP §1301.02. Likewise, the “TM” symbol, which is occasionally used in connection with service marks, is not, by itself, an indication that the designation functions as a service mark.

<sup>20</sup> In re DSM Pharm., Inc., 87 USPQ2d at 1624; see In re Ancor Holdings, LLC, 79 USPQ2d 1218, 1220 (TTAB 2006) (citing In re Walker Research, Inc., 228 USPQ at 692); TMEP §1301.04(a).

<sup>21</sup> See In re Ancor Holdings, LLC, 79 USPQ2d at 1220 (“[W]e must base our determination of public perception of applicant’s mark on the manner of use of [the mark] in the advertising which has been submitted as a specimen.

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Further, we must make that determination within the current commercial context, and, in doing so, we may consider any other evidence of record bearing on the question of what impact applicant's use is likely to have on purchasers and potential purchasers." (quoting *In re Safariland Hunting Corp.*, 24 USPQ2d 1380, 1381 (TTAB 1992)).

<sup>22</sup> *In re DSM Pharm., Inc.*, 87 USPQ2d at 1626 ("In determining whether a specimen is acceptable evidence of service mark use, we may consider applicant's explanations as to how the specimen is used, along with any other available evidence in the record that shows how the mark is actually used."); *In re Ancor Holdings, LLC*, 79 USPQ2d at 1220.

<sup>23</sup> See *In re Ralph Mantia Inc.*, 54 USPQ2d 1284, 1286 (TTAB 2000) (finding a business card and stationery displaying the mark and the word "design" were acceptable specimens of use for applicant's mark in connection with commercial art design services, noting that "[i]t is not necessary that the specific field of design, i.e., commercial art, also appear thereon" and that "the word 'design' alone is sufficient to create in the minds of purchasers an association between the mark and applicant's commercial art services"); *In re Metriplex, Inc.*, 23 USPQ2d 1315, 1316 (TTAB 1992) (finding the submitted specimens acceptable to show use of applicant's mark in connection with data transmission services because the specimens showed "the mark as it appears on a computer terminal in the course of applicant's rendering of the service" and noting that "purchasers and users of the service would recognize [applicant's mark], as it appears on the computer screen specimens, as a mark identifying the data transmission services which are accessed via the computer terminal"); *In re PrintCo., Inc.*, Ser. No. 78155673, 2006 TTAB LEXIS 264, at \*8 (July 14, 2006) ("When appropriate, the Board has been fairly flexible in accepting service mark specimens.").

<sup>24</sup> *In re Ancor Holdings, LLC*, 79 USPQ2d at 1221.

<sup>25</sup> See TMEP §§807.12–807.12(a)(iii) and 807.12(d)–807.12(e) regarding agreement of the mark on the drawing and on the specimen.

<sup>26</sup> See *In re Dell Inc.*, 71 USPQ2d 1725, 1729 (TTAB 2004) (finding a mark "sufficiently prominent" even though it was "shown in a smaller type size than other words appearing on the webpage," given that it appeared "in a bullet listing of information about the product," and was placed "at the beginning of a line and [was] followed by the 'TM' trademark indicator"); TMEP §904.03(i)(B)(1). Compare *In re Quantum Foods, Inc.*, 94 USPQ2d 1375, 1378 (TTAB 2010) (describing an applied-for mark as "prominently displayed" on the specimen when the mark appeared by itself above pictures relating to applicant's goods in relatively large font and in a different color than some of the other text on the page), with *In re Osterberg*, 83 USPQ2d 1220, 1223 (TTAB 2007) (finding the applied-for mark not prominently displayed because it was buried in text describing the mark and, while the mark was shown in bold font, so was other matter), and *In re LaBellarte*, Ser. No. 76526520, 2009 TTAB LEXIS 399, at \*7 (May 29, 2009) (concluding that the mark, SOFT ROOM, would not be perceived as a service mark because, inter alia, it is "in the same font and size as other wording arranged randomly on the specimen").

<sup>27</sup> See *In re Osterberg*, 83 USPQ2d at 1223; *In re LaBellarte*, 2009 TTAB LEXIS 399, at \*7.

<sup>28</sup> *In re Universal Oil Prods. Co.*, 476 F.2d 653, 655, 177 USPQ 456, 457 (C.C.P.A. 1973) ("The minimum requirement is some direct association between the offer of services and the mark sought to be registered therefor."); see also *In re Adver. & Mktg. Dev., Inc.*, 821 F.2d 614, 620, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987) ("The 'direct association' test does not create an additional or more stringent requirement for registration; it is implicit in the statutory definition of 'a mark used \* \* \* to identify and distinguish the services of one person \* \* \* from the services of others and to indicate the source of the services.'"); *In re Johnson Controls, Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994) ("While the nature of the services does not need to be specified in the specimens, there must be something which creates in the mind of the purchaser an association between the mark and the service activity."); TMEP §1301.04(b).

<sup>29</sup> *In re Universal Oil Prods. Co.*, 476 F.2d at 655, 177 USPQ at 457.

<sup>30</sup> See *In re Monograms Am., Inc.*, 51 USPQ2d 1317, 1318 (TTAB 1999); TMEP §1301.04(b).

<sup>31</sup> *In re Monograms Am., Inc.*, 51 USPQ2d at 1318; see also *In re Atlas Media Corp.*, Ser. No. 76685286, 2009 TTAB LEXIS 215, at \*3 (Mar. 6, 2009).

<sup>32</sup> See *In re Ralph Mantia Inc.*, 54 USPQ2d at 1286 (reversing the specimen refusal since the term "design" appeared on applicant's letterhead stationery, envelope, and business cards and stating "[i]t is not necessary that the specific field of design, i.e., commercial art, also appear [on the specimen]. Here, the word 'design' alone is sufficient to create in the minds of purchasers an association between the mark and applicant's commercial art services."); *In re Monograms Am., Inc.*, 51 USPQ2d at 1318; see also TMEP §1301.04(c) ("To create an association between the mark and the services, the specimen does not have to spell out the specific nature or type of services."); *In re Zinpro Corp.*, Ser. No. 85369372, 2013 TTAB LEXIS 146, at \*7-8 (Mar. 22, 2013) ("As to the required degree of specificity, the involved specimen does not have to spell out the specific nature and type of services. Rather, a general reference to the industry may be acceptable to create an association between the mark and the services.").

<sup>33</sup> See *In re Monograms Am., Inc.*, 51 USPQ2d at 1318 ("There must be, however, a direct association between the mark sought to be registered and the services specified in the application, and there must be sufficient reference to the services in the specimens to create this association" (emphasis added)); *In re Prof'I Research Consultants, Inc.*, Ser. Nos. 77490850 & 85447154, 2013 TTAB LEXIS 99, at \*6-7 (Feb. 25, 2013) (finding the submitted webpage specimen unacceptable because it "simply does not specify what type of services are offered by applicant" and noting that "[w]ith such vagueness, it would require a real leap for consumers to understand that the webpage is associating" the mark with the identified services); *In re Ingram Micro Inc.*, Ser. Nos. 78321253 & 78321254, 2011

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TTAB LEXIS 371, at \*15-17 (Nov. 15, 2011) (finding manuals and website printouts unacceptable as specimens of use for the identified services because the services were not referenced in connection with the mark but, instead, were identified by other terms); *In re R & B Receivables Mgmt., Inc.*, Ser. No. 77855168, 2011 TTAB LEXIS 294, at \*6-8 (Sept. 23, 2011) (finding specimen consisting of a photo of signage on, and in front of, the building in which services are rendered unacceptable as an advertising-type specimen since it did not sufficiently reference the services); *In re Chengdu AOBi Info. Tech. Co.*, Ser. No. 77723547, 2011 TTAB LEXIS 188, at \*5-6 (May 31, 2011) (finding that the submitted webpage specimen's "vague references" to "online service" and applicant's ambition to become "one of the world's top utility producers and Windows system service providers" were insufficient to show use of mark for the identified computer programming, software design, website hosting, and other computer-related services).

<sup>34</sup> See *In re Metriplex, Inc.*, 23 USPQ2d 1315, 1316-17 (TTAB 1992) (noting that "the requirements specific to specimens which are advertising are not applicable" and finding the submitted specimens acceptable to show use of applicant's mark in connection with data transmission services because the specimens showed "the mark as it appears on a computer terminal in the course of applicant's rendering of the service" and noting that "purchasers and users of the service would recognize [applicant's mark], as it appears on the computer screen specimens, as a mark identifying the data transmission services which are accessed via the computer terminal"); TMEP §1301.04(b); see also *In re Zinpro Corp.*, 2013 TTAB LEXIS 146, at \*7 ("[U]nder some fact patterns, even if it is clear that the specimens of use do not contain a reference to the services, they are still deemed acceptable."); *In re Ultimus, Inc.*, Ser. No. 78688816, 2008 TTAB LEXIS 304, at \*7 (Mar. 31, 2008) ("When used in the actual sale of services, as opposed to their advertising, it is not per se necessary that the services be referenced, but in such cases it may be necessary to explain how the mark appears during the rendering of the service and, therefore, why the purchaser or user of the service would recognize and associate the mark with the service.").

<sup>35</sup> See *In re Metriplex, Inc.*, 23 USPQ2d at 1316-17; see also *In re Zinpro Corp.*, 2013 TTAB LEXIS 146, at \*7. Compare *In re McGowan Publ'g Co.*, Ser. No. 77582970, 2013 TTAB LEXIS 364, at \*6-9 (June 27, 2013) (finding the submitted webpage specimens acceptable evidence of use of the mark for financial and investment services because "a client or prospective client of applicant's investment advisory services would view the mark on the web page in close proximity to links for documents used by applicant in rendering those services (i.e., the contract between applicant and the client and applicant's Registered Investment Advisor disclosures)" and "[t]hus, the links to these documents create an association between the mark and the offered service activity"), and *In re Robert Bosch GmbH*, Ser. No. 75473538, 2001 TTAB LEXIS 353, at \*2-3 (May 3, 2001) (finding the submitted specimens acceptable evidence of use of the mark in connection with training services because the specimens included photographs of signage bearing the mark outside the applicant's building and at a display booth referred to as a "demo work station" at applicant's headquarters where guests are informed about the identified training services; noting that "[t]he nature of applicant's service does not need to be spelled out in greater detail on the specimen"), with *In re R & B Receivables Mgmt., Inc.*, 2011 TTAB LEXIS 294, at \*6-8 (finding specimen consisting of a photo of signage on, and in front of, the building in which services are rendered unacceptable as showing the mark in the course of rendering the services because the sign is not used in rendering the financial advisory services; noting that the sign is "merely directing an existing client to applicant's location" similar to advertising and that "[u]pon seeing this sign, it could be literally for anything that one might find in an office park"), and *In re Ultimus, Inc.*, 2008 TTAB LEXIS 304, at \*8-9 (affirming refusal of a specimen submitted as evidence of use of the mark UNRULY EVENTS for "providing on-line communications links which transfer the website user to other local and global web pages featuring software for workflow automation" because, despite the fact that the wording UNRULY EVENTS itself served as a hyperlink, there was no mention of the communications links services on the specimen and no explanation from the applicant of how the mark would be recognized and associated with the identified services).

<sup>36</sup> See *In re Metriplex, Inc.*, 23 USPQ2d at 1316 (finding the submitted specimens acceptable based, in part, on applicant's explanation that the specimens showed the mark as it appeared on a computer terminal in the course of rendering the services); see also *In re Ultimus, Inc.*, 2008 TTAB LEXIS 304, at \*7-8 ("When used in the actual sale of services, as opposed to their advertising, it is not per se necessary that the services be referenced, but in such cases it may be necessary to explain how the mark appears during the rendering of the service and, therefore, why the purchaser or user of the service would recognize and associate the mark with the service.").

<sup>37</sup> See *In re Johnson Controls, Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994) ("While the nature of the services does not need to be specified in the specimens, there must be something which creates in the mind of the purchaser an association between the mark and the service activity."); *In re The Wrestling Zone, Inc.*, Ser. No. 77561949, 2009 TTAB LEXIS 661, at \*4-5 (Nov. 2, 2009) (finding the submitted specimen unacceptable as evidence of use of the mark for pay-per-view and on-demand television transmissions of live wrestling exhibitions because the mark was used to advertise a particular entertainment event and not video-on-demand services, noting that the "reference to video-on-demand on the specimen is used only in an informational sense to notify the public of the options available for viewing the wrestling event"); *In re Broad. Architecture, Inc.*, Ser. No. 77153464, 2009 TTAB LEXIS 97, at \*6-10 (Mar. 19, 2009) (finding the submitted specimen unacceptable for radio broadcasting services because the mark would be perceived as identifying a radio program and not as a source indicator for radio broadcasting services).

<sup>38</sup> Cf. *In re Sones*, 590 F.3d 1282, 1288, 93 USPQ2d 1118, 1123 (Fed. Cir. 2009) ("[T]he test for an acceptable website-based specimen, just as any other specimen, is simply that it must in some way evince that the mark is 'associated' with the goods and serves as an indicator of source." (emphasis added)). The requisite mark-services association is present when the specimen makes a direct link or connection between the mark and the identified

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services. See, e.g., *In re LaBellarte*, Ser. No. 76526520, 2009 TTAB LEXIS 399, at \*9 (May 29, 2009) (finding the submitted specimens unacceptable since they lacked direct mark-services association because the mark, SOFT ROOM, only identified a proprietary principle or system used in performing the applicant's services, and noting that "[t]here is no direct association of 'soft room' with the services listed in the application" and that "'soft room' . . . would not be perceived as a service mark for the editing and design services mentioned in the specimen; the identification of soft room as a principle in the text of the specimen precludes a direct association with the stated services and there is nothing else in the specimen to make the necessary direct association").

<sup>39</sup> Compare *In re Metriplex, Inc.*, 23 USPQ2d at 1316 (finding the submitted specimens acceptable based, in part, on applicant's explanation that the specimens showed the mark as it appeared on a computer terminal in the course of rendering the services), with *In re Ingram Micro Inc.*, Ser. Nos. 78321253 & 78321254, 2011 TTAB LEXIS 371, at \*16-17 (Nov. 15, 2011) (finding the submitted specimens unacceptable because they "do not show a proper nexus with the identified services" and the services "are too attenuated from the proposed mark and are described under different terms").

<sup>40</sup> See TMEP §806.03(c) regarding amending filing basis from §1(a) to §1(b), and 904.07–904.07(b)(i) regarding requirements for substitute specimens.

<sup>41</sup> See 37 C.F.R. §2.64; TMEP §714.03.

<sup>42</sup> See TMEP §§1202.01, 1202.03–1202.04, 1301.02(a), 1301.02(e)–1301.02(f). No specimen refusal should issue if the mark identifies, for example, both a process and the identified services and the requisite mark-services association is present. See TMEP §1301.02(e).

<sup>43</sup> 15 U.S.C. §§1051, 1052, 1053, 1127; see TMEP §1301.

<sup>44</sup> *In re Ancor Holdings, LLC*, 79 USPQ2d 1218, 1221 (TTAB 2006).

<sup>45</sup> Examining attorneys may visit the Trademark Law Library website, located at <http://ptoweb.uspto.gov/ptointranet/trademarks/lawlibrary/classtech.htm>, which provides links to various websites relating to technological services, and is searchable by subject matter and classification number.

<sup>46</sup> 37 C.F.R. §2.61(b).

<sup>47</sup> *In re Metriplex, Inc.*, 23 USPQ2d 1315, 1317 (TTAB 1992) (finding the submitted specimens acceptable to show use of applicant's mark in connection with data transmission services because "we have a situation where the service are rendered through the means of a tangible item, namely, a computer terminal, so that the mark can appear on the computer screen, and the specimens show such use").

<sup>48</sup> See TMEP §§1202.08–1202.08(f) regarding titles of single creative works and §1301.02(d) regarding titles of radio and television programs.