

## NEW TRADEMARK OFFICE PILOT STUDY

### ❖ Steer Clear of Unsold Goods ❖

The Trademark Office published new rules effective June 22, 2012 as part of a two year pilot study aimed at determining the accuracy of the trademark register. The new rules give trademark examining attorneys authority to request, post-registration, at the proof of use (Sections 8 and 71) stage, additional evidence of use, including specimens of use, sufficient to establish use of all of the goods listed in the registration. The requests for additional proof will come in the form of a post-registration office action, and the Trademark Office has already started issuing such actions. While the right to request additional proof existed with respect to new applications, prior to the implementation of the new rules, the authority to request such additional proof post-registration did not exist. **At the conclusion of the two year study, the Trademark Office will evaluate the results and determine whether or not to permanently implement the new rules.**

#### The US Trademark Office explained its rationale as follows:

“The objective of the final rule is to facilitate the USPTO’s ability to verify the accuracy of identifications of goods/services in trademark applications and registrations. The rule ensures that the USPTO may properly examine the nature and veracity of allegations of use made during the trademark application or post registration phase, and upon request, may require additional specimens or other information or exhibits, such as a photograph of the mark appearing on certain goods.”

**The initial program will be fairly limited, and the process and timing will be familiar. The Trademark Office will randomly select approximately 500 trademark registrations for which a Section 8 or 71 affidavit was filed and issue an Office action requiring proof of use of the mark on two additional goods/services per class.** The random selection will include all types of registrations and will represent less than 1% of the total number of affidavits usually processed during a typical six month period.” Normal response times, namely six months, will apply to these office actions.

**The motivation for the pilot program was, at least in part, the Court of Appeals for the Federal Circuit’s decision in *In re Bose Corp.*, (Federal Circuit 2009), clarifying the high standard for fraud on the USPTO in trademark cases and overruling a number of TTAB decisions which had lowered the bar for fraud.** Based on the high standard of fraud, and the holding that only a finding of fraud would result in cancellation of the entire registration (as opposed to a finding of mistake which would result only in cancellation of specific goods) there remains little to insure the accuracy of the trademark register. Thus, the new rules introduce another layer of accountability, thereby insuring the accuracy of the register. Under the new rules,

“if a response is filed but fails to include the required evidence or specimens, the USPTO will deem the Section 8 or 71 affidavit unacceptable as to the goods or services to which the requirement pertained and delete them from the registration. Such a response may also trigger a further requirement for proof of use as to some or all of the remaining goods/services. However, assuming the Section 8 or 71 affidavit is otherwise acceptable, and any requested proof of use as to remaining goods/services is satisfied, the remaining goods/services will be unaffected. By contrast, if no response to the Office action is filed within the response period, and no time remains in the statutory filing period, the registration will be cancelled (37 CFR 2.163(c), 7.39(b)).”

From a practical standpoint, registration owners should take care to carefully review their actual usage within the US at the time of proof of use (Section 8 or 71 for Madrid Protocol registrations) to avoid the negative implications of the failure to prove use on all registered goods/services upon request from the Trademark Office.

*To discuss the new trademark rules, please contact a Lackebach Siegel attorney today.*

## NEW RULES AT A GLANCE:



- Apply to both US based and Madrid Protocol registrations
- USPTO will randomly select approximately 500 trademark registrations for which a section 8 or 71 affidavit was filed and issue an Office Action
  - An Office Action will require proof of use of the mark on two additional goods/services per class and may include a request for additional specimens of use
  - Registrants will have six months to respond to the Office Action, which response must include a declaration that the mark is being used on the specified goods/services
  - If a response is filed, but does not adequately prove use of the specified goods/service, those goods or services will be deleted from the registration (but the remaining goods/services of the registration will remain) and may trigger a further request for additional proof of use as to the remaining goods/services
  - If no response is filed, the entire registration will be canceled
  - A more accurate trademark register should result in better trademark search results and reduced “actual use” investigations
  - Will likely have a greater substantive impact on Madrid Protocol registrations and other foreign originating registrations with extensive identifications of goods/services

The new rules can be found at <http://www.gpo.gov/fdsys/pkg/FR-2012-05-22/pdf/2012-12178.pdf>.

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