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Avoiding Problems with Trademark Specimens

Trademark applications, renewals and declarations of continued use require the trademark applicant or owner to submit evidence that the trademark is used in commerce. For services we almost universally use the trademark owner's website. For tangible products, the trademark must be "affixed" to the item and thus a digital photo of the trademark on the product or its packaging generally works. A common problem we run into is that of "mutilation" of what was applied for or registration. For example, if a client came to us and wanted to register CHING'S CHIPS™ for potato chips we would respond as follows:

A well-informed trademark examining attorney at the U.S. Patent & Trademark Office would require us to disclaim the term CHIPS from the mark as a whole. Therefore, it would make more sense only to register CHING'S as a standard character claim (any presentation of the word) because that is the dominant feature of the trademark.

However, when it is time for the marketing department to product the packing we might see something like the following:



Specimen #1 is a mutilation of the original mark. We never registered SUPER nor CHIPS. The brand is CHING'S (which can be upper case, lower case, title case or in any font). Specimen #2 is still a problem because the terms CHING'S and CHIPS are on the same line, with the same font forming a new trademark....CHING'S CHIPS. Finally, Specimen #3 is acceptable because CHING'S is denoted in a larger font, on a separate line and even in a separate color than the term "Chips." This will give the company the ability to use CHING'S as a "house mark" for other items such as CHING'S pretzels, CHING's cereal or the like. In conclusion, it is important that there be good agreement between what is registered and what is marketed to the consumer. If you ever have any questions on this, do not hesitate to contact our office.



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