Trademark applicants before the United States Patent and Trademark Office (the “PTO”) seeking to register a mark for “a full line of pharmaceuticals” are subject to a new evidentiary standard for establishing use of their mark.

Generally one must identify with specificity each product with which one is using or intends to use a mark, but in rare circumstances the PTO may accept an identification of goods that refers to “a full line of” products that virtually all fall in the same class, e.g., “a full line of pharmaceuticals” in International Class 005.

Generally, too, if more than one product is identified in a class one need submit a specimen of use with only one of the identified products; while the examining attorney may request one or more additional specimens, in practice such requests are relatively rare.

Recently, however, the PTO announced a new evidentiary standard for establishing use of a mark with “a full line of pharmaceuticals”:

If the goods are a “full line of pharmaceuticals,” the examining attorney must require the applicant to provide evidence that it uses the mark in connection with pharmaceuticals to treat diseases or health problems in all categories in the World Health Organization (“WHO”) International Statistical Classification of Diseases and Related Health Problems.” Trademark Manual of Examining Procedure, §1402.03(c) Marks for a “Full Line of…”

The version of the International Statistical Classification of Diseases, or “ICD”, currently in effect in the US classifies diseases into 17 categories. To establish “proof of use in connection with pharmaceuticals to treat diseases or health problems in all categories in the WHO International Statistical Classification of Diseases and Related Health Problems” id., applicants must submit evidence of use of their mark with at least one pharmaceutical product that is used to treat a disease in each of these 17 categories.

Although the new evidentiary burden “is not a requirement for specimens, but rather a requirement that applicant provide evidence to substantiate the claim of use as a mark for a “full line of” a genre of products”, id., the burden is substantially greater.

Applicants who are unable to meet this new evidentiary standard must narrow their identification to a full line of a subset of a genre, such as “a full line of cardiovascular pharmaceuticals”, or to a specific product, such as “aspirin”.

Applicants who are able to meet this new evidentiary standard may realize the benefits of federal registration of their mark for use with “a full line of pharmaceuticals.”

For more information, contact Thomas Dunn at tdunn@mbbp.com.