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Will the COVID-19 Pandemic Impact the Ability to Secure an "Incontestable" Trademark?

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Section 15 of the Lanham Act, subject to certain specified exceptions, provides that the right of an owner "to use [a] registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable."[1] This affords the owner of a registered mark valuable benefits, including, subject to certain express exceptions, a bar on others challenging:

- The validity of the mark, including any challenge that the mark is defective on the grounds of mere descriptiveness.[2]
- The registration of the mark.
- The ownership of the mark.
- The owner's exclusive right to use the mark in connection with the registered goods and services.[3]

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To secure the benefits of incontestability, within one year after the expiration of the five-year period, the owner must file with the U.S. Patent and Trademark Office ("PTO") an affidavit setting forth, among other things, that the mark has been in continuous use for such five consecutive years and is still in use in commerce.[4]

CONTINUOUS USE IN THE COURTS

Courts have held that to satisfy the "continuous use" requirement for incontestability, the mark must have been used throughout the entire period in connection with the sale of goods or services that were sold or transported in commerce.[5] In another context, that of the "prior use" defense to a claim of infringement of a registered mark, where the party seeking to assert the defense must prove that its use of the mark was in continuous use prior to the registration of the mark of which it is accused of infringing, courts have held that for use to be a continuous use, the use must be "maintained without interruption"[6]

COVID AND CONTINUOUS USE

In light of the COVID-19 pandemic, and the resultant temporary closure of many businesses, the question arises whether such closures, and the possible temporary non-use of registered trademarks during this period of closure, will interfere

with trademark owners' ability to claim continuous use and thereby secure incontestable trademarks. While caselaw is scant on this issue in the context of incontestability, certain cases may be instructive.

In *Brittingham v. Jenkins*,[7] the court held that the registration of a service mark for a French fry product had not become incontestable because the mark was not used continuously in connection with the sale of goods in commerce for the required five-year period following registration. The court rejected the trademark holder's argument that during the two years when his French fry business was closed, the mark was nevertheless used in the name of the new business he helped to create, in a lease agreement, and in the advertising of his new business. The court reasoned that the five-year continuous use provision of 15 U.S.C. § 1065 applies solely to the use of a mark in connection with the sale of goods and services and not in relation to other business activities.[8] The court also confirmed that neither the Lanham Act nor the published cases contain any exceptions to the five-year continuous use requirement for incontestability.[9]

Similarly, the court in *Elvis Presley Enterprises, Inc. v. Capece*,[10] explained that the nonuse of "The Velvet Elvis" service mark during the period while the nightclub at issue was closed may also break the period of continuous use required to establish the mark as incontestable under 15 U.S.C. § 1065.

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Moreover, while the PTO, as a result of the Coronavirus Aid, Relief, and Economic Security ("CARES") Act, has set up procedures to extend deadlines with respect to certain actions, nothing set forth in such Act, nor the regulations adopted by the PTO, appears to toll the incontestability requirement of "continuous use" during the pandemic.[11]

CONCLUSION

In light of this, trademark owners wishing to secure the benefits of incontestability at the earliest possible date should consult their legal advisors about what, if anything, they may do during the pandemic to maintain their claim of "continuous use."

Notes

1. *See* 15 U.S.C. § 1065 (emphasis added).
2. *See Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 105 S. Ct. 658, 661 (1985).
3. *See* 15 U.S.C. § 1115(b).
4. *See* 15 U.S.C. § 1065; 37 C.F.R. 2.167(f).
5. *See Brittingham v. Jenkins*, 914 F.2d 447, 454 (4th Cir. 1990).
6. *Casual Corner Assocs., Inc. v. Casual Stores of Nev., Inc.,* 493 F.2d 709, 712 (9th Cir.1974); *see also Conversive, Inc. v. Conversagent, Inc.,* 433 F.Supp.2d 1079, 1089 (C.D.Cal.2006); *Garden of Life, Inc. v. Letzer,* 318 F.Supp.2d 946, 957 (C.D.Cal.2004) (same) and that the use must be more than "sporadic, casual, and nominal" *Conversive,* 433 F.Supp.2d at 1089 [quoting *Garden of Life,* 318 F.Supp.2d at 957].
7. 914 F.2d at 454.
8. *Id*.
9. *Id*.
10. 141 F.3d 188, 205, ft. 9 (5th Cir. 1998).
11. *See* CARES Act Sub. 12004(a), March 31, 2020, USPTO Notice of Waiver of Trademark-Related Timing Deadlines under the CARES ACT, *available at https://www.uspto.gov/sites/default/files/documents/TM-Notice-CARES-Act_0.pdf.*