

REPORT

**CHANGE IN FILING PERIODS AND GRACE PERIODS
FOR U.S. TRADEMARK REGISTRATIONS
OBTAINED UNDER THE MADRID PROTOCOL**

March 30, 2010

Effective March 17, 2010, the Trademark Technical and Conforming Amendment Act of 2010 ("TTCAA")¹ made significant changes to the Trademark Act that affect deadlines for taking various actions to maintain U.S. registrations obtained under the Madrid Protocol. The TTCAA (i) changes the time periods in which owners of Madrid Protocol registrations may file Declarations of Use to maintain those registrations, (ii) changes the associated grace periods for owners of such Madrid Protocol registrations, and (iii) relaxes the formerly harsh consequences of filing a Declaration of Use in the name of the wrong owner.

I. New Filing Periods for Declarations of Use

Under U.S. law, all owners of trademark registrations must file Declarations of Use (that is, declarations establishing that the mark is being used in U.S. commerce in connection with all of the goods and services identified in the registrations) by (i) the six-year anniversary of the date of registration, (ii) the ten-year anniversary of the date of registration, and (iii) each successive ten-year anniversary of the date of registration.²

Prior to enactment of the TTCAA, the time periods in which a trademark owner could file a Declaration of Use for the first ten-year anniversary deadline and for each successive ten-year anniversary deadline were different for Madrid Protocol registrations than for all other U.S. registrations. Previously, the owner of a Madrid Protocol registration had to file a Declaration of Use within a one-year period immediately preceding the six-year anniversary deadline, but within a six-month period immediately

preceding each ten-year anniversary deadline.³ For all non-Madrid Protocol registrations, the relevant filing period was a one-year period immediately preceding the six-year anniversary deadline and each ten-year anniversary deadline.⁴

The TTCAA has harmonized the Declaration of Use filing periods under U.S. law. Now, all owners of trademark registrations (including Madrid Protocol registrations) may file the required Declarations of Use during the one-year period immediately preceding the six-year anniversary deadline and each ten-year anniversary deadline.⁵

II. New Grace Periods for Declarations of Use

Prior to enactment of the TTCAA, owners of non-Madrid Protocol trademark registrations had the option to file a Declaration of Use during a six-month grace period immediately following the expiration of any statutory deadline for filing a Declaration of Use.⁶ However, for Madrid Protocol registrations, there was no grace period available following the six-year anniversary deadline, and there was only a three-month grace period available following each ten-year anniversary deadline.⁷

³ 15 U.S.C. § 1141k(a) (2009).

⁴ 15 U.S.C. § 1058(b) (2009).

⁵ 15 U.S.C. §§ 1058, 1141k (2010).

⁶ 15 U.S.C. § 1058(c) (2009). Filing a Declaration of Use during a grace period was (and remains) subject to payment of a grace period surcharge. 15 U.S.C. §§ 1058(c), 1141k(a)(2)(B) (2009); 15 U.S.C. §§ 1058(a)(3), 1141k(a)(3) (2010).

⁷ See 15 U.S.C. § 1141k(a) (2009).

¹ Pub. L. No. 111-146, 124 Stat. 66 (2010).

² 15 U.S.C. §§ 1058, 1141k (2010).

March 30, 2010

The TTCAA has harmonized the grace periods under U.S. law. Now, all owners of U.S. trademark registrations (including Madrid Protocol registrations) may file Declarations of Use during a six-month grace period immediately following the expiration of any Declaration of Use deadline.⁸

III. Consequences of Errors in Declarations of Use

If a trademark owner files a Declaration of Use that contains one or more deficiencies, the U.S. Patent and Trademark Office (USPTO) will issue an Office Action that identifies the deficiency. The owner will then have six months from the date of the Office Action in which to correct the deficiency, even if that six-month period extends beyond the expiration of the applicable grace period.⁹ Previously, a trademark owner was unable to cure the deficiency in a Declaration of Use that was filed in the name of the wrong owner.¹⁰ The only way for a trademark owner to cure such a deficiency was to file a new Declaration of Use in the name of the correct owner prior to expiration of the applicable grace period deadline. If a trademark owner failed to file a Declaration of Use in the name of the correct owner prior to the grace period deadline, the USPTO would cancel the registration.¹¹

The TTCAA has amended the Trademark Act to specifically include filing a Declaration of Use in the name of the wrong owner as a deficiency that is curable according to the same rules that govern the correction of other

deficiencies. Now, if a trademark owner files a Declaration of Use in the name of the wrong owner, the USPTO will issue an Office Action that identifies the deficiency. The owner will then have six months from the date of the Office Action in which to correct the deficiency, even if that six-month period extends beyond the expiration of the applicable grace period.

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⁸ 15 U.S.C. §§ 1058, 1141k (2010).

⁹ Depending on the circumstances, a trademark owner may need to pay a deficiency surcharge and/or a grace period surcharge to correct a deficiency in a Declaration of Use. See 37 C.F.R. § 2.164 (2009).

¹⁰ It was (and remains) possible to correct a mere error (for example, a typographical error) in the presentation of the correct owner's information in a Declaration of Use. See TRADEMARK MANUAL OF EXAMINING PROCEDURE §1604.07(f) (6th ed. 2009).

¹¹ 37 C.F.R. § 2.164(b) (2009).