

INTELLECTUAL PROPERTY ALERT

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UPDATE: US Patent & Trademark Office Issues New Trademark Use Rule (Delayed until March 21, 2017)

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ALERT UPDATE: The US Patent & Trademark Office (USPTO) planned to implement an auditing program on February 17, 2017, which would introduce new requirements for declarations of use filed pursuant to Sections 8 or 71 of the Trademark Act. Now, the USPTO has decided to delay the effective date of the auditing program until **March 21, 2017**.

In summary, the USPTO will implement an auditing program under which it will audit approximately ten percent of the total number of mandatory declarations of use filed annually for trademarks registered for use with more than one good or one service per class. For audited declarations of use, the USPTO will require a trademark registrant to submit additional evidence in order to verify that the trademark has actually been used in commerce in connection with all of the goods and services identified in the registration. Trademarks with insufficient evidence may be subject to cancellation.

There are a few things about the new rule that trademark registrants and applicants should keep in mind...

First, as we previously mentioned, a trademark registrant should consider keeping a file or database of specimens of use for each good and service identified in each federal trademark registration that it owns. This would allow the trademark registrant to easily meet any audit requirements imposed upon it under the new rule. In addition, it would allow the trademark registrant to complete a review of its registered marks to determine those that are actively in use. A trademark registrant could then identify trademarks that have not been in use, or where use has lapsed, for specific goods or services in the registration. For such marks no longer in use (or no longer in use with certain goods or services), the trademark registrant can then determine whether to remedy the problem or to let the mark fall subject to cancellation.

Second, applicants applying for new trademarks should verify that they are in a position to continuously use their respective trademarks in connection with every good and service identified in an application. An applicant could benefit by developing a clear business plan to ensure that its trademark use for each good and service listed in its application will not lapse due to a business expansion into other goods or services, or a shift in business focus.

If you have questions about your trademark or other intellectual property needs, please contact one of the listed Roetzel attorneys.

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