



Newsletter

JULY 2004

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Our office will be closed for the following holidays:

Sept 6th – Labor Day

Our next newsletter will be mailed out the beginning of October 2004.

Remember if you have an article that you would like to contribute to our newsletter just fax it to us for our review. We must receive the article no later than September 15th for our October newsletter.

INSIDE THIS ISSUE

1 **Keeping a Trademark Registration**

KEEPING A TRADEMARK REGISTRATION

Rights in a federally-registered trademark can last indefinitely so long as the owner continues to use the mark to identify its goods or services and files all necessary documentation in the United States Patent and Trademark Office.

Documents to File

In order to keep a registration alive, the owner of the registration must file, at appropriate times, an affidavit or declaration of continued use or excusable nonuse under Section 8 of the Trademark Act (also known as a Section 8 Declaration); and an application for renewal under Section 9 of the Trademark Act (also known as a Section 9 Renewal) In addition, the owner of a registration on the Principal Register may file a Declaration of Incontestability under Section 15 (Section 15 Declaration) of the Trademark Act.



Time Period for Filing Documents

Between the 5th and 6th year after registration the owner must file a Declaration of Continued Use or Excusable Nonuse, (also known as a Section 8 Declaration). Failure to file the Section 8 Declaration results in the cancellation of the registration. (There is a 6-month grace period.)

After 5 consecutive years of continuous use in commerce following registration the owner may file, but is not required to file, a Declaration of Incontestability under Section 15 of the Trademark Act if, among other things, the mark is registered on the Principal Register.

Between the 9th and 10th year after registration, and every 10 years thereafter (for registrations issued or renewed on or after November 16, 1989) the owner must file a Section 8 Declaration and an Application for Renewal under Section 9 of the Trademark Act. Failure to file these documents results in the cancellation and expiration of the registration. (There is a 6-month grace period.)

WHEN MUST I FILE A SECTION 8 DECLARATION?

The owner of the registration must file a Section 8 Declaration during the following time periods:

At the end of the 6th year after the date of registration (or the date of publication under 15 U.S.C. §1062(c) for marks registered under the Trademark Acts of 1905 or 1881), and

At the end of each successive 10-year period after the date of registration. The owner has a total of 18 months to file a Section 8 Declaration. The Section 8 Declaration may be filed one year prior to the filing due date or during the 6-month grace period immediately after the filing due date.

WHAT IS THE FILING FEE FOR FILING A SECTION 8 DECLARATION?

The current fee for filing a Section 8 Declaration is \$100 per class of goods/services. There is an additional grace period surcharge of \$100 per class of goods/services for filing during the 6-month grace period.

WHAT MUST I INCLUDE IN A SECTION 8 DECLARATION?

A Section 8 Declaration must include:

- * The registration number;
- * The name and address of the current owner;
- * The fee for filing the Declaration;
- * If the mark is in use: a statement that the registered mark is in use in commerce; a

- * list of the goods/services recited in the registration on or in connection with which the mark is in use; and one specimen per class of goods/services. Examples of acceptable specimens are tags/labels for goods, and advertisements for services.

- * If the owner resides outside the United States, the designation of a domestic representative; and

- * A signed and dated affidavit or declaration under 37 C.F.R. §2.20

WHO MAY SIGN A SECTION 8 DECLARATION?

The owner or a person who is properly authorized to sign on behalf of the owner may sign the Section 8 Declaration. That is:

- * A person with legal authority to bind the owner;

- * A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or

- * An attorney as defined in 37 C.F.R. Section 10.1(c) who has actual written or verbal power of attorney or an implied power of attorney from the owner.

IS THERE A FORM FOR FILING A SECTION 8 DECLARATION?

Yes. USPTO standard forms for filing a Section 8 Declaration and a combined 10-year Section 8 Declaration and Section 9 Renewal Application are available.

HOW WILL I KNOW IF MY SECTION 8 DECLARATION HAS BEEN ACCEPTED?

Section 8 Declarations are reviewed by paralegals in the Post Registration Division. If the Section 8 Declaration is accepted, the USPTO will send a Notice of Acceptance. If the Section 8 Declaration is refused, the Office will send an Office Action stating the reasons for refusal and any remedies available.

WHAT IS A DECLARATION OF EXCUSABLE NONUSE?

A Section 8 Declaration of Excusable Nonuse is a sworn statement, filed by the owner of a registration, that the mark is not in use in commerce due to special circumstances that excuse such nonuse and is not due to any intention to abandon the mark. Section 8 of the Trademark Act, 15 U.S.C. 1058.

WHAT SPECIFIC TYPE OF INFORMATION MUST I INCLUDE IN A SECTION 8 DECLARATION OF EXCUSABLE NONUSE?

If the owner of the registration is claiming excusable nonuse of the mark, the Section 8 Declaration must include:

- * The registration number;
- * The name and address of the current owner;
- * The fee for filing the Declaration;
- * A list of the goods/services in the registration on or in connection with which the mark is not in use in commerce; the date of the last use of the mark in commerce; the approximate date when use in commerce is expected to resume; details regarding the reason for nonuse; and specific steps being taken to resume use.
- * If the owner resides outside the United States, the designation of a domestic representative; and
- * A signed and dated affidavit or declaration under 37 C.F.R. §2.20.

MORE ABOUT EXCUSABLE NONUSE.

In general, nonuse must be temporary, and the owner must clearly demonstrate how the circumstances prevent use of the mark in commerce and what efforts are being made to resume use. Please note that nonuse due to the decreased demand for a product does not by itself constitute "excusable nonuse."

IF MY SECTION 8 DECLARATION OF EXCUSABLE NONUSE IS ACCEPTED, DO I HAVE TO FILE ANOTHER SECTION 8 DECLARATION WHEN I RESUME USING THE MARK?

No. Once the USPTO accepts the Section 8 Declaration of Excusable Nonuse, the owner of the registration is not required to file another Section 8 Declaration until the next statutory filing period.

WHAT IS A SECTION 15 DECLARATION?

A Section 15 Declaration is a sworn statement, filed by the owner of a mark registered on the Principal Register, claiming "incontestable" rights in the mark for the goods/services specified. Marks registered on the Supplemental Register are not eligible for claims of incontestable rights under Section 15.

WHAT IS AN "INCONTESTABLE" REGISTRATION?

An "incontestable" registration is conclusive evidence of the validity of the registered mark, of the registration of the mark, of the owner's ownership of the mark and of the owner's exclusive right to use the mark with the goods/services. The claim of incontestability is subject to certain limited exceptions set forth in §§15 and 33(b) of the Trademark Act, 15 U.S.C. §§1065 and 1115(b). 15 U.S.C. §1065.

AM I REQUIRED TO FILE A SECTION 15 DECLARATION?

No. The filing of a Section 15 Declaration is optional. An owner may choose to claim the benefits of incontestability by filing a Section 15 Declaration or may elect to retain the registration without those benefits. The term of the registration, for purpose of renewal, is not affected in either event.

IS THERE A PARTICULAR TIME PERIOD FOR FILING A SECTION 15 DECLARATION?

Yes. A Section 15 Declaration may not be filed until the mark has been in continuous use in commerce for at least five consecutive years subsequent to the date of registration for marks registered under the Act of 1946 (and subsequent to the date of publication under §12(c) of the Trademark Act, 15 U.S.C. §1062(c), for marks registered under the Acts of 1905 and 1881 for which the benefits of the Act of 1946 have been claimed). The Section 15 Declaration must be executed and filed within one year following a 5-year period of continuous use of the mark in commerce.

IS THERE A FEE FOR FILING A SECTION 15 DECLARATION?

Yes. The current fee for filing a Section 15 Declaration is \$200 per class of goods/services, and the filing fee for a Sections 8 & 15 Combined Declaration is \$300 per class.

WHAT MUST I INCLUDE IN A SECTION 15 DECLARATION?

A Section 15 Declaration must include:

1. The registration number and the date of registration;
2. The fee for each class of goods/services in the registration to which the Declaration pertains;
3. A statement that:

(a) the mark has been in **continuous use in commerce** for a period of five years subsequent to the date of registration, or the date of publication under 15 U.S.C. §1062(c), on or in connection with the goods/services recited in the registration and is still in use in commerce;

(b) there has been **no final decision adverse** to the owner's claim of ownership of the mark for the goods/services, or to the owner's right to register the mark or to keep the same on the register; and

(c) there is **no proceeding** involving the **claimed rights** pending in the USPTO or in a court of law and not finally disposed of; and

4. A signed and dated affidavit or declaration under 37 C.F.R. §2.20.

WHO MAY SIGN A SECTION 15 DECLARATION?

A person who is properly authorized to sign on behalf of the owner may sign the Section 15 Declaration. That is:

1. A person with legal authority to bind the owner;
2. A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or
3. An attorney as defined in 37 C.F.R. §10.1(c) who has actual written or verbal power of attorney or an implied power of attorney from the owner.

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ADDRESS CORRECTION REQUESTED

IS THERE A FORM FOR FILING A SECTION 15 DECLARATION?

Yes. USPTO standard forms for filing a Section 15 Declaration and a combined Sections 8 & 15 Declaration are available.

TO WHAT EXTENT DOES THE OFFICE EXAMINE A CLAIM OF INCONTESTABILITY UNDER SECTION 15?

The USPTO neither examines the merits of Section 15 Declarations nor "accepts" Section 15 Declarations. However, the USPTO will review a Section 15 Declaration to determine whether it complies with statutory requirements. The USPTO will acknowledge receipt of only those Section 15 Declarations that meet all statutory requirements.

DOES MY CERTIFICATE OF REGISTRATION EVER EXPIRE?

Yes. Subject to the filing of Section 8 Declarations, federal trademark registrations issued on or after November 16, 1989, remain in force for 10 years, and may be renewed for 10-year periods. Trademark registrations issued or renewed prior to November 16, 1989 remain in force for 20 years, and may be renewed for 10-year periods.

HOW DO I RENEW MY TRADEMARK REGISTRATION?

To renew a federal trademark registration, you must file an Application for Renewal under Section 9 of the Trademark Act, 15 U.S.C. §1059. Professional Legal Assistors can assist you with these filings.

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