Use Requirements for Trademarks- Avoidance of Cancellation Actions for Non-Use

MARY JUDE V. CANTORIAS[1]

Introduction

Under Philippine law, a trademark right is considered to be a form of property. As an attribute of ownership over such property, the owner of a registered mark enjoys the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade such mark in relation to the products or services for which it is registered, and in certain cases, prevent altogether the use of such registered mark in relation to entirely dissimilar products or services, where such use would result in a likelihood of confusion.

Republic Act 8293 or the Intellectual Property Code of the Philippines (IP Code)[2] mandates that rights to a mark shall be acquired solely through registration made validly in accordance with its (RA 8293) provisions. In some other jurisdictions however, trademark rights may be established either through "actual use in commerce" or through "registration" with the trademark office or both. Due to the diverse nature of trademark rights enforcement and protection, and its territorial nature, an effort to harmonize, if not unify, the rules through international law came into play.

The first successful attempt to treat protection of intellectual property as an item of trade negotiations among nations, and perhaps to establish the minimum requirements for IP rights protection, is the TRIPS Agreement or the Agreement on Trade Related Aspects of Intellectual Property Rights, Annex 1-C of the Marrakesh Agreement Establishing the World Trade Organization.[3] Article 15.3 of the TRIPS Agreement essentially provides that:

---

1 Lecturer, Arellano University School of Law.

2 Signed into law on June 06, 1997 by then President Fidel V. Ramos and took effect on January 01, 1998.

3 Significant Developments in Intellectual Property Law: Treaties, Statutes and Jurisprudence, Vicente B. Amador, http://www.ibp.org.ph

> "Members may make registrability depend on use. However, actual use of a trademark shall not be a condition for filing an application for registration. An application shall not be refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of application."

The development of Philippine laws in intellectual property rights have been mainly based on US laws and jurisprudence. It is no wonder then that much of our practices here have been aligned to that of the United States Patent and Trademark Office (USPTO).

Under US trademark law, registration is not a prerequisite for using a mark or protecting a mark against infringement. In that jurisdiction, protection of trademark rights can accrue simply through actual use of the mark in commerce. Those marks that are not registered but nonetheless are eligible for protection are called common law trademarks or service marks.[4] Trademark rights, under US Federal law, arise from either (1) actual use of the mark, or (2) the filing of a proper application to register a mark in the USPTO stating that the applicant has a bona fide intention to use the mark in commerce.[5]

Under certain international agreements, like the TRIPS, an applicant from outside the United States may file for trademark registration in the United States based on an application or registration in another country. The IP Code recognizes as well what is known as priority rights, complying with certain requirements, where an application for registration of a mark filed in the Philippines and which application for registration for the same mark was previously duly filed in a country that affords reciprocal rights to Philippine nationals, shall be considered as filed as of the day the application was first filed in that foreign country. An application claiming priority right must be filed within six (6) months from the date the earliest foreign application was filed.[6]

---

4 http://www.probonopartnership.org/publications/trademark.htm

5 http://wolfgreenfield.com/media/news/news.8.pdf

6 Rule 203, Trademark Regulations (as amended by Office Order No. 08)

This paper will journey with the trademark right holder in traversing the vagaries of IP rights and protection pertaining to the use requirements of trademarks to avoid cancellation actions from a third party or to initiate cancellation actions against third party for non-use.

Concept of use in commerce and non-use

In essence, an applicant with the USPTO who has already commenced using a mark in commerce may file for registration based on that use (a "use" application) while an applicant who has not yet used the mark may apply for registration based on a bona fide intention to use the mark in commerce (or what they refer to as an "intent-to-use" application). This is in variance to Philippine trademark law under the IP Code that recognizes the "first-to-file" system, where the use of a mark in actual Philippine commerce prior to registration does not clothe said mark with any protection but is merely a fulfillment of one of the requirements for trademark registration pertaining to declaration of actual use or the DAU. Once application has commenced, it is imperative that actual use of the mark in commerce takes place within the period above specified. Otherwise, such mark is open to cancellation proceedings from any third party who may be minded to do so or *motu propio* by the Director of Trademarks.

The use in commerce must be a bona fide use in the ordinary course of trade, and not made merely to reserve a right in a mark. Use of a mark in promotion or advertising before the product or service is actually provided under the mark on a normal commercial scale does not qualify as use in commerce. For trademarks, the date of first use in commerce (US jurisdiction) [interstate commerce or commerce between the U.S. and another country] would be the earliest date a product bearing the mark (on the product itself or on a label or package for the product) was sold or distributed to the public.[7] Mark owners can minimize loss of rights in their marks first, by properly maintaining the marks and second, by monitoring third parties who attempt to use their marks or confusingly similar variations of their marks.[8]

---

7 http://www.probonopartnership.org/publications/trademark.htm

8 Preventing Loss of Federal Trademark and Service Mark Rights, Janet M. Garetto, Jenkens & Gilchrist P.C, Intellectual Property Today, September 2002, http://library.findlaw.com.

Forms issued out by the Philippine Intellectual Property Office (IPO) for purposes of showing proof of actual use require a verified declaration of certain information, among others, to wit: (1) the date when the mark was first used, (2) the goods or services on which the mark is actually and presently used in the Philippines, (3) the name and address of the establishment(s) where the goods are sold and/or the services are rendered. Finally, attached to the verified declaration are five (5) labels or pictures of the mark or at least pictures of the stamped container visibly or legibly showing the mark.

Under the IP Code, particularly Sec. 145 thereof, it is provided that:

> A certificate of registration shall remain in force for ten (10) years, provided that the registrant shall **file a declaration of actual use** and evidence to that effect, **or** shall **show valid reasons based on the existence of obstacles to such use**, as prescribed by the Regulations (means the Rules of Practice in Trademarks and Service Marks formulated by the Director of Trademarks and approved by the Director General: Sec. 121.6, RA 8293), within one (1) year from the fifth anniversary of the date of registration of the mark. **Otherwise, the mark shall be removed from the Register by the Office**. (*Emphasis Supplied*)

It has yet to be tested if a sale through the internet may be considered as actual use in commerce, where the products are sold on-line and orders may be shipped from all over the world, not withstanding lack of actual presence of goods for sale in the Philippine market.

As in Philippine trademark registration, to obtain a federal registration in the US, applicants must use their marks in commerce in connection with all of the items recited in the application. To maintain the federal registration, mark owners must continue commercial use of their marks. For trademarks, this requires continued placement of the mark in or on the goods, containers, or documents associated with the recited goods. For service marks, this requires continued use or display of the mark in selling or advertising the recited services. If mark owners fail to maintain use of their marks in the United States for a sufficient period of time and intend not to resume usage, abandonment may result from non-use. If

usage of a mark is interrupted and the mark is subsequently deemed abandoned, the mark owner cannot revive the original rights in the mark following the non-use period. In other words, where a period of non-use results in abandonment, subsequent use of the mark cannot revive the original rights in the mark. The subsequent use represents a new and separate use with a new date of first use.[9]

In the case of *Romero v. Maiden Form Brassieres Co., Inc., 10 SCRA 556, citing Nims, Unfair Competition and Trademarks, p. 1269*, the Philippine Supreme Court had occasion to illustrate such circumstances that justify non-use of a mark in this jurisdiction. "Non-use because of legal restrictions is not evidence of intent to abandon. Non-use of their ancient trademark and the adoption of new marks by the Carthusian Monks after they had been compelled to leave France were consistent with an intention to retain their dispute over their old mark. Abandonment will not be inferred from disuse over a period of years by statutory restrictions.

Likewise, in the case *of Philippine Nut Industry, Inc. v. Standard Brands Incorporated, et.al., GR No. L-23035, July 31, 1975,* the Philippine Supreme Court went on to say: "Still on this point, petitioner contends that Standard Brands' use of the trademark PLANTERS was interrupted during the Japanese occupation and in fact was discontinued when the importation of peanuts was prohibited by Central Bank regulations effective July 1, 1953, hence it cannot be presumed that it has acquired a secondary meaning. We hold otherwise. Respondent Director correctly applied the rule that non-use of a trademark on an article of merchandize due to legal restrictions or circumstances beyond one's control is not to be considered as abandonment. In this case, the Japanese occupation and the issuance of a Central Bank regulation prohibiting the importation of peanuts were considered as circumstances beyond one's control.

Based on the foregoing, it can be inferred that what Philippine law contemplates as a circumstance beyond one's control that would amount to a "legitimate reason" for non-use is such circumstance that would almost be penal in nature, carrying with it a sanction which cannot be easily brushed off.

---

[9] Preventing Loss of Federal Trademark and Service Mark Rights, Janet M. Garetto, Jenkens & Gilchrist P.C, Intellectual Property Today, September 2002, http://library.findlaw.com. (SUPRA note 8)

Petitions for Cancellation

Meanwhile, under Sec. 151 of the IP Code, a petition to cancel a registration of a mark may be filed with the Bureau of Legal Affairs (BLA) by any person who believes that he is or will be damaged by the registration of such mark. Pursuant to said Section 151, Rule 8 of the Regulations on *Inter Partes* Proceedings (Petitions for Cancellation of a Mark, Patent, Utility Model, Industrial Design, Opposition to Registration of a Mark and Compulsory Licensing) was laid down by the Office of the Director General of the Intellectual Property Office, pursuant to its rule making powers, to set the guidelines for cancellation of registered of marks, among others.

Section 2 of such Rule 8 of the Regulations on *Inter Partes* Proceedings, further provides that the petition for cancellation of the registration of a mark may be filed:

(a) Within five (5) years from the date of registration of the mark under the IP Code;

(b) At any time, if the **registered mark becomes the generic name** for the goods or services, or a portion thereof, for which it is registered, or has been **abandoned**, or its registration was obtained fraudulently or contrary to the provision of the IP Code, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. **A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service**. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which the mark has been used. Evidence on purchaser motivation shall not be admitted.

> (c) At any time, if the registered owner of the mark **without legitimate reason fails to use the mark within the Philippines, or to cause it to be used in the Philippines** by virtue of a license during an uninterrupted period of at least there (3) years. (*Emphasis Supplied*).

On the other hand, Section 124.2 of the IP Code also provides that:

> The applicant or the registrant shall file a declaration of actual use of the mark with evidence to that effect, as prescribed by the Regulations within three (3) years from the filing date of the application. Otherwise, the application shall be refused or the mark shall be removed from the Register by the Director.

Otherwise stated, the failure to file the declaration of actual use, while the application for registration of a mark is pending or if already approved and registered, within the three year period, is a ground for refusal of registration or removal from the register *ipso jure*.

A distinction, however, must be made between a mark in the process of registration and a mark already registered with the Trademark Office. While the IP Code expressly provides that the owner of a registered mark may **show valid reasons based on the existence of obstacles to such use** within one (1) year from the fifth anniversary of the date of registration of the mark, the law is silent as to whether a declaration of (valid/reasonable) non-use may be accepted for a mark yet to be registered.

Corollarily, non-use of a mark may be excused if caused by circumstances arising independently of the will of the trademark owner. Lack of funds shall not excuse non-sue of a mark.[10]

---

[10] Sec. 152, IP Code.

Application and registration: Non-use vis-à-vis abandonment under RA 8293 and the US Trademark Act

Further on the issue of abandonment, the Philippine Supreme Court held that "To work an abandonment, the disuse must be permanent and not ephemeral; it must be intentional and voluntary, and not involuntary or even compulsory. There must be a thoroughgoing discontinuance of any trademark use of the mark in question."[11] Based on the foregoing ruling of the Supreme Court, abandonment of a (registered) trademark has two elements: (1) ceasing use; and (2) the intent not to resume use.[12]

Inferring from Section 2 of Rule 8 earlier quoted, the continuous non-use of a mark by the registered owner, without legitimate reason, for an uninterrupted period of three (3) years, or longer, is sufficient ground for the cancellation of its registration. This provision creates the presumption of abandonment on the part of the registered owner for non-use of a mark, without legitimate reason, for a period of three (3) years.

The concept of abandonment, insofar as an application for registration of a mark is concerned, finds a different meaning in this jurisdiction under Rule 614 of the Trademark Regulation, which provides that: "If an applicant fails to respond, or to submit a complete response, within the period given counted from the mailing date of an action of the (Trademark) Examiner, the application shall be deemed abandoned as of the day immediately following the last day of the aforesaid period." The action of the Examiner refers to any form of determination that the applicant is not entitled to the registration of his mark for any reason. The applicant will be so notified and will be advised of the reasons for the denial of the application and of any formal requirements or objections, and he will be given such information and references as may be helpful to him in the further prosecution of his application.

The foregoing notwithstanding, an abandoned application may be revived as a pending application within three (3) months from the date of abandonment, if it is shown to the satisfaction of the Director (of the Bureau of Trademarks), and upon payment of the required fee, that the

---

11 Philippine Nut Industry, Inc. v. Standard Brands, Inc., et.al., GR No. L-223055, July 31, 1975.

12 Cerveceria Centroamericana SA v. Cerveceria India, Inc 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989).

delay was due to fraud, accident, mistake, or excusable negligence. There shall be no revival of an abandoned application that has been revived once before on the same issue.[13]

On the other hand, where the mark is already registered, in §8 of the US Trademark Act, 15 U.S.C. §1058, the owner of the registered mark must file an affidavit or declaration of continued use or excusable non-use within the allowed period, or the registration will be cancelled: (1) between the fifth and sixth year after the date of registration or date of publication under §12(c) of the Act; and (2) within the year before the end of every ten-year period after the date of registration.

In §8(c)(1) of the Act, 15 U.S.C. §1058(c)(1), the affidavit or declaration may be filed within a grace period of six months after the expiration of the deadline set forth in §8(a) of the Act, upon payment of an additional grace period surcharge.

If the owner of the registration does not file an affidavit or declaration of continued use or excusable nonuse before the end of the grace period, the registration will be cancelled. [37 C.F.R. §§2.160(a) and 2.164(b)]

The affidavit cannot be filed before the period specified in §8(a) and (b) of the Act. The purpose of the affidavit is to show that the mark is still in use in commerce within the relevant period, which cannot be done by an affidavit filed prior to that period. [*In re Holland American Wafer Co*., 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984)]

If an affidavit is filed before the period specified in §§8(a) and (b) of the Act, the Office will issue a notice advising the registrant that the affidavit is premature; of the appropriate time for filing the §8 affidavit; that the fee(s) submitted will be held; and that the registrant may file a new affidavit at the appropriate time or may request a refund at any time. There is no deficiency surcharge. The prematurely filed affidavit will be placed in the file. If a newly executed affidavit or declaration is not filed before the end of the grace period, the registration will be cancelled and the fees refunded.[14]

---

13 Rule 615, Trademark Regulations.

14 http://www.uspto.gov/web/offices/com/sol/tmlwtrty/postreg.htm

It would indeed be interesting if the Philippine Trademark Office will be made to decide on an issue above contemplated in *In re Holland American Wafer Co*. case, given the fact that US trademark laws have persuasive effect in our jurisdiction. This US case may be a prelude of things to come.

Both Philippine and US rules require that an affidavit or declaration of continued use must include a specimen or facsimile showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed. The specimen must show use of essentially the same mark as the mark shown in the registration on or in connection with the goods or services listed in the certificate of registration.

Evidently, the affidavit of actual use or declaration of continued use presupposes that indeed the owner of the registered mark continues the bonafide use of its mark on the goods or services in the course of trade. Failing to satisfy the scrutiny of the respective trademark officers, a registered mark may be cancelled on account of non-use amounting to abandonment.

Excusable non-use in US soil

Under US Trademark, Rule 2.161(f)(2), 37 C.F.R. §2.161(f)(2), an affidavit or declaration claiming excusable nonuse must recite facts and circumstances that clearly demonstrate that nonuse is due to special circumstances beyond the owner's control that excuse the nonuse, and is not due to any intention to abandon the mark. The affidavit or declaration must state when use in commerce stopped and give the approximate date when use is expected to resume. It must also specify the reason for nonuse, the steps being taken to put the mark back in use in commerce, and any other pertinent facts. The determination of whether the nonuse is excusable is made by the Post Registration paralegal. If the paralegal holds that the facts set forth do not show excusable nonuse, the owner may file supplementary evidence or explanation.[15]

It goes without saying then that if the preceding is not satisfactory, then the registered mark is in danger of being removed from the registry.

---

[15] http://www.uspto.gov/web/offices/com/sol/tmlwtrty/postreg.htm

In his article, *Preventing Loss of Trademarks Rights: Quantitative and Qualitative Assessments of "Use" and Their Impact on Abandonment Determinations, 94 Trademark Reporter 634 (May-June, 2004),* Christopher T. Micheletti discoursed on the quantity and quality of use of trademarks and provided an analytical framework for assessing "use" of the mark at issue. There, he said that quantitative measures of use such as dollar and unit sales are rarely the sole determinant of abandonment. Courts examine other quantitative use variables such as licensing use, use in advertising and promotion, and the geographic scope of use. He further stated that "Courts also assess a variety of qualitative variables, including commercial use versus noncommercial use, "sham" use, the extent of residual goodwill, and the products or services with which use is made. Finally, in some cases, the quantitative or qualitative nature and scope of use may impact the court's assessment of the trademark's owner's intent not to resume use, which must be proven in order to establish abandonment."

A case in point

"A recent decision of Canada's Federal Court of Appeal has provided further guidelines in determining whether use of a design mark which varies from the form under which it is registered under Canada's *Trade-Mark Act,* 1985 R.C.S.c. T-13, will constitute use of the registered trade-mark. The Court concluded that use of a variant mark will be assimilated to use of the registered mark, provided that the continuing commercial impression remains the same." (*Munsingwear Inc. v. Promafil Canada Ltée* No. A-235-90, July 8, 1992).

Too, in Section 152.2 of RA 8293, the use of the mark in a form different from the form in which it is registered, which does not alter its distinctive character, shall not be a ground for cancellation or removal of the mark and shall not diminish the protection granted to the mark.

In the given case above, applicant Promafil Canada Ltée ("Promafil") applied for the expungement of Munsingwear Inc.'s ("Munsingwear") design trade-mark under Section 18(1) of the *Trade-Marks Act*, on the ground, *inter alia*, of abandonment. The Trial Judge who heard Promafil's application held for expungement. In 1977, Munsingwear's licensee, Stanfield's Limited, applied to register under the *Trade-Marks Act* a mark which consisted in the representation of a penguin for use with sport shirts and walking shorts. This application

matured to registration in 1981, under number TMA 261,104, following which, it was assigned from Stanfield's Limited to Munsingwear while Stanfield's Limited was recorded as a registered user. Over the years, Munsingwear's licensee diversified its clothing products sold under the aforementioned trade-mark to cover sweaters in 1978 and socks in 1982. However, during the early 1980's, apparently because it realized that the trade-mark it was using on its wares slightly differed from the mark under its registered form, Munsingwear applied on June 28, 1985 to register the altered version of its trade-mark,

The two versions of the trade-mark were referred to by the Trial Judge as then "slim penguin" mark and the "corpulent penguin" mark. The representation of the slim penguin was found not to have been used since 1982. Consequently, in order to determine if the trade-mark registered under No. TMA 261,104 (the "slim penguin") was indeed abandoned by Munsingwear in 1982, the **Court would have to decide if use of the corpulent penguin trade-mark could be assimilated to the use of the slim penguin trade-mark**. Determination of this issue would resolve the question of abandonment of the trade-mark registered under No. TMA 261,104. The Trial Judge, Mrs. Justice Reed, had concluded for abandonment when she wrote: "In my view, the visual impact of the two designs is sufficiently different that I could not conclude that one is merely a variant of the other or that an unaware purchaser would conclude they denoted the same origin...Since I do not find that the corpulent penguin is a mere variant of the registered penguin design (the slim penguin), the applicant has proven that the mark is no longer in use in Canada".

However, the Federal Court of Appeal, under the pen of Mr. Justice MacGuigan, took a different view. In doing so, it reviewed the similarities and dissimilarities of the slim penguin trade-mark and the corpulent penguin trademark.

The appellate court held that: “In my opinion these differences do exist. The question is whether they are sufficient to make the two trademarks substantially different. The appellant contended that the dominant features of the registered mark have been preserved by its more corpulent depiction: (1) both forms show the outline of a penguin; (2) both forms show front-elevational views of a penguin; (3) both penguins are standing; (4) both are looking to the left; (5) both have their arms and legs outstretched; and (6) both are wearing a tuxedo. In short, both forms show a fanciful line-drawing of a spread-eagled penguin wearing a formal vest. This analysis also appears to be accurate. Which, then, should prevail?"

The Court referred to Section 7(e) of the *Lanham Act*, 15 U.S.C. § 1057(e) which permits amendments to registration, provided they do not alter materially the character of the mark. Quoting from Gilson, *Trademark Protection and Practice* vol. I (1991), at 4-62 to 4-64 and *Dreyfus Fund Incorporation v. The Royal Bank of Canada,* 525 F. Supp. 1108 (1981), **the Court concluded that US law requires "the maintenance of the same continuing commercial impression" for permitted amendment.**

After review of the marks at issue, the Court of Appeal set aside the decision of the Trial Judge and concluded that the trade-mark registered under TMA 261,104 was still in use: "Looking at the facts of this case in the light of then Canadian law, which emphasizes the maintenance of identity and recognizability and the preservation of dominant features, I can respectfully conclude only that the Trial Judge committed a palpable and overriding error in finding that the visual impact of the two designs is substantially different. **My conclusion would not be weakened if I were to take account of the American standard of "the same, continuing commercial impression**". The two designs are different, admittedly, but in my opinion they differ only in petty details. The dominant impression created by the dominant features in both designs is that of a spread-eagled, formally dressed penguin, with head, beak and limbs turned similarly.[16]" *(Emphasis Supplied)*

The author therein commented that this decision is interesting in that it referred to the specific provisions for amendment of a trademark registration, which exist in the US.

Without attempting to be a savant, this representation believes that the preceding argument may prove handy and it would seem easy to see where Philippine jurisprudence may thread given a similar situation.

---

[16] Lifted from: US law assists court in finding that registered trademark, used in a variant form, was not deemed abandoned, Barry Gamache, http://www.robic.com/publications/Pdf/142.031.pdf

The World Intellectual Property Organization- the sacred middle ground

"The World Intellectual Property Organization (WIPO) is one of the specialized agencies of the United Nations (UN) system of organizations. The "Convention Establishing the World Intellectual Property Organization" was signed at Stockholm in 1967 and entered into force in 1970. However, the origins of WIPO go back to 1883 and 1886, with the adoption of the Paris Convention and the Berne Convention respectively.

WIPO became a specialized agency of the United Nations when an agreement was signed to that end between the United Nations and WIPO which came into effect on December 17, 1974. A specialized agency, although it belongs to the family of United Nations organizations, retains its independence. Each specialized agency has its own membership. The agreement between the United Nations and WIPO recognizes that WIPO is, subject to the competence of the United Nations and its organs, responsible for taking appropriate action in accordance with its basic instrument and the treaties and agreements administered by it, *inter alia*, for promoting creative intellectual activity and for facilitating the transfer of technology related to industrial property to developing countries in order to accelerate economic, social and cultural development.

Why is an intergovernmental intellectual property organization needed? Intellectual property rights are limited territorially; they exist and can be exercised only within the jurisdiction of the country or countries under whose laws they are granted. But works of the mind, including inventive ideas, do and should cross frontiers with ease in a world of interdependent nations. Moreover, with growing similarity in the approach and procedures governing intellectual property matters in various countries, it makes eminent sense to simplify practice through international standardization and mutual recognition of rights and duties among nations.

Therefore, governments have negotiated and adopted multilateral treaties in the various fields of intellectual property, each of which establishes a "Union" of countries which agree to grant to nationals of other countries of the Union the same protection as they grant to their own, as well as to follow certain common rules, standards and practices.

The Unions administered by WIPO are founded on the treaties. A Union consists of all the States that are party to a particular treaty. The name of the Union is, in most cases, taken from the place where the text of the treaty was first adopted (thus the Paris Union, the Berne Union, etc.).The treaties fall into three groups.

The first group of treaties establishes international protection, that is to say, they are treaties which are the source of legal protection agreed between countries at the international level. For instance, three treaties on industrial property fall into this group—the Paris Convention, the Madrid Agreement for the Repression of False and Deceptive Indications of Source on Goods and the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration.

The second group consists of treaties which facilitate international protection. For instance, six treaties on industrial property fall into this group. They are the Patent Cooperation Treaty, which provides for the filing of international applications for patents, the Madrid Agreement Concerning the International Registration of Marks, the Lisbon Agreement, which has already been mentioned because it belongs to both the first and second groups, the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure and the Hague Agreement Concerning the International Deposit of Industrial Designs.

The third group consists of treaties which establish classification systems and procedures for improving them and keeping them up to date. Four treaties, all dealing with industrial property, fall into this group. They are the International Patent Classification Agreement (IPC), the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks and the Locarno Agreement Establishing an International Classification for Industrial Designs.

Revising these treaties and establishing new ones are tasks which require a constant effort of international cooperation and negotiation, supported by a specialized secretariat. WIPO provides the framework and the services for this work."[17]

---

[17] Lifted from: WIPO Intellectual Property Handbook: Policy, Law and Use, Geneva, WIPO Publication, No. 489 (E), ISBN 9292-805-1291-7, WIPO 2004, Second Edition

Conclusion

In summary, a Declaration of Actual Use is a sworn statement, filed by the owner of a registered mark or by the applicant, or their duly authorized representative, that the mark is in use in commerce. If the owner of the registered mark is claiming excusable nonuse of the mark, a Declaration of Excusable Non-Use may be filed. However, it would seem that the filing of a Declaration of Excusable Non-Use is only available for registered trademarks, as RA 8293 is silent on whether an excusable non-use declaration may be filed for purposes of maintaining a trademark application.

The purpose of such Declaration is to remove marks no longer in use from the register and to allow another, not the registered owner thereof, to make us of the same should he be minded to do so. In effect, a trademark that is no longer in use is reverted to the public domain and may be open for appropriation by someone other than the previous owner.

Post registration maintenance of a registered trademark would obviously mean to continue using the mark in the form in which it is registered, and on the products or services for which the mark has been registered, subject only to such exceptions as the law may allow. Indeed post registration maintenance may be time consuming and may require expense on the part of the registered owner, but it will all be worth the effort if you are protecting an economically viable mark.

On a more pragmatic level, author Janet M. Garetto, in her paper *Preventing Loss of Federal Trademark and Service Mark Rights, originally published in the September 2002 issue of Intellectual Property Today*, has this to say:

> "Mark owners should use their marks as source indicators, maintain a continuous commercial impression by minimizing format changes, and maintain a similar style or quality of goods or services sold under their marks.
>
> Trademark and service mark owners should properly use their marks as source indicators for the specific products or services recited in their registration.

> Mark owners should not use their marks as generic names such as noun forms of the mark and adjectives that refer to the category or class of goods or services. If the mark owner improperly uses its mark in a generic manner, the consuming public may also describe the product or service in this form. Eventually, the mark may become the generic name for the goods or services recited in the registration, and the mark may be deemed abandoned.
>
> Trademark and service mark owners may change the format of their marks but must not substantially change the format. Where material modifications to the mark occur, the mark owner may be prevented from claiming priority of use from the earlier form of the mark because the newer mark may form a different commercial impression than the earlier mark. If the modifications are sufficiently material, the owner may be prevented from "tacking" or claiming priority from the earlier mark, and the earlier mark may be deemed abandoned. In contrast, where a continuous commercial impression is maintained with a format change in the mark, priority can be dated to the earlier mark and abandonment can be avoided."

But more importantly, it is the vigilance of the trademark owner that will save him from the expense and loss of efforts in having to go through a cumbersome and protracted opposition or cancellation case against third parties who may attempt to use their marks or confusingly similar variations of their marks. As recommended by Ms. Garetto, mark owners should search for applications which are pending within the PTO (or in our case, with the IPO) that potentially infringe or conflict with their marks. The IPO maintains an Electronic Official Trademark Gazette that can aid a mark owner in searching for such pending applications. When a potentially conflicting mark is discovered through this monitoring process, the mark owner may wish to take action to prevent registration of the potentially conflicting mark because unconsented uses progressively weaken the mark's strength.

Ultimately, and as clichés would have it, prevention would be a more prudent option than finding "cure".