

Trademark Advisory: U.S. Customs--A Trademark Owner's Ally

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Your trademarks are the face and identity of your business and, therefore, one of your company's most valuable assets. Your business most likely has expended or will expend significant time and resources creating your trademarks, promoting them as a source identifier for your goods, and registering them with the United States Patent and Trademark Office (USPTO). Having gone this far, you should seriously consider taking the next simple step of recording your trademarks with the United States Customs and Border Protection (CBP), a bureau of the Department of Homeland Security. CBP can be an effective ally in helping you protect these valuable assets from infringement for a minimal cost.

If you have ever seen a "Made in _____" sticker or notation on a product, you are well aware that a significant part of U.S. commerce involves products being imported from other countries, the majority of which come from Asia, Mexico and South America. These foreign goods come into the United States through ports of entry where CBP Officers inspect them before authorizing them to enter the country. CBP conducts these inspections, at all of its 317 ports of entry, in an effort to prevent the importation of counterfeit products that infringe federally registered marks and thereby erode the profits of U.S. businesses. Significant safety and quality issues are also a problem with counterfeit products, which can tarnish the reputation of a trademark owner.

So, how does CBP determine which goods are counterfeit and violate another's federally registered trademark rights? When a federally registered trademark is recorded with CBP, the information is entered into an extensive trademark recordation system that is accessible to CBP Officers at all U.S. ports of entry and around the world. Customs officials will then use this recorded information to detain, seize and forfeit shipments of trademarked goods that they "reasonably suspect" violate a federally registered mark, then notify the trademark owner of the detention or seizure. Following the seizure of the merchandise, CBP may provide a sample of the suspect goods to the trademark owner to examine or test, or use in the pursuit of a trademark infringement lawsuit.

Besides the CBP monitoring and seizing infringing merchandise at ports of entry, there are several other advantages to recording a trademark with CBP. First, because CBP is a so-called trademark watchdog, it helps your company in its efforts to locate and prosecute unauthorized importers illegally using your company's federally registered trademarks. Second, CBP has the authority to impose heavy monetary fines against anyone who assists in the attempted introduction into the United States of counterfeit merchandise, and may request that the U.S. Attorney's Office prosecute those involved under the Trademark Counterfeiting Act of 1984. This can aid in preventing individuals and companies from engaging in the unlawful importation or exportation of infringing goods and deter repeat offenders. Finally, CBP officers are located at American embassies around the world, and routinely work with foreign law enforcement agencies to conduct raids on counterfeit production facilities abroad and to criminally prosecute those involved in the manufacture and exportation of infringing merchandise.

Recording a trademark with CPB is a relatively simple process, but it needs to be done very carefully. If inaccurate or incomplete information is provided to CPB, it can result in your company's merchandise or goods consigned to your distributors and licensees being unnecessarily detained at a port of entry. While you ultimately will be able to authorize the release of such merchandise, such detainment may interfere with your

business relationships, resulting in breaches of contracts or strained relationships with your distributors and licensees. JD SUPRA™
<http://www.jdsupra.com/post/documentViewer.aspx?fid=6ae02c71-6116-400b-9b92-7a3ba0877a9d>

Trademarks registered on the USPTO's Principal Register may be recorded online through the CBP's Intellectual Property Rights E-Recordation system at www.cbp.gov. Unfortunately, marks registered on the USPTO's Supplemental Register or with state trademark agencies are not eligible for recordation with CBP. In order to submit an application to record your federally registered trademark, you will need the following information:

- USPTO Trademark Registration Number
- digital images of your mark in .jpg or .gif format
- country where the products bearing your trademark are manufactured
- names and principal business addresses of each foreign person or entity authorized or licensed to use your federally registered mark and a statement as to the use authorized
- identity of any parent or subsidiary company or other foreign company under common ownership or control which uses the trademark abroad.

In addition to the information contained in the application, you will need to submit the following items to the CBP:

- a status copy of your certificate of registration certified by the USPTO
- five copies of your registration certificate
- a check or money order for the government recordation fee, which is currently \$190 per class of goods identified in an application.

Once all the necessary paperwork and fees have been submitted to CBP, recordation with the CBP and protection thereunder will be deemed effective on the date that the application is approved, which will be indicated on the Notice of Recordation issued by the CBP. Recordation and protection of your mark will remain in force so long as your mark is registered and renewed with the USPTO and an application to renew the Customs recordation is filed with the CBP no later than three months after the expiration date of your federal trademark registration.

In today's global economy, where there is widespread pirating and counterfeiting of intellectual property, it is crucial for companies to adequately protect their federally registered trademarks. Recordation with the CBP is one cost-effective way of policing your marks. If you are interested in this process, please contact your Mintz Levin trademark representative to discuss recording your federally registered trademarks with CBP.

For more information on or assistance with this or any other trademark matter, please contact one of the trademark attorneys listed below or the Mintz Levin attorney who ordinarily handles your legal affairs.

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