

3243 P St. NW, Washington, D.C. 20007 • 202-298-6002 • www.dunnerlaw.com

IP Practice specializing in trademark and copyright law; IP counseling; domestic and international maintenance and protection of IP portfolios; internet issues; IP audits and strategies relating to IP portfolios; drafting and negotiating IP and IT-related agreements

Lisa A. Dunner, Esq.
Founder

ldunner@dunderlaw.com

Adam W. Sikich, Esq.
Associate

asikich@dunderlaw.com

Virginia Knapp Dorell
Law Clerk

vrkdorell@dunderlaw.com

© 2011 Dunner Law PLLC

Keep It Once You Have It: Maintaining Your Federal Trademark Registration

Congratulations! It's an exciting day when the sealed copy of your registered trademark arrives on your desk from the U.S. Patent and Trademark Office (PTO).

However, just because you have your certificate in hand does not mean that you can sit back and rely on your use of the mark to keep your registration alive.

One common misconception about maintaining a federal trademark

registration is that once you have it, your work is finished; all that needs to be done is to use it.

In fact, very important maintenance documents must be filed with the PTO in order to maintain your registration. Failure to submit these documents can result in cancellation of your registration.

Below we review what these filings are, when to file them, and what materials should accompany them.

Declaration of Use or Excusable Nonuse

A document representing your "Declaration of Use or Excusable Nonuse" must be submitted to the PTO between the 5th and 6th anniversaries of the date your trademark registered.

A Declaration of Use proves you are using the mark in commerce or that you have a valid excuse for not doing so. It ensures that the PTO does not cancel your registration.

If your mark is in use, you must submit (1) a

statement listing the goods or services covered by the registration and (2) a sample showing your use for the goods or services listed in the registration. Depending on whether your trademark is used in connection with goods or services, an acceptable sample might be a product label, menu, or an advertisement.

Even if you have not continuously used the mark for five years, you still have to file a Declaration of Use to show that you have not

abandoned your mark. A Declaration of Excusable Nonuse would be filed in the alternative, but only under exceptional circumstances (e.g., war, hurricane) that may have prevented any use of your mark. The explanation accompanying the declaration would set forth the "special circumstances" that should excuse your nonuse. Importantly, you must state that you have no intention to abandon your mark, despite the nonuse.

Declaration of Incontestability

This declaration is important because, if accepted by the PTO, then your registration will be declared “incontestable.”

Incontestability makes it harder for others to challenge your mark.

ownership. However, the registration can still be challenged on the basis of abandonment, fraud, or that the mark has become generic.

An incontestable registration means that you have used your mark continuously for five years – without interruption. The importance of “incontestable” status is

that the mark cannot later be challenged on the grounds of validity, registration, or

Like the Declaration of Use or Excusable Nonuse, the Declaration of Incontestability must be submitted to the PTO between the 5th and 6th anniversaries of the date your mark registered.

Maintenance filings have foreseeable deadlines and are easy to plan for, especially with the use of a docketing system or other form of deadline tracking.

Keeping on top of your filings will ensure that your registrations stay alive and continue to be valuable intellectual property assets for your business.

Combined Declarations

Because the timeframes for filing the above declarations coincide, you can file a Combined Declaration — it is an efficient and easy way to file them together.

You can do this only if you have continuously used your mark in commerce for five consecutive years after the date of registration on the Principal Register.

Renewing Your Federal Trademark

Every 10 years from the date of your mark’s registration, you must file a Declaration of Use and/or Excusable Nonuse and an Application for Renewal. You must include a sample of your mark that reflects your continued use of it in interstate commerce.

Renewal applications are extremely important.

For trademark information: www.uspto.gov

Failure to file one will result in the cancellation or expiration of your registration.

Maintenance filings have foreseeable deadlines and are easy to plan for, especially when using a docketing system or

other form of deadline tracking.

Keeping on top of your filings will ensure that your registrations stay alive and continue to be valuable intellectual property assets for your business.