

U.S. TRADEMARK ATTORNEY

FILING FOREIGN TRADEMARKS IN THE U.S.

If filed properly, applications by foreign individuals or entities filed in the U.S. may enjoy great advantages over U.S. domestic applications filed in the U.S.

- If the U.S. application is based on a foreign application in a treaty country, the foreign application can enjoy the filing date (of up to six months before) of the application previously filed in a foreign country.¹
- If the U.S. application is based on a foreign registration in a treaty country, the applicant does not have to prove “actual use” to obtain U.S. registration.

These can be huge advantages.

U.S. trademark applications must be filed on one of three bases including: (1) Section 1(a) actual use; (2) Section 1(b) bona fide intent to use; or (3) Section 44(e) a foreign registration in a treaty country (or on a foreign application under 44(d) which matures into a foreign registration for 44(e)).

We will now review each of these bases.

1. 1(a) Actual Use. The applicant must show actual use in U.S. commerce, provide the date of first use, file originals of an example of use, and sign a declaration in the application verifying that the mark is being used.

2. 1(b) Bona Fide Intent to Use. The applicant need not prove actual use until the mark has been “allowed” (approved by the U.S. trademark office). Registration is not completed until actual use is proven but the applicant maintains the original filing date for protection. A

¹ A foreign application must be filed within six (6) months prior to the U.S. application [Section 44(d)]. With 44(d), one is able to enjoy the filing date of the previous foreign application (“Priority Date”). This may provide a big advantage to foreign applicants since a 44(d) application will receive priority over another application filed after the Priority Date. A 44(d) foreign filing must mature into a foreign registration to maintain the date.

separate filing fee is required when one files a Statement of Use to prove use. The filing of the Statement of Use can sometimes be postponed for an additional two years beyond the original approval (“allowance”) date.

3. 44(e) Foreign Registration. The application may be based on a foreign application or registration. However, the application may first be based on a foreign application if filed within six months of the filing of the application in a foreign country, but eventually the foreign application needs to be registered. For a foreign registration, the applicant must provide a certified copy and a translation of the registration obtained in the applicant’s “country of origin”² and that country must be party to a trademark convention or treaty (“treaty country”³).

The applicant must also certify in the U.S. application that the applicant has a bona fide intent to use the mark in the U.S. **However, the applicant does not need to prove actual use in order to obtain registration, so foreign applicants utilizing 44(e) have a huge advantage over U.S. applicants.**

Trap for the Unwary. There still can be problems if a foreign applicant under 44(e) does not actually timely use a mark.

1. The applicant must sign a statement verifying the applicant has a bona fide intent to use the mark in the U.S. This could be challenged if there has been no use after time.

2. Like U.S. applicants, once the application matures into U.S. registration, the applicant will need to prove use during the sixth year after the registration and again at the time of renewal of the registration after 10 years.

3. **Caution: if there has been no actual use, the applicant may have a difficult time arguing in an infringement lawsuit against a user of the mark that there is a likelihood of confusion by the other mark.** Also, the other mark owner could argue that the applicant abandoned the bona fide intent to use as time passes. Abandonment of a mark is generally a question of fact. There is a general presumption that if one does not use a mark for three years

² “Country of origin” is defined as the country in which the applicant has a bona fide and effective industrial or commercial establishment or, if applicant does not have such, then the country of domicile, or if no domicile, then the country where the applicant is a national. Thus, an applicant could have more than one country of origin.

³ A country which is a party to a trademark convention or treaty with the U.S.

that it is abandoned. However, this is rebuttable based on the specific facts of the intent of the applicant.

Power of Attorney. There is no need for a foreign applicant to send us a power of attorney for the U.S. We become the domestic representative for the foreign applicant to receive correspondence. However, we do have the applicant sign the application since it includes the applicant's statement of bona fide intent to use the mark in U.S. commerce. The costs and fees are the same for foreign filers as for U.S. filers.

Descriptions of Use. In every application, one must specify how the mark is to be used. Experienced trademark attorneys are adept at using appropriate but broad statements to provide broad coverage. For example, in some countries a mark for automobile alternators might simply have a description of "automotive parts" and be accepted. This would generally not occur in the U.S. since the U.S. examiners try to limit the scope of use for each application and would want the use to state the specific use such as "automotive parts, namely alternators." Our experience has shown that the U.S. examiners do try to grant rights to treaty countries and may be more willing at times to accept broader use descriptions contained in foreign registrations. This could be another advantage to foreign filings.

Summary

Foreign applications filed in the U.S. may enjoy great advantages over U.S. domestic applications filed in the U.S.

If one has filed an application in a foreign treaty country within the past 6 months, the original filing date can be retained in the U.S.

If one has obtained a trademark registration in a foreign treaty country, one can obtain registration in the U.S. without having to prove actual use.

Broader descriptions of use already registered in foreign countries may be accepted in the U.S. where similar applications by U.S. applications may not be accepted.

Our firm has filed hundreds of foreign applications in the U. S.

For more information and fee estimates for filing applications in the U.S., please contact Kevin J. Collette at 206-654-2252 (direct), 206-652-2952 (facsimile), or collette@ryanlaw.com (e-mail). Please check our web site at <http://www.ryanlaw.com> for other information on trademarks and filing requirements.