
U.S. Trademark Office Seeks Change In Trademark Maintenance Filing Requirements

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Most trademark owners know that §8 of the Trademark Act (15 USC §1058) requires an affidavit of use to be filed between the fifth and sixth anniversaries of the registration date of the trademark. Failure to file an affidavit of use by the sixth anniversary results in the registration being canceled. On August 10, 2012 the US Trademark Office announced its plans to request Congress amend §8 of the Trademark Act to require that the affidavit of use be filed between the third and fourth anniversaries instead.

This amendment, if enacted, will make §8 of the Trademark Act consistent with § 45 (15 USC § 1127), which provides that nonuse of a trademark for three consecutive years is considered prima facie evidence of abandonment. The change also will harmonize US law with that of many foreign countries, which provide for the automatic cancellation of trademark registrations after three years unless an affidavit of use is submitted. The four year limit will provide the Trademark Office with the ability to clear the registry of "deadwood" trademark registrations, including, in particular, trademark registrations filed by startup companies. The Trademark Office observes in its announcement that startup companies have significantly higher failure rates during the first two years after establishment than during the three years that follow. Although not mentioned in the official announcement, accelerating the date on which the affidavit of use must be filed will also accelerate the date on which the Trademark Office can collect the fee for filing the affidavit of use.

The proposed amendment will not change the date on which the affidavit of incontestability may be filed, which remains on or after the fifth anniversary. A link to the full announcement is at <http://www.gpo.gov/fdsys/pkg/FR-2012-08-16/html/2012-20130.htm>.

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