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Overinclusive Recitations of Goods and Services Can Weaken Your U.S. Trademark Rights

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Clients who seek registration of marks in the U.S. and/or file maintenance documents in the U.S. based on the "defensive" filing strategy used in many jurisdictions around the world should adjust their strategy for the U.S.

U.S. trademark law ***strictly requires*** that U.S. trademark registrations be tied to use of a particular mark for goods/services in U.S. commerce. *See* 15 U.S.C. § 1051(a)(1), (a)(3)(C). While non-U.S. companies can secure a registration based upon intent-to-use, this requirement importantly includes a specific *bona fide* intent to use the mark on **each and every** good and service listed in a U.S. application. *See M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1897–98 (Fed. Cir. 2015) (affirming TTAB; *bona fide* intent must be "firm" and supported by objective evidence as to the goods/services recited in the application); *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2008–09 (TTAB 2015) (sustaining opposition for lack of *bona fide* intent to use the mark on the goods identified in the application).

When a maintenance document is filed in a U.S. registration, **each and every** good and service listed in that registration must be in current use in the U.S. *See* 15 U.S.C. § 1058(b)(1)(A) and(B). It is wholly irrelevant that the U.S. registration was derived from a broad International Registration or based upon a home country registration which allowed broader recitations. The U.S. application or designation must **only** be for the goods/services that are in use/will be in use in the U.S., and you should maintain documentation that proves this intention. The U.S. does NOT recognize the ability to hold "defensive" registrations. However, U.S. courts generally grant broader protection than "just" the goods/services identified in a registration. That is, a U.S. court (or the Trademark Trial and Appeal Board) reviewing a matter of likelihood of confusion considers factors like how closely related the respective goods/services are and whether the trademark owner is likely to expand into the goods/services offered by the second-comer. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors for likelihood of confusion, including "the similarity or dissimilarity and nature of the goods or services as described in an application or registration" and "the likelihood that the prior owner will bridge the gap"); *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (articulating likelihood-of-confusion factors, including the proximity of the products and the likelihood that the senior user will expand into the junior user's market). Further, the U.S. recognizes so-called common law rights based upon use of a mark for particular goods/services, regardless of whether a federal trademark registration covers those goods/services. *See* J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 4:1 (5th ed. 2019) ("Trademark ownership in the United States is acquired by use, not by registration. Federal registration does not create the trademark right; it only confers procedural and substantive advantages."); *See also* 15 U.S.C. § 1125(a) (Lanham Act § 43(a)) (providing a cause of action for infringement of unregistered marks based on use in commerce).

Remember: Use of the mark for some goods/services in a particular class is **not** sufficient for proof that there is a *bona fide* intent with relationship to ALL of the goods/services in that class and/or to maintain all goods/services in an existing registration.

The fact that an owner of a U.S. registration (based upon a home country registration or as an IR designation) has 3 years from the date of registration to commence use and the first maintenance document proving use in the U.S. is not required until the 6th year of registration does NOT excuse a lack of *bona fide* intent. *See Société des Produits Nestlé S.A. v. Cándido Viñuales Taboada*, Opposition No. 91232597 (TTAB Aug. 5, 2020) (an IR holder must have, at the time of filing, a verified *bona fide* intention to use the mark in U.S. commerce, an effort to reserve rights is not sufficient); *Honda Motor Co., Ltd. v. Friedrich Winkelmann*, 90 USPQ2d 1660, 1662 (TTAB 2009) (Applicant relying on a home country registration "must … verify … that he has a *bona fide* intent to use the mark in U.S. commerce" and applying the same objective *bona fide* intent analysis as under § 1(b)).

Special Considerations for International Registrations

Many international clients add the United States to their global trademark coverage using the Madrid System. The quick "click" system can be deceptively easy. For the U.S., you must include Form MM18 (E) which is a *sworn* statement that there is a *bona fid*e intent to use the mark in U.S. commerce. *See* https://www.wipo.int/documents/d/madrid-system/docs-en-form_mm18-editable1.pdf.

When making a U.S. designation in a Madrid filing, use the opportunity to narrow the recitation to goods/services of interest and for which there is a *bona fid*e intent to use the mark, at least for the U.S. designation.

When Filing a National Application in the U.S.

Many non-U.S. clients who do not use the Madrid system for protecting their mark in the U.S. still use their existing applications/registrations to determine the recitation for the U.S. STOP! The recitation for the U.S. application should be based upon the specific goods/services that the Applicant has a *bona fide* intent to offer in the U.S.

The mere fact that the home country registration has a broad list of goods/services does not mean that all of these goods/services should be included in the U.S. application. The U.S. application can be for any portion of the goods/services, as long as there is the requisite *bona fide* intent-to-use the mark for the goods/services.

How Narrow is Narrow Enough?

As a general rule, the USPTO (including the TTAB) and U.S. courts broadly construe words with common commercial names. For example, if the goods are "pants," there is no requirement to identify "women's pants" and/or "men's pants" and/or "children's pants." The phrase "pants" can be adopted—even if only one of these kinds of pants are being sold in the U.S. Similarly, a word like "shirts" would be deemed to be sufficient to cover "blouses," "short-sleeved shirts," "knitwear shirts," "men's shirts," etc. Naturally, if a specific good is very important to a client, it is perfectly acceptable (and even recommended) to add that specific item. For example, if a client's key product is dressy blouses, they may choose to adopt a recitation such as "clothing, namely, shirts and blouses."

Document Bona Fide Intent

If another party challenges your U.S. application or registration, adversaries (and the tribunals to whom the adversaries complain) will look for objective, contemporaneous proof of intent or use at the time of the U.S. application or designation. *M.Z. Berger & Co., supra* (lack or documentary evidence related to demonstrate a genuine commercial intent was indicative of no *bona fide* intent). Useful examples of what might prove such intent include: a U.S.-specific product or service roadmap, budget or board approval for a U.S. launch, distributor or reseller agreements or emails mentioning U.S. distribution, U.S.-targeted marketing plans, prototype or packaging work tied to U.S. commercialization, or filings/communications related to U.S. regulation or compliance. *See* McCarthy, *supra* § 19:22 (types of objective evidence probative of *bona fide* intent to use a mark in commerce, include product plans, marketing plans, promotional materials, distributor agreements, budgets, internal documents, and other evidence demonstrating concrete steps toward commercialization). Oral statements are helpful, but business documents are the strongest evidence and often decide disputes. The more specific these documents are and the more closely tied to the mark in question, the better the position will be if the client's application or registration is challenged by an interested third party.

Overinclusion: More Can be Less

Overly broad identifications commonly cause trouble in several ways:

(1) When you want to enforce your rights, you may be in a precarious position asserting a registration that could have flaws (such as lack of *bona fide* intent at the relevant time);

(2) In legal proceedings, the other side may secure deletions for unsupported goods or services

and thereby gain a strategic advantage;

(3) If the other side can prove that the overinclusive recitation was fraudulent, it may be able to delete WHOLE class(es) of goods/services (even if there is use for some of those goods/services) and the statutory benefits of registration as to those classes; and

(4) When filing maintenance documents, the USPTO's audit and Trademark Register "cleanup" efforts can force owners to prove use for multiple goods/services (and the audit targets goods/services for which there is least likely to be proof) or remove items from the registration. The audit process can be arduous, time-consuming and expensive.

Fraud: A Caution

An opponent seeing a laundry list of goods/services may very well assert a claim of fraud when attacking such a registration. Specifically, such a party may allege (if it has a sufficient basis) that a statement to the USPTO was knowingly false and made with intent to deceive. A party challenging a trademark registration may assert a claim of fraud claiming there is a knowing false statement of fact made with intent to deceive the USPTO in a USPTO filing. *See* 15 U.S.C. § 1064(3) (fraud as a ground for cancellation can be used at any time, even after many years of registration); *See also* McCarthy, *supra* § 31:41 (discussing fraud in procurement and maintenance of registrations). The Board has repeatedly cited a case from its reviewing court that "fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application." *In re Bose Corp*., 580 F.3d 1240, 1243 (Fed. Cir. 2009). *See Chutter, Inc. v. Great Management Group, LLC*, 2021 USPQ2d 1001 (TTAB 2021) (Registrant's counsel knowingly filed false statements with regard to incontestability which the Board held subjected the subject registration to cancellation. The Federal Circuit reversed due to the specifics of the case.) While fraud is not easy to prove, when proven it can be fatal to the application or registration *with no time limits for such an assertion*.

Fraud allegations are taken very seriously by the Board and its reviewing court and can have severe consequences. While current case law requires proof of *intent* to deceive (i.e., that fraud is not established by mistake or poor record-keeping alone), there can be very real consequences even in connection with being targeted with a claim of fraud. Also, the allegation itself can increase costs, risks and exposures. Of course, a tribunal can always find that an application or registration tainted by fraud is completely void (and thus, the owner loses all of the benefits of that registration, including any priority and/or constructive first use dates).

The Trademark Trial and Appeal Board has held that entire classes of goods/services can be canceled where one or more items recited in that class were deemed to be included fraudulently. *See Univ. of Ky. v. 40-0, LLC*, 2021 WL 839189, at *10 (TTAB 2021) (citing *Meckatzer Lowenbrau Benedikt Weiss KG v. White Gold, LLC*, 2010 WL 1946273, at *3 (TTAB 2010) and *G&W Labs. Inc. v. GW Pharma Ltd.*, 2009 WL 226025, at *2 (TTAB 2009)). ("Fraud as to any goods in a single class

renders [a registration] void as to all goods in that class, so fraud based on nonuse cannot be cured by deleting some goods from a class.") This can be a very serious consequence—especially if the client intends to rely on its priority date or a constructive use date (as of the U.S. filing date) as a basis to prevail in a priority dispute over a particular trademark.

Best Practice: Carefully review each and every good or service identified in all U.S. applications and make a further careful review with each maintenance filing to ensure that the same meet the requirements of U.S. practice as explained above. If there are existing applications or registrations that might be targeted by the USPTO and/or an interested third party: cull the recitations now!

USPTO and Overly Broad Recitations

Maintenance Fee Audit Program

The USPTO continues to introduce more procedures to try to ensure that only marks for goods/services that are entitled to a U.S. registration remain on the Register. Several years ago, the Post-Registration division of the USPTO commenced an audit program (for maintenance documents). This post-registration audit program tries to ensure that trademark registrations remain limited to goods and services for which the mark is actually in use in U.S. commerce. Under this program, which began as a pilot in 2017 and is now permanent, the USPTO may audit a registration after a Section 8 or Section 71 maintenance filing (i.e., Declaration of Continued Use) and require the Registrant to submit additional specimens showing current use for selected goods or services. Failure to provide acceptable proof of use can result in mandatory deletion of goods or services, additional fees, or cancellation of the registration if statutory maintenance requirements are not met. *See* https://www.uspto.gov/trademarks/maintain/post-registration-audit-program. Being subject to this audit process, and then having to delete goods/services, could also signal to an interested third party that there could be a potential fraud issue associated with a particular registration.

Application Fee Surcharges

In 2025, surcharges for non-complying and lengthy recitations were added to the application filing structure, in part to discourage overinclusion in national applications. Even if only one class uses a custom recitation (i.e., one not *exactly* from the ID Manual) an extra fee of $200 *per class* is exacted. Custom recitations are also limited to 1000 characters, after which further fees are added to the application fee. The USPTO previously announced that these charges will be introduced into the Madrid System at a future date, so using the IR system and designating the U.S. will no longer be a way to avoid these potentially high fees.

Reexamination and Expungement Proceedings

In December 2021, following enactment of the Trademark Modernization Act of 2020, the USPTO introduced expungement and reexamination proceedings to provide faster, less costly mechanisms for third parties to challenge registrations that include goods or services not actually used in U.S.

commerce. These procedures allow petitions to delete unused goods and services from registrations or cancel registrations in whole or in part when the mark was never used in connection with the challenged goods/services. According to the USPTO, as of January 2025, these proceedings have resulted in the clearance of more than 25,000 unused goods and services from the federal trademark register, helping to reduce overly broad recitations and improve register accuracy. *See* https://www.uspto.gov/trademarks/protect/requesting-expungement-or-reexamination-proceeding.

Best Practices

1. **Cull proactively.** Review every U.S. application and registration (including national/direct filings and IR designations) and proactively authorize us to remove any goods or services that cannot be convincingly documented to a tribunal to prove there was a *bona fide* intent at the time of filing as well as requisite use at the time of maintenance filings.

2. **Limit future applications.** Only goods/services that meet the U.S. legal requirements should be included in new applications and designations.

3. **Maintenance filings**. When filing a U.S. Declaration of Continued Use (filed during the 6th year of every registration and during every 10th anniversary year), carefully review and **permanently delete** goods/services which are not in use in the U.S., as required by U.S. law.

4. **Keep documentation.** For each application filed in the U.S., proactively create and maintain clear business records of the *bona fide* intent to use the mark in the U.S. Similarly, maintain records of U.S. sales activities at the time of maintenance filings.

Conclusion

Having a U.S. registration that is enforceable without serious concerns of being attacked by the other side strengthens a client's enforcement ability. Also, U.S. trademark law considers whether there is a likelihood of confusion based primarily on the similarity of the marks and the relatedness of the respective goods/services. There is no requirement that the targeted goods/services be identical to the goods/services in an asserted registration. Thus, while U.S. law does not recognize "defensive" trademark registrations, it does provide an umbrella of protection beyond the specific goods/services recited in a U.S. registration.

As always, we look forward to helping you navigate this aspect of U.S. trademark law and develop the best strategies.

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