

Indigenous Rights

Protecting trademark rights of native cultures in
New Zealand and Australia

■ India

Impact of the Wyeth ruling

■ Online Advertising

Keywords and brands



The benefits of local expertise

IN SUMMARY

- Use your usual American trademark counsel to maintain registration in the US rather than a corporate renewal service.
- In filing a Declaration of Use, pay close attention to the identification of goods and services.
- When maintaining registration, consider whether the use is actually current.
- Submit acceptable specimens of use to avoid receiving unnecessary Office Actions.

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🌐 *Maintaining US trademark registrations: beware the corporate renewal services approach*

By **Peter S. Sloane** of Ostrolenk, Faber, Gerb & Soffen, LLP

The global trademark industry continues to grow at a significant rate. Despite a stagnant economic environment in the US, 2007 set a new record for annual trademark filings here. Last year, over 300,000 trademark applications were filed with the US Patent and Trademark Office – the highest number ever. More trademark filings mean more trademark registrations to maintain down the road.

Some foreign companies consider using a corporate renewal service to maintain their US trademark registrations. These renewal services, which often have a patent-centric history and focus, promote their services as enabling businesses to manage their ever-increasing trademark portfolios with efficiency to ensure that maintenance deadlines are met in a timely manner. However, they often accomplish such savings by farming out the work to their network of foreign agents, which often means the lowest cost provider.

Whilst it may make sense to employ such renewal services in patent cases, where the payment of annuities is straightforward, and in trademark cases in jurisdictions where payment of official fees is all that is necessary to maintain registration, it is far preferable for foreign companies to

continue to use their usual American counsel to maintain their US trademark registrations. Because the USPTO has strict examination procedures, a corporate renewal service may overlook the many pitfalls in US trademark practice.

Declaration of use

American trademark lawyers often think that our system is straightforward and transparent. However, many of our laws and regulations use arcane terminology and rules that confound foreign practitioners. Sensitivity to the differences between US and foreign trademark practice is important in counselling non-US clients.

For example, our strict practice regarding acceptable identification of goods and services in pending trademark applications is quite well known abroad. Unlike many other countries that permit registration for entire classes of goods or international class headings, the US requires the identification of very specific goods and services in filing applications. However, our rigorous requirements for maintaining trademark registrations are not quite as well publicised.

Following registration in the US, the first point of misapprehension occurs between the fifth and sixth anniversary, when there is a



maintenance deadline. During that one-year period, plus a six-month grace period, it is necessary to file a Section 8 Declaration of Use. "Section 8" refers to that numbered section of the US Trademark Act. The USPTO does not refer to the Declaration as a renewal, but that is essentially what it is. Without timely filing the Section 8 Declaration, the registration automatically lapses for non-use.

Filing the Section 8 Declaration of Use requires much more, though, than just paying the official fee. The Declaration includes a verification that the registered mark is, in fact, in current use for all the specific goods and services identified in the registration. Falsity in filing the Declaration may make the entire registration vulnerable to attack by others in a cancellation action based upon fraud before the USPTO.

In *Medinol Ltd. v. Neuro Vaxx, Inc.*, 67 U.S.P.Q.2d 1205 (T.T.A.B. 2003), the USPTO cancelled a registration where the registrant claimed use of the mark on the two goods named in the registration when, in fact, the mark was only used for one of the goods.

Medinol did not change US trademark law and practice. Similar cases had previously reached the same result. However, it had been some time before the USPTO published such a decision. For this generation of American trademark lawyers, the concisely worded decision, with its harsh result, served as a wake up call about the need to pay close attention to the trademark maintenance process.

Importantly, some seemingly rational excuses for making mistakes in the Declaration of Use are not acceptable as defences to fraud in the US. In *Hurley International LLC v. Paul and Joanne Volta*, 82 U.S.P.Q.2d 1339 (T.T.A.B. 2007), fraud was found despite the contention that the registrant was not represented by counsel and failed to understand the legal

requirements for asserting use. In *Hachette Filpacci Presse v. Ella Belle, LLC*, 85 U.S.P.Q.2d 1090 (T.T.A.B. 2007), the claim that the registrant's principal, who signed the Declaration, did not understand English did not

obviate a fraud finding.

The risk of committing fraud is exacerbated when a registration covers a lengthy list of goods or multiple classes. Simply instructing a renewal service to file the Section 8 Declaration of Use, without taking the time to carefully review the identification of goods with the client to confirm that the mark is currently used in the US for each item, may result in an overbroad and false declaration.

For example, if a registration covers both eyeglass frames and cases for eyeglasses, but the eyeglass cases are not currently sold in the US, they should not be included in the Section 8 Declaration of Use when filed. Those goods will eventually be dropped from the registration when the Declaration is accepted. However, the benefit in insulating the registration from third party attack based on fraud outweighs any loss in rights.

Indeed, the registrant should not fret about any loss of rights by dropping goods from the registration. Trademarks are not patents. The rights are not strictly limited by the claims. Under the "related goods" doctrine in US trademark law, the registration should protect the mark for goods that are closely related to those still covered by the registration.

Interestingly, the USPTO will not question whether the mark is in fact currently used in the US for all the goods or services identified in the registration. This may lead to a false sense of security. It is only when the registrant relies upon the registration in challenging third party trademarks that the latent defect may become evident. At that point, the third party may counter claim to petition to cancel the registration on the ground of fraud committed earlier during the maintenance process.

One must also pay attention to more than just the specified goods and services when filing the Declaration of Use. The Declaration affirms that the mark is in "current" use in commerce with the US. If a product is sold in the US within the past six months, it seems reasonable to claim current use. However, if the product at issue is a large industrial machine that costs hundreds of thousands of dollars, and is sold only once every so often, the meaning of "current" use should be construed more liberally. This is the kind of detailed analysis that a knowledgeable trademark attorney, who knows the ins and outs of the client's business, can provide.

Just as with the identification of goods and services, the Examiner in the USPTO will not inquire into whether the use is actually current. As a result, if the use is not current, it may result in a latent defect in the registration that may only come to light in a dispute with a third party.

In filing the Section 8 Declaration of Use, it is also necessary to submit a specimen of use for any one of the goods or services in each separate class in the registration. Obtaining acceptable specimens of use often requires time and diligence beyond that offered by corporate renewal services.

For example, in a quirk of US trademark practice, the US Trademark Office will accept advertising as a specimen of use for services, but not goods. Acceptable types of specimens to prove use of a trademark for goods include limited things such as hang tags, labels or packaging for the goods.

Filing a faulty specimen of use should prompt an Office Action refusing to accept the specimen. Any savings incurred in using a renewal service to file the Section 8 Declaration of Use will be wiped out by the time and expense later required to respond to the Office Action and submit a substitute specimen.

Filing the Section 8 Declaration of Use is at times more than just about maintaining the registration. It also offers the opportunity to amend the mark if warranted. Under US trademark law, the specimen of use must show the mark in substantially the same form as registered. If the mark shown in the specimen differs slightly from the mark pictured in the registration, but the difference does not rise to the level of an impermissible material alternation of the mark, to avoid an unnecessary objection from the Examiner, it is sometimes advisable to request amendment of the mark when filing