

REPORT

**TRADEMARK POST REGISTRATION AUDIT
AND SPECIMEN PROTEST PROGRAMS**

April 20, 2018

**I. Trademark Post Registration
Audit Program**

The United States Patent and Trademark Office has recently commenced random audits of trademark registrations to verify that the subject mark is in use in connection with all of the goods and services listed in the registration. The audit takes place at the time the Declaration of Use is filed. If selected to participate in the audit, an Office Action is issued requesting confirmation and additional evidence that the mark is used on selected goods and services listed in the registration. If the Registrant does not provide sufficient evidence of use for the identified goods and services, the registration may be cancelled either in whole or in part.

A. Background

The USPTO's Post Registration Audit Program was instituted in response to growing concerns that the trademark register is cluttered with registrations that cover goods and services for which the Registrant has not used or is no longer using the mark and is therefore not entitled to registration. These registrations may serve as obstacles to trademark owners with legitimate interests in registering their trademarks. During a pilot audit program instituted a few years ago, the USPTO randomly selected 500 trademark registrations for which Registrants filed six-year

declarations of use. They audited these registrations by requiring the Registrants to submit proof of use for at least two additional goods or services per class. The USPTO found that in over half of the cases selected, the Registrants did not or could not show the additional proof of use. In the interest of maintaining an accurate register free of "deadwood" (i.e. abandoned) goods and services, the USPTO in mid 2017 decided to make the program permanent.

B. Summary of the Audit Program

Registrations may be audited if Registrants file a Section 8 or 71 Declaration of Use and the registration includes at least one class with four or more goods or services, for example:

1. The registration covers the following goods: Baseball caps and hats; Pants; Shorts; Socks; T-shirts; Undergarments; (all in Class 25).

OR

2. The registration includes at least two classes with two or more goods or services, e.g.:

- Purses and suitcases (Class 18)
- Clothing, namely shirts, shorts, pants, coats and hats (Class 25)
- Financial Services (Class 36)

Once a registration is selected for audit and examined, the USPTO will issue an Office

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Action. The Office Action will have a six month response deadline from the date of the Office Action or to the end of the statutory filing period, whichever is later. This period does not include the grace period. In response to the Office Action, the Registrant must submit evidence clearly demonstrating that the trademark is used in connection with the identified goods or services.

If the Registrant is unable to submit acceptable proof of use for the noted items, the Registrant should delete those items and any other goods or services identified in the registration for which they cannot provide sufficient proof of use. Deletion of the specifically selected goods or services may result in a second Office Action requiring proof of use for all remaining goods and/or services for which proof of use is not of record.

C. Recommendations

1. Registrants should continue to take great care to review all the items in the registration for ongoing use. This has always been important because (1) it is a statutory requirement to maintain the registration and (2) failing to delete unused goods and services can complicate later enforcement actions by giving an opponent an opportunity to bring a counterclaim asserting fraud. Formerly, the existence of one good specimen per class might avoid stringent Trademark Office review of the other items in the class. This is no longer assured and failure to meet audit requirements may be fertile ground for an opponent to explore even as to assertion of other registrations owned by the same party.
2. If the number of registered goods and services covered is small, consider submitting specimens for all or most of the items listed. This may forestall any audit.
3. At a minimum, Registrants should retain copies of any candidate specimens gathered, even

if they are not initially submitted, for potential use in response to an audit.

II. Email Pilot Program for Protesting Fraudulent Trademark Specimens

On March 6, 2018, the USPTO announced an email pilot program that allows third parties to protest trademark specimens that are possibly fraudulent and not in actual use, such as digitally created, fabricated or altered specimens. The Protest must include either (1) objective evidence of third party use of the identical image without including the mark in question, or (2) the prior registration numbers and/or serial numbers of applications in which identical images of objects, mock-ups of websites, etc. all bearing different marks have been submitted to the USPTO. The Protest emails can be submitted to: TMSpecimenProtest@uspto.gov.

Emails must be received by the USPTO no later than the 30th day after publication of the mark for opposition. Emails can also be submitted at any time prior to publication. Email submissions will receive an automatic reply that indicates the email has been received and no other response will be sent to the party submitting the email. To determine the outcome of the matter one must follow the status of the application on TSDR.

The program is designed to combat doctored specimens filed by applicants who may not actually be using their marks in U.S. commerce but want to reserve rights in the mark. If it appears that an applicant has filed a use based application based on a fraudulent or altered specimen, trademark owners can take advantage of this program to challenge the application before they would otherwise have to file a formal opposition on the grounds of fraud. Similarly, if such a fraudulent application would likely bar subsequent registration, applicants can file a report to challenge the application before

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receiving a refusal from the USPTO. However, the very narrow definition of protestable specimens will likely limit the usefulness of this program.

Conclusion

The email pilot program is further evidence of the USPTO's current initiatives to maintain the accuracy and integrity of the Federal Register.

The USPTO has reserved the right to alter or terminate the program at any time based on the volume of Protest emails received as well as the operational needs of the Office.

Please contact the Oliff Trademark Group with any questions at trademarkgroup@oliff.com.

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Oliff PLC is a full-service Intellectual Property law firm based in historic Alexandria, Virginia. The firm specializes in patent, copyright, trademark, and antitrust law and litigation, and represents a large and diverse group of domestic and international clients, including businesses ranging from large multinational corporations to small privately owned companies, major universities, and individual entrepreneurs.

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