



Recording Trademarks and Copyrights with U.S. Customs & Border Protection

In 2020, U.S. Customs and Border Protection (CBP) seized approximately \$1.3 billion worth of counterfeit goods being illegally imported in the United States. In part, this success is due to brand owners partnering with CBP to stop importation of counterfeit goods into the United States that infringe on federally registered trademarks and copyrights covering the counterfeit goods. The federal registrations are registered with Customs Recordation as part of CBP's Intellectual Property Rights (IPR) program. CBP rarely detains or seizes counterfeit goods with trademarks or copyrights that are *not* recorded. Therefore, recording intellectual property with CBP is a vital part of any enforcement strategy. Below is a step-by-step guide to recordation.

1. Eligibility and Fees

In the case of trademark infringement directed to imported counterfeit goods, the brand owner must have a federal U.S. trademark registration on the Principal Register covering the counterfeit goods and the trademark registration must be recorded with the CBP. The government fee for recording a trademark registration is \$190 USD per class of goods recited in the registration. However, the trademark owner does not have to record the registration for every class recited in the registration. Rather, the trademark owner can limit its CBP recordation to those classes of goods for which protection is desired.

For registered copyrights, the recordation fee is \$190 USD per copyright. Pending copyright registrations may also be recorded and granted temporary registration status for a six-month period.

2. Recordation

The recordation forms may be submitted online. To complete the form, applicants will need to provide the following information:

- A copy of the registration certificate from the United States Patent and Trademark Office ("USPTO") or the U.S. Copyright Office ("Copyright Office"), or proof of a pending application with the Copyright Office;
- Digital images of the trademark or copyright as it is used in commerce. Images must be in JPG, GIF, or PDF format. Only five images are allowed, and each must be 2MB or less;
- Names and principal business address of any manufacturers, licensees, parent company, subsidiary, or other parties that are authorized to use the trademark or copyright;
- Countries of manufacture; and
- Name, address, telephone number, and email address of a point of contact that CBP may contact regarding any questions about enforcement.

Once recordation is complete, CBP will issue a notice confirming that recordation has been made and include a recordation number.

3. Lapse and Renewal

Recordations remain in force concurrently with the underlying federal registration. Accordingly, for example, if a trademark registration lapses, the recordation will also expire.

In addition, recordations must be renewed. Trademark registration recordations must be renewed every 10 years. Currently, the renewal fee is \$80 USD per international class of goods. Copyright registration

recordations must be renewed every 20 years, and the renewal fee is \$80 USD per copyright registration. There is a 90-day grace period for expired recordations. Otherwise, to revive the recordation, the IPR holder will need to file a new application.

4. Changes to Recordation

Any changes to information on the recordation—especially changes to contact information, updates regarding authorized use, and licensee information—should be submitted to by email to IPRRQuestions@cbp.dhs.gov. A request to update a recordation should be submitted on company letterhead and indicate all the recordation numbers for which the change is requested.

5. Additional Information

Brand owners can arm CBP with additional information, like product identification guides and images of genuine products. Under the Trade Secrets Act, 18 U.S.C. § 1905, CBP personnel are prohibited from disclosing proprietary information. IPR holders may also further educate CBP personnel through product identification training, either by webinar, or by in-person training in the field. IPR holders are also encouraged to report information related to suspicious shipments and parties importing counterfeit goods.

Conclusion

Recordation with CBP of federally registered trademarks and copyrights may provide a cost-effective method of preventing counterfeit goods from entering the U.S. Although CBP does not currently offer a similar recordation program for owners of utility and design patents, legislation is pending to create a recordation program with CBP for goods that are believed to infringe design patents. In the meantime, owners of utility and design patents must seek relief from the U.S. International Trade Court or federal district courts to halt the importation of infringing goods. 🍷

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