



Mesmer & Deleault, PLLC
41 Brook Street, Manchester, NH 03104
Seacoast Office: One New Hampshire Ave., Suite 125
Portsmouth, NH 03801



“Tip of the Month”

Trademark Incontestability

Between the fifth and sixth years of registration for a federally-registered trademark, the trademark owner must file a statement of use declaring that the mark is being used in interstate commerce. We recommend to our clients that a declaration of incontestability also be filed at this time. Trademark owners ask, “What is incontestability and why do I need it?”

In essence, incontestability status conclusively establishes the validity and ownership of the mark for the goods and services described in the declaration. Incontestability status is not required, but it expands trademark rights by making the mark immune from certain legal challenges.

When a trademark owner sues for trademark infringement, a common defense is for the defendant to claim that the mark is not a valid trademark. If the mark is incontestable, a defendant cannot assert that defense, claim improper registration or challenge the ownership of the mark. A defendant also cannot defend infringement by claiming that the mark is “merely descriptive” of the goods or services. In addition, the infringing defendant may not oppose a request for an injunction even if the mark is not yet in use in a particular geographic region.

Incontestability status establishes a presumption of validity and ownership of the mark unless the defendant can establish fraud, abandonment of the mark for non-use, or that the mark has become generic. Thus, in practice, the mark is not truly incontestable, but is much safer from attack by a defendant in litigation.

A trademark registered on the US Trademark Office’s Principal Register may be classified as incontestable by filing an affidavit after five years of continuous use from the date of federal registration. The declaration of incontestability can be filed sometime between the fifth and sixth anniversaries of the date of federal trademark registration. The declarant must also confirm that no final judgment has been rendered against the mark and that the mark has no pending challenges.

If you have questions about registration, maintenance, or enforcement of a trademark, contact the attorneys at Mesmer & Deleault, today at (603) 668-1971 or send an email to mailbox@biz-patlaw.com.

Frank B. Mesmer, Jr.
Robert R. Deleault
Ross K. Krutsinger
Joshua N. Mesmer
Steven H. Slovenski – *of Counsel*
0614



(603) 668-1971
Fax (603) 622-1445
E-mail: mailbox@biz-patlaw.com
Website: www.biz-patlaw.com