

# International Trademark Filing Strategies

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# 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

# 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

## 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

## 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





# Bona Fide Intent to Use

- *Combe v. Wolff* (TTAB 2017):
  - Ability to market or manufacture goods in foreign country supports *bona fide* intent to use in US
- *Kelly vs. Creative Harbor* (ED Mich. 2015):
  - Lack of *bona fide* intent to use some goods/services supports deletion of entire class
- But Note: If any fraudulent intent, entire application is void *ab initio*

## 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



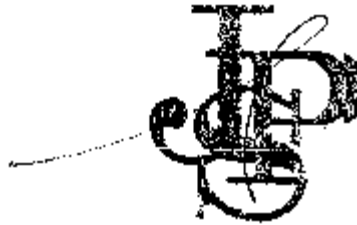
# Abandonment of Mark

- 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???





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