

USPTO Adopts New Regulations for Trademark Specimens of Use

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Unlike the practice in many countries, in most cases the U.S. requires a trademark owner to place the mark into *actual use in commerce* and provide specific types of proof of use before the registration certificate will issue. Similar requirements apply to the mandatory declaration of use to maintain or renew a U.S. registration. Effective February 17, 2017, the United States Patent and Trademark Office (“PTO”) has amended its rules relating to the amount of proof necessary to substantiate current use of the mark for post-registration declarations of use. [37 CFR Part §§ 2.161 and 7.37](#).

Post-registration requirements to prove use in U.S. commerce

Under § 8 of the Lanham Act, a trademark registrant must file a declaration that the mark is in current use in commerce and provide a specimen of that use between the 5th and 6th years after registration and every 10th year, when the registration is renewed. Similar requirements under § 71 of the Act apply to

owners of International Registrations with extensions of protection to the U.S. under the Madrid Protocol. Specimens of use submitted to the PTO must illustrate how the owner is using the mark in commerce in connection with the particular goods or services identified in the application or registration. Specimens of use for trademarks are usually photos of packaging or labeling for the goods bearing the mark or of the mark placed directly on the goods. Specimens of use for service marks are usually advertising or promotional material for the services bearing the mark. For registrations originally based on the Madrid Protocol or on registrations obtained in other countries, the § 8 or § 71 declaration of use is the first time proof of use of the mark in U.S. commerce is required.

The PTO has discretion to issue regulations about the number and kind of specimens of use that must be produced. Previously, the rules only required *one* specimen of use for each International Class of goods or services in the application or registration, regardless of the number of goods/services identified in each class. For example, a mark registered for five types of jewelry items in International Class 14 and ten types of clothing items in International Class 25 would currently require only two specimens of use, for one jewelry item and one clothing item. In an effort to more accurately identify marks that are no longer in use and should be cleared from the register so that others may use them, the new regulations allow the trademark examiners to require evidence of use for more than one covered item per class and other types of evidence of use, such as information, exhibits, affidavits or declarations.

PTO Pilot Program 2012-2014

Prior to adopting the new rules, the PTO conducted a pilot program in 2012-2014, affecting 500 randomly chosen registered marks. Registrants were required to produce additional proof of use of the marks as a means to assess and improve the accuracy and integrity of the trademark register. That number represented less than 1% of the declarations of use then filed in a six-month period. Specially trained senior attorneys conducted the examinations. The randomly selected registrations for which evidence of use was filed received a request for two additional specimens per class. If the owner could not provide that evidence, those goods were deleted from the registration and the declaration of use was subjected to further review. The selection of marks was random and did not depend on the length or content of the goods/services in the registration.

The owner of a registration selected for the pilot program was allowed to voluntarily delete the goods/services for which additional specimens were requested as an alternative to providing the specimens. That voluntary action did not trigger cancellation of the entire registration although it might have subjected the registration to a request to verify the remaining goods/services.

Under the pilot program, the owners of 51% of the randomly chosen registrations failed to supply the requested additional proof of use for specific goods or services. Of those 51%, owners in 35% of the cases requested that some goods or services be deleted from their registration. The remaining 16% of the registrations were cancelled in full because the owners failed to respond to the request for additional proof. In total, 84.4% of the chosen registrations ultimately produced acceptable declarations of use, including acceptances issued after the challenged goods/services were deleted from the registrations. The results of the pilot program convinced the PTO that a permanent amendment to the declaration of use rules would benefit the public by clearing the register of deadwood that would otherwise require the public to incur the costs and burdens of use investigations, PTO proceedings to oppose applications or cancel registrations, and civil suits to resolve disputes over marks.

New Requirements

Under the new rules, the PTO will conduct random audits of all § 8 and § 71 declarations filed every year in which the mark is registered for more than one good or service per class. The PTO initially anticipates

conducting audits of approximately 10% of the declarations. That number may increase, depending on the program results and available resources. In addition to the one specimen of use per class currently required, owners of audited registrations will be required to provide additional proof of use, including specimens for two additional goods/services per class. Additional proof for other goods/services may also be required. The PTO will advise owners to delete goods/services for which they cannot provide the requested proof and also to delete voluntarily any other goods/services for which the mark is no longer in use. If the owner cannot provide the requested proof, the PTO will delete those goods/services from the registration. If the owner fails to respond to the audit request, the entire registration will be cancelled. An owner may also voluntarily file proof of use for each item in a registration to attempt to forestall an audit.

Words to the Wise

The PTO's renewed hunt for marks that were never used or are no longer used is not supposed to focus on any one class of owner or type of mark, such as Madrid Protocol extensions of protection or applications based on registrations from other countries. However, those types of registrations often contain extremely long descriptions of goods or services because proof of use is not required to obtain the International Registration or foreign country registration on which the U.S. application is based, and proof of use in U.S. commerce is not required of those applicants at the registration stage. When it comes time to file the § 8 or 71 declaration with proof of use in U.S. commerce, it may be necessary to delete a large number of goods/services from those registrations, which may call into question whether the owner had the required intent to use the mark in U.S. commerce when the application was initially filed. An infringer might attempt to invalidate the registration on that basis. Therefore, close attention should be paid to the goods/services in such applications at the time they are made, and only those goods/services for which the owner has a bona fide intent to use the mark in U.S. commerce should be included in the application.

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