

PUBLICATION

WINTER IS COMING... and the PTO Will Be Pruning Your Deadwood!

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The U.S. Patent and Trademark Office has a new random audit procedure for trademarks aimed at removing deadwood from the Register.

The random audit is the result of a multi-year pilot program launched in 2012 to assess the accuracy and integrity of the Trademark Register as to *actual use of marks with the goods/services* listed in the registry.

Under the pilot, 500 trademark registrations with six-year Section 8 or Section 71 declaration of use filings were randomly selected for additional proof of use. In the pilot investigation:

- 51 percent of registrations were unable to verify previously claimed use
- 35 percent of registration owners deleted goods/services for nonuse
- 16 percent failed to respond to pilot Office actions and were cancelled

The pilot ended, but the dismal showing indicated a need for ongoing measures to encourage registration owners to file accurate declarations of use.

Under the new rules, trademark owners will need to heed the motto of the House of Stark. As the meaning behind the words "Winter is Coming" is one of warning and constant vigilance, so the trademark owner should make sure *now* that goods and services are accurately identified in a registration.

The U.S. PTO will conduct random audits of Section 8 Affidavits and Declarations of Continued Use or Excusable Nonuse where the mark in question is registered for more than one good or service in a single class. Trademark owners selected for an audit may be required to provide additional proof of use of their marks in commerce. Further, marks should be used as originally registered, because a modified mark is not entitled to the same protections as the original mark. No new spaces, hyphens, or font changes.

For additional information on maintaining the registration of your trademarks or on how the new rules may affect your registrations, please contact any member of the Firm's Trademark and Branding Group.