
United States Patent and Trademark Office: Post-Registration Audit Program

By Allison Strickland Ricketts

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Effective March 21, 2017, the U.S. Patent and Trademark Office (USPTO) plans to implement a post-registration audit program to obtain additional evidence of use of registered marks. The Office's notice of final rulemaking can be viewed at www.gpo.gov. The new program is intended to help the USPTO ensure the accuracy of claims that a trademark is in use in commerce in connection with the goods/services listed in the registration.

The U.S. Lanham(Trademark) Act requires the owner of a U.S. trademark registration to periodically file a declaration identifying the goods and services claimed in the registration for which the mark is in use (and deleting the goods and services for which there is no use). This Declaration of Use must be filed between the fifth and sixth-year anniversary of the initial registration of the trademark (or during a six-month grace period thereafter), and within one year before the tenth anniversary of the registration and every ten years thereafter (or during a six-month grace period). Section 8 of the law requires such a filing by an owner of a registration that issued under Section 1 (use in commerce) or Section 44 (ownership of a home-country registration from a Paris Convention country). Section 71 of the law requires such a filing by the owner of a registration that issued under Section 66 (extension of protection of an International Registration). The owner must submit with the Declaration of Use a specimen showing how the mark is currently used on one product or service in each registered class. This is true even if the registration identifies more than one product or service in each class. When a registration

identifies more than one product or service in a class, the post-registration audit program will allow the USPTO to request evidence of use on additional products or services.

The USPTO has announced its intention to issue an Office action to randomly selected owners that have filed a Section 8 or Section 71 Declaration of Use in a registration that identifies more than one good or service per class, requiring the owner to “provide additional proof of use in the nature of information, exhibits, affidavits or declarations, and specimens showing use in commerce.” It is anticipated that the Office action will require the trademark owner to supply this evidence for up to two additional items in each class. There will be a six-month period for the owner to respond to the Office action and supply the requested evidence of use. The response must include a declaration signed by the owner confirming that the additional evidence of use shows use of the mark during the statutory filing period (i.e., before the end of the grace period).

If the owner does not respond to the Office action, then the entire registration will be cancelled. This is so even though an acceptable specimen of use was filed for one good or service, unless there is time left in the grace period during which a fresh Section 8 can be filed.

If the owner cannot provide additional evidence of use for the items for which the proof of use is requested, it will be permitted to delete those items from the registration. The Office action will advise the owner to delete all goods and services listed in the registration that are not in use in commerce because the Office may issue subsequent actions requiring proof of use on some, or all, of the remaining goods and services.

TIPS:

To avoid the expense of receiving and responding to a post-registration Office action, trademark owners may wish to voluntarily provide valid specimens of use for all goods and services in the registration with the initial Section 8 or Section 71 filing. This is especially so for registrations that cover only a few products and/or services.

Trademark owners may wish to delete “synonymous” terms from a registration in order to reduce the number of items for which additional evidence of use could be required. For example, deleting the terms “T-shirts, knit shirts, polo shirts, tank tops” from a registration that already identifies “shirts,” and claiming use for only “shirts,” would not narrow the scope of protection accorded the mark. If the Section

8 or 71 Declaration of Use is filed near the end of the graceperiod, it would be prudent to preserve evidence of use of the mark for all items listed in the registration before the end of the grace period, in case the registration is selected for audit.

Primary Contacts

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