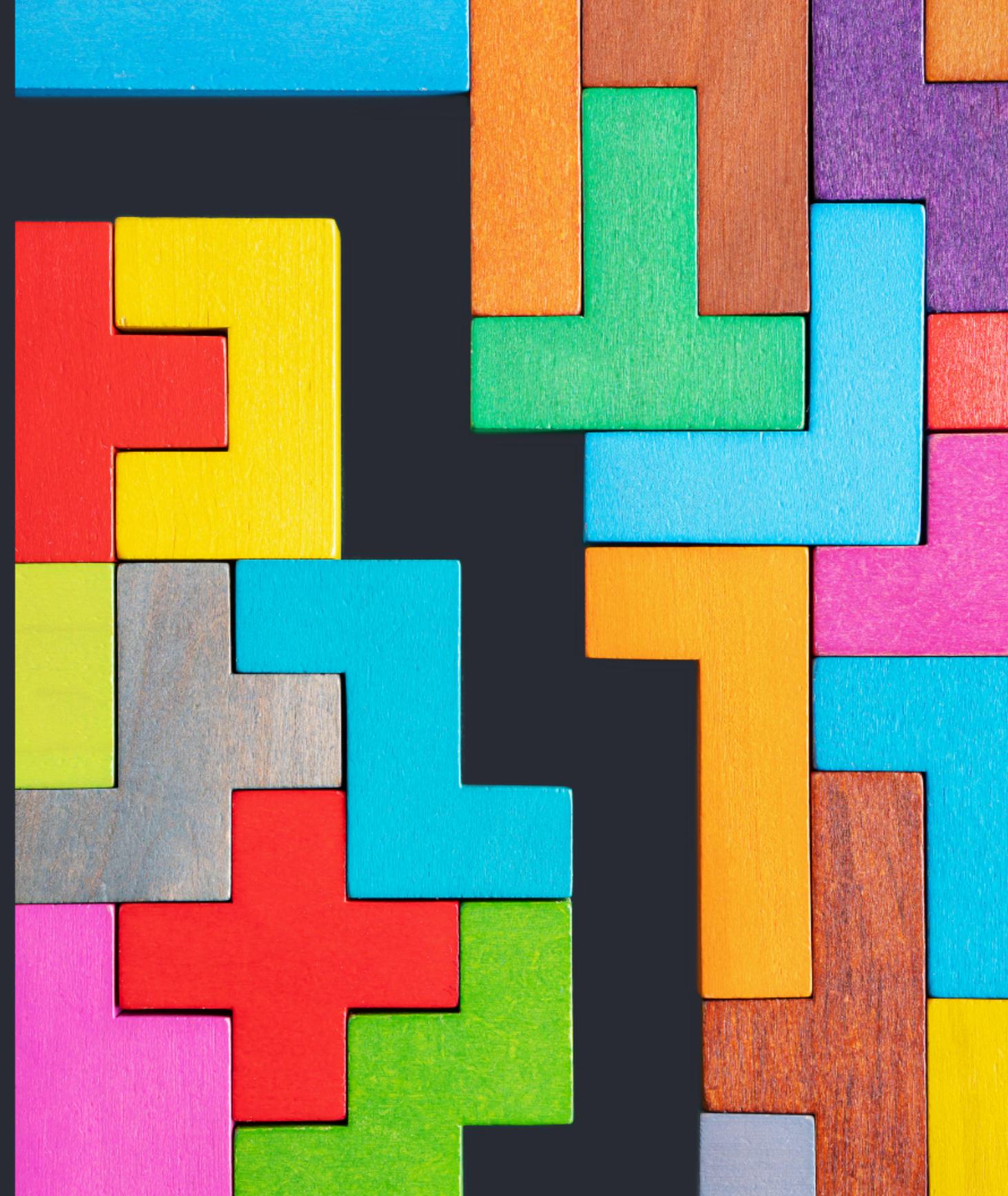


The ultimate guide to trademark renewals

RULES, IDEAS AND OPTIONS



Keeping trademarks alive

A distinctive trademark is a remarkable business tool, serving as the face and fingerprint of a brand while protecting that very same identity. But simply using your registered trademark in association with the relevant products is not enough to ensure its long-term survival. Every trademark must be periodically renewed wherever it is registered to retain maximal protection. This guide will take you through the ins and outs of the trademark renewal process and illustrate how you can simplify each step by partnering with an established global Intellectual Property (IP) services provider.

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Trademarks are evergreen IP, or are they?

In terms of keeping your brand identity at the forefront of consumers' minds, few things are as effective as a strong trademark. Or, better yet, a diverse portfolio of trademarked IP: business and product names, logos, symbols, slogans and other catchy identifying marks.

These IP assets can define your company's image for decades while registering them in salient jurisdictions gives you legal recourse against unauthorized use and counterfeiting. Of course, registration is not the end of the story. Trademarks must be renewed, typically at 10-year intervals and accompanied by fee payments. However, unlike patents, which inevitably expire, trademarks can be maintained indefinitely.

Registered trademarks' visibility and protection have a value that is not easy to quantify. Still, **with up to 90%** of a company's worth to be found in its intangibles, it can be immense. With the registration process itself taking substantial time and effort, why not capitalize on that work for as long as possible?



The trademark renewal process explained

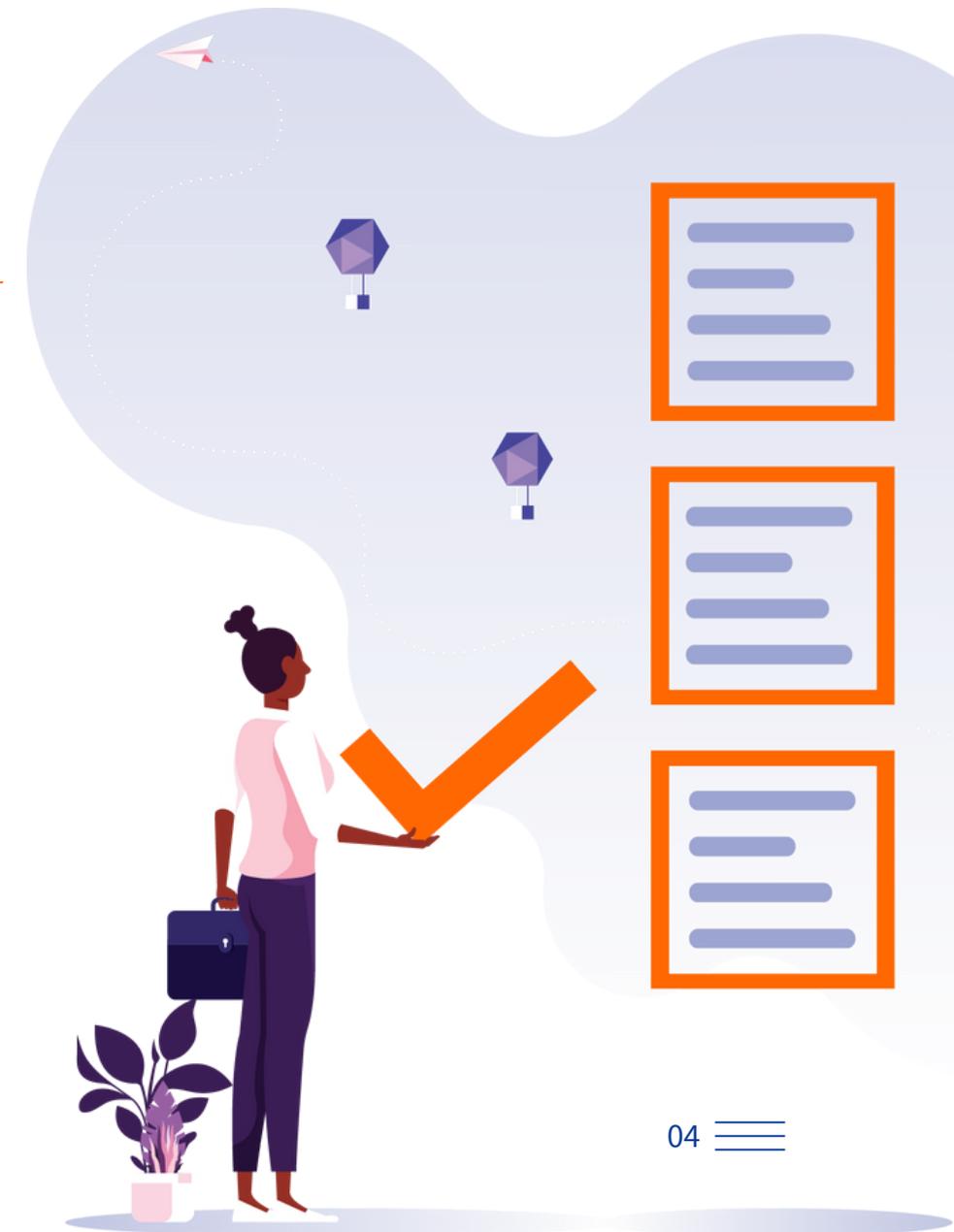
In many jurisdictions — and for international trademarks registered through the World Intellectual Property Organization (WIPO) Madrid System — renewal entails no more than submitting an application form and paying the associated fee for each mark. Most trademark owners file for renewal online, but IP offices also accept mail filings.

Sometimes additional documentation is necessary, most notably in the United States. Renewing a U.S. trademark or an international filing extended to the United States requires you to submit a declaration of use or excusable non-use. This material must attest to the commercial use of the mark in conjunction with the goods and services detailed in its initial registration or reasonably explain why the mark is not in use. Affidavits verifying use or excusable non-use, apart from the owner's declaration, are also necessary.

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These documents must first be filed no later than six years after the registration date, once again no later than 10 years post-registration and every 10 years thereafter.

Other jurisdictions requiring declarations of (intended) use, affidavits or both include Argentina, Cambodia, Cape Verde, Haiti, Mexico, Mozambique, the Philippines and Puerto Rico.





Potential renewal complications

Failure to meet deadlines is the most obvious pitfall to trademark renewals. There is typically a six-month grace period following the original deadline, during which registrants can pay a surcharge to submit renewal applications. Once this period expires, trademark offices consider a registration abandoned. Reinstatement is possible in cases of office errors or other extraordinary circumstances, but relying on such a safety net is unwise.

Additionally, even in countries that do not require declarations of use for renewal, any mark that is not in commercial use for more than five years is vulnerable to revocation by its registering office.

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Some jurisdictions have renewal obligations beyond fees, application forms and use declarations. Examples include public notices (Maldives, Micronesia), taxes (Honduras, Cayman Islands) and proof of renewal (Gibraltar, Solomon Islands).

Though uncommon, such provisions are just as important to the IP offices requiring them as all other regulations. Last but not least, attempting to renew a mark that does not apply to all of the goods or services for which it was registered initially can be problematic. Offices will, at minimum, invalidate the trademark's protection in those categories.

When not to renew

Understanding when renewal is unnecessary is every bit as important as knowing the steps for maintaining essential trademarks.

If you or your organization no longer offer products or services associated with specific marks, attempting to renew them would be a waste of time and resources. Let marks that have become genuinely inessential lapse and amend registrations to remove superfluous items. If your organization has rebranded or introduced new marks for existing offerings, renewing trademark protections for old IP might not make sense.

The same is true for trademarked product names that have become pervasive enough in public discourse to be considered generic. It can take many years for this to happen, but it is hardly unheard of, as evidenced by "hovercraft," "trampoline" and "kerosene."



The importance of record-keeping

Comprehensive record-keeping is integral to trademark renewals. The starting point should be a definitive inventory of your organization's registered trademarks. Particular attention should be placed on ownership information as it is likely various marks will be spread across different entities or subsidiaries of the business. Updating this catalog when ownership changes occur due to mergers, acquisitions, or other circumstances will ensure trademark protection continues uninterrupted.

Other important details for each registered trademark's record include:

- Dates and registration numbers
- Goods and services to which marks apply (with examples)
- Jurisdictions in which marks are registered
- Evidence of acquired distinctiveness (where applicable)
- Evidence of use (e.g., advertising materials)
- Licenses and licensees (where applicable)
- Deadlines for required maintenance actions (renewal applications, payments, use declarations, etc.)

Since most or all of these records will be stored digitally, IP management software that can arrange trademark portfolios in accordance with an organization's unique needs will be invaluable.



Four questions to ask during the renewal process

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Who oversees trademark renewals?

Other than in the smallest businesses, this should not be the responsibility of one person. A dedicated team or third-party partner will be essential.

2

Who contributes to the portfolio?

While those with the most IP experience should be responsible for day-to-day portfolio management, having input on trademark strategy from marketing, sales and customer service personnel and the C-suite is always beneficial.

3

How are renewals managed?

Are you using a dedicated IP management platform that includes support for all renewal processes or keeping track of records and deadlines in some other way?

4

Does the portfolio align with brand strategy?

If the answer to this question is ever "no" for one or more trademarks, you must shrewdly assess whether renewal is worth the time and effort (and begin developing more suitable marks).

Five steps for securing renewals

Though the trademark renewal process may sometimes be complex, it can be distilled down to a handful of key steps:

- ① **Keep meticulous records:** As described earlier, a complete transcript of registration and licensing information for every trademark is a must.
- ② **Update for ownership changes:** Failing to account for even a single trademark's change in ownership could negatively impact your organization's bottom line.
- ③ **Stay on schedule:** Place alerts for all relevant deadlines. Missing renewal dates is a non-starter, even accounting for grace periods. For example, the WIPO adds an extra 50% charge for renewals filed within its six-month reprieve window.
- ④ **Set priorities:** Long before renewal dates are on the horizon, you should determine which trademarks need to be renewed, which marks could be renewed but are not essential and which assets (if any) should be abandoned.
- ⑤ **Budget appropriately:** Earmark funds for the renewal expenses associated with — at a minimum — all top-priority trademarks.





How to manage trademark renewals

If your trademark portfolio is small or you have the resources to maintain a dedicated IP team, it may be possible to manage the renewal process in-house.

However, this is no simple task, even for specialized internal teams. It requires keeping track of regulations and monitoring renewal dates across multiple jurisdictions to ensure all applications are filed on time with all necessary documentation. Alternatively, a law firm can oversee your renewals. Trademark lawyers will keep abreast of regulatory changes and ensure you are notified as deadlines approach. Though this approach may alleviate some hassle, you will still be responsible for various aspects of portfolio management, and over time, the cost of keeping the firm retained may become unsustainable.

Advantages of a trademark renewals service provider

The third option is to choose an IP service provider that offers a comprehensive approach to managing the trademark renewal process. Availing of a fully integrated IP administration system that handles the process from start to finish allows for more advanced cost efficiencies while securing accuracy and reliability.

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An empowered provider will have the capacity to manage even the largest trademark portfolios across the globe with an optimized system for overseeing timely filings, fee payments and record-keeping.

Suppose the IP service provider also has an in-house legal division and is affiliated with trusted third-party law firms all over the world. In that case, this further ensures that changes in trademark regulations will be monitored and processes adjusted accordingly. Additionally, a highly qualified provider may also be able to supply your organization with IP management software and other cutting-edge solutions that can make the renewal process more streamlined and less stressful.



Choosing Dennemeyer as your renewal partner

Dennemeyer has been in the business of managing trademarks and all other IP assets for 60 years. Across six continents, our trademark specialists are responsible for overseeing more than 700,000 registered trademarks in over 200 jurisdictions. When you let us take the reins of your trademark renewals and other crucial management processes, you reduce your organization's administrative burden and free up resources to focus on core business activities and objectives.

Benefits of using Dennemeyer's trademark renewals services:

- Web-based solutions available 24/7, including Dennemeyer's Portfolio Management app and IP Lounge
- Dependable data transfer and checks to ensure accurate documentation and filing
- Guaranteed on-time renewal filings and fee payments
- Tailor-made renewal solutions with flexible add-ons
- Qualified legal expertise and representation around the world through Dennemeyer's local offices and trusted partners
- Fixed service fees for transparent and competitive pricing

Move forward with a simplified, streamlined trademark renewal process and talk to a Dennemeyer expert today.





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