



MAINTAINING PATENTS, TRADEMARKS & SERVICEMARKS

Welcome to another edition of Protecting Your Creativity by The Livingston Firm. Each edition of Protecting Your Creativity will discuss various aspects of intellectual property law and related business matters. This edition discusses what is required to keep patents and federal trademark registrations in force.

When the United States government issues a patent or trademark/servicemark registration, it is in essence issuing a conditional monopoly to the owner of the patent or trademark/servicemark registration. With regard to patents, the owner of a patent can prevent others from using, selling, making, offering to sell and/or importing an invention into the United States. With regard to trademark registrations, the owner of a trademark/servicemark registration can prevent others from using a confusingly similar name. The grant of a monopoly in the form a patent or trademark/servicemark is conditioned on certain requirements which are time critical or an owner of a patent or trademark/servicemark can lose its monopoly. In the case of patents, maintenance fees are required to be paid periodically. In the case of trademarks/servicemarks, proof of continued use, renewals and the payment of fees are required.

The process of obtaining patents and trademark/servicemark registrations can require a large investment of time and money. That is why it is especially disappointing when a new client comes into our office and we find out that patents and or trademark/servicemark registrations they thought they owned are no longer in force because maintenance fees were not paid or the proper affidavits and/or renewals were not filed.

PATENTS

Maintenance fees are required to be paid to the United States Patent and Trademark Office ("USPTO") after the issuance of a utility patent to keep the issued patent in force for the life of twenty years. Unlike utility patents, design and plant patents are not subject to maintenance fees after issuance. There are three maintenance fee payments due every 4 years that must be made during the life of the utility patent to keep it in force. The first maintenance fee is due by 4 years after the issue date of a utility patent, the second at 8 years and the third at 12 years. These fees are payable six months in advance of the due dates at 3 ½, 7 ½ and 11 ½ years from the issue date of the patent and can be paid with a nominal surcharge (currently only \$65) during the six month

period preceding each due date. If a maintenance fee is not paid in a timely manner then the patent will expire and fall into the public domain. Once a patent expires, the patent can only be revived under certain conditions upon filing a petition and paying substantial fees.

TRADEMARKS & SERVICEMARKS

After a trademark/servicemark receives a federal registration during the first 10 year term of a federal registration, a sworn statement in the form of an affidavit or declaration must be filed between the fifth and sixth year from the date of registration. The affidavit or declaration must state that the mark has been in continued use in interstate commerce since its registration. If the continued use affidavit/declaration is not filed between the fifth and sixth year of registration, then the trademark/servicemark registration will be cancelled. For a registration on the principal register an affidavit or declaration of incontestability may and should also be filed between the fifth and sixth year. The incontestability affidavit/declaration makes a trademark/servicemark registration incontestable by third parties, except for fraud.

In addition to the requirement of filing the continued use affidavit/declaration during the initial ten year term of a federal trademark/servicemark registration, prior to the end of the initial ten year term and every ten years thereafter a renewal application and fees must be filed with the USPTO or the registration will be cancelled.

As a side note, although State of Florida trademark/servicemark registrations do not require the filing of continued use affidavit/declarations, State registrations must be renewed every five years.

CONCLUSION

The loss of intellectual property rights, which are often a business's most valuable assets, can be devastating to a company. Therefore, the maintenance of patent and trademarks is of utmost importance. As clients often do not know of such requirements or fail to calendar or remember same, they usually rely upon, often unwittingly, their attorneys to do so for them. Unfortunately, many patent attorneys and patent agents choose not to or fail to advise, properly calendar and remind their clients of patent maintenance requirements. As a result many individuals and businesses unknowingly lose their patents. Similarly, many attorneys do not advise, calendar and remind their clients of required trademark/servicemark continued use affidavit/declaration and renewals; thus, the clients lose their trademark/servicemark registrations. Advising, calendaring and sending reminders for paying patent maintenance fees, and filing required trademark/servicemark affidavits/declarations is a service our firm provides to every client.

The Livingston Firm specializes in all areas of intellectual property law including patents, trademarks, copyrights, trade secrets, franchising, litigation and business law. As the largest full-service intellectual property law firm in Southwest Florida with over forty

years of combined experience, The Livingston Firm can be there to assist you from beginning to end with protecting your ideas and inventions and getting those ideas and inventions to market.

Thank you for taking the time to read this edition of Protecting Your Creativity. If you are in need of our services then please contact us to schedule an appointment.

Edward M. Livingston, Esq., U.S. Registered Patent Attorney, Board Certified in
Intellectual Property Law
Erica L. Loeffler, Esq.
Bryan L. Loeffler, Esq., U.S. Registered Patent Attorney

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The Livingston Firm
963 Trail Terrace Drive
Naples, FL 34103
239-262-8502
www.thelivingstonfirm.com
tlf@thelivingstonfirm.com

With offices in Fort Myers