

TRADEMARK CORNER

U.S. Trademark Post-Registration Obligations

Once a trademark has been registered with the United States Patent and Trademark Office (USPTO), the owner must maintain continued protection of the mark by complying with various post-registration obligations. These obligations include filing renewal registrations and declarations of continued use; monitoring the marketplace for any unauthorized use; and policing any alleged infringement or dilution, including, if appropriate and necessary, enforcing trademark rights.

Filings Renewals and Declarations of Use

With the registration, a mark owner may now use the trademark notice symbol, “®”, on the mark whenever it is used in the United States. It would be prudent to use the notice symbol with the mark at all times.

The registration will remain in force for ten (10) years (and every other successive ten-year period with timely renewals) provided the mark owner:

- Continuously uses the mark in commerce;
- Files a Declaration of Continued Use (or Excusable Non-use) for the mark and pays the associated USPTO fees between the 5th and 6th years after the registration date;
- Files a Declaration of Continued Use (or Excusable Non-use) for the mark and pays the associated USPTO fees between the

9th and 10th years after the registration date;

- Files an Application for Renewal for the mark and pays the associated USPTO fees between the 9th and 10th years after the registration date;
- Files a Declaration of Continued Use (or Excusable Non-use) for the mark and pays the associated USPTO fees between each 9th and 10th-year period after the date when the first ten-year period ends; and
- Files an Application for Renewal for each mark and pays the associated USPTO fees between each 9th and 10th-year period after the first ten-year period ends.



Failure to file the above-identified documents within the time limits provided (and any applicable extensions) may lead to the cancellation of the registration. Additionally, the mark owner is under a constant obligation to provide truthful information to the USPTO. The consequences for failing to do so may lead to a finding of fraud and subsequent cancellation of the registration. Thus, the mark

owner should ensure that it is accurately declaring the goods and services on which the mark is being used in the filings with the USPTO, i.e., the Declaration of Continued Use (or Excusable Non-use) and Application for Renewal for the mark.

Monitoring Unauthorized Use

A mark owner also has the continuing obligation to monitor its mark for any unauthorized use. A failure to do so can lead to the mark being deemed abandoned because of its inability to identify and distinguish the source (or origin) of the goods or services of the owner from those of another. Indeed, marks that become so well known that they are used to generally describe that class of goods/services lose all their trademark rights. This phenomenon is called genericide and some examples include ASPIRIN, THERMOS, TRAMPOLINE, ESCALATOR, CELLOPHANE, ZIPPER, and BAND-AID.



Like performing clearance searches, monitoring can be accomplished in a number of informal and formal ways. The most effective is to sign-up for an annual subscription to a watch service run by a reputable provider, such as Corsearch or Thompson Compumark.



These services will run searches for identical or confusingly similar marks and alert the mark owner of any potential unauthorized uses. For example, searches can catch newly published marks by the USPTO so that an opposition proceeding can be commenced to prevent registration of the offending mark. An outside trademark attorney should review the search results and recommend whether any further action is necessary. By having a monitoring plan in place, the mark owner has the opportunity to step-in early and minimize brand injury and other trademark-related problems. The frequency and scope of monitoring will depend upon several factors, including the overall brand protection plan, the amount and level of competition at stake, and the mark owner's financial resources.

A systematic monitoring plan also helps create a record of policing the mark. It complements any informal policing conducted by the mark owner, such as vigilantly scouring the Internet and following-up on word-of-mouth leads.

Policing Alleged Infringement and Dilution

Finally, monitoring alone may be insufficient to protect the mark if there is concern over the use by the third-party and/or the mark is being infringed or diluted. In that case, a cease-and-desist communication, commencement of a lawsuit, and/or the filing of an injunction application to enforce the trademark rights may be necessary. Each situation is fact-specific and calls for a tailor-made response. An experienced trademark attorney will be able to assist the mark owner in selecting a course of action that is appropriate for the circumstances.

For more information on the Trademarks and Unfair Competition Practice at Fox Horan & Camerini LLP, please contact Theo Cheng at tcheng@foxlex.com or (212) 480-4800.

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