

United States Patent and Trademark Office

Post Registration Proof of Use Pilot Status Report

(Filings examined through June 30, 2014)

Overview

The United States Patent and Trademark Office (USPTO) randomly selected 500 registrations for which Section 8 or 71 Declarations of Use were being filed to participate in a pilot program to assess the accuracy and integrity of the trademark register as to the actual use of the mark with the goods and/or services identified in the registration.

As part of the pilot program, selected trademark owners were required to submit proof of use of their marks for two additional goods and/or services per class, in addition to the specimen(s) submitted with their maintenance filings. If a response to the inquiry did not fully address the requirements of the pilot or included a request to delete the goods and/or services identified for the pilot, the registration was subject to further proof of use requirements to verify the accuracy of the identification of goods and/or services in the registration. The USPTO selected a statistically significant sample of registrations under Trademark Act Sections 1(a), 44(e), 66(a), and 1(a) and 44(e) combined (dual basis) under the pilot.

Summary of Results to Date

As a reminder, in each of these selected cases, the trademark owner submitted with its Section 8 or 71 Declaration a sworn statement that the goods and/or services covered by the filing were in use in commerce. As of June 30, 2014, 470 of 500 registrations have completed the pilot, or 94%.

To date, in approximately half of the registrations selected for the pilot, the trademark owners failed to meet the requirement to verify the previously claimed use on particular goods and/or services. 172 of the registrations, or 34%, involved deletions of the goods and/or services queried under the pilot. In another 78 registrations, or 16%, the trademark owner failed to respond to the requirements of the pilot and any other issues raised during examination of the underlying maintenance filing, resulting in cancellation of the registration. Accordingly, of the 500 registrations selected for the pilot, to date a total of 250 registrations, or 50%, were unable to meet the requirement to verify the previously claimed use.

At this point, notices of acceptance and notices of acceptance and acknowledgement have issued for 392, or 78%, of the registrations examined under the pilot. Thus, they completed the pilot either by satisfying the proof of use requirements or making deletions but otherwise showing the requisite proof of use as to the remaining goods and/or services.

The statistics compiled to date support continuing the dialogue on the need for ongoing efforts aimed at ensuring the accuracy and integrity of the Trademark Register as to the actual use of marks with the goods and/or services included in registrations.

Deletions/Cancellations to Date by Basis for Registration

Basis for Registration	Percentage of Registrations Selected for the Pilot Deleting Goods/Services Queried Under the Pilot	Percentage of Registrations Selected for the Pilot Receiving Notices of Cancellation
Section 1(a)	27%	17%
Section 44(e)	56%	7%
Section 66(a)	61%	18%
Combined Section 1(a) and 44(e)	63%	13%

Continuing the Discussion on Suggestions for Improving the Accuracy of Identifications of Goods and Services in Registrations at the USPTO

To that end, reproduced below are four suggestions from a prior roundtable discussion hosted by the USPTO and the George Washington University Law School on the topic of “The Future of the Use-Based Register.” The USPTO welcomes public comment on these or other suggestions to TMPolicy@uspto.gov, and plans to hold a roundtable discussion to further explore this topic.

1. Create a streamlined non-use expungement procedure (analogous to the Canadian expungement proceedings under Section 45 of the Trademarks Act). For example, a party who believes a trademark owner is not using its mark on some or all of the goods and/or services in its registration could file a request with the USPTO to require that the owner prove use of its mark for the goods and/or services. If the owner complies, that ends the procedure. Otherwise, any goods and/or services for which the owner has not provided the requisite proof would be deleted from the registration.
2. (A) Require specimens for all goods and/or services listed in the registration when the first Section 8 or 71 declaration is filed; or (B) Require specimens for all goods and/or services listed in the registration when the first Section 8 or 71 declaration is filed, and mandate that the specimen must be a photo showing use of the mark in conjunction with the claimed goods and/or an advertisement for the services.
3. Increase the solemnity of the declaration. For example, (1) require the trademark owner to check a box stating that he/she understands the seriousness of the oath, or (2) require statements accompanying Section 8 and 71 declarations detailing steps taken to verify use with the goods and/or services in the registration.
4. Conduct random audits of Section 8 and 71 declarations. Require that a Section 7 Request be filed (along with the required fee) to delete any goods and/or services randomly queried by the USPTO for which the trademark owner is unable to show proof of use after filing its Section 8 or 71 declaration.

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