

UNITED STATES: REQUIREMENTS FOR TRADEMARK MAINTENANCE AND RENEWAL

A. Maintenance

An affidavit (or declaration) attesting to the use of a registered mark must be executed and filed within the year following the fifth anniversary and no later than the sixth anniversary of a registration. A six-month grace period is available after the sixth anniversary date.

A specimen showing use of the trademark on at least one of the goods and services in each class claimed in the registration must be submitted with the maintenance.

B. Renewals

A registration may be renewed for successive periods of ten (10) years from the date of registration or the date of the renewal registration then expiring. The renewal affidavit (or declaration) must be executed and filed in the 12-month period prior to the 10th anniversary of the registration date. A six-month grace period is available after the registration expiration date. A specimen showing use of the trademark on at least one of the goods and services in each class claimed in the registration must be submitted with the renewal.

The following applies both to Maintenance and Renewals:

1. Signature

The affidavit or declaration may be signed by any of the following:

- i. The individual applicant, or where the owner is a corporation or partnership, an authorized signatory of the corporation or the general partner of the partnership;
- ii. A person with legal authority to bind the applicant;
- iii. An attorney with actual or implied authority from the owner.

A facsimile copy of the signature is acceptable.

2. Ownership

Only the current owner of the mark should file. Any change of name, merger or assignment of the registration should be recorded prior to or at the time of renewal or maintenance.

3. Specimens of Use

The affidavit or declaration of use must be accompanied by a showing of use of the mark in commerce in the United States. This showing can be made for goods by filing labels, containers or nameplates of the goods, and for services by filing of advertisements, or business promotion documents. These should be duplicates of those materials actually used in commerce which contain the mark. Copies of invoices are not required. While ordinarily one specimen of use per class will suffice, the Trademark Office can request one specimen for each of the listed goods.

4. **Form of Mark**

If the form of the mark as registered is no longer the form of the mark in use, it may be necessary to amend the registered mark. An amendment which does not change the basic identity of the mark will be permitted, but if the change is significant, it may be necessary to file a new application.

5. **Goods or Services in Use**

If the mark is not currently being used for all the goods or services covered in the registration, the affidavit should refer only to those items in current use. All other items should be deleted from the registration. If the mark is now being used on goods or services not covered by the registration, it may be advisable to obtain a new registration for those goods and services. New goods and services may not be added to a registration.

6. **Non-use**

If the mark is not in use in the United States, consideration should be given to filing an affidavit or declaration of non-use. Such affidavit or declaration is required to show both an intention not to abandon the mark, and excusable non-use due to specific facts and reasons for the non-use, outside of the control of the registrant. Lack of demand for the goods is not likely to be accepted as excusable non-use. However, it may be sufficient to state that the mark has been in use, and there is a temporary interruption due to a cause beyond the control of the trademark owner (with a specified predicted date of resumption of use), or that orders are in process (with a specified predicted date of delivery), or government approval is awaited. Each case is examined on its own facts.

7. **Incontestability**

If the registered mark has been in continuous use in the United States for five consecutive years, it is possible to also claim "incontestability" status. This claim can be combined in the same documents as a use affidavit or declaration, as in A above, or can be separately filed at any time. The claim is optional, but is strongly recommended as it will shield the registration from cancellation on several grounds, including prior third party use.