

USPTO ISSUES FINAL RULE AFFECTING REGISTERED TRADEMARK OWNERS AND APPLICANTS

Intellectual Property & Technology Alert
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Practices & Industries

Copyrights

The U.S. Patent and Trademark Office (USPTO) has issued a final rule regarding establishing use of marks in interstate commerce that imposes additional requirements on trademark applicants and registrants. “Use” is a term of art in U.S. trademark law, and establishing use of a mark is crucial with respect to obtaining and/or maintaining trademark rights and registrations. The final rule went into effect on June 21, 2012.

There are two main facets to the final rule:

- First, the final rule expressly permits the USPTO to request additional specimens per class, as well as supporting documentation, including affidavits, declarations, and exhibits, in connection with trademark application and applicable post-registration filings. The final rule clarifies and codifies the USPTO’s authority with respect to requesting additional information concerning use of a mark, and it attempts to harmonize the process for doing so in the pre- and post-registration contexts. Essentially, the final rule permits the USPTO to require additional information as may be “reasonably necessary” to properly examine trademark applications and post-registration filings. Therefore, the USPTO may now start to request additional information more frequently and in more situations.
- In addition to the above rule change, the final rule provides for a pilot program designed to verify the accuracy of post-registration claims that a registered trademark is in use on the identified goods/services. From June 21, 2012 through June 21, 2014, the USPTO will require additional proof of use for approximately 500 randomly selected marks for which Section 8 or 71 affidavits are filed during the relevant period. The USPTO intends to require the owners of the selected marks to provide proof of use of the mark on two additional goods/services per class.

To prepare for compliance with the requirements of the final rule, registered trademark owners and applicants should strive to maintain at least three acceptable specimens for different goods/services within each class listed in an application or registration. For example, if a trademark owner uses its mark on labels or tags for goods in Class 9, and the application or registration lists 10 different Class 9 goods,



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having a label or tag specimen for at least three of the listed goods will help to reduce the risk of cancellations of or refusals to register marks, or the deletion of certain goods/services for failure to prove use of the marks in interstate commerce.

The Trademark Rules of Examining Procedure provide that acceptable specimens for goods generally include labels, tags, or containers for the goods; inscriptions on the goods themselves; or displays associated with the goods. Acceptable specimens for services must show the mark as actually used in the sale, rendering, or advertising of the applied-for services, and they typically include Internet advertising, newspaper and magazine advertisements, brochures, billboards, and direct-mail leaflets.

