

The Post-Registration Handbook:

A Quick and Easy Guide to the Care and Maintenance of Your Trademark

By

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DISCLAIMERS

PLEASE READ THESE DISCLAIMERS: This handbook is intended to provide an informational overview to small business owners or other nonlawyers, and is not intended to provide legal advice as to any particular situation. The laws and regulations applicable to trademarks are complex and subject to change. Experienced trademark counsel should be consulted regarding the information covered in this handbook. This handbook may be considered attorney advertising materials in some jurisdictions.

ABOUT THE FIRM

Norton Law Corporation is a business and trademark law firm designed for the needs of entrepreneurs and established business owners alike. At the core of Norton Law Corporation is the use of technology and flat fee billing to enhance the legal services clients receive and give clients the personal attention they deserve, all while being completely transparent about price and services through up-front fixed-fee billing on most matters. In other words, Norton Law Corporation strives to take the stress out of seeking legal assistance. For more information about Norton Law Corporation, please visit our website at nortonlawcorp.com.

ABOUT THE AUTHOR

Eric Norton is a business and intellectual property attorney, and the founder of Norton Law Corporation. Mr. Norton created Norton Law Corporation to provide top tier legal services at affordable prices for business owners of all types—from small business owners, to tech entrepreneurs, to officers of major multinational corporations.

Admitted to practice in California, he received his Juris Doctor from the Chapman University School of Law with an emphasis in Environmental, Land Use, and Real Estate Law. Prior to law school, Mr. Norton graduated from UCLA with a Bachelor of Science degree in Microbiology, Immunology, and Molecular Genetics.

Mr. Norton is an avid photographer, an architecture buff, a sucker for new technology and good design, and a lover of brown shoes.

CONGRATULATIONS!

You're the owner of a freshly registered trademark. Feels good, doesn't it?

No more need for you to use that TM symbol. You're a member of the ® club now.

And for those of you who don't know how to make that fancy "R in a Circle" logo, here's a little trick that works a lot better than hunting through the symbols list. Just press Option + R if you're a Mac user or Control + Alt + R if you're a Windows person.

With the heavy stuff out of the way, it's time to talk about the next steps you'll need to undertake as a trademark owner. After all, registering a trademark is only the first step. A huge first step toward protecting your brand, but a first step nonetheless. From here on out, you're required to keep the USPTO up to date on what's going on with your trademark. That means you need to do two things: file post-registration documents with the USPTO and monitor the use of your mark.

In other words, you need to care and maintain your mark—and this guide will show you how.

DEADLINES

If the USPTO is famous for anything, it's the length of time you had to wait for registration. With registration times up to around 6-8 months on the low end, that's an impressive wait time—though they do receive thousands of new trademark applications each day. But if the USPTO is famous for anything else, it's imposing deadlines far into the future that they warn you of one time and never again. We've broken these deadlines down into required and optional categories.

Required Deadlines

Required Deadline 1: Five to Six Years After Registration

The first of these deadlines occurs between the fifth and sixth year after registration. At this time, you must file a Section 8 Declaration of Use (or Excusable Nonuse). There's also a fee of \$100 at the time of this writing.

Basically, the Section 8 declaration requires you to state, under penalty of perjury, you're still using the mark in commerce for the products/services your mark is registered for. Alternatively, the Section 8 declaration can state that you're not using the mark currently—but you have a very good reason as to why not. Failing to file the declaration will result in the cancellation of your mark (which means you'll have to start the registration process all over again). And improper filing can cause other issues.

If you miss the deadline, there's still hope. The USPTO gives you a six-month grace period to file the Section 8 declaration after the sixth year of registration. Of course it's never a good idea to try and file things after the deadline, and the USPTO accordingly punishes late filers with an extra \$100 fee per class. If you miss this six-month grace period, however, there are no further extensions.

We can file your Section 8 declaration for you for a \$95 flat fee plus applicable USPTO fees.

Required Deadline 2: Nine to Ten Years After Registration

The second required deadline comes between the ninth and tenth year after registration. You must file a Section 8 Declaration of Use (or Excusable Nonuse) *and* a Section 9 Application for Renewal. Of course, there's also an associated fee of \$500 at the time of this writing (which breaks down to \$400 for the Section 9 application and \$100 for the Section 8 declaration).

The Section 8 declaration is exactly the same as the one filed five years prior. The Section 9 application is very similar, but contains a request to renew the registration.

As with the Section 8 declaration, if you miss the deadline to file this combined application, you still have a six-month grace period after the tenth year of registration. The USPTO does, however, impose a fee of \$200 per class for late filings. And, accordingly, they do not allow filings after this grace period under any circumstances.

We can help you file the combined declaration and application for a \$245 flat fee per mark plus USPTO government fees.

Required Deadline 3: Every Ten Years After Registration

The third and final required deadline comes every ten years after registration, when you are required to file a combined Section 8 Declaration of Use (or Excusable Nonuse) and a Section 9 Application for Renewal. Just like before, there is a fee attached; currently set at \$500 at the time of this writing.

We can help you file the combined declaration and application for a \$245 flat fee per mark plus USPTO government fees.

Optional Filings

Declaration of Incontestability

Along with the required filings, there are also a number of optional filings, the most important of which is the Section 15 Declaration of Incontestability. By filing this document, and after review by the USPTO, your registered trademark becomes “incontestable,” which basically means that the fact your trademark is registered is conclusive evidence of your ownership of the mark and your right to use the mark with the goods/services you’ve registered for.

The Section 15 declaration can be filed at any time after five years of registration provided you have been using the mark for five consecutive years. However, I always recommend filing the Section 15 Declaration of Incontestability at the same time you submit the Section 8 Declaration of Use (or Excusable Nonuse) since the timing matches perfectly and, honestly, why wouldn’t you want to supercharge your trademark registration with an incontestability designation?

As is commonplace for the USPTO, the Section 15 declaration carries a fee, currently \$200 at the time of this writing, while the combined Section 15 declaration and Section 8 declaration is \$300 at the time of this writing. Both fees are per class.

We can help you with the Section 15 and Section 8 declarations. Our fee for filing the combined declaration is \$195 per mark plus all applicable USPTO fees, and our fee for filing just the Section 15 declaration is \$145 per mark plus all applicable USPTO fees.

Change of Ownership, Amendment, Correction or Surrender

These are all optional filings that carry no deadline.

Each of these is classified under Section 7, and all of them have to do more with housekeeping matters than anything else. Nevertheless, they are worth mentioning in this guide for completeness.

The first of these housekeeping forms is the Section 7 Request for Amendment or Correction of Registration Certificate. This is the form you'll use if you need to change something in the registration after your trademark has been registered. Maybe you've moved to a new office. Maybe there was a mistake in how your company's name was spelled. Doesn't matter. So long as your change to the registration information is immaterial (for example, it doesn't affect the classes of goods/services your trademark is registered for or the phrasing or design of your mark), you're good to go. Our fee to file this form is \$95 plus the USPTO filing fee of \$100 at the time of this writing.

The other form is the Section 7 Surrender of Registration for Cancellation. This form allows you to voluntarily cancel one or more classes of goods/services your mark is registered under, or your mark's registration in its entirety. Our fee to file this form is \$95.

MONITORING YOUR TRADEMARK

Monitoring your trademark is one of the most important things you'll need to do as a trademark owner. The USPTO thinks of trademarks with what essentially amounts to a "use it or lose it" philosophy. Basically, if you don't use your trademark with the associated class you're registered under, the USPTO may not be too willing to extend you registration when it's time to renew.

More importantly, however, is the need to police the use of your mark. As your brand grows and becomes more well-known, rival companies and individuals hoping to make a quick buck on your brand's good name will come out of the woodwork trying to use your trademarked name, logo, slogan, or otherwise, to build their own brand. And guess what? The USPTO will not lift a finger to help stop companies and people from infringing or diluting your trademark. It's up to you to police your own mark to ensure you're using it properly, but that others are not using it in ways you don't approve of.

So how does one go about monitoring a trademark? Well, it requires at least a regular review of new business filings, new trademark applications (with the USPTO and the World Intellectual Property Organization), domain name registrations, and an overview of how you're using your registered trademark in commerce.

Our trademark monitoring services cover all of the sources you need to track your registered trademark for a flat fee of \$345 per year.

AVOID GENERICIDE

Genericide. Death by becoming generic. You probably think I made that term up. Not a pleasant word to a trademark attorney, and it should definitely not be a pleasant word to you as a trademark owner. And believe me, the last thing you want to do with your mark is allow it to succumb to death by genericide.

So what is genericide? Simply, it's what happens to your mark when it becomes generic. Since trademarks are designed to be unique, creative, and individual to their particular product/service, they tend to die when they become part of the common language. That's why you can't trademark something like apple for an apple (but you can for a computer or record company) or chair for a chair (but you can for a video game development company). Those words are part of the common vocabulary and are simply too generic to be trademarkable.

However, when a trademarked word becomes so popular that it is added to the common language, it gets classified as generic, and bad things happen. Look at aspirin, yo-yo, and zipper. Those are three commonly used words that all used to be trademarks of their respective owners. You see, when a trademark becomes generic, others can petition to have the registration stripped from the mark since it is now generic or in rare cases, the USPTO can refuse to renew your mark because it is now generic. In fact, Google and Photoshop are two words that are currently in danger of becoming generic at the time of this writing, as more and more people are googling a search term or photoshopping a picture.

So, how do you prevent genericide? As your brand grows, you need to be vigilant about how people use your trademark. Establish guidelines and enforce them so people know that whatever your mark is, it is not to be used as the generic term for all items of its type. That's why you see companies like Xerox saying you don't Xerox a document, you photocopy it, or you don't blow your nose on a Kleenex, you use a facial tissue.

ASSIGNING YOUR TRADEMARK

There may come a time that you'll want to transfer ownership of that trademark to another person or entity. Maybe it's because you've sold your business. Maybe you decided to change the name of your company. Or maybe you just sold the trademark to another party. No matter the circumstance, that's where an assignment comes into play.

Unlike the other filings with the USPTO, an assignment is a little different. Instead of using the USPTO's standardized forms, you actually have to draft your own assignment agreement. They're not terribly complex, though they do have several requirements that need to be met for the assignment to be valid. As with every other legal document you work with in your business, we recommend you seek counsel from a lawyer before entering into a trademark assignment, and we are always ready to help with all of your trademark assignment needs.

Our flat fee for trademark assignments is \$295 per mark plus the USPTO filing fees of \$40 per mark at the time of this writing.

WATCH OUT FOR SCAM TRADEMARK COMPANIES

As a registered trademark owner, you are going to receive a lot of mail from companies claiming to have their own trademark registries or companies offering you services that don't really exist or are not necessary in the slightest. While these scam mailings have slowed down from their height a few years ago, they are still out there.

Often these mailings are intentionally designed to look like real invoices from an official source. But don't be confused, as they are not from the USPTO or any other governmental agency. The services offered by these mailings often have no value, and are merely an attempt to defraud you.

The most common kind of scam mailing is the fraudulent invoice. Companies send out these invoices that look official, like you owe money to the USPTO or World Intellectual Property Organization (WIPO) if you want to retain the rights in your trademark. Many examples have been kindly provided by the USPTO on their [Solicitation Warning page](#) and the WIPO on their similar [Warning page](#).

If you receive a notice like this or one which raises any doubts, please do the following:

1. Do not pay it.
2. Contact Norton Law Corporation.
3. Check the USPTO or WIPO websites (links above) to see if your notice or similar notices have been received by others.
4. Send a copy of the notification to the USPTO at TMFeedback@uspto.gov and/or the WIPO at pct.legal@wipo.int. Be sure to include a copy of the letter/invoice and the envelope it came in, the date of receipt, whether you originally thought what you received was an official communication, and whether you mistakenly paid the fees in response to the communication (and if so, include a copy of the cancelled check or other proof of payment).
5. Alert anyone else you know who may have received such a notice.
6. Make a complaint with the Federal Trade Commission (FTC) and/or the appropriate state agency.

NOW GET OUT THERE AND BUILD YOUR BRAND

With all of the technicalities of trademark care and maintenance out of the way, you need to focus on just one thing: building your brand. After all, that's why you registered your trademark in the first place—because you knew the need to safeguard your company's intellectual property and you wanted the world to know that your mark belongs to you. So what are you waiting for? Now is the time to expand your brand to its greatest potential so that one day, it can join the ranks of other famous trademarks and become a household name.