

United States: USPTO Tightens Requirements For Commercial Use Of Trademarks

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First published on www.mondaq.com

On March 21, 2017, the USPTO implemented changes to its requirements for continued use of trademarks in commerce that will require some trademark owners to provide additional materials and documentation when they renew their registrations. Registrants need to be aware that they may be randomly selected for this program, and understand what will be required of them if they are selected.

For a trademark to be federally registered, it must be used in commerce in the United States in connection with **all** of the goods and services recited in the application. To enforce this requirement, the Trademark Office requires that applicants provide specimens showing the mark being used in connection with actual goods or services.

Prior to this recent change, the USPTO has required **only one specimen of use** in each International Class for which a trademark is registered. For example, if a company sells compact disks (CDs), CD recorders and related products, such as cables, all in International Class 9, the PTO previously required the submission of a specimen of actual use for only one of those products to support the listing of the various products in Class 9. If one specimen is provided for one product listed (in a given Class), then the PTO did not ask for specimens showing the other products. Just as a specimen is required when the application is filed, a specimen is also filed when the application is renewed.

Effective March 21, 2017, the PTO has implemented a permanent program of auditing declarations of continued use when renewals are filed. Under this new program, approximately 10 percent of registrants filing a Section 8 or a Section 71 declaration for registrations covering more than one product or service per Class will be asked to provide further proof of use of the additional goods and services. In most cases, this will involve filing additional specimens, declarations, and information showing that the mark is being used in connection with all of the goods listed, not just one example per International Class. This requirement will be sent to the registrant as an Official Action, with the standard six-month time for response. If the trademark owner is unable to provide the requested information for those additional products or services, then those products or services will be deleted from the registration. If the trademark owner does not respond to the Official Action, the PTO will cancel the entire registration.

Trademark owners are already required to sign a declaration with each renewal confirming that the mark is still in use with each and every product or service listed. Some trademark owners, however, do not retain specimens for each and every product. Given this modification to PTO procedure, we recommend that all trademark owners conduct a detailed review of their trademark registrations that are

coming up for renewals or declarations of continued use, and collect specimens of use for **each of the products or services listed in the registration**. Retaining records of such specimens will not only assist when reviewing the declaration that must be signed with the renewal, it will also provide records that can be provided to the PTO if the renewal in question is selected for auditing, or in the event the renewal is challenged during trademark litigation.

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