

## Renewing Trademark Registrations

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Imagine that you are advising your client regarding the renewal of a trademark registration for a mark that you originally registered just under ten years ago. Your client is the current owner of the registration and wishes to maintain the registration. What do you need to do in order to best support your client?

The first step is knowing what is due and when. Determining when a trademark registration is due for renewal can be easily overlooked because the only notification provided by the United States Patent and Trademark Office (“USPTO”) is included in the initial certificate of registration as originally issued. 15 U.S.C. § 1058(d) (1946). If the renewal is not properly docketed, it could be passed over accidentally. In order for your client to maintain the trademark registration, the owner must renew the registration every ten years from the date of registration. While failure to properly and timely file the registration renewal application will not cause an abandonment of your client’s rights to the mark, it will take away the benefits of federal registration. If the renewal is missed, your client is required to re-register in order to have these benefits commencing the entire trademark registration process from the beginning, which is a time-consuming and costly endeavor compared to the renewal process.

In the past two decades, two important pieces of legislation have been enacted that will affect your client’s registration renewal process. While this may seem like “old news,” we are currently coming up on the ten- and twenty-year anniversaries of these Acts, which means that the registration renewal filing dates for many marks are fast approaching. Specifically, the Trademark Law Revision Act of 1988, which took effect on November 16, 1989, made it so that all registrations issued under the Trademark Act of 1946 (15 U.S.C. §§1051 *et seq.*) §§ 1 and 44 will remain in force for ten years (as opposed to the previous 20-year period). *See* Pub. L. No. 100-667, 102 Stat. 3935 (1988). Additionally, the Trademark Law Treaty Implementation Act of 1998 (hereinafter “TLTIA”), effective October 30, 1999, changed the required filings with regard to trademark registration renewals, specifically a Declaration of Use and/or Excusable Nonuse of a Mark under 15 U.S.C. § 1058 (“§8 Declaration”) and Application for Renewal of Registration of a Mark under 15 U.S.C. § 1059 (“§9 Renewal Application”) are now required filings. Pub. L. No. 105-30, 112 Stat. 3064 (1998).

A §8 Declaration must be filed by the record owner of the registration between the 5<sup>th</sup> and 6<sup>th</sup> years after the date of registration and by the end of each successive 10-year period after the date of registration. Your client may file the §8 Declaration up to one year prior to the filing due date, or during a 6-month grace period following the filing due date, if accompanied with a grace-period surcharge. It should be noted, that even the Director lacks authority to waive the deadline for filing the §8 Declaration, so it is vital that your docket properly reflects the cut-off date for filing and that you notify your client with ample time to make any revisions to his current use or non-use of his registered mark. *See* Trademark Manual of Examining Procedure (“TMEP”), §1604.04 (5th ed. 2007), *see also* Frequently Asked Question about Maintaining Registration, <http://www.uspto.gov/web/trademarks/workflow/prfaq.htm> (last visited Sept. 29, 2009). If the required §8 Declaration is not filed, the registration will be cancelled.

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The Trademark Law Treaty, which was implemented in the U.S. by the TLTIA, expressly prohibits requiring the owner of a registration to submit a declaration indicating the use of a mark in order to renew the registration. Therefore, the previous renewal provision under §9 requiring such an attestation was removed. However, while there appears to be no proof of use required in a §9 Renewal Application, such proof is required in a Declaration of Use under §8, which has the same time period for filing under the TLTIA as a §9 Renewal Application. *See* 15 U.S.C. §1058. Assuming that your client meets all of the requirements of both §§8 and 9, a Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of Registration of a Mark under Sections 8 & 9 form was created by the USPTO to simplify the ten-year declaration and renewal process. *See* 37 C.F.R. §2.166 (1999), PTO Form 1963.

In addition to other requirements, *see* TMEP §1604 for a full list of renewal and declaration requirements, any §8 Declaration of Use must verify that there is a *bona fide* use of the mark in commerce. Such use of the registered mark must be made in the ordinary course of trade, thus being considered commercial use and not a mere token use, nor can such use be made merely to reserve a right in the mark. *See* 1 ANNE GILSON LALONDE, GILSON ON TRADEMARKS §4.03[2][a] (Matthew Bender). It should be noted that this *bona fide* use in commerce standard is not the same as the continuous use in commerce standard used for a statement to obtain incontestability under 15 U.S.C. §1065. Such an affidavit is not the subject of this article, but it could be relevant to your client's registration, and it should be recognized that this affidavit under §15 requires five years of continuous use of the mark in commerce before the affidavit can be filed. *See* GILSON ON TRADEMARKS §4.03, citing *Urantia Foundation v. Maaherra*, 895 F.Supp. 1338 (D. Ariz. 1995).

What happens if you remind your client of the renewal deadline and your client advises you that the use of the registered mark has ceased by the time it is due for a renewal? Your client cannot file the §8 Declaration of Use asserting use of the mark when there is currently no use. Your client may decide to recommence use of the trademark so that a §8 Declaration claiming use of the mark in commerce can be truthfully and timely filed at any time before the expiration of the grace period without being cancelled. *See* GILSON ON TRADEMARKS §4.03[2][a]. The owner of the registration must prove that the mark is currently being used with respect to each product or service listed in the registration, in good faith, in the ordinary course of trade. If your client cannot so prove, then each product or service that is not currently in use must be omitted from the §8 Declaration of Use. *Id.* But, once your client removes the goods or services from the renewal application, the renewal is deemed to only be sought for the actual goods or services listed, and any omitted goods or services will be deleted from the trademark registration. *See* TMEP §1606.08(c).

In addition to the statements in the §8 Declaration, your client must file a specimen showing that the mark is currently in use, preferably in the form of a label or packaging. If this is not possible, the registrant must provide reasoning for any non-use of the mark. *See* 15 U.S.C. §1058(a) and 37 C.F.R. §2.161. The purpose of §8 is to remove unused and abandoned marks from the Principal Register, and it is not intended to cancel registrations that are not being used due to a temporary interruption in the use of the mark because of circumstances beyond the control of the registration owner. *See* TMEP §1604.11, citing *In re Moorman Mfg. Co.*, 203 U.S.P.Q. 712 (Comm'r Pats. 1979). If your client's mark is not currently in use in commerce, but if there is a reasonable excuse, the special circumstances can be explained in a §8 Declaration of Excusable

Nonuse, showing that the non-use was not done with the intention to abandon the mark. *See* 15 U.S.C. §1058(b)(2). For examples of special circumstances amounting to excusable non-use, see TMEP §1604.11. Additionally, you should also advise your client that non-use of the mark for three consecutive years would be considered to be *prima facie* abandonment of trademark rights. *See* GILSON ON TRADEMARKS §3.02[9][a].

Among the helpful ideas to foster a successful registration renewal include docketing your client's ten year renewal date as early as fourteen months before the deadline in order to confer with your client regarding the use of the mark in commerce. Informing your client well before the deadline and grace-period with enough time to confirm or implement *bona fide* use can be vital to a successful and smooth renewal of a trademark registration. Just because the renewals are only due every ten years does not mean you should wait until the last minute to confirm the status of use of the trademark. If you wait too long, your client may not be able to renew a registration that your client wishes to maintain because there will be insufficient time to take the actions required to submit a renewal application.