

Trademark Owners Take Note! USPTO Implements New Evidence Requirements for Proving Use or Continued Use of Federally Registered Trademarks

February 02, 2017

Effective February 17, 2017, the U.S. Patent and Trademark Office (USPTO) will change its rules for examining:

1. Affidavits or declarations of continued use or excusable nonuse of trademarks filed under Section 8 of the Trademark Act, and
2. Affidavits or declarations of use in commerce or excusable nonuse under Section 71 of the Act.[1]

The USPTO's goal in implementing these new rules is to create a more accurate and reliable trademark register to help avoid imposing needless costs and burdens on the public, such as those associated with investigating actual use of the mark to assess any conflict, opposition or cancellation proceedings, civil litigation, and so forth.

The new rules will permit the USPTO to require additional evidence of use to verify the accuracy of claims that a trademark is in use in commerce in the United States in connection with **all of the goods and/or services listed** in the registration or application. Such additional evidence may include, for example, information, exhibits, affidavits or declarations, and additional specimens.

The new rules represent a shift from the USPTO's current practice, which requires an applicant or registrant to submit only a single specimen of use or continued use in commerce **per class of goods and/or services listed** in the application or registration with a Section 8 or Section 71 affidavit.

Trademark registrants and applicants should prepare for these changes by:

1. Retaining evidence of use for all goods and/or services listed in their applications or registrations, in the event the USPTO requests additional evidence of use;
2. Conducting internal audits to ensure that evidence of use exists for all goods and/or services listed in their applications or registrations, especially in advance of making any affidavit or declaration submission to the USPTO; and

3. Preparing to amend the goods and services descriptions associated with their applications or registrations, to remove goods or services from those descriptions when such goods or services will not be, or are no longer being, branded with the mark.

Historically, trademark owners have periodically submitted proof of continued commercial use of the registered trademark in the form of an affidavit or declaration, stating the extent to which the “use in commerce” is ongoing, with respect to each class of goods and/or services for which the mark is being or has been registered.

However, applicants and registrants at times have failed to delineate the extent of their use, or lack thereof, with respect to all of the goods and services identified in their trademark applications or registrations. The USPTO’s new rules address this problem, permitting it to impose additional requirements upon applicants and registrants.

If you have further questions on this issue, please contact a member of McGlinchey’s Intellectual Property team.

[1] Changes in Requirements for Affidavits or Declarations of Use, Continued Use, or Excusable Nonuse in Trademark Cases, 82 Fed. Reg. 6259 (Jan. 19, 2017).