

The Importance Of Trademark Maintenance And Check-Ups

Intellectual Property Adviser

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Consider whether your business wants to confront these issues:

- A knock-off website refuses to stop using a brand similar to yours and claims that your company failed to register your trademark, even though you've been using it for decades.
- The potential acquirer of your company says you don't have your latest – and best – brand registered as a trademark. It then uses that fact as justification for a reduction in its offer.
- Your new lender wants to delay a closing because the trademark registration for your company name expired without renewal.
- Your company was diligent protecting brands in the past, but trademark protection issues were put on the back burner, and now your new brands lack formal registrations.

Surprisingly, some successful, growing companies have found themselves in similar positions. They have been rudely awakened to learn that they have forgotten to protect their newer brands or that their old trademark registrations had lapsed. Sometimes, the person designated to oversee brand protection had transitioned into another role or even another company. Other times, the company focused on protection issues in the past, but then failed to get “check-ups” to determine whether the old array of protection still made sense as new brands were introduced and the company evolved.

Trademark registrations issued in the United States after November 16, 1989 last for ten (10) years. See 15 U.S.C. §§ 1058-59. In order for a registration to survive to the end of that initial ten-year term, the trademark owner must make a mid-term filing between its fifth and sixth years proving that the owner continues to use the trademark. If the interim filing is not made, the registration will be cancelled after the sixth year. A major purpose of that law is to clean out dead-wood registrations. If a trademark owner is not careful, however, its registration will also be tossed out.

At the end of the registration decade, the trademark owner should consider applying for a ten-year renewal. Without a filing, the registration will expire. Trademark rights can also evaporate by an intentional abandonment of the brand or a failure to use the trademark for multiple years, even if the registration appears to be valid on the government's books.

In order to avoid the jams described above, consider engaging in regular “trademark checkups.” Working with counsel, you can verify that you have registered the names, logos, and brands that you want protected. It is a good opportunity to update old registrations, register new brands, and obtain more peace of mind about your intellectual property rights.

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If you have questions regarding the above, please contact attorney David Sar.