Trademark Pilots

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Pilot case study: Integrity of the Trademark Register

• The Trademark Register functions to give notice to businesses as to what trademark rights already are claimed

• New legal development in 2009 called into question the accuracy of the Register as a reflection of marks actually in use

• Mixed views on whether and to what extent changes should be made to address the issue
Post Registration Pilot to assess accuracy of the Register

• Before making changes, implemented a pilot program to assess degree of inaccuracy of the Register
  – Randomly selected 500 representative trademark registrations to audit
  – Required owners to verify ongoing use of the trademark for selected goods/services in the registration
Post Registration Pilot rulemaking considerations

• NPRM for permanent increased USPTO authority to require additional evidence of ongoing trademark use
• Concerns expressed about burden on users from increased authority
• NFRM added a “sunset” to make the increased authority temporary only for the pilot, allowing for review of pilot results prior to any permanent change
Post Registration Pilot implementation

• Determining number of cases to audit, randomization and representative sampling
• Procedures for audits and followup
• How to measure results
• How to collect and record audit data
• Staffing for new workload
• Staff training and consistency
• Communications plan for the pilot
Results of Post Registration Pilot

- USPTO interim and final reports on pilot
- For more than half of the audited trademark registrations, the owner was unable to verify the actual use of the mark for the goods/services queried
- USPTO roundtable to discuss pilot results and next steps
- Pilot results brought about consensus for USPTO to make changes to improve accuracy of the Register
Post pilot rulemaking & permanent program

• Another NPRM for permanent increased USPTO authority to require additional evidence of ongoing trademark use
• Random audit program made permanent
• Public support due to pilot results
• Other measures also implemented to improve accuracy of the Register; more on the way
Other USPTO trademark pilots

• Specimen protests pilot program
• Technology evolution registration amendments pilot program
• Expedited cancellation TTAB pilot program