



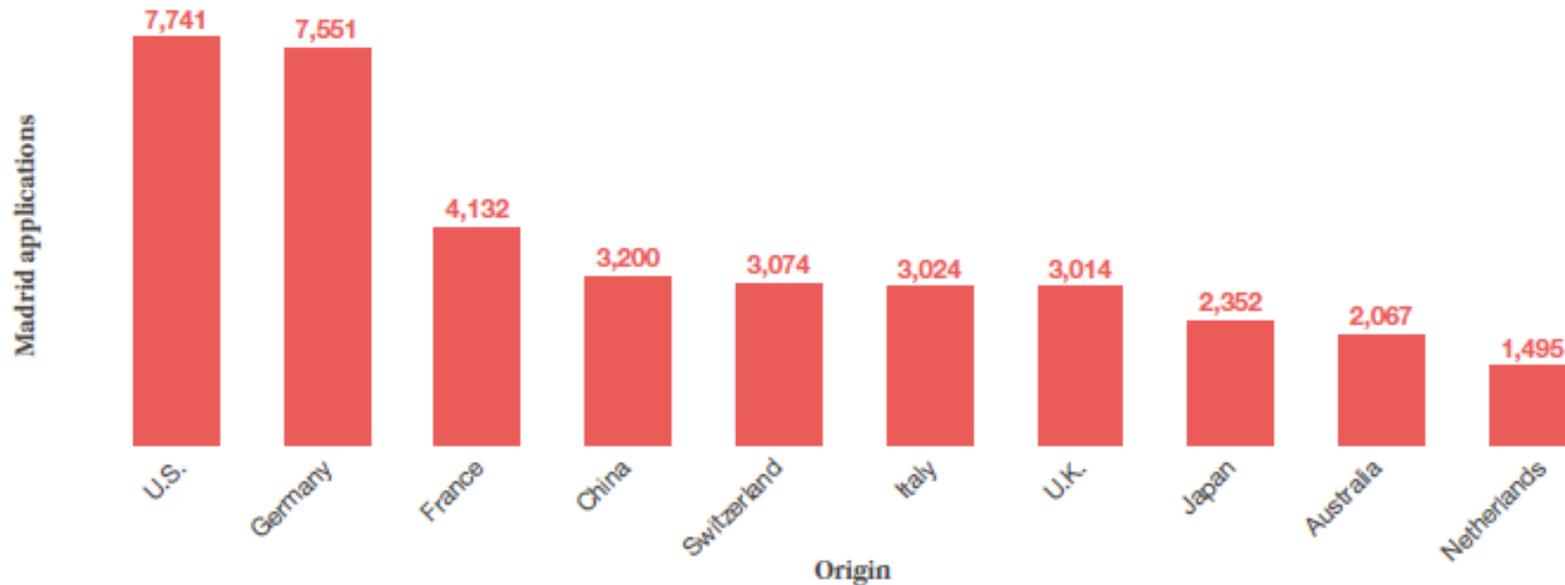
# **International IP Rights: Tips and tricks for international trade mark applications**

FICPI 17<sup>th</sup> Open Forum  
Venice, Italy  
October 27, 2017



# International Applications Filed by US Applicants

International applications for the top 10 origins, 2016

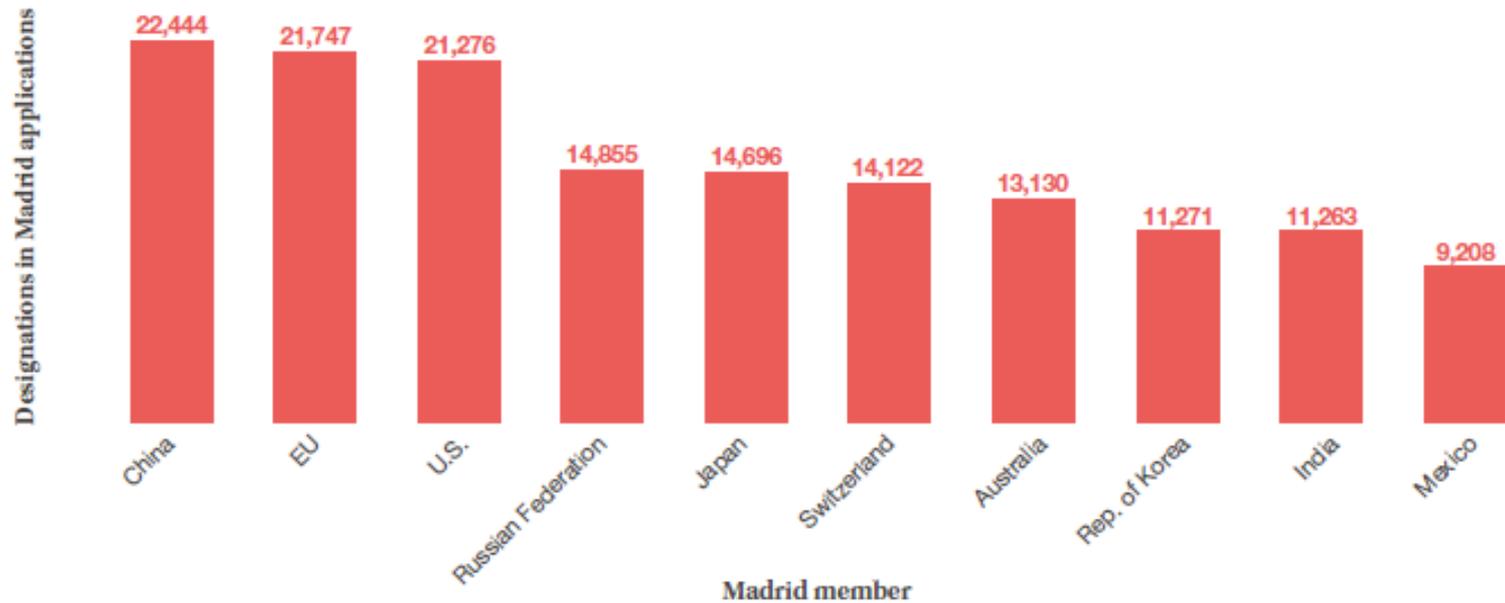


Source: WIPO Madrid Yearly Review, 2017 International Registration of Marks; [www.wipo\\_pub\\_940\\_2017.pdf](http://www.wipo_pub_940_2017.pdf)



# International Applications Designating the US

Designations in international applications for the top 10 designated Madrid members, 2016



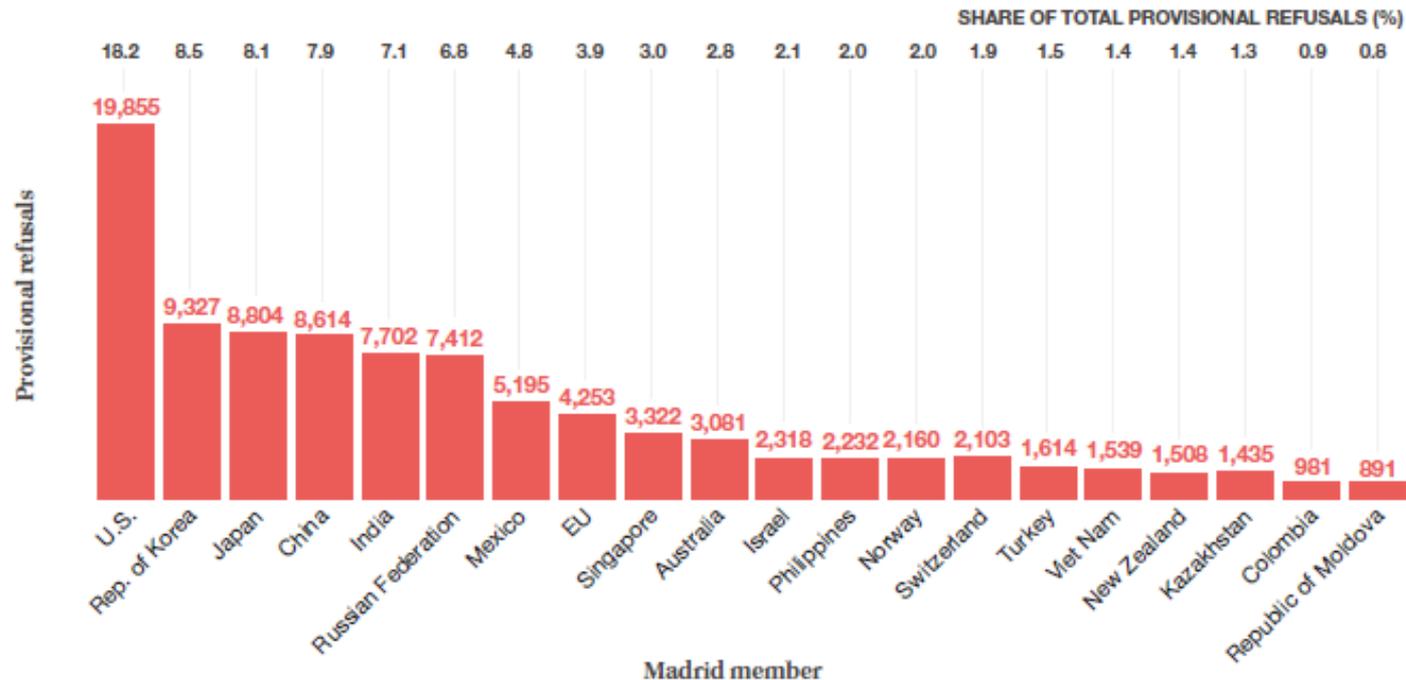
Source: WIPO Madrid Yearly Review, 2017 International Registration of Marks; [www.wipo\\_pub\\_940\\_2017.pdf](http://www.wipo_pub_940_2017.pdf)



# US = Top Issuer of Provisional Refusals

Provisional refusals of designations by selected designated Madrid members, 2016

**The U.S. and the Republic of Korea issued the largest numbers of provisional refusals of designations in 2016.**



Source: WIPO Madrid Yearly Review, 2017 International Registration of Marks; [www.wipo\\_pub\\_940\\_2017.pdf](http://www.wipo_pub_940_2017.pdf)



# Provisional Refusals: Identification of Goods/Services Issues

- Identification must be: “specific, definite, clear, accurate, and concise”
- Usually acceptable to USPTO if it:
  - 1) Describes the goods/services so that an English speaker could understand what the goods/services are
  - 2) Meets the *standards* (not necessarily the language) set forth in the US ID Manual
  - 3) Is not a class heading, and
  - 4) Is in the correct class - no language that makes classification difficult to determine or ambiguous



# Provisional Refusals: Identification of Goods/Services Issues

- USPTO is notorious for requiring specificity in all applications
- Complicating factor for Madrid extensions: not possible to transfer goods/services between classes or add a class
- If clarification required by the USPTO reveals certain goods/services should be reclassified, the items are deleted
- Example: “plastic film” in Class 16 = indefinite as it may include goods in multiple classes. If amended to “plastic film for use in laminating paper,” the goods will be deleted because they belong in Class 17
- Only exception: Receipt of a classification correction from WIPO



# Provisional Refusals: Identification of Goods/Services Issues

## Recommendations:

- Review U.S. Acceptable Identification of Goods and Services Manual (“ID Manual”) <https://tmidm.uspto.gov/id-master-list-public.html>
  - Listings in ID Manual will be accepted by USPTO
  - ID Manual listings are not exhaustive; serve as a guide
- Take time to craft identifications for US extensions that accurately reflect the applicant’s goods/services of interest and intent to use, and will also be acceptable to USPTO examiners



# Post-Registration Issues: Section 71 Declaration of Use

- Requirement for all Madrid US extensions
- Due:
  - 1) between 5<sup>th</sup> and 6<sup>th</sup> anniversary of the date of registration/  
protection in the US; *and*
  - 2) within the year before the end of every 10-year period  
after the date of registration/protection in the US
- Specimen of use required for only one good or service per class, but Declaration states that under penalty of perjury Registrant is using the mark on *all* of the listed goods/services



# Post-Registration Issues: New USPTO Random Audit Procedure

- 2-year pilot program – launched July 2012
- Purpose: Assess accuracy and integrity of the Trademark Register as to actual use of marks for the goods/services listed in post-registration Declarations of Use
- 6-year Declaration of Use Filings (Section 8 or Section 71)
- 500 registrations randomly selected
- Required to submit “proof of use” for additional items
- 51% (253 registrations) – failed to verify the claimed use
  - 35% - deleted the goods/services queried
  - 16% - failed to respond and were cancelled



# Post-Registration Issues: New USPTO Random Audit Procedure

- New rule effective March 21, 2017
- Random (computer-generated) selection of registrations that have a post-registration Declaration of Use filing
  - Single-class registrations -- at least 4 goods/services
  - Multi-class registrations -- at least 2 classes have at least 2 goods/services
- Approximately 10% of post-registration Declaration of Use filings each year -- may increase
- After Declaration of Use filing, Office Action issues requiring proof of use for 2 additional items in each class



# Post-Registration Issues: New USPTO Random Audit Procedure

## Response to initial Office Action:

- Acceptable proof of use provided for queried items - **or** - queried items deleted **and** specimens of record qualify as proof of use for any remaining items  
→ **Notice of Acceptance**
- Queried items deleted or unacceptable proof of use is provided for queried items, **and** additional items remain in the registration without acceptable proof of use  
→ **second Office Action** requiring proof of use for all items in the registration



# Post-Registration Issues: New USPTO Random Audit Procedure

## Response to second Office Action:

- Acceptable proof of use provided for queried items - **or** - queried items deleted **and** specimens of record qualify as proof of use for any remaining items → **Notice of Acceptance**
- Some queried items deleted **or** unacceptable proof of use provided for some items → **Notice of Partial Cancellation\*** and **partial Notice of Acceptance**

\*Petition Option (within 6 months of Notice of Partial Cancellation)  
- to review Examiner's refusal of proof of use; or  
- to invoke "supervisory authority" with facts supporting that providing proof of use is "unduly burdensome"



# Post-Registration Issues: New USPTO Random Audit Procedure

## No Response to initial Office Action:

- After expiration of the statutory period for filing the Declaration of Use, the registration is **cancelled in its entirety**
- If time remains in the statutory filing period, Registrant may file a **new Declaration of Use** with new filing fees, but the new filing will also be subject to a full audit (i.e. all goods/services)



# Post-Registration Issues: New USPTO Random Audit Procedure

## Recommendations:

- Be prepared to provide evidence of use for all goods/ services in each class when filing Section 71 Declaration of Use
- Keep accurate records of use of each good/service
- Review the sufficiency of evidence of use
- Consider submitting specimens of use for all goods/ services in each class to avoid audit Office Action



# Top US Tips & Tricks

- Tailor US extension with US use-based system in mind
- Carefully craft identification of goods/services to try to meet USPTO examination standards
- Maintain records of actual use in the US and be prepared to file proof of use every 5 years



# Thank you!