

March 1, 2021

## **Beware of Trademark Registration Audits and Other Issues of Nonuse!**

More and more trademark registrations are being audited by the U.S. Patent and Trademark Office (“USPTO”) to confirm that the trademark is actually being used with all of the goods and/or services listed on the trademark registration. An audit may result in the USPTO refusing to renew your registration or demanding deletion of certain registered goods/services. This is a good opportunity to remind you of how a trademark registration is properly maintained.

### Trademark Registrations Must Be Maintained

Every federally registered trademark must be maintained by filing a Section 8 declaration of use and/or Section 15 declaration of incontestability between the fifth and sixth anniversaries of the registration, and a Section 8 declaration of use and a Section 9 renewal at 10 years, with subsequent 10-year intervals. These filings must be accompanied by evidence of your actual use of the trademark (called “specimens”). A specimen is an example of how the trademark is used in association with the registered goods/services. Examples of specimens for goods are tags, labels, instruction manuals, containers, photographs that show the mark on the actual goods or packaging or displays associated with the actual goods at their point of sale. Examples of specimens for services are signs, photographs, brochures, website printouts or advertisements that show the mark used in the actual sale or advertising of the services.

At the time of renewal, the trademark owner must actually be using each and every good and/or service listed on the registration certificate. If not, they should be deleted.

### About the USPTO’s Audit Program

The USPTO randomly selects trademark registrations for audit to help ensure that the federal register has only marks that are actually being used. The audit program focuses on registrations that include at least one class with four or more goods and services or at least two classes with two or more goods or services. We have noticed that submitting one specimen per class, with many goods/services in that class, may be sufficient in some registrations, while risky in others. If the trademark registration is audited, the trademark owner will be required to prove use of the mark for additional goods/services in the registration or to delete them.

### New USPTO Fees

Earlier this year, the USPTO implemented new fees for requests to delete goods/services or classes from valid federal registrations during the maintenance period or during an audit. The fee is \$250 per class or specific item (with some minor exceptions), and this fee must be paid whether a trademark owner requests or is required to delete good/services.

### How To Avoid These New Fees

Be diligent and keep your records regarding use of the registered trademark in commerce with registered goods/services. Examples of such evidence are photographs of each good with marks, printouts of websites with the URL and the date of printing, and copies/photos of advertising or promotional materials advertising registered services. If some

goods/services are no longer in use, you may be entitled to be excused for temporary nonuse, especially if certain circumstances are outside of your control.

### Scam Letters

Scammers are rampant and offering their renewal services for high prices and often do not include filing Section 15 declarations of incontestability or reviewing appropriate specimens. While it is widely known that failure to file Section 8 declarations of use will result in cancellation of the registration, scammers frequently file only Section 8 declarations of use, without filing Section 15 declarations of incontestability as well. Section 15 declarations of incontestability are very important in perfecting and enforcing your rights because its acceptance forecloses certain challenges to your registration.

### Keep Your Attorney Informed On Your Trademark Use

If you intend to change the way you use your mark or the goods and services you offer, let your attorney know, in case action needs to be taken in regard to your trademark registration. Some changes, such as changing the wording of your mark or the way it appears, may cause you to lose rights in your trademark registration entirely. We recommend running such changes by your attorney before you implement them.

And of course, do not file your maintenance papers with the USPTO without contacting us first. Peacock Law has dealt with and won many audits, and we'd be happy to assist you with your trademarks.

If you have questions or need assistance with the registration, contact your attorney. If you are not sure who that is, you may contact our trademark specialist Svitlana Anderson, Esq. [sanderson@peacocklaw.com](mailto:sanderson@peacocklaw.com).