

## U.S. TM Filings – Reliance on Foreign Registration

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# Topics

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1. What is TM “Use” for registration in the U.S.?
2. Filing Bases for U.S. TM Applications – What are the options?
  - a) Use
  - b) Intent-to-Use
  - c) Foreign Application/Registration
  - d) International Registration/Madrid Protocol
3. Advantages and Disadvantages of Relying Solely on Foreign Registration

# Typical Recommendation for Filing U.S. TM Application

File application based on:

- Intent-to-Use and/or Use
- and**
- Foreign application/registration



# What is TM “Use”?

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- Government’s power to issue TM registrations based on the Constitution’s commerce clause
- A trademark “**used in commerce**” is eligible for registration per section 1 of the Trademark Act (15 U.S.C. § 1051)
  - A mark subject of foreign registration is also eligible for registration per section 44(e) [15 U.S.C. § 1126(e)] or 66(a) [Madrid Protocol, 15 U.S.C. § 1141f(a)]
- “**Commerce**” is defined as “all commerce which may lawfully be regulated by Congress” (15 U.S.C. § 1127)
  - Types of commerce encompassed in this definition are interstate, territorial, and between the United States and a foreign country

# Use in Commerce

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- “**Use in Commerce**” is defined as “the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark” (15 U.S.C. § 1127)
- **Goods:**
  - Mark is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale,  
and
  - the goods are **sold** or **transported** in commerce
- **Services:**
  - Mark is used or displayed:
    - in the **sale** or **advertising** of services,  
and
    - the services are **rendered** in commerce, or the services are rendered in more than one State or in the U.S. and a foreign country and the person rendering the services is engaged in commerce in connection with the services

# Filing Basis - Use and Intent-to-Use in the U.S.

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- **Use** – applicant is using the trademark in connection with the goods and services [section 1(a), 15 U.S.C. 1051(a)]
- **Intent-to-Use** – applicant has a bona fide intent to use the mark in the U.S. [section 1(b), 15 U.S.C. 1051(b)]
  - a bona fide intention to use a mark in commerce under circumstances showing the good faith of such person
  - **Recommendation:** Before filing, applicant should create dated documents detailing plans for using mark on goods/services for distribution or rendering in the U.S.
- **Dual Basis** - Can claim “Use” for some goods/services and “Intent-to-Use” for other goods/services
  - **Recommendation:** Fine to claim “use” for one class and “ITU” for another class; but best not claim “use” for some goods/services in a class and “ITU” for other goods/services in the same class

# Example A

## Recommend:

- Class 25 – Shirts, shorts, pants, jackets; Headwear
  - Use based
- Class 14 – Jewelry; Watches
  - ITU



## Example B

### Do Not Recommend:

- Class 25 – Shirts, shorts, pants, jackets; Headwear
  - Use based
  - ITU

**\*\* In this situation, best to just file ITU for the whole class**





# Section 44(e) Filing Basis – Foreign Registration

- **Foreign Registration** [section 44(e), 15 U.S.C. § 1126(e)]
    - Based on mark’s registration in applicant’s country of origin
    - Use of mark in the U.S. is not required to obtain registration
    - But, **must have bona fide intent to use** the mark on all the goods/services identified in the application
    - **Priority Claim** - Can file in U.S. within six months of first filed application for the mark in country of origin [section 44(d), 15 U.S.C. § 1126(d)]
      - Foreign application must mature to registration to obtain U.S. registration
  - **Recommend - Multiple Bases**
    - ITU and/or Use
    - and**
    - Foreign Registration
- \*\* Can later delete one basis for registration and rely solely on the other**

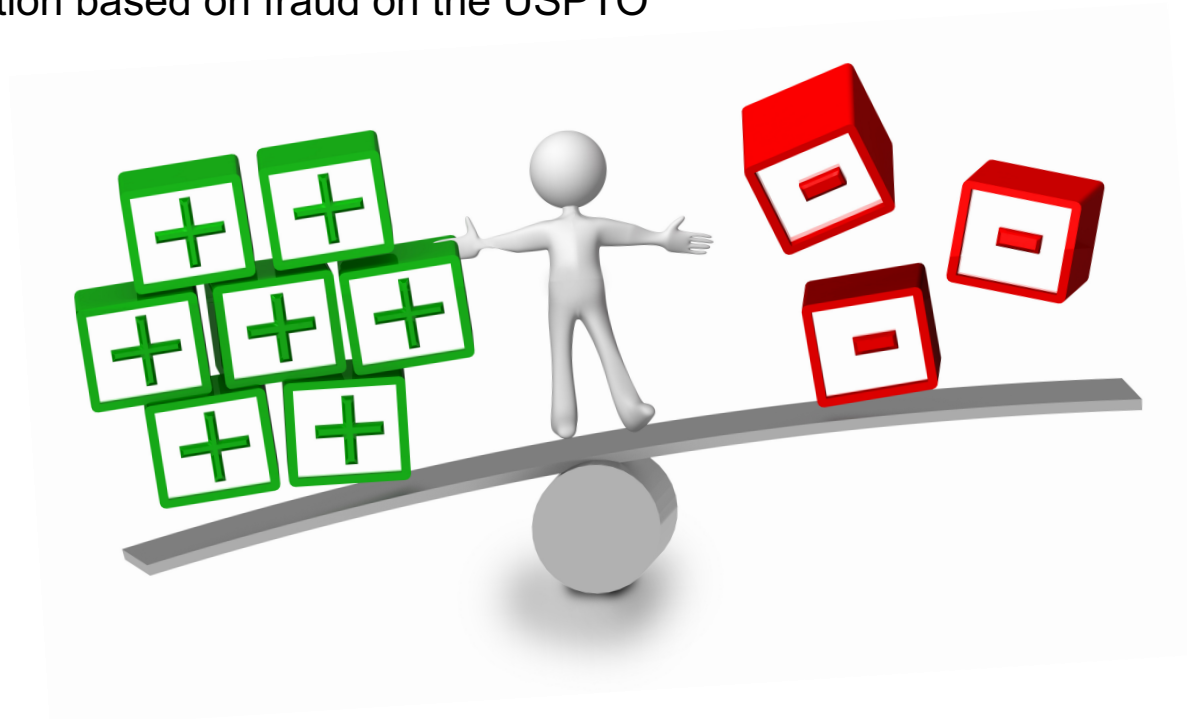
# Section 66(a) Filing Basis – International Registration (Madrid Protocol)

- International Registration
  - Designate U.S.
  - Use of mark in the U.S. is not required to obtain registration



# Advantage - Avoiding TM Use Requirement is Tempting

- If application based on section 44(e) or 66(a), **no** need to:
  - Claim use of mark on all identified goods and services
  - Submit first use dates
  - Submit evidence showing mark's use in the U.S. prior to registration
- Avoid Big Risk - If applicant claims use on all the goods/services, and that turns out to be false, ensuing registration susceptible to cancellation based on fraud on the USPTO



## Disadvantage - Risks to Consider

If relying solely on section 44(e) or 66(a) for registration:

- Another party could oppose application or petition to cancel registration based on:
  - No bona fide intent to use mark on certain or all goods/services when application filed
- Another party could petition to cancel registration based on:
  - Abandonment
    - No intent to begin use of mark in the U.S. in connection with certain or all goods/services
- Another party could adopt an identical or confusingly similar mark
  - Believes registrant does not have trademark use in U.S. to support infringement action

# No Bona Fide Intent to Use Mark

- Another party can oppose an application or petition to cancel a registration claiming:
  - Trademark owner did not have the required bona fide intent to use the mark on certain or all goods or services when application filed
- Applications or registrations that identify numerous goods and services that seem unrelated are targets for this claim
  - **Example:** Class 9 – Sunglasses; Fire extinguishers; Computer software; Radio receivers
- Best way to overcome claim:
  - Produce written documents dated prior to application's filing date that detail trademark owner's intent to use mark in the U.S. in connection with all the goods/services

# Abandonment – Definition (15 U.S.C. § 1127)

- A mark shall be deemed “abandoned” if:
  - When its use has been discontinued with **no intent to resume** such use
  - “**No intent to resume**” may be inferred from the circumstances
- **Presumption of Abandonment**
  - Nonuse for **three consecutive years** shall be *prima facie* evidence of abandonment
- What about registrations under section 44(e) or 66(a), where use was not required to obtain registration and thus, cannot be “resumed”?
  - The phrase “no intent to resume use” is changed to “no intent to begin use”
  - For presumption, three years measured from U.S. registration date

*See Imperial Tobacco Ltd v. Philip Morris, Inc.*, 899 F.2d 1575 (Fed. Cir. 1990); *SaddleSprings, Inc. v. Mad Croc Brands, Inc.*, 104 USPQ2d 1948 (TTAB 2012)

# Abandonment Can Occur at Any Time

- Another party can petition to cancel a registration based on abandonment at any time
  - Presumption occurs three years after registration
    - shifts **burden of production**
    - mark owner must come forward with evidence indicating that:
      - it is using the mark, or
      - despite three years of non-use, it intends to use mark in U.S. within a reasonably foreseeable time
  - Can still claim abandonment prior to three years from registration, but no presumption
    - Initial burden on petitioner to show registrant has no intent to begin using mark in the U.S.
      - Difficult for petitioner to find evidence that registrant has no intent to begin using mark
    - Registrant can provide evidence that it is using, or intends to use the mark in the U.S.

# Advantages of Claiming TM Use for Registration

- If the applicant is using the mark in the U.S., then claiming use to obtain registration may:
  - Persuade others not to challenge registration based on no bona fide intent to use or abandonment
  - Persuade others not to adopt an identical or confusingly similar mark
    - If registrant is using the mark in the U.S., then there is basis for infringement claim



# Final Comments

- If U.S. registration obtained solely on 44(e) or 66(a):
  - If after registration the registrant begins using mark in the U.S., publicize that use
    - Should persuade others not to challenge the registration
  - If the petition to cancel is limited to certain goods or services that the registrant no longer cares about, can:
    - Negotiate settlement with petitioner, or
    - Just concede and the USPTO will delete those goods or services from the registration

# Questions



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