

# Trademark Registrations: Maintenance and Renewal

A Lexis Practice Advisor® Practice Note by Peter S. Sloane and Michelle J. Levin, Leason Ellis LLP



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This practice note discusses maintenance and renewal requirements for U.S. trademark registrations, including requirements for filing a Declaration of Use and/or Excusable Non-use under Section 8 of the Trademark Act (Section 8 Declaration) and an Application for Renewal under Section 9 of the Act with the U.S. Patent and Trademark Office (USPTO). The note also discusses how to claim incontestability under Section 15 of the Act (via a Section 15 Declaration).

Note that Sections 8 and 9 of the Trademark Act only apply to registrations obtained through Section 1 (use-based) and Section 44 (based on a foreign registration) of the Act. Registrations obtained pursuant to the Madrid Protocol are governed by Section 71 of the Trademark Act. For a more detailed discussion on maintenance and renewal of Madrid Protocol registrations, see [Madrid Protocol-Based Registrations: Maintenance and Renewal](#). For guidance on

the Madrid system (including the Madrid Protocol), see [Madrid International Trademark System](#).

Effective August 3, 2019, all foreign-domiciled trademark applicants, registrants, and parties to Trademark Trial and Appeal Board proceedings must be represented by an attorney licensed to practice law in the United States in all trademark matters. This includes all statutorily required maintenance submissions. Additionally, effective December 21, 2019, all trademark submissions (including all required maintenance filings) must be filed electronically, with limited exceptions. See Changes to the Trademark Rules of Practice to Mandate Electronic Filing, 84 FR 52363 (Oct. 2, 2019).

## Section 8 Declaration of Use

A U.S. trademark registration is valid for 10 years. However, as a requirement to maintain the registration through the first 10 years, a Section 8 Declaration must be filed between the fifth and sixth anniversaries of the registration date (or within the six-month grace period following the end of the sixth year). This is referred to as maintenance of the registration.

Subsequent Section 8 Declarations are also required for renewal of the registration. They must be filed between the ninth and tenth anniversaries of the registration date and each successive 10-year period thereafter (or within the six-month grace period following the end of the 10-year period). A registration will only remain valid if a Section 8 Declaration is filed during the maintenance and renewal periods. For more on renewal, see U.S. Trademark Registration Renewal below.

The purpose of a Section 8 Declaration is to remove marks from the Register that are no longer used in commerce. The USPTO does not send reminders regarding the deadlines and requirements to file the Section 8 Declaration. It is the responsibility of the trademark owner to file the required Declaration.

The requirements for the Section 8 Declaration are as follows:

- State that the mark is currently in use in commerce on or in connection with the goods and services identified in the registration.
- Submit a specimen (i.e., an example) of use for each class in the registration.
- Pay the required fee (calculated per class).
- Submit a statement, signed and verified (sworn to) by a person properly authorized to sign on behalf of the owner, attesting to the use or excusable non-use of the mark.
- If applicable, set forth the goods and services in the registration with which the mark is not in use and show that the non-use is due to special circumstances which excuse the non-use (and is not due to any intention to abandon the mark).

The current fee for filing a Section 8 Declaration is \$125 per class, if filed electronically. If the Declaration is filed in the six-month grace period following the deadline, there is an additional fee of \$100 per class, if filed electronically.

### Filing a Section 8 Declaration Form

The Section 8 Declaration must be filed electronically through the USPTO's online filing system, [Trademark Electronic Application System](#) (TEAS), with limited exceptions.

### Ownership

The Section 8 Declaration must be filed by the owner of the mark. If the registration has been assigned, the assignment should be recorded with the Assignment Branch of the USPTO (for more on assignment, see [Assignments of Trademarks](#)). If the person or entity signing the Declaration is not the record owner of the mark, or if it is unclear whether the party who filed the Section 8 Declaration is the present owner, the USPTO will issue an Office Action.

The Section 8 form includes an opportunity to change and update the owner's address without filing a separate form.

### Goods and/or Services

The Declaration must specify on which goods and services the mark is currently in use. The Section 8 Declaration

form will populate the goods and services covered by the registration, separated by class. If the mark is currently in use for all the goods or services in a specific class, then the owner may keep all the goods or services as listed. However, if the owner has ceased using the mark for some of the goods or services in any particular class, those specific goods or services must be deleted. The form includes extra space where the owner can specify which goods or services are still in use and which goods or services are no longer in use and should be deleted.

For example, if a registration for the mark ACME covers t-shirts and shorts, but at the time of filing the Section 8 Declaration the owner is no longer selling shorts, the owner should specify that the mark is no longer in use in commerce for shorts and that shorts should be deleted from the registration.

New goods or services cannot be added to the registration, and traditionally, goods could not be updated to reflect changes in technology (e.g., if a registration covered tape cassette players, the registration could not be amended to cover MP3 players).

However, in the fall of 2015, the USPTO announced a pilot program to allow, under limited circumstances, amendments to identifications of goods/services in trademark registrations that would otherwise be beyond the scope of the current identification. Amendments will be permitted where they are deemed necessary because evolving technology has changed the manner or medium by which the underlying content or subject matter of the identified products and services are offered for sale or provided to consumers. Additional information about the pilot program (which currently does not have a termination date) can be found on the [USPTO website](#).

### Specimens

Along with stating which goods or services the mark is currently used in connection with, a specimen of use must be submitted for each class of goods or services. Only one specimen is required per class, regardless of the number of goods or services included in the class.

Acceptable specimens for goods include photographs or photocopies of labels, tags, or product packaging. Acceptable specimens for services include advertisements, promotional materials, or website printouts that display the mark and refer to the services. Note, however, that advertising and promotional materials are generally unacceptable as specimens of use for goods.

The mark indicated on the specimen must be substantially the same as the registered mark. However, marks are

often updated and changed in the five or six years after registration. Specimens that reflect a change in a mark may be accepted if the change is not a “material alteration.” Whether a change is considered a material alteration is very subjective and is decided on a case by case basis. Generally, if the overall commercial impression of the mark has changed, it will be considered a material alteration. Changes in background may be permissible.

### **Excusable Non-use**

It is possible, in limited circumstances, to file a Section 8 Declaration and claim excusable non-use. In this rare case, a registration may be maintained even if a mark is not currently in use. An excusable non-use claim must include the following:

- The date when use of the mark in commerce stopped
- The approximate date when use is expected to resume
- Facts showing that special circumstances exist that excuse the non-use and that the non-use is not due to an intention to abandon the mark

Do not merely state that special circumstances exist; be sure to include substantive proof. You should specify not only the reason for the non-use, but also the specific steps being taken to put the mark back in use. You should also show that non-use of the mark is due to circumstances beyond the owner’s control.

Non-use may generally be excused in extenuating circumstances such as:

- A trade embargo
- Temporary non-use due to the sale of a business
- Temporary non-use due to a catastrophe

Conversely, business decisions (such as changes in strategy), ordinary business interruptions, and decreased demand for a product are generally not acceptable reasons for non-use.

### **Signatory**

The Section 8 Declaration must include a statement signed and verified by a person properly authorized to sign on behalf of the owner (i.e., a person with legal authority to bind the owner or a person with firsthand knowledge of the facts). If the owner is an individual, the individual should sign the Declaration. An attorney acting on behalf of the owner may also sign.

### **Appointing an Attorney of Record and Domestic Representative**

The Power of Attorney given by a client during the prosecution of an application ends once the mark registers.

Therefore, a Power of Attorney form is included in the Section 8 Declaration to appoint a new attorney of record or re-appoint the attorney who handled the underlying application. A separate Power of Attorney is not necessary.

Registrants who are not domiciled in the United States can appoint a domestic representative upon whom notices or process in proceedings affecting the registrations may be serviced. The Section 8 Declaration also includes a form to appoint a domestic representative. If a domestic representative is designated, you must identify the representative’s name, email address, and postal address, and the designation must be signed pursuant to 37 C.F.R. § 2.193(e)(8).

### **Possible Amendment of a Mark in a Registration**

As discussed above, although it is possible to submit a specimen that reflects an updated version of a mark (if the change is not a material alteration), the mark remains as originally registered. To amend the mark of record to agree with the mark as it is currently used, the owner can file a request to amend the registration, known as a Section 7 Request, and pay the required fee. If the change is accepted, the USPTO will issue an updated certificate to reflect the new mark. The current fee for filing a Section 7 Request is \$100 (if filed electronically).

### **Post Registration Office Actions and Deficiencies**

Section 8 Declarations are examined by the Post Registration section of the USPTO. If the Examiner finds any problems or has any questions regarding the filing, a post registration Office Action will issue. The trademark owner may then respond to the Office Action and attempt to resolve any issues. (If the initial time period to file the Section 8 Declaration has passed, an additional “deficiency fee” may be incurred upon responding to the Office Action.)

Note that the USPTO will conduct random audits of up to 10 percent of the combined total of Section 8 and 71 Declarations filed each year in which the mark is registered for more than one good or service per class. If you are selected for an audit, the USPTO will issue an Office Action requiring additional proof of use for specified goods/services (generally, for two additional goods/services per class). You must respond within six months and either:

- Submit the required proof of use (e.g., information, exhibits, affidavits or declarations, specimens of use)
- Delete those goods/services for which the mark is not being used

Failure to respond will result in cancellation of the entire registration (unless time remains in the Section 8 grace period, in which case you may file a complete new Section 8 Declaration, with a new fee and grace-period surcharge). The USPTO may also issue subsequent Office Actions requiring proof of use on some, or all, remaining goods/services. See 37 C.F.R. § 7.37(h); 82 Fed. Reg. 6259.

## Claim of Incontestability

Section 15 of the Trademark Act allows the owner of a registration to claim “incontestability” of a mark that has been in continuous use for five years after the date of registration. Incontestability affords certain presumptions and rights to a registered mark. Filing a claim of incontestability is not required, but is usually desirable where the registrant meets the prerequisites.

### The Effect of Incontestability

If a registration is “incontestable,” the registration is conclusive evidence (subject to certain statutory defenses) of:

- The validity of the registered mark and its registration
- The registrant’s ownership of the mark
- The registrant’s exclusive right to use the registered mark in commerce

In other words, the exclusive right to use a registered mark in commerce on or in connection with the registered goods/services becomes incontestable. See 15 U.S.C. §§ 1065, 1115(b).

Incontestability is only available to registrations on the Principal Register (including registrations issued pursuant to the Madrid Protocol), but not for registrations on the Supplemental Register. For more on the differences between the two Registers, see [Principal vs. Supplemental Register](#).

### Requirements for Filing a Claim of Incontestability

In order to claim incontestability, a registered mark must be in use on a continuous basis for five consecutive years after the registration date. Therefore, the earliest date a registrant can file a claim of incontestability is on the five year anniversary of the registration date (assuming the registration is otherwise eligible).

There is no deadline to file a Section 15 Declaration; it can be filed at any time after the five year anniversary of the registration (so long as the mark has been in continuous use for five consecutive years preceding the filing date of the Declaration). Additionally, filing a Section 15 Declaration is

optional, even if the registration is eligible. The requirements for maintaining and renewing a registration are separate and are not affected by claiming incontestability. However, given that the timing for claiming incontestability and filing a Section 8 Declaration coincide during the maintenance period (i.e., after the fifth year of registration), registrants frequently file both simultaneously. In fact, the USPTO filing system, TEAS, provides a convenient [form](#) combining the two.

Similar to the Section 8 Declaration, the Section 15 Declaration must be filed in the name of the current owner of the registration. If a registration has been assigned, the assignment should be recorded with the Assignment Branch of the USPTO (for more on assignment, see [Assignments of Trademarks](#)).

The Section 15 Declaration must specify the goods or services for which the mark has been in continuous use for the five year period preceding the filing of the Declaration. (More than one Section 15 Declaration can be filed at different times for different goods or services in the same registration.)

The Section 15 Declaration must state that there has been no final decision adverse to the owner’s claim of ownership of the mark for the goods or services, or to the owner’s right to register or maintain registration of the mark. It must also state that there is no proceeding involving these rights pending in the USPTO or in a court. In other words, if a registration is the subject of a pending lawsuit or proceeding before the Trademark Trial and Appeal Board, incontestability cannot be claimed.

Lastly, the Section 15 Declaration must include a statement signed and verified by a person properly authorized to sign on behalf of the owner (i.e., a person with legal authority to bind the owner or someone with firsthand knowledge of the facts). An attorney acting on behalf of the owner may sign. If the owner is an individual, the individual should sign.

A fee is required for each class to which the Section 15 Declaration pertains. The current fee is \$200 per class (if filed electronically).

A Section 15 Declaration is only reviewed to determine whether the filing meets the requirements under the relevant statute. It is “acknowledged” by the USPTO, but not substantively examined. No showing or proof beyond the owner’s verified statement is required. The question of whether the registration is actually incontestable and the validity of the claim of incontestability is an issue to be decided by a court in a proceeding involving the mark, should one ever arise.

# U.S. Trademark Registration Renewal

A trademark registration may be renewed for periods of 10 years at the end of each successive 10-year period following the date of registration. Registrations that are not renewed in a timely manner are canceled.

While a Section 8 Declaration is required to maintain the registration between the fifth and sixth year of registration, actual renewal of the registration takes place on each ten-year anniversary. A renewal application is required under Section 9 of the Trademark Act, and each renewal application must accompany a Section 8 Declaration. For more on Section 8 Declarations, see Section 8 Declaration of Use above.

A renewal application under Section 9 must:

- Be signed by the registrant or the registrant's representative
- List the goods or services to be renewed (if renewal is for less than all the goods or services in the registration)

- Include the requisite fee (the current fee is \$300 per class, if filed online)

The renewal application must be filed within one year before the expiration of the registration (each ten-year period). There is a six-month grace period for filing a renewal application for an additional fee. Currently, the additional fee is \$100 per class, if filed online.

Because the deadlines for filing renewal applications coincide with the deadlines for filing the Section 8 Declaration, a [combined form](#) is often filed and is available through the USPTO electronic filing system, TEAS. The combined form is almost identical to a Section 8 Declaration, but includes the request for renewal as well as the requirement to pay the renewal fee.

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A partner at Leason Ellis LLP, Peter Sloane counsels clients, prosecutes trademark and copyright applications, and litigates intellectual property disputes. His clients span from major well-known companies to privately owned businesses to individuals. They operate in fields as diverse as consumer electronics, luxury goods, entertainment, pharmaceuticals and industrial products.

Peter counsels clients on all aspects of trademark adoption and protection including licensing. From advising clients on issues of inherent registrability to computer database and full searching, he is adept at taking the steps necessary to ensure that a mark is properly vetted prior to adoption. Peter is also familiar with the issues that arise in foreign trademark searching when a client has plans to use its mark abroad. Over the years, he has handled a number of global trademark portfolios.

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Michelle (Dorman) Levin practices in all aspects of domestic and foreign trademark prosecution. Her experience extends to a wide range of industries including luxury goods, publishing, electronics and food and beverages.

Michelle has conducted all phases of trademark prosecution and maintenance before the U.S. Patent and Trademark Office, including preparing and filing responses to Office Actions in all types of substantive refusals. Michelle has also conducted trademark searches and drafted opinions regarding the availability and registrability of trademarks, counseled clients regarding registration requirements in the U.S., negotiated license agreements, and conducted intellectual property due diligences. Outside the U.S., she has worked on trademark matters in over 100 countries, prosecuting foreign trademark applications, including international applications filed through WIPO, and maintaining international trademark portfolios.

Michelle has also assisted in copyright, trademark, and patent litigations, including extensive legal research, and prepared and filed documents for trademark opposition proceedings before the Trademark Trial and Appeal Board. She has also registered and maintained domain name registrations, handled UDRP proceedings, and prepared and filed copyright applications.

While in law school, Michelle interned at Burberry Limited, where she conducted internet trademark enforcement and drafted trademark settlement agreements, cease-and-desist letters, and correspondence to infringing parties. She also interned at Classic Media, Inc., where she drafted licensing, merchandising, promotional, agency, and work for hire agreements.

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