

## **U.S. Declarations of Use for Madrid-Based U.S. Registrations**

### **The Required Declarations**

Owners of U.S. Registrations obtained under the Madrid Protocol -- take note. November 2008, which is five years after the U.S. joined the Madrid Protocol, marks the beginning of deadlines for maintaining Madrid-based U.S. Registrations. Such registrations are subject to additional maintenance requirements, as discussed in more detail below. Therefore, if you are operating under the assumption that a Madrid-based U.S. registration can be maintained solely by renewing the Madrid registration with the International Bureau (IB) every ten years, then you are operating under a false assumption that may be fatal to your U.S. registration. The consequences of noncompliance with the *independent* U.S. deadlines for filing Declarations of Use are cancellation of the U.S. registration before it is due for international renewal, and the loss of valuable U.S. registration rights. Registrants and their attorneys should be aware of these independent U.S. requirements for filing Declarations of Use and the deadlines for compliance.

### **Compliance with U.S. Deadlines**

International Registrations through the IB are valid for ten (10) years, and can be maintained by filing for renewal every ten (10) years. On the other hand, in order to maintain the U.S. extensions of Madrid-based registrations, the U.S. Trademark Act requires the periodic

filing of Declarations of Use in the United States Patent and Trademark Office (USPTO). A Declaration of Use verifies the goods (services) set forth in a registration on which a mark is currently in use in the U.S., or that the mark is not in use due to special circumstances that justify such nonuse. A registration can be maintained only for those goods (services) for which a mark is in use at the time of filing the Declaration, unless a Nonuse Declaration is filed and accepted for those goods (services) for which the mark is not currently in use in the U.S. The U.S. Trademark Act uses the term “affidavit” rather than the term “declaration”.<sup>1</sup>

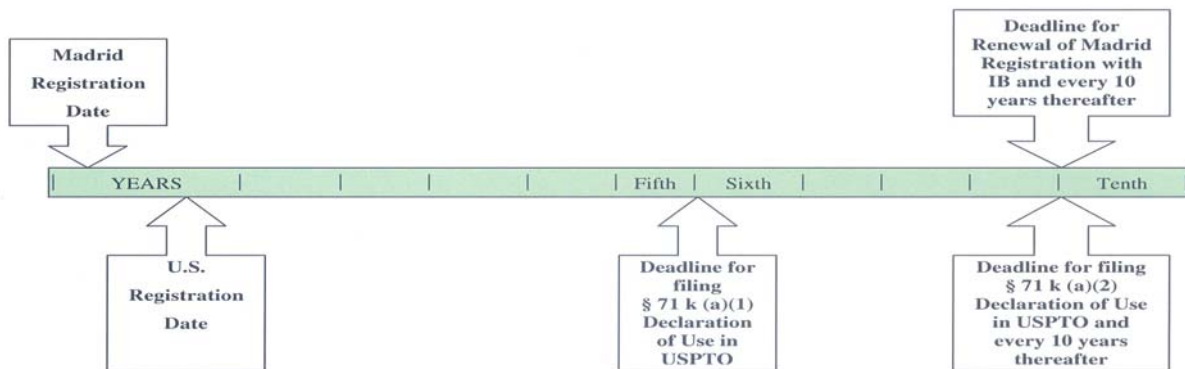
When must these Declarations of Use be filed in the USPTO in order to maintain Madrid-based U.S. Registrations? Section 71 of the U.S. Trademark Act, 15 U. S. C. §1141k (a)(1), as shown in the accompanying timeline, requires that a Declaration of Use under §71k (a)(1), of the U.S. Trademark Act must be filed in the USPTO between the fifth and sixth years after the date of the U.S. Registration (not the date of the international registration). A specimen showing use of the mark on the goods, as used in the U.S., must be filed with the Declaration of Use.

Section 71, 15 U.S.C. §71k (a)(2), also as shown in the accompanying timeline, requires that a Declaration of Use must be filed within the six (6) month period preceding the end of the ten (10) year term and for every successive ten-year term of the U.S. registration. Otherwise, the U.S. registration will be cancelled. Upon payment of a late fee, there is a three (3) month grace period after the expiration of the ten (10) year deadline.

---

<sup>1</sup> The two terms are often used interchangeably. This article refers to “declarations”, rather than “affidavits”, because a declaration does not require notarization, and, thus, is the more common and preferred form for filing.

## Timeline for filing Declarations of Use in the USPTO for Madrid-based U.S. Registrations



### **The Optional Incontestability Declaration**

Although not required, pursuant to §73m another type of Declaration referred to as a “Declaration of Continuous Use” may also be filed either at the time the §71k (a)(1) Declaration is filed, or any time thereafter. This Declaration verifies that (1) the mark in question has been in continuous use in the U.S. for the five (5) years preceding the filing of the §73m Declaration, (2) there has been no final decision adverse to registrant’s claim of ownership or right to register, and (3) there is no proceeding involving the registrant’s rights pending in the USPTO or in any court. Upon acceptance of the §73m Declaration, the U.S. registration will become incontestable within the meaning of the U.S. Trademark Act. One of the benefits of incontestability is that it limits the grounds for which a proceeding to cancel a registration may be filed.

### **Conclusion**

Accordingly, for U.S. extensions of an international registration under the Madrid Protocol, the owner must comply not only with the renewal deadlines in accordance with the rules of the IB, but must also comply with the Declaration of Use deadlines under the U.S. Trademark Rules. The consequences of not doing so will result in the loss of the U.S.

registration. Consulting with a U.S. attorney, and docketing the U.S. deadlines, will help to insure compliance with the Declaration of Use deadlines.

*Joseph F. Schmidt, Julie A. Katz, Michele S. Katz*

*All partners at the law firm, Husch Blackwell Sanders Welsh & Katz*