



**The United States Patent and Trademark Office is Seeking Comments on Potentially Amending the Federal Trademark Act, the Lanham Act, to Require the Filing of a Declaration of Use After Three Years of Trademark Registration Rather Than the Current Five**

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by [Phillip Barengolts](#), Partner

On August 16, 2012, the United States Patent and Trademark Office (USPTO) issued a Request for comment in the Federal Register on the potential amendment of the Federal Trademark Act – the Lanham Act – to require the filing of the first Affidavit or Declaration of Use or Excusable Nonuse (Affidavit) from between the third and fourth year after the issuance of a trademark registration, or the six-month grace period that follows. See [www.gpo.gov/fdsys/pkg/FR-2012-08-16/pdf/2012-20130.pdf](http://www.gpo.gov/fdsys/pkg/FR-2012-08-16/pdf/2012-20130.pdf). Specifically, the USPTO “is interested in receiving public input on whether and why such an amendment is or is not favored.” The deadline to submit comments is October 15, 2012.

Currently, under Sections 8 and 71 of the Lanham Act, the period to file the required Affidavit is between the fifth and sixth years after the trademark registration issues. This proposal would require Congress to amend the Lanham Act, and the USPTO cannot implement this change itself through a rulemaking or otherwise.

The purpose of the Affidavit is to eliminate “deadwood” (marks that are not actually used) from the federal trademark register. For attorneys and companies actively involved in the clearance of potential trademarks, having an accurate trademark register is valuable, and reduces trademark selection costs. However, as any diligent trademark attorney will tell you, just because a trademark registration has expired does not mean that the underlying trademark is not in use, nor does an active trademark registration reveal the scope of use in the marketplace – only an investigation can provide such details.

A potentially important consideration for this request by the USPTO is that an applicant for a trademark registration in the U.S. relying upon a foreign trademark registration (under Sections



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44(e) an 66(a) of the Lanham Act) does not need to submit a specimen of use to obtain the registration. Thus, such registrations would now be subject to a use requirement two years sooner.

The specific questions on which the USPTO seeks comment are:

1. Is “deadwood” on the trademark register a concern of yours, and what impact do you believe it has?
2. Do you favor or oppose an amendment to shorten the first filing deadline for Affidavits or Declarations of Use or Excusable Nonuse under Sections 8 and 71 as a means of ensuring the accuracy of the trademark register? (Please explain why.)
3. If you favor shortening the deadline, what time period do you believe would be most appropriate for the first filing deadline?
4. Are you concerned that an amendment to the first Section 8 and 71 affidavit deadline would foreclose the ability to combine the filing with the filing of an Affidavit or Declaration of Incontestability under Section 15? What impact do you believe separating these filings would have?

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