

RAISE YOUR RIGHT HAND AND REGISTER: TWO SIGNIFICANT CHANGES IN TRADEMARK USE REQUIREMENTS

Have you filed a trademark application, statement or declaration of use, or renewal recently? If so, you may have noticed that your verified statements supporting a submission in the trademark registration process look a little different!

1) As of January 1, the United States Patent and Trademark Office (USPTO) has changed its forms to emphasize that **trademark registrants submit their affidavits or declarations under penalty of perjury**.

- It has always been the case that any untruths or concealment of relevant facts carry consequences, including the imperilment of your registration or application. Penalties for perjury may also apply, such as a fine, imprisonment for up to five years, or some combination of both.[1]
- To stress the seriousness of the document and avoid the “too long; didn’t read” signature practice, the USPTO now requires registrants to check the box next to each relevant provision as an extra acknowledgement.

KEY TAKEAWAY: We recommend you review these statements carefully for accuracy—especially statements regarding *use* of marks.

2) In addition to these formatting changes, the USPTO has instituted a more substantive measure to “clean up” the Register and ensure its integrity.

- Effective this past March 23, approximately **10% of renewal filings will be randomly chosen to undergo a specimen audit**. As part of the audit, the USPTO will check whether the specimens submitted demonstrate that the registrant’s mark is being used with all the goods and services enumerated in the registration’s identification of goods and services.[2] If the specimens do not adequately support use of the mark with each specified good or service, the USPTO will request additional supporting specimens.
- The USPTO will require registrants that cannot support their claims of use with all items listed in their identification of goods and services to delete the unsupported items. If the USPTO receives no response following its request for additional specimens, the registration will be

cancelled.

KEY TAKEAWAY: Noting these changes, trademark registrants should be prepared to provide evidence of use of marks with *all* the goods and services covered by a registration, as well as review all submissions carefully for veracity! Even unintentional misstatements can result in partial or complete cancellation of trademark registrations and losses to a trademark portfolio.

??[1] Trademark Manual of Examining Procedure (TMEP) § 1604.05 (citing 37 C.F.R. §§ 2.161).

?[2] 18 U.S.C. §§ 1101, 1621.



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Dana provides high level, strategic counseling to her clients in Silicon Valley and across the globe. Her focused practice includes trademark audits, portfolio analysis, domestic and international clearance, registration and enforcement, domain name disputes, licensing. Dana handles trademark disputes, including opposition issues and opposition and cancellation proceedings before the Trademark Trial and Appeal Board of the United States Patent and Trademark Office. She has counseled a wide array of clients from start-ups to well-known and established companies in various industries including consumer electronics, semiconductor, banking, consumer products, music and entertainment.

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