

Proof of Use Programs at the United States Patent and Trademark Office and the Relation to Foreign-Based Trademark Registrations

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In recent years, the United States Patent and Trademark Office (“USPTO”) has initiated programs related to the trademark registration process that are worthy of note to foreign business owners with a current or future presence in the US market. These programs are aimed at combatting the systematic problems inherent in a common law use-based trademark jurisdiction, particularly when contrasted with civil law jurisdictions with no use requirements.

Unlike the majority of trademark offices throughout the world, the USPTO requires that marks be used in commerce in order to maintain registration. This requires both a sworn declaration that the mark is in use in US commerce and the submission of a specimen showing the mark as used for the goods or services related to it. While foreign applicants may be able to initially circumvent these use requirements through Madrid Protocol filings and filings based upon registrations from the applicant’s home jurisdiction, this circumvention is merely temporary—at some point a foreign registrant will have to prove use of the mark in the United States.

Despite the use requirement, time and again, the USPTO has found that the Principal Register is cluttered with marks not actually used in the US, whether through discontinued use or the absence of any initial use. This “deadwood” on the Register can cause legitimately filed marks to be blocked from registration, leading to costly and drawn-out cancellation proceedings between applicants and the owners of inactive marks. Further, the marks not in use make pre-filing clearance searches less accurate, as it is harder to identify potential conflicts in the American market when marks on the Register are potentially subject to cancellation for non-use.

The following two programs have been designed by the USPTO as means to combat the problems of non-use that frequently arise, whether inadvertently due to misunderstandings of US trademark practice or intentionally by bad faith filers. Both are important to keep in mind when filing a foreign trademark application, whether through a Madrid designation or national filing, and when later maintaining its registration.

Post Registration Proof of Use Program

The first program to be aware of is the proof of use auditing program recently made perma-



nent by the USPTO. See www.uspto.gov/trademarks-maintaining-trademark-registration/post-registration-audit-program. The purpose of this program is to weed out registrations that are overly broad or cover marks no longer in use in the US for all the goods and services listed. Instances of these types of registrations are more prevalent with foreign trademark owners due to their unfamiliarity with US trademark practice and requirements.

For example, in countries without use requirements it is generally beneficial to file broadly to best protect an owner’s right in the mark against third parties. As such, there may be an inclination to cover ancillary goods and services under the subsequent US registration, regardless of whether the applicant realistically intends to use the mark so broadly in the US. Although beyond the scope of this article, such an overbroad filing without a bona fide intent to use may subject the application, and resulting registration, to attack by others on the ground of fraud upon the USPTO.

In attempting to uphold the integrity of the registry, the USPTO’s audit program may randomly select for review any registration, foreign-based or otherwise, at the time of filing either a Section 8 or Section 71 declaration of use (required between the fifth and sixth year after registration and every ten years after registration). A registration may be susceptible to auditing if the registration covers one class with four or more items listed (i.e., clothing, namely, shoes, shirts, socks, and pants) or two or more classes with two or more items listed in at least two of those classes (i.e., clothing, namely, shoes and socks in Class 25 and purses and bags in Class 18).

If selected for auditing, the registrant will receive a Post-Registration Office Action.

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This Office Action will identify two items from each class and require proof of use of the mark in the US in the form of specimens for these items. Specimens may consist of, among other things, materials such as screenshots of websites advertising the services offered in connection with the mark or offering the goods in conjunction of the mark for sale, or photographs of the mark affixed to the actual goods or their packaging.

In the event that the registrant cannot prove use of the mark for the specific items selected, in response to the Office Action, it should delete all goods or services for which the mark is not currently used in the US. If the registrant only deletes the items selected by the USPTO for audit, a second Office Action will follow, requiring proof of all other items listed. Consequently, if there are items not offered in commerce that were not specifically addressed by the USPTO, being proactive in deleting those items will save both time and money. Better yet, since by filing a Section 8 or Section 71 declaration of use the registrant is acknowledging through a sworn statement that the mark is used in the U.S. for all the goods and services identified in the registration, the declaration of use should be accurate to begin with when filing.

Specimen Protest Pilot Program

Foreign parties seeking trademark protection in the United States should further be aware of a new pilot program at the USPTO, which also relates to the use of the mark in commerce. Recent trends have indicated that some foreign parties have taken to doctoring specimens of use in an attempt to bypass actual use of the mark in the US and place marks on the Register that otherwise would be refused.

The USPTO has always sought to identify specimens that appear to be altered, such as webpages with doctored dates to indicate earlier use or the addition of marks to stock images when the mark is not actually used in the US for those goods or services. However, the Office alone cannot catch all fraudulent specimens submitted, and often those best able to identify a false use of the mark on goods are competitors and other third parties with unique knowledge of the norms,

products, and services of a particular industry.

The pilot program, described at www.uspto.gov/sites/default/files/documents/Specimen%20Protests%20Email%20Pilot%20Program.pdf, enables third parties who believe a specimen is fraudulent or falsified to contact the USPTO with such information. The communication must include either objective evidence of the image at issue without the mark featured in the specimen (such as a URL showing that the actual webpage does not feature the mark, or an image showing the goods without the mark affixed) or prior application or registrations using the same website image or goods with different marks affixed to it (such as previous applications using the same stock photograph with an entirely different logo digitally printed on the image). The deadline to submit this evidence is the last day of the opposition period, although the USPTO requests submissions at the earliest possible stage of the application's examination.

Foreign applicants who are actually using their marks in the US market and who are filing use-based applications should not be overly concerned by this pilot program as they should presumably have legitimate specimens to submit without any need for alteration. However, those applicants who may be unsure of what is and is not an acceptable specimen of use are encouraged to seek local counsel.

The differences between US and foreign trademark practice easily lends itself to confusion and misunderstanding. As always, the best way to avoid issues with the USPTO is to ensure that foreign applicants have a bona fide intent to use the mark in the US for all identified goods or services when filing applications and maintaining registrations, and that they avoid tampering with specimens of use in an effort to obtain registration. The USPTO should be commended for its efforts to clean up the Register to more closely conform with the realities of the marketplace and to ensure that trademark owners comply with its rules of practice.