

MADRID PROTOCOL CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

INTERNATIONAL REGISTRATIONS CONTAINING A DESIGNATION OF THE UNITED STATES OF AMERICA

FILING OF AFFIDAVITS OF CONTINUED USE IN COMMERCE

1. It is recalled that the Madrid Protocol entered into force with regard to the United States of America, on November 2, 2003.
2. It is further recalled that at the time of its accession to the Madrid Protocol, the United States of America made the notification provided for by Rule 7(2) of the Common Regulations under the Madrid Agreement and Protocol, in accordance with which the United States of America requires, as a designated Contracting Party, a declaration of intention to use the mark (see Information Notice No. 23/2003).
3. In order to avoid invalidation of protection under United States law, holders of nationally-issued registrations, as well as holders of international registrations which include a designation of the United States of America, are required, in accordance with the provisions of the United States Trademark Act, to periodically affirm the continued use in commerce (or claim excusable non-use) of a mark with respect to the goods and/or services for which the mark has been granted protection.
4. The first affidavit affirming continued use in commerce, along with supporting evidence of use (or excusable non-use) is required to be submitted to the United States Patent and Trademark Office (USPTO) between the fifth and sixth anniversary of the date of issuing, by the USPTO, of a certificate of extension of protection (i.e., the United States registration date granting the extension of protection). This is *not* the date of the international registration or a subsequent designation in which the United States of America has been designated.
5. Please note that the affidavit should *not* be sent to the International Bureau of the World Intellectual Property Organization (WIPO). The affidavit is required to be sent directly to the USPTO. Any such document that is received by the International Bureau will be disregarded and will be thus without effect, for the purposes of the USPTO.
6. Following the expiry of the sixth anniversary of the date of issuing, by the USPTO, of a certificate of extension of protection, a further six-month grace period is allowed, during which the affidavit may be filed, on payment of an additional mandatory late fee.

7. The content of the affidavit must include a listing of the goods and/or services on or in connection with which the mark is in use in commerce and a specimen, such as a photograph of the goods, or an advertisement for the services, showing the current use of the mark. If the mark is not currently in use on or in connection with some or all of the goods and/or services, the affidavit must set forth those goods and/or services for which the mark is not in use and state that such non-use is due to special circumstances which excuse such non-use, and that it is not due to any intention to abandon the mark.
8. The affidavit must be signed and sworn, or supported by a declaration, as required by 37 C.F.R. §2.20, by a person who is properly authorized to sign on behalf of the holder. A person who is properly authorized to sign on behalf of the holder is: (1) a person with legal authority to bind the holder; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the holder; or (3) a qualified United States attorney as defined in 37 C.F.R. §11.1, who has an actual or written or verbal power of attorney, or an implied power of attorney, from the holder.
9. Failure to file such an affidavit will result in cancellation of the United States registration. Upon cancellation, the USPTO will notify the International Bureau of the invalidation of the mark in the United States of America.
10. After notification of invalidation, a holder may seek protection for the same mark in the United States of America by filing a subsequent designation. The subsequent designation may contain all or fewer of the goods and/or services in the international registration. After notification of the subsequent designation to the USPTO, the mark will be examined to determine if the holder is entitled to protection under the United States Trademark Act, as of the effective date of the subsequent designation.
11. For the purpose of submission of the affidavit, an online form has been made available by the USPTO at: www.uspto.gov. The form constitutes a properly-worded declaration for the purposes of 37 C.F.R. §2.20 and allows for the payment of the required fees by way of credit card, electronic transfer of funds, or to a deposit account in the name of the USPTO.
12. A further affidavit should be filed during the course of the year-long period leading to the tenth anniversary of the date of issuing by the USPTO of the certificate of extension of protection, or within the six-month grace period following that anniversary, accompanied by the late-payment fee. Subsequent affidavits should be filed during the course of the year leading to each following ten-year anniversary of the date of issuing by the USPTO of the certificate of extension of protection.
13. For further information on Registered Extension of Protection Maintenance Requirements in the United States of America, holders may refer to the USPTO website at: http://www.uspto.gov/trademarks/law/madrid/Madrid_Tips_Sec71_Filers.jsp.
14. For detailed policy and procedural information on "Use in Commerce", reference should be made to Chapter 900 of the USPTO's Trademark Manual of Examining Procedure at: <http://tess2.uspto.gov/tmdb/tmep/0900.htm>

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