

## INTELLECTUAL PROPERTY ALERT

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### US Patent & Trademark Office Issues New Trademark Use Rule

By *Suzanne K. Ketler, Ph.D., Partner*  
*Lindsie Everett, Associate*

On January 19, 2017 the United States Patent and Trademark Office (USPTO) published a notice in the Federal Register introducing new requirements for declarations of use in commerce filed pursuant to Sections 8 and 71 of the Trademark Act.

A declaration of use is a statement a trademark registrant is required to make, under penalty of perjury, which affirms that the owner's trademark is in use in commerce on or in connection with all goods or services identified in the relevant registration. A trademark registrant must file a declaration of use between the fifth and sixth anniversaries of the issuance of its federal trademark registration, and again when the trademark registration is renewed (between the ninth and tenth anniversaries of the issuance of the registration and every ten years thereafter). Failure to file the declaration on time or within the allotted grace period results in the cancellation of the trademark registration.

Effective **February 17, 2017**, the USPTO will employ an auditing program under which it may require a trademark registrant to submit additional information, exhibits, affidavits, declarations, or additional specimens of use in order to verify its claims that its trademark has actually been used in commerce in connection with all of the goods and services identified in the registration. The USPTO will implement the audit on approximately ten percent of the total number of declarations of use filed annually for trademarks registered for use with more than one good or one service per class. The registrations targeted in such audit will be randomly selected.

**So what does this mean for trademark registrants and applicants?** On one hand, the new rule will promote and encourage accurate declarations of use, which will permit the USPTO trademark register to more accurately reflect trademarks that are actually in use in commerce in the United States. Such accuracy will decrease costs for both trademark applicants and the USPTO, because without it, USPTO examiners and potential trademark applicants may waste time and money issuing or responding to office actions based upon existing registrations for marks that may no longer be in use. Worse, the Trademark Trial and Appeal Board and applicants may need to handle or file even more costly cancellation proceedings against such registrations in order to clear them from the USPTO register.

On the other hand, the new rule will require a trademark registrant to be more diligent than ever to be sure that it is continuously using its trademark in connection with every good and service identified in its registration. If a trademark registrant's use of its trademark for specific goods or services lapses for a period of time for non-excusable reasons, or if the registrant is simply unable to provide additional proof of use that is sufficient, an audited trademark registrant will be required to delete those goods or services from its registration for which it cannot show use. Further, if a trademark registrant fails to respond to an audit request under this new rule, its entire registration will be cancelled.

In order to avoid loss of rights under the new rule – including deletion of key goods and services from a registration or cancellation of a registration altogether – a trademark registrant should consider employing a couple of “best practices.” First, 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. Second, with its Section 8 or Section 71 filings, a trademark registrant should be careful to delete any goods or services that it no longer offers under the mark (unless such non-use is temporary).

Roetzel has experience in assisting clients with filing and maintaining trademark registrations, including filing declarations of use. Please contact one of the listed Roetzel attorneys if you have questions about your trademark or other intellectual property needs.

**Authors**

Suzanne K. Ketler, Ph.D.  
[sketler@ralaw.com](mailto:sketler@ralaw.com)

Lindsie Everett  
[leverett@ralaw.com](mailto:leverett@ralaw.com)

**Additional Contacts**

Christopher P. Reuscher  
[creuscher@ralaw.com](mailto:creuscher@ralaw.com)

Terrence H. Link II  
[tlink@ralaw.com](mailto:tlink@ralaw.com)

**Media Contacts**

Wendy Castorena  
[wcastorena@ralaw.com](mailto:wcastorena@ralaw.com)

Ashley McCool  
[amccool@ralaw.com](mailto:amccool@ralaw.com)