

## **Madrid Protocol Concerning the International Registration of Marks**

### **International Registrations Containing a Designation of the United States of America: Courtesy Email Reminders of the Requirement to File Affidavits of Continued Use in Commerce Before the United States Patent and Trademark Office (USPTO)**

1. The United States Patent and Trademark Office (USPTO) has provided information to the International Bureau of the World Intellectual Property Organization (WIPO) on the procedure for holders of international registrations designating the United States of America (US) to receive courtesy email reminders of the requirement to file affidavits of continued use in commerce.
2. To avoid invalidation of protection under the law of the US, holders of US registrations as well as holders of international registrations containing a designation of the US are required to periodically affirm, in an affidavit, the continued use in commerce (or claim excusable non-use) of a mark with respect to the goods and services for which the mark has been granted protection. This affidavit must be filed directly with the USPTO.
3. As of January 2015, holders of US registrations and of international registrations designating the US receive a courtesy email from the USPTO reminding them of the upcoming deadline to file an affidavit of continued use in commerce if the holders have:
  - (a) a “live” registration on the date the reminder is sent,
  - (b) provided a valid email address to the USPTO, and
  - (c) authorized email communication with the USPTO.
4. These reminders are sent on the start date of the period to file the affidavit of continued use to the email addresses on record with the USPTO. The reminders identify the mark and indicate, *inter alia*, the deadline to file the said affidavit, as well as the grace period deadline and the filing fee per class. No reminders are sent by regular mail and no follow-up emails are attempted for undeliverable emails. Any failure by the USPTO to provide the courtesy email reminders or any non-receipt of such reminders will not excuse a holder who fails to meet its statutory obligations.
5. Holders are encouraged to use the USPTO Trademark Application Electronic System (TEAS) Change of Correspondence Address Form to indicate, update, or delete the email addresses to which the USPTO can send courtesy email reminders. To do so, holders need to enter the corresponding US application serial or US registration number. These numbers can be found in the statement of grant of protection sent by the USPTO under Rule 18*ter*(1) or (2) of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement. Holders cannot enter the international registration number. TEAS is available online at the following address: <http://www.uspto.gov/trademarks-application-process/filing-online>.

6. For further information on the requirement to file an affidavit of continued use (or excusable non-use), holders may refer to the USPTO website at: [http://www.uspto.gov/trademarks/law/madrid/Madrid\\_Tips\\_Sec71\\_Filers.jsp](http://www.uspto.gov/trademarks/law/madrid/Madrid_Tips_Sec71_Filers.jsp). Please, also see Information Notice No. 16/2010 at: [http://www.wipo.int/edocs/madrdocs/en/2010/madrid\\_2010\\_16.pdf](http://www.wipo.int/edocs/madrdocs/en/2010/madrid_2010_16.pdf).

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