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Intellectual Property Alert

TTAB Cancels Registrations for Fraud When Registrant Does Not Use the Mark on *All* of the Goods Listed in its Renewal

Unlike some foreign jurisdictions, US law requires actual use of a trademark prior to affording protection for that mark. Accordingly, a trademark applicant must actually use its mark in connection with each of the goods or services listed in its application before it will be allowed to register. In addition, as part of the renewal process, applicants must submit Declarations of Continued Use (Section 8), certifying that the applicant is still using its mark with each of the goods and services listed in the registrations. This can be a perilous trap for the unwary.

In two recent rulings, the Trademark Trial and Appeal Board (TTAB) cancelled entire registrations for fraud simply because the application incorrectly indicated that the registrant had used their mark in connection with EACH of the goods listed in their registration.

In both *Herbaceuticals, Inc. v. Xel Herbaceuticals, Inc.* (No. 9204512 (T.T.A.B. March 7, 2008) (precedential) and *Sierra Sunrise Vineyards v. Montelvini, S.P.A.* (No. 92048154) (T.T.A.B. September 10, 2008) (non-precedential), the TTAB cancelled registrant's entire registration. In each case, the TTAB found that filing a false Declaration of Continued Use claiming use on all the goods in the registration, when in fact each registrant was only selling some of the goods in the US, constituted a fraud on the USPTO and required cancellation of the registration. The TTAB rejected proffered defenses of inadvertence, confusion by foreign counsel, and lack of intent to defraud. In *Sierra Sunrise*, it rejected the claim that extensive advertising constituted use in the US. The TTAB found that without sales of each good listed, registrant had not used the mark in commerce.

Practice Tip: Before seeking registration or renewal in the US, require that your client investigate its actual use of its mark in the US. Then require that it confirm in writing to you that it is indeed making use of the mark on all of the goods/services in the application or registration prior to filing a Statement or Declaration of Use. If necessary, delete any missing goods/services before filing.

If your client is seeking to extend its rights in the US under the Madrid Protocol and by modifying its application in the US it would make the international registration vulnerable elsewhere, we recommend filing a separate US application. This will, of course, affect your client's claims of priority.

Please contact the attorneys in our Intellectual Property Department if you have any questions, or if we can be of any service.

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