

# USPTO Announces COVID-19 Trademark Use Guidance

by Andrew L. Goldstein

## A FREEBORN & PETERS LLP CLIENT ALERT

On April 9, 2021, the United States Patent and Trademark Office (“USPTO”) provided guidance regarding filings required to maintain trademark registrations and non-use of the registered mark due to COVID-19. This Client Alert is part of Freeborn’s ongoing analysis of the pandemic’s impact on intellectual property (prior alerts available [here](#), [here](#), [here](#), and [here](#)).



In order to maintain a registration for a trademark in the USPTO, the owner of the registration must file a Declaration under Section 8 of the Trademark Act stating that the registered trademark is in use in commerce in connection with the goods and/or services listed in the registration. The Section 8 Declaration must be filed in the fifth year of the registration (i.e., within the 1-year period immediately preceding the expiration of 6 years from the registration date), and then every 10 years from the registration date as part of the renewal process.

The USPTO announced that if COVID-19 has directly impacted you or your business and temporarily prevented you from using your registered trademark, you may request to be temporarily excused from using your trademark.

If you have an upcoming deadline to file a Section 8 Declaration for a registered mark and if you have been prevented from using the mark due to the pandemic, when you file the Declaration, you can provide a statement that includes the following:

- An explanation of how COVID-19 has affected you or your business and caused you to temporarily stop using your trademark for the goods and/or services covered by your registration;
- The date your trademark was last used;
- The steps you are taking to resume use; and,
- The approximate date you expect to resume using your trademark.

If you meet the above requirements, the USPTO will temporarily excuse you from meeting the use requirements under Section 8 and will not cancel the registration for your trademark. The foregoing also applies to the use requirement under Section 71 of the Trademark Act for registrations issued pursuant to the Madrid Protocol.

The USPTO did not state whether the above applies to the requirement to commence use of a mark within three years from the Notice of Allowance for an intent-to-use application, but the same should arguably apply to the use requirement for an intent-to-use application.

**Please note that the USPTO’s policies may evolve in the coming weeks, and Freeborn & Peters LLP is continuously monitoring the COVID-19 impact on intellectual property rights and regulations. If you have any questions, please contact Andrew Goldstein ([agoldstein@freeborn.com](mailto:agoldstein@freeborn.com); (312) 360-6438) or another member of Freeborn & Peters LLP’s Intellectual Property Practice Group, or visit [Freeborn’s COVID-19 webpage](#).**

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Andrew focuses his practice in the area of Intellectual Property and Information Technology. He has extensive experience in the areas of intellectual property law, including trademark, copyright, trade dress; internet, website, cloud computing, technology, outsourcing, IoT and computer law in general; advertising, marketing, and promotion law; and entertainment law, including video production, theater and dance-related matters.

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