

10 STEPS TO MAINTAIN YOUR TRADEMARK (SERVICE MARK) - REGISTERED or NOT

By Alex Butterman*

CONGRATULATIONS! You are the proud owner of a trademark or service mark registration from the U.S. Patent and Trademark Office. A trademark or service mark is property that belongs to your business and can be valued as a business asset. A registered mark is a more valuable business asset because the registration with the USPTO confers added rights and benefits such as:

- Nationwide rights in the mark;
- Presumption of ownership and validity of the mark – an evidence shortcut that helps demonstrate your exclusive right to use the mark as a mark on the specific goods/services associated with the mark;
- U.S. Customs ability to stop the entry of goods at U.S. ports that could infringe your rights in the mark;
- U.S. federal court jurisdiction over a law suit involving the mark;
- Public notice of your rights in the mark and the listing of your mark and registration rights in a free public federal government database;
- Prevention of the registration of any “confusingly similar” mark in the USPTO;
- Use of the federal registration ® (“R in a circle”) symbol with the mark (and related federal registration markings);
- Formal U.S. government issued certificate evidencing the registration of the mark.

A TRADEMARK REGISTRATION CAN BE VALID INDEFINITELY PROVIDED THE FOLLOWING TEN (10) STEPS ARE TAKEN:

- 1 through 8:** **USE** the mark (this cannot be emphasized enough);
9: **ENFORCE** exclusive rights to the mark; and
10: **RENEW** the registration every ten years after showing continuous use at the 6th year anniversary.

1. **USE THE MARK** by always applying (affixing) the mark to the associated goods as they travel through U.S. Commerce and display the mark whenever advertising the associated services. The mark needs to identify for consumers that your business, and only your business, is the provider of the goods or services associated with that mark. Consumers should know to associate that mark specifically with your business.
2. **KEEP USING THE MARK** *continuously and do not stop using the mark*. If others need to use the mark, even your own companies, subsidiaries, or the like, issue a LICENSE to use the mark – that is a

written agreement with the other user(s) defining the terms of use of the mark and exerting control over that use. If the mark cannot be used for reasons beyond the control of your business, document and maintain evidence of that reason as well as your intention to resume using the mark when possible again.

3. **USE THE MARK** *exactly as indicated on the registration certificate and in the same exact manner each time.* Never pluralize the mark or use it as a possessive. Always use precisely the same pictorial representation of the design (if any) shown on the registration certificate, including the same color scheme unless the registration is in black and white and does not cover any specific color.
4. **USE THE MARK** *set apart from surrounding words and material in different, more prominent fonts and sizes such as ALL CAPITALS; Underlined; **bold type** or "quotations."* Consumers need to distinguish the mark from other text on the label or in the advertisement so consumers recognize the term as a mark and not as descriptive or informational matter.
5. **USE THE MARK** *as an adjective, NOT a verb or noun.* As an adjective, the mark modifies your goods or services which should be described generically. For example, "MARK brand goods;" "Staas & Halsey legal services." Use of the mark as a noun results in the mark being considered generic and rights in the mark could be lost.
6. **USE THE MARK** *in the United States marked with the federal registration symbol: ® ("R in a circle").* The symbol should be adjacent to the mark, preferably at the lower or upper right hand corner. If exporting the goods to any other country, please do NOT use this registration symbol and contact us to ascertain what is required to comply with the local marking regulations.
7. **USE THE MARK** *and update the USPTO database with any changes in the ownership information for the registration.*
8. **USE THE MARK**, *the goodwill generated by that use and the ownership of the mark must remain together.* If a mark is to be conveyed, transferred or secured as collateral, the business associated with that mark and its goodwill must be included in that ownership transfer.
9. **RENEW** *and maintain the registration in the USPTO by filing the mandatory Section 8 Declaration of Continuing Use during the period between the 5th and 6th year of the registration date; and by filing that same mandatory Section 8 Declaration and a Section 9 Renewal application on each decade anniversary of the registration date (e.g.,*

registered Jan. 1, 2010; renewals due on Jan. 1, 2020; Jan. 1, 2030; etc.). In addition to the USPTO government fees associated with each declaration filing, each Section 8 declaration will require the submission of a "specimen" or example of how the mark is affixed to the goods or displayed with the services as well as a sworn declaration that the mark is still being used with the goods/services.

- 10. ENFORCE** *your exclusive right to use the mark by promptly monitoring for, and discovering, any third party use of the same or "confusingly similar" mark on any goods or services that may be competing, similar or related to your business. If any improper or unauthorized third party use of the mark is found, or observed being applied for in the USPTO, promptly contact your trademark attorney or retain one to discuss an effective strategy for dealing with that incident.*

IF THE MARK IS **NOT** REGISTERED, you still could have rights in it and all of the above applies *except* for numbers 6, 7 and 9.

- 1 through 5:** **USE** the mark (this cannot be emphasized enough);
10: **ENFORCE** exclusive rights to the mark

As you can see, constantly using the mark exactly as portrayed in the registration certificate for the goods or services listed therein is the single most important action needed to maintain a trademark registration, followed by enforcing your exclusive rights to the mark. Use of the mark also is critical to the ability to enforce those exclusive rights as well as to renew the registration in the USPTO.

Let Us Tailor an Intellectual Property Solution for Your Business

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