

Excusable Non-Use of U.S. Trademarks in the Time of COVID

U.S. Trademark laws are based on the premise that rights in a trademark exist so long as the mark is continuously used in interstate commerce. Once you cease use of the mark without an intention of resuming such use, the mark may be subject to cancellation or abandonment by a third party.

So what does one do when it has to shut down its business, the sale or manufacture of products, or can no longer provide services due to the current Covid crisis but will be facing an upcoming filing for a Declaration of Use or Renewal at which time they have to attest that the mark is in use and will continue to be in use?

In all of my years of practice, I have never actually had to deal with this issue on a large scale. While it has come up only a couple of times due to strange circumstances which were limited to a particular client or industry, the current crisis will likely lead to many companies and individuals facing this issue.

Per TMEP §1604.11, “[t]he purpose of Section 8 of the Trademark Act is to remove from the register those registrations that have become deadwood...[i]t is not intended, however, to cancel registrations because of a temporary interruption in the use of the mark due to circumstances beyond the control of the owner of the registration.”

It is likely that “Excusable Non-Use” as detailed in Section 1604.11 will be a way for owners of registered trademarks to continue to protect their trademark rights and registrations until they are able to go back to business as usual if their businesses are indeed impacted by Covid and that is the cause of their non-use. Of course, registrants will need to properly evaluate the reason that they have ceased use and confirm that they are entitled to benefit from this provision. But it is definitely worth looking at if you have upcoming deadlines regarding continued use to see if it can benefit you and protect your registration.

At Buchalter, we understand that these are challenging and rapidly changing times. We have attorneys experienced in adapting and navigating clients through these trying environments and are here to help however you need. If we can be of assistance and to discuss various options and specific situations, please feel free to contact Farah Bhatti (fbhatti@buchalter.com).



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