

PROTECTING YOUR REGISTERED TRADEMARK

NW CORPORATE LAW

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If you've ever obtained a registered trademark from the United States Patent and Trademark Office (USPTO), then you've received an official certificate that even has a fancy gold seal on it. It's the type of document that makes you think you've made it to the end of a long road and there's no work left to be done (sort of like a diploma). You've got the stamp of approval from the United States government, after all. Well, that's not quite the case. Just like other assets, unless you work to protect them, they may get damaged, deteriorate, or lose value. So, onwards you must go with more work to be done. In that vein, this article sets forth the steps that you should consider taking (in no particular order) to protect your trademark after it's been registered with the USPTO.

KEEP USING THE TRADEMARK

This step might seem like a no-brainer: you should continue using your trademark (or service mark) in commerce or you might lose your rights to use the mark at all. Sometimes companies register trademarks with the USPTO and then later focus their efforts on selling different goods or services. When that happens, those companies are no longer putting others on notice that they are claiming rights to their mark. A gap in the marketplace opens up, and other companies can step into that gap and start using that same mark, or at least make a good argument that they are permitted to do so. The lesson here is that if you spent all of the time and money in obtaining a registered trademark, and you intend to maintain it, then keep doing business under that mark and put it on your products or services in a conspicuous place. Most importantly, list it on the products or services that fall under the classification that you registered your trademark under. For example, if your products are shoes (Class 25), then place your trademark on the shoes themselves and any associated product packaging. Also consider putting the world on notice that you have a registered trademark by using the registered trademark symbol —you know, this one: ® —in connection with your mark.

RENEW YOUR REGISTRATION

Your registration with the USPTO will eventually expire unless you renew it. The first renewal deadline will occur between the fifth and sixth years after the registration date. During that time period, you must file what's called a Declaration of Use. If the USPTO accepts that filing, then your registration will continue for the remainder of the ten-year period following the registration date. Between the ninth and tenth years after the registration date, you again must file a Declaration of Use along with an Application for Renewal. You'll be required to complete those same filings every ten years thereafter. The USPTO is quite lenient about filing late: if you miss any of the renewal deadlines, as long as you make the filing within six months after the deadlines and pay an additional fee, the USPTO still will allow you to make the filings.

POLICE YOUR TRADEMARK

Your registered trademark is valuable, so you need to protect it. One way to protect it is by monitoring other USPTO trademark filings to determine if anyone else is trying to register the same, or a similar, trademark. Every Tuesday the USPTO publishes in its Official Gazette a list of all marks that it expects will register on the Principal Register. You can search the Official Gazette by going [here](#) and entering your relevant search criteria. Another option for monitoring other applications is to set up an account with MyUSPTO and then set up alerts through that system's Trademark Official Gazette Watch feature. (As of the date of this article, that system is still in alpha testing mode.) Consider policing your registered trademark by other means as well. In the United States, trademark rights arise by use of a mark in commerce. It's important to make sure that others aren't using the same or similar mark on the same or similar goods or services, even if they haven't filed applications with the USPTO. To that end, apart from periodically running Google searches, consider running searches of state trademark databases (states have their own trademark databases), and domain name registries (others may register related domains in bad faith while intending to profit from the goodwill associated with your registered trademark). If your business grows large enough, you might find that others will try to import counterfeit goods bearing your trademark into the United States. To help prevent those goods from entering the United States, you can record your registered trademark with the United States Customs & Border Protection agency. Taking the above steps will, at a minimum, give you a better chance of protecting your registered trademarks and will allow you to build value in those trademarks.