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MAINTAINING U.S. TRADEMARK REGISTRATIONS

- SIXTH YEAR MAINTENANCE FILING

A Section 8 Declaration must be filed within the sixth year of registration to maintain any U.S. registration, whatever its original filing basis may have been. This Declaration states that the mark is currently in use in commerce in or with the United States. It must also be accompanied by the same kind of specimens of use as are accepted to show use in the context of an application. The Declaration must be filed prior to the sixth anniversary of the registration date to avoid additional fees; a six-month grace period is available, however, at an additional cost. We recommend filing the Declaration as soon as it is permitted to do so to have time to cure any possible deficiencies before the time period expires.

Particular care should be taken in reviewing the list of goods and services upon which use is claimed. In contrast to other jurisdictions, where a broad recitation is permitted, the U.S. Patent and Trademark Office requires a specific listing of the goods and/or services with which the mark is used. It also requires use on every, single item recited in the description of the goods and/or services. If the mark is no longer in use for any item, then the registration can be maintained for the other listed items.

The Declaration must be accompanied by a specimen of the manner in which the mark is used. Suitable examples for a trademark are: labels, hang tags, packaging. Suitable examples for a service mark are: marketing brochures, advertisements, or stationery (so long as the services are also described in the example).

If use has commenced in commerce in or with the United States, but the mark is not currently in use, it is possible to maintain the registration if the owner intends to resume use by submitting a detailed explanation of the circumstances and future plans. Furthermore, the mark need only be in use at the time the Declaration is filed with the Office. Therefore, it is perfectly acceptable to resume use for the purpose of submitting the Declaration and maintaining the registration.

It is also possible to file a Section 15 Declaration at this time which can be combined with the Section 8 Declaration. Such a Declaration states that the ownership and use of the mark by the registrant are not in dispute. The advantage of filing this Declaration is that, once it is accepted, anyone seeking to challenge the registration has a much more limited basis upon which to do so. If there is a dispute over the mark during the fifth year, the Declaration may not be submitted,

but it can be submitted any time thereafter and after the dispute has been resolved. There is no deadline for filing this Declaration.

The sixth-year declaration is only required once. Maintenance filings thereafter are in the form of renewal applications.

- RENEWAL

Under current law, an application to renew a U.S. trademark registrations must be filed within ten years of the anniversary date of the original registration or last renewal, although a six-month grace period following the expiration of this term is available at an additional cost. Applications registered or last renewed prior to November 18, 1989, had an initial twenty-year term and ten-year terms thereafter.

The application must state that the mark is currently in use in commerce in or with the United States. There are no exceptions to this use requirement. Again, care must be taken in reviewing the list of goods and/or services to confirm that the mark is presently in use with every single item listed. Specimens demonstrating use, as described above, must be filed with the renewal application. We recommend filing the application in good time so that any possible deficiency in the application or the specimens may be cured before the term expires.

- OTHER REQUIREMENTS

These maintenance filings will only be accepted from the owner of the registration on record with the Trademark Office at the time of filing. The maintenance filings are only effective if they are filed by the true, legal owner of the registration at the time of filing. The Office is presently recording a change of name or assignment within a matter of weeks from the date of filing. Any assignments or name changes should be recorded promptly to avoid problems with maintenance filings.

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