

Frozen Until March 21: The USPTO's New Evidence Requirements to Clear "Deadwood" From The Federal Trademark Register

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by Jennifer Collins



President Trump's deep freeze of regulatory actions has delayed the effective date of new rules issued by the United States Patent and Trademark Office (USPTO) to assess and promote the accuracy of the trademark register.

Marks that receive federal protection but are not actually used in commerce are known as "deadwood." Having an accurate and reliable trademark register helps avoid needless costs and burdens on the public caused by the presence of deadwood in the

Federal Trademark Registry, such as conducting use investigations, proceedings to cancel the registration or oppose the application, civil litigation, or selecting alternative marks. Because deadwood is a drag on the whole registration system, the USPTO has adopted new rules to address this issue. See Changes in Requirements for Affidavits or Declarations of Use, Continued Use, or Excusable Nonuse in Trademark Cases.

Effective March 21, 2017, the new rules will allow the USPTO to require additional evidence of use (such as exhibits, affidavits or declarations) to verify that a trademark is in use in commerce in the United States *in connection with all of the goods and/or services listed in the registration or application*. These rules apply to the examination of:

1. Affidavits or declarations of continued use or excusable nonuse filed pursuant to Section 8 of the Trademark Act; and
2. Affidavits or declarations of use in commerce or excusable nonuse filed pursuant to

Related Capabilities

- Trademark, Copyright + Advertising
- Intellectual Property Litigation

Section 71 of the Trademark Act.

This is a shift from the current practice which requires an applicant or registrant to submit only a single specimen of use or continued use in commerce per class of goods and/or services listed for Section 8 or 71 affidavits.

The USPTO took action to correct the issue of deadwood after a two year pilot program found that in 51% of the 500 registrations selected for the pilot, the trademark owners were unable to supply additional verified evidence of use on goods and/or services for which use in commerce was initially claimed.

The new rules also enable the USPTO to clear the register of marks that were never in use or are no longer in use by cancelling, in whole or in part, registrations for marks that are not in use for the goods and/or services identified in the registration. Section 8 or 71 affidavits in which the mark is registered for more than one good or service per class will be subject to random audit by the USPTO. The USPTO anticipates that it will initially conduct random audits of up to 10% of such affidavits, and may increase the percentage going forward.

To prepare for the changes in USPTO examination practice, applicants and registrants should consider taking the following actions:

1. Conduct an audit of your trademark portfolio to ensure evidence of use exists for all goods and/or services identified in the applications or registrations;
2. For goods and/or services no longer in use, amend the applications or registrations to remove those goods and/or services; and
3. Retain evidence of use for all goods and/or services listed in the applications or registrations.

Taking these actions will help prevent your valuable trademark assets from turning into deadwood to be cleared away by the USPTO.