

Publications

Client Alert: More Changes are Coming to Trademark Practice: Specimens and Declarations

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Trademarks

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We recently reported changes to the Trademark Office and Trademark Trial and Appeal Board (Board) fee schedule and revised rules of procedure that went into effect January 14, 2017 for both new and pending cases. [Click here for more information](#). More changes are going into effect at the Trademark Office that may increase the vulnerability of trademark registrations both during prosecution and after registration.

Specimens

To maintain or renew a United States trademark registration, the registrant must file a Declaration of Use declaring the mark is in use in commerce in connection with **each** item in the registration. Items not in use must be deleted. The registrant currently must only provide one specimen of use **per class**. For example, if the registration claims use of the mark in connection with:

Class 25 "Shirts, Hats, Socks, Footwear, Pants," and

Class 35 "Retail store services featuring clothing; Wholesale services by direct solicitation by sales agents in the field of clothing,"

the registrant is declaring use of the mark with five individual goods in class 25 and two types of services in class 35. However, the registrant will only provide two specimens of use, one for each class.

While the filing requirements will remain the same, beginning February 17, 2017*, the Trademark Office will be permitted to request proof of use for **each good or service claimed** or any other information, exhibits, affidavits or declarations as may be "reasonably necessary for the USPTO to verify the accuracy of claims." The goods and/or services for which the registrant timely provides proof of use of the mark in commerce in the United States will remain in the registration, whereas, the goods and/or services for which the registrant does not provide

proof of use will be deleted from the registration. Failure to respond to the request for information within six months of the request will result in cancellation of the **entire registration**.

Accordingly, we now **strongly** recommend that when gathering specimens for filing a Declaration of Use, registrants also collect and preserve specimens of use for **each** good or service claimed in the registration. This will be especially important for registrations based on a foreign registration. Because there is no proof of use requirement for such applications prior to the issuance of a registration, these registrations are likely to be examined more thoroughly during maintenance and renewal to ensure that they accurately reflect the market reality.

Declarations

The requirements for signing a Statement of Use to obtain a registration or a Declaration of Use to maintain or renew a registration have also changed. The signatory has always been attesting to several statements upon signing these documents. The declarations will now require that the signatory **individually** affirm several statements by clicking a box by each statement. An example is shown [here](#).

Because an owner must affirmatively check the box for each attested statement, it is even more important that the signatory be the applicant, registrant, or someone that has **firsthand knowledge** about the trademark, rather than the attorney of record, for a few reasons.

First, if the registration or application is challenged, the challenger may allege that the attorney who signed (and clicked each box) had no personal knowledge of the facts in the declaration. Usually an attorney obtains the information contained in a declaration from their client. Simply asking the client prior to signing may not be enough to constitute the requisite "inquiry reasonable under the circumstances." Failure to satisfy this standard of inquiry could void the application (or any resulting registration), as the declaration warns.

Second, if a factual statement contained in the declaration is at issue in a challenge (for example whether the goods bearing the mark were in use in commerce in the US), the attorney of record who signed the declaration may become a witness in the litigation. Under various state rules of professional conduct, attorneys appearing as witnesses (and in some cases their firms) may be disqualified from representing the client in any litigation that may ensue. An attorney of record becoming a witness may also lead to the disclosure of attorney-client privileged communications.

For these reasons, we strongly recommend that the applicant/registrator or a person with direct knowledge of the issue sign these declarations and make the affirmative statements by clicking the boxes.

If you require assistance with a filing at the Trademark Office or another trademark matter, please feel free to contact an attorney in the Vorys Trademark Group.

**UPDATE: The effective date for this new rule has recently been delayed until March 21, 2017.*