



Trademark Owners Should Proactively Audit Goods and Services Coverage

A trademark registration issued by the U.S. Patent and Trademark Office (USPTO) is a valuable asset to a trademark owner in view of the substantial statutory benefits, advantages, and remedies it provides. A federal registration provides statutory notice to the public of the trademark it represents and the USPTO maintains a register of all trademark registrations. In its role as gatekeeper, the USPTO strives to ensure the integrity of the register and to clear away any “dead wood” registrations for trademarks that have been abandoned. The USPTO views its gatekeeper role as a benefit to the public in that the removal from the trademark register of registrations for abandoned trademarks (1) reduces the unnecessary blockage of future trademark applications and (2) maintains the integrity of the register to provide notice of existing trademark rights to the public.

In recent years, the USPTO has enhanced its gatekeeper oversight of the trademark register in further ensuring that marks are actively and currently being used in connection with the goods and services listed in the registrations. The USPTO will occasionally conduct an audit and require the registration owner, at the time of renewal, to provide evidence of the current usage of the mark on all of the goods and services listed in the registration. This goes beyond what is normally provided in the specimen for a representative item from the goods and services listing. If the registration owner fails to provide evidence of current usage of the mark on particular items in the goods and services listing, then such items are deleted from the registration.

Trademark owners should be aware of recent federal legislation and USPTO fee changes that may have an impact on their registrations if such registrations list goods and services that are not currently marketed under the trademark. The

Trademark Modernization Act of 2020 (TMA) provides procedures to challenge applications and registrations that inaccurately claim use of the mark. In particular, the TMA provides an interested party with procedures to petition the USPTO to expunge (remove) or reexamine a registration for a trademark that has not been fully used in commerce as statutorily required. As an example, a registrant's non-use of the mark for particular goods or services listed in the registration can subject it to a challenge under the TMA procedures. The TMA will be implemented by December 27, 2021.

The USPTO has implemented a fee (\$250 per class) for requests by registration owners to delete goods or services from their registration during the renewal of the registration or after an audit of the registration by the USPTO. However, the fee is not imposed in deleting goods or services from one's registration if the change is made before the time that the renewal is submitted.

Key Takeaway

Registration owners should be proactively incentivized to conduct their own internal audit of the goods and services listed in their trademark registration prior to any upcoming renewal period to determine whether any goods and services that are not currently marketed under the trademark should be deleted from the registration.

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