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MAINTAINING A FEDERAL TRADEMARK REGISTRATION

THE FIRST DAY POST-REGISTRATION

1. USING THE FEDERAL REGISTRATION SYMBOL ®

While common law trademarks and trademarks for federal application may lawfully only use the TM symbol, federally registered trademarks can and should be displayed with the registered symbol shown here ®. The registered symbol serves to put the public on notice that the mark is federally registered and is an indicator of a status that results in liability for additional damages by an infringer. Owners of registered marks should make sure that all uses of the mark, including use on websites, social media, product packaging, product tags, etc display the registered symbol after the mark.

2. TRADEMARK POLICING AND RIGHTS ENFORCEMENT

Federal trademark registration is an investment that creates a valuable business asset that can be licensed, sold and otherwise monetized. As with any investment, a prudent owner seeks to protect their interests because failure to do so can result in depreciation of the asset or even total loss. While ownership of tangible property can be usurped by squatters, the value and ownership of trademarks can be attacked by infringers, applicants for federal registration of confusingly similar marks, and cyber squatters among others. To complicate matters further, under the legal doctrine of laches, trademark owners who knew or reasonably should have known about infringement of their trademark and failed to timely act in defense of their rights, may be barred from relief entirely. Therefore, in order to maintain the value and ownership of their trademark, owners should be actively policing their trademarks through use of trademark and domain name monitoring services and as necessary, engaging in rights enforce through the issuance of cease and desist letters, filing of oppositions with the US Patent and Trademark Office (USPTO) and filing of Uniform Domain-Name Dispute Resolution Policy complaints.

a. Trademark and Domain Name Monitoring Services

Trademark and domain name monitoring services are offered by many Intellectual Property law firms. These services monitor the USPTO Official gazette, state registries, business name databases, social media usernames and domain name registries among others for marks identical or confusingly similar to those of the trademark owner. These reports are reviewed by an attorney and flagged for any uses which are damaging to the trademark registration and actionable for rights enforcement.

b. Cease and Desists

The first option in case of infringement is issuance of a cease and desist letter. These letters not only assert the trademark owner's rights but they also serve to put the infringer on notice of the ownership of the mark and provide evidence of the owner's efforts to police the mark in the event of a lawsuit.

c. USPTO Oppositions

In the case of applications for federal trademark registration, the USPTO publishes applications for opposition by the public. Trademark owners who believe a published application is confusingly similar to their registration and may devalue the registration, have 30 days to file an opposition or request for extension of time to file an opposition. The opposition process before the USPTO Trademark Trial and Appeal Board is a form of administrative litigation involving filing of petition, dispositions, testimony periods, etc. In the end, the Board makes a decision on whether the opposed application is sufficiently dissimilar to the registration to be allowed to mature to registration or whether the opposed application would cause harm to the trademark owner's registration.

d. Uniform Domain-Name Dispute Resolution Policy(UDRP) Complaints

Cybersquatting occurs when a second party registers a domain for a trademark or containing a trademark with the intent of selling the domain to the trademark owner at a profit or with the intent of misdirecting the trademark owner's web traffic and profiting off the reputation of the trademark. In these cases, the domain can cause confusion among the trademark owner's customers and the second party's asking price for the domain, assuming there is an offer to sell, is unreasonably high. In order to acquire the domain, the trademark owner would need to file a UDRP complaint, providing evidence of the trademark registration and arguments outlining why the domain ownership should be transferred. A one or three judge panel then reviews the arguments and determines whether the domain will remain with the second party or be transferred to the trademark owner. This process allows trademark owners to maintain the valuable goodwill of the trademark while preventing others from profiting off the trademark.

THE SIXTH YEAR ANNIVERSARY

Between the fifth and sixth year after registration of the trademark, a combined declaration of use and incontestability under Section 8 & 15 must be filed with the USPTO. This document asserts that the mark has continually been in use since registration. Failure to timely file this document will result in cancelation of the registration by the USPTO.

THE TENTH YEAR ANNIVERSARY

Between the ninth and tenth year after registration of the trademark, a combined declaration of use and application for renewal under sections 8 & 9 must be filed with the USPTO. Like the Section 8 & 15 filings, this document also asserts continued use of the mark but differs with the inclusion of a renewal document. This document must be filed within one year before every tenth anniversary of the registration. Failure to file this document will result in cancelation of the registration.

LIFETIME OF THE MARK

1. KEEP UP WITH BRAND EXPANSION

Over time, a trademark owner may expand the number of products/services sold under the trademark beyond what the registration covers. In the event of product/service expansion, a trademark owner will need to apply for additional registrations in order to acquire ownership of the trademark in relation to the additional goods/services. Failure to acquire registration for the additional goods/services could result in the trademark being used or acquired for those additional goods/services by a second party.

2. KEEP UP WITH CHANGES IN INTERESTS

Like other business assets, trademarks may be assigned, licensed, used as collateral in a mortgage, subject to a lien, etc. These instruments affecting the ownership interests in trademark, must be recorded with the USPTO in order to maintain the validity of the registration.

3. CANCELLATION BY ABANDONMENT

A trademark registration may be cancelled if abandonment can be proven. In order to avoid this fate, trademark owners must consistently use and document use of their trademarks. In addition to increasing the notoriety and therefore the value of the trademark, use and marketing of the trademark keeps the registration valid. In the event that the trademark owner is not using the mark, the owner should license the mark to a distributor or agent for use for a set time.

4. CANCELLATION BY 'GENRICIDE'

While every trademark owner seeks to build a popular brand, too much popularity can result in the trademark registration becoming generic and subject to cancellation. Today, many commonly-used words were once registered trademarks; aspirin, escalator and trampoline were all registered trademarks at one point. Trademark registration provides exclusive ownership of a distinctive mark but if the trademark owner and the general public improperly use the trademark in a descriptive way, the distinctiveness of the trademark is diminished, it becomes generic and subject to cancellation.

CONCLUSION

Trademark maintenance requires diligence and a multifaceted approach. From the day of registration through the lifetime of the trademark, owners must ensure that the trademark is proactively policed, that maintenance documents and changes in interest are properly recorded with the USPTO and that marketing efforts are not only continuous but also nuanced in how the trademark is used in order to maintain distinctiveness. Failure to maintain the trademark registration in any of these areas can result in a loss of value in the trademark or even cancellation of the registration.