

The New Trademark Post Registration Proof of Use Audit Program

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In November of 2017, the United States Patent and Trademark Office (USPTO) started a new program to make sure that trademark registrations were correct and truthful—the Post Registration Proof of Use Audit.

When a trademark is filed in the United States, the owner includes a “specimen” (i.e., proof of use). To keep the registration, the trademark owner must file a declaration of use with the USPTO between the 5th and the 6th year of the registration and every 10 years thereafter. As part of the filing, the trademark owner must show how the mark is used in commerce in connection with the goods and/or services covered in the registration.

The USPTO will conduct audits at random of the declarations of use for marks registered for multiple goods or services in the same class. At this time, the USPTO is estimated to audit up to 10 percent of the declarations of use filed each year. It is believed that the percentage will increase depending on the results of the audit and the number of USPTO resources that are assigned to the project.

What is “proof of use”?

Proof of use is evidence that clearly shows how you are using your mark in commerce on the identified goods or in connection with the services in your registration.

Examples for goods:

- ✓ Photographs that show the mark on a tag or label affixed to the goods
- ✓ Hang tags or labels with the mark and the generic name of the specific goods on the tag or label
- ✓ Screen shots of webpages that show the mark being used in connection with the goods at their point of sale
- ✓ Photographs of the mark on packaging where the goods are visible through the packaging
- ✓ Photographs of the mark on packaging where the packaging identifies the specific goods included in the package

Examples for services:

- ✓ Copies of brochures or flyers where the mark is used in advertising the services
- ✓ Photographs of the mark on retail store or restaurant signs

- ✓ Photographs of the mark on service vehicles
- ✓ Screen shots of website printouts where the mark is used in the actual sale or advertising of the services

How is “proof of use” different from a “specimen”?

For goods, the criteria for proof of use is stricter than the criteria for a specimen. Proof of use requires additional evidence that demonstrates that you actively use your mark in commerce with the goods identified.

For example, the following types of specimens would not meet the criteria for proof of use:

- ✓ A hangtag by itself that does not identify the goods
- ✓ A label by itself that does not identify the goods
- ✓ Packaging by itself that does not identify or show the goods
- ✓ For services, proof of use is the same as a specimen

If you are audited, the trademark owner must respond within six months of the date of the office action. If you fail to respond to the office action in the allotted time, the USPTO will cancel the registration.

THE ACTION. The USPTO may now issue post-registration office actions requiring evidence of use on multiple goods or services for Section 8 and 9 trademark renewal affidavits.

THE EFFECT. The USPTO may cancel registrations in whole or in part where a registrant fails to provide requested evidence of use of additional goods and services listed in a registration.

LOOKING AHEAD. Owners of registrations should ensure that they can support renewal filings with evidence of use on all goods and services in the registration.

WHY. The USPTO is trying to clean and clear out the “dead wood”.

WHO. Use a trademark attorney to file your federal registrations. This will reduce the likelihood of receiving an office action and save you time and money.

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