Insights: Publications

Allegations of Fraudulent Procurement or Maintenance of Federal Registrations Since *In re Bose Corp.*

The Trademark Reporter Volume 104 Number 5

OCTOBER 1, 2014

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The allegation that a trademark or service mark owner has defrauded the U.S. Patent and Trademark Office (USPTO) can arise in multiple contexts under the Lanham Act. A registration can be cancelled "at any time" if the registration "was obtained fraudulently" under Section 14(3) of the Act, and this provision has been judicially expanded to reach fraudulent filings made under Section 8 of the Act to maintain existing registrations. The filing of a fraudulent declaration of incontestability under Section 15 is an affirmative defense to the otherwise "conclusive evidence" of mark validity attaching to the resulting incontestable registration4 and can even be fatal to the registration itself. Outside the context of *inter partes* litigation within the USPTO, Section 37 provides that "[i]n any action involving a registered mark," the court "may determine the right to registration, order the cancelation of registrations, in whole or in part, restore canceled registrations, and otherwise rectify the register with respect to the registrations of any party to the action." Finally, allegations of fraud on the USPTO can come into play in the private cause of action under Section 38, which provides that "[a]ny person who shall procure registration in the Patent and Trademark Office of a mark by a false or fraudulent declaration or representation, oral or in writing, or by any false means, shall be liable in a civil action by any person injured thereby for any damages sustained in consequence thereof.

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