Nutter McClennen & Fish LLP
Attorneys at Law
www.nutter.com

USPTO Expands Ability to Request Additional Specimens and Other Information from Trademark Applicants and Registrants

November 15, 2012
Legal Update

On May 22, 2012, the U.S. Patent and Trademark Office (USPTO) published final rules that: (1) expand the ability of the USPTO to obtain specimens or other information reasonably necessary for proper examination, (2) allow the USPTO to conduct a post-registration pilot program to assess the accuracy of the register, and (3) facilitate the USPTO with verifying the accuracy of identifications of goods/services on the register. The rules took effect on June 21, 2012.

These rules allow the USPTO to request additional information from trademark applicants and owners. In particular, the USPTO can now: (1) upon request, require any specimens, information, exhibits, and affidavits or declarations deemed *reasonably necessary to examine a post registration affidavit or declaration of continued use* in trademark cases, and to assess the accuracy and integrity of the register; and (2) upon request, *require more than one specimen* in connection with a use-based trademark application, an allegation of use, or an amendment to a registered mark. In addition to the actions the USPTO can request of applicants, applicants and registrants should consider being pro active in assessing the scope of the descriptions of goods/services associated with their applications and registrations.

Two Year Pilot Program

To assess the integrity of the register, the USPTO plans to review approximately 500 registrations under a pilot program. The USPTO will randomly select registrations for which Section 8 or 71 affidavits of continued use in commerce are filed and will issue an Office Action requiring proof of use of the mark for two goods/services per class. If the owner is unable to provide the requested proof with particular goods/services, those goods/services will be deleted from the registration and the affidavit will be subject to further review by the office. Upon expiration of the two year pilot program, the USPTO may request additional specimens and information when deemed *reasonably necessary for examination* of a particular Section 8 or 71 affidavit. The request for additional information will be triggered based on an incomplete nature of a trademark owner's response rather than the length or content of the registration.

Practical Advice for Applicants and Trademark Registrants

Trademark applicants should closely consider the intended use of the goods/services at the time of filing and focus on the description of the goods/services listed in the application. This is particularly true when the application claims priority to a foreign trademark application under the Madrid Protocol, and may not have a description of goods/services drafted with U.S. laws in mind.

Registrants should also consider the *current* use of goods/services in commerce at the time of filing the Section 8 or 71 affidavits, and consult their attorney to ensure that the description of the goods/services is consistent with the use. If the trademark owner is not using all of the goods or services listed in a registration and the non-use is not excusable, the Section 8 or 71 affidavit can be filed with specimens from particular types of goods/services used, and the non-used goods/services will be voluntarily deleted from the registration. While this will not cause the USPTO

to cancel the mark, they may request additional information and/or specimens to verify the accuracy of the remaining goods or services claimed in the registration. Accordingly, owners and attorneys should be prepared to submit specimens for each class of goods/services. Depending on the outcome of this pilot program, the USPTO may issue further rules that will affect how the description of goods/services should be drafted.

This advisory was prepared by Nutter's Intellectual Property practice. For more information, please contact your Nutter attorney at 617.439.2000.

This update is for information purposes only and should not be construed as legal advice on any specific facts or circumstances. Under the rules of the Supreme Judicial Court of Massachusetts, this material may be considered as advertising.

Practice Areas
Intellectual Property