

International Trademark Filing Strategies

World IP Forum 2015
New Delhi, India
January 12, 2015

David M. Silverman, Partner
Davis Wright Tremaine LLP
Washington, D.C.
DavidSilverman@dwt.com

Filing Bases in US

- **Intent to Use (ITU)—Sec. 1(b) of Lanham Act**
- **Actual Use—Sec. 1(a)**
- **Foreign Application—Sec. 44(d)**
- **Foreign Registration—Sec. 44(e)**
- **Madrid Protocol—Sec. 66**



Davis Wright
Tremaine LLP
DEFINING SUCCESS TOGETHER

1) Intent to Use—Sec. 1(b)

- **Way to protect mark not yet in use in U.S. commerce—filing basis only**
 - Intent to use must be *bona fide*
- **Establishes priority as of filing date**
- **Results in Notice of Allowance**
- **Statement of Use required for reg.**
- **Anyone can file on this basis**



Davis Wright
Tremain LLP
DEFINING SUCCESS TOGETHER

2) Actual Use—Sec. 1(a)

- **If mark used in U.S. commerce or between U.S. and another country**
- **Requires specimen(s) of use**
 - **One per class—generally**
- **Results in Certificate of Registration**
- **Anyone can file on this basis**

Definition of Use

- **Use must be “bona fide” use in US commerce**
 - **In the ordinary course of trade**
 - **Not isolated**
 - **Not made merely to reserve rights**

3) Foreign Application—Sec. 44(d)

- **Filing basis only—not registration**
- **Priority may be based on home country application within 6 mos.**
- **Must state bona fide intent to use in U.S.**
- **Application may remain pending until foreign registration issues**



Davis Wright
Tremain LLP
DEFINING SUCCESS TOGETHER

4) Foreign Registration—Sec. 44(e)

- Foreign registration required for U.S. registration (but not use in U.S.)
- Must state *bona fide* intent to use in U.S.
- U.S. cannot be country of origin



Benefits of Section 44

- **May be combined with use or ITU**
 - **Either basis can be deleted later**
 - **TIP: File 1(b) and 44(d)...use whichever occurs first (US use or foreign reg.)**
- **No use required for registration**
- **Supplemental Register available**
- **U.S. registration independent of home country registration**



Davis Wright
Tremain LLP
DEFINING SUCCESS TOGETHER

5) Madrid Protocol (Sec. 66)

- **Extension of Protection to U.S. Based on Home Country (Basic) Registration**
- **Can claim priority within six months**
- **Must state *bona fide* intent to use in U.S.**

Benefits of Madrid Protocol (Sec. 66)

- **Can be less expensive if no US attorney required**
- **Avoids need for multiple filings**
- **No use required for registration (“Extension of Protection”)**



Madrid Protocol Drawbacks (1/3)

- **Cannot be combined with any other basis for registration (Sections 1 or 44)**
- **No Supplemental Registration**
- **Response to USPTO Office Action will likely require US counsel**
- **No amendment of mark allowed**

Madrid Protocol Drawbacks (2/3)

- **Dependent on success of underlying “basic” application**
- **Subject to “central attack” within 5 years of basic registration**
 - **Can convert to national (US) application within 3 mos. after cancellation**

Madrid Protocol Drawbacks (3/3)

- **Assignees must be eligible to hold a Madrid Protocol registration in U.S.**
- **Affidavit and renewal deadlines can be missed without US counsel**
 - **TIP: Authorize email correspondence to receive reminders from USPTO (less expensive too)**

All Applications



- **Narrow goods/services descriptions required**
- **TMEP: “The identification of goods/services must be specific, definite, clear, accurate, and concise.”**
- **TIP: Use ID Manual**

Examples of Specificity Required



Software: Describe function
e.g. “Computer game software for use on mobile and cellular phones”



Television program: What kind?
e.g. “Entertainment in the nature of *ongoing* television programs in the field of [news/comedy/variety, etc.]” (Note: More than one required)



ALL Registrations

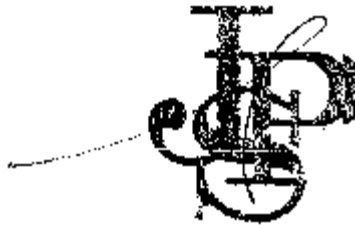
- **Affidavit Of Use required during sixth year of registration**
 - **Acceptable specimens: *On goods/In connection with services***
- **Excusable nonuse difficult to show**
 - **Factors outside owner's control**

Abandonment of Mark

- **Abandonment = No use + No intent to use**
- **Presumed after 3 years of non-use**
 - Issue only if challenged
 - Was 2 years prior to 1996
- **Compare: Affidavit of use due in year 6**
- **Registration may be declared void *ab initio* if mark not used on ALL goods/services**

Imperial Tobacco v. Philip Morris (Fed. Cir. 1990)

- **Cancellation of Imperial's Sec. 44 registration based on non-use in U.S.:**



- **Intent Not to Use \neq Intent to Abandon Reg.**
 - Registrants will always deny intent to abandon
 - In this pre-1996 case, 2 year presumption

Dragon Bleu v. VENM (TTAB 2014)

- **Same use vs. non-use standards apply to Sections 44 and 66**
- **Three years begins with date of US registration**

WHAT ARE *YOU* GOING TO DO???



Davis Wright
Tremaine LLP

DEFINING SUCCESS TOGETHER

**David M. Silverman
Davis Wright Tremaine
Washington, D.C.
(202) 973-4261**

DavidSilverman@dwt.com



**Davis Wright
Tremaine LLP**

DEFINING SUCCESS TOGETHER