
Federal Circuit Affirms Trademark Webpage Specimen Must Contain Information Essential to Purchasing Decision

In Re: Siny Corp., No. 2018-1077 (Fed. Cir. Apr. 10, 2019)

By: Adam Reis & Barry Irwin | April 15, 2019

On request from the USPTO pursuant to Fed. Cir. R. 32.1(e), the Federal Circuit reissued a precedential version of a non-precedential opinion affirming the refusal to register a trademark because the specimen was not a point of sale display.

This case makes clear that when relying upon a webpage specimen to show use in commerce of a trademark for goods, the page should depict a point of sale. Reading between the lines, best practices would include a specimen that contains a means for ordering the goods if possible and, at the very least, information essential to the purchasing decision, such as price, minimum order quantities, accepted methods of payment, and shipping details. A specimen that merely provides contact information will not suffice to demonstrate use in commerce.

15 U.S.C. § 1127 provides that in order to show use in commerce, a mark may be “placed in any manner on the goods or their containers or the **displays associated therewith** or on the tags or labels affixed thereto.” Such a display can show use in commerce if it is a “point of sale” display, but not if it is mere advertising. This was the key issue throughout this appeal.

Siny Corp. (“Siny”) filed a use-based trademark application in connection with a fabric used in textile manufacturing. Siny submitted a specimen consisting of a webpage printout. The examiner refused registration on the grounds that the specimen was “mere advertising material,” noting in particular the lack of a means for ordering the goods. In response, Siny submitted a new specimen, now containing text reading “For sales information:” followed by a phone number and email address, which Siny argued constituted a means to purchase the goods. The examiner disagreed, issuing a final rejection in which he found the cited language merely informed consumers how to obtain more information, and did not enable consumers to make a purchase. Siny appealed to the Patent Trial and Appeal Board (“Board”).

According to the Board, the specimen lacked much of the information essential to a purchasing decision, e.g., price, minimum order quantities, accepted methods of payment, and shipping details. Siny argued that because the goods were industrial goods used in manufacturing, the ultimate sales transaction required assistance from Siny sales personnel. The Board nonetheless found 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.” The Board also noted Siny’s failure to submit evidence of how sales were made. The Board thus affirmed the examiner’s refusal to register the mark.

On appeal, the Federal Circuit noted the issue of whether a specimen is advertising or a point of sale display is a factual question reviewed for substantial evidence. The Federal Circuit found that the Board’s careful consideration of the absence of information essential to a purchasing decision, the dependence on extraneous information to make a sale, and the absence of evidence of how sales were made was not overly rigid and did not lack substantial evidence, thus affirming the Board’s decision.