

## Strict Liability For Misstatements in Descriptions of Goods and Services

### *Fraud on the U.S. Trademark Office and Its Consequences*

More and more since 2003, the United States Trademark Trial and Appeal Board (TTAB) is finding that fraud is being perpetrated on the United States Patent and Trademark Office (USPTO). The reason is that the TTAB has adopted a 'bright-line' rule of law under which an applicant is presumed guilty of fraud for including in the description of goods or services particular products or services for which the mark is not actually being used. A trademark registered with the USPTO should not cover more than a trademark owner is actually entitled to protect-the goods for which the mark is actually being used.

Whether the fraud is committed knowingly, innocently, or the consequences of such a finding can be costly or even devastating for the trademark owner. The rule is now being strictly enforced, and the "penalty-for-perjury" is that the application or registration containing false claims must be voided or cancelled in its entirety, regardless of any lack of actual intent to deceive. The fraud cannot be cured by merely deleting the unused goods or services, and the TTAB has not been shy in summarily canceling registrations obtained contrary to this new standard.

***Fortunately, such an outcome can be easily avoided by always adhering to these guidelines:***

- **All information submitted to the USPTO must be completely accurate** – Otherwise, any registration that results is vulnerable to cancellation based on fraud as discussed above.
- **There must be use on *all* goods or in connection with *all* services identified in an application** – Not revising the description of goods or services during prosecution to delete anything for which the mark is not in fact being used is considered fraud on the USPTO.
- **Post-registration filings (Section 8 and renewal applications) must be treated the same way.**

## Are You Truthfully Adhering to the Use Requirements?

### **KEY POINTS:**

- **It is crucial to be accurate in all descriptions of goods and services.**
- **By including or continuing to include goods or services that are not actually being used in a description, a trademark owner places the entire application or registration at risk.**
- **A cancelled registration or void application is the high price paid for not truthfully adhering to actual use requirements.**

*To discuss your trademark registration issues, please contact: Renée L. Duff, [RDuff@Lackebach.com](mailto:RDuff@Lackebach.com)*

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