

Practice Update

USPTO: Over Half of Applications/Declarations Studied Over-Claim Covered Goods/Services

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It has been the practice of some brand owners to include more goods in a use-based trademark application or declaration than were actually being used. Under TTAB precedent such as *Medinol v. Neuro Vasx, Inc.*, 67 USPQ2d 1205, 1209 (T.T.A.B. 2003), such over-claiming risked cancellation of the application and/or mark. The TTAB had held that “[a] trademark applicant commits fraud in procuring a registration when it makes material representations of fact in its declaration which it knows or should know to be false or misleading.” Such over-claiming became less risky after *In re Bose Corporation*, 580 F.3d 1240, 1245 (Fed. Cir. 2009), when the Federal Circuit held that “a trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the PTO.” After *In re Bose*, the USPTO began a study on the practice of over-claiming in 2012 and found that over half of the applications studied were over-claiming the covered goods.

Beginning in July of 2012, the USPTO began randomly selecting 500 registrations for which Section 8 or 71 Declarations of Use were being filed in a pilot program to assess the accuracy and integrity of the trademark register as to the actual

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use of the mark with the goods and/or services identified in the registration. Trademark owners for the 500 applications were required to submit proof of use of their marks for two additional goods and/or services per class, in addition to the specimen(s) submitted with their maintenance filings. If the response to the inquiry was insufficient, the registration was subject to further proof of use requirements to verify the accuracy of the identification of goods and/or services in the registration. The USPTO found that, through October 15, 2014, “in just over half of the registrations selected for the pilot, the trademark owners failed to meet the requirement to verify the previously claimed use on particular goods and/or services. 173 of the registrations, or 35 percent, involved deletions of the goods and/or services queried under the pilot. In another 80 registrations, or 16 percent, the trademark owner failed to respond to the requirements of the pilot and any other issues raised during examination of the underlying maintenance filing, resulting in cancellation of the registration.”

The study has resulted in four recommendations that are being debated and considered:

1. Create a streamlined non-use expungement procedure (analogous to the Canadian expungement proceedings under Section 45 of the Trade-marks Act). For example, a party who believes a trademark owner is not using its mark on some or all of the goods and/or services in its registration could file a request with the USPTO to require that the owner prove use of its mark for the goods and/or services. If the owner complies, that ends the procedure. Otherwise, any goods and/or services for which the owner has not provided the requisite proof would be deleted from the registration.
2. (A) Require specimens for all goods and/or services listed in the registration when the first Section 8 or 71 declaration is filed; or (B) Require specimens for all goods and/or services listed in the registration when the first Section 8 or 71

declaration is filed, and mandate that the specimen must be a photo showing use of the mark in conjunction with the claimed goods and/or an advertisement for the services.

3. Increase the solemnity of the declaration. For example, (1) require the trademark owner to check a box stating that he/she understands the seriousness of the oath, or (2) require statements accompanying Section 8 and 71 declarations detailing steps taken to verify use with the goods and/or services in the registration.
4. Conduct random audits of Section 8 and 71 declarations. Require that a Section 7 Request be filed (along with the required fee) to delete any goods and/or services randomly queried by the USPTO for which the trademark owner is unable to show proof of use after filing its Section 8 or 71 declaration.

The USPTO is seeking comments by email at TMPolicy@uspto.gov. Please [click here](#) for a link to the study and [click here](#) for a PowerPoint presentation related to the study.

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