

Publications

Client Alert: New Pilot Program By U.S. Trademark Office: Could Affect All Registrants

Related Attorneys

William H. Oldach III

Related Services

Intellectual Property

Trademarks

CLIENT ALERT | 8.14.2012

The U.S. Patent and Trademark Office has instituted a pilot program in which it will be pulling some post-registration Declarations of Use and requesting proof of use for additional items listed in the goods/services description, instead of only one in a class, as is the custom now. These Declarations of Use are due between the 5th and 6th year of the registration, and then at every 10th year anniversary. The purpose of the program is to encourage applicants and registrants to be more precise in their declarations of use and to test the "accuracy and integrity" of the trademark register. The Trademark Office has indicated that it will randomly and periodically request this additional evidence, not for every registration, and not only registrations owned by non-U.S. registrants.

A Declaration of Use must be filed together with proof of then-current use of the mark in the U.S. This pilot program is in reaction to the recent spate of litigation for "fraud" against applicants and registrants who have filed declarations of use covering goods or services for which they were not currently using the mark. With the Bose decision (in which the Court of Appeals of the Federal Circuit severely cut back the basis for these fraud actions), the fraud cases have abated for now. But for a two-year period the Trademark Office will be requesting additional specimens, information, exhibits, affidavits or declarations that they deem reasonably necessary to determine whether the mark is actually used on goods or in connection with services. For now, this program will test only post-registration Declarations of Use: Section 8 and Section 71 (Madrid Extensions of Protection). But it could be extended in the future to pending applications in which use must be proven (use-based or intent-to-use, but not Madrid or Section 44 applications filed by non-U.S. applicants based upon a foreign application/registration).

Non-U.S. applicants will be particularly affected because they often base their trademark filings on broad lists of goods/services. Even if their original application was based upon a national registration and therefore did not have to prove use, at the 6th anniversary of the registration, they currently have to prove use (or excusable non-use –

the criteria for which is extremely difficult to meet). The registrant signs a declaration under perjury, that they are currently using the mark (in commerce in the U.S. or exported to the U.S.) on each and every good and service listed in the registration – not just the one in each class for which they submit a specimen.

If the registrant cannot prove use for the goods/services requested, those goods or services will be deleted from the registration. In other words, the entire registration will not be invalidated unless the registrant fails to respond to the request entirely.

Here are our recommendations:

- When filing the application, review the list of goods and services for which the application is proposed. (Even if filed on the basis of the Madrid Protocol, or on a national application/registration, there is still a requirement that the applicant have a bona fide intent to use the mark in the U.S.) The applicant may wish to include services related to the client's "main" focus of activity for which use might more easily be proven later even if those goods/services are not then used in the U.S. (for instance, reservation services for a hotel chain).
- When a Statement of Use or Affidavit of Use is due, have the registrant confirm current use in the U.S. on each and every good/service in the registration.
- Inform the registrant that during the examination of the declaration they may need to produce a specimen of goods/services for additional items – possibly each item.
- Seek our advice on the form and circumstances of acceptable specimens and type of commerce. As noted above, there are some situations in which the "main" service or product is not provided in the U.S., but related services (for instance, reservation services through the internet for a hotel chain) can be proven.
- File one specimen for each class; delete all items in the list of goods/services that are not then currently in use.
- If the mark is in a stylized form or includes a design/logo, the mark in use must exactly match the drawing of the trademark in the registration. If it does not, seek our advice on options.
- File additional applications to cover deleted or additional items as appropriate.

For more information, contact one of the Vorys attorneys referenced to the right.