

Saving Time and Costs In The U.S. Trademark Registration Process

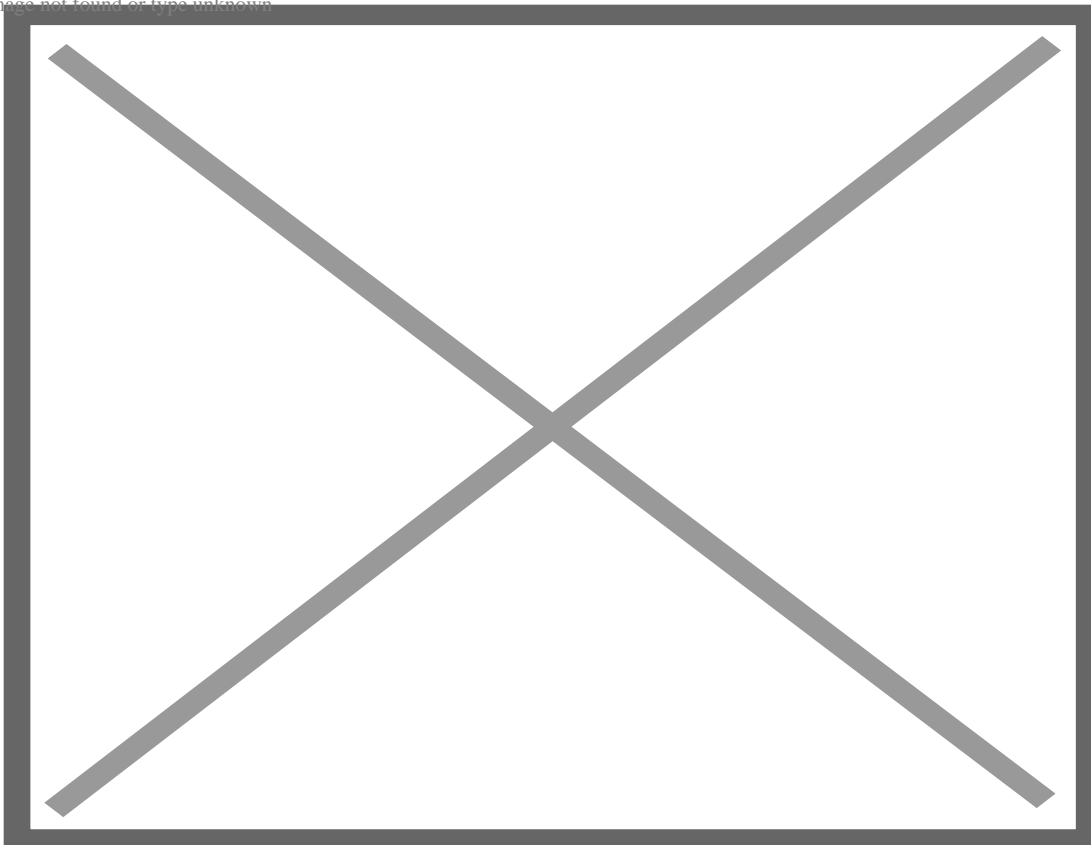
Description

The complex U.S. trademark registration system makes many trademark owners from other countries reluctant to file national applications or extend international applications to the U.S. One reason often given is the higher cost of obtaining trademark protection in the U.S. due to the statutory requirements and the formalities that must be observed. It is frequently overlooked, however, that a U.S. trademark registration covers a largely English-speaking, highly sophisticated market of over 325 million people. Despite the costs, the United States remains a very desirable country in which to file trademark applications. In fact, for the year ended September 30, 2018, non-U.S. applicants filed about 30% of the total trademark applications filed with the U.S. Patent and Trademark Office (USPTO).

There are five bases for filing an application to register a trademark in the U.S.:

1. based on actual use of a mark in commerce in the U.S. (Section 1(a))
 2. based on a bona fide intention to use a mark in commerce in the U.S. (Section 1(b))
 3. based on an earlier-filed foreign application in the applicant's "country of origin" (Section 44(d))
 4. based on ownership of a registration of the mark in another country (Section 44(e)), and
 5. extension of protection of an international registration to the U.S. under the Madrid Protocol (Section 66(a)).
- In applications based under Sections 1(b), 44(d), 44(e) and 66(a), all applicants must declare in their application that they have a "bona fide intention to use the mark in commerce" in the U.S. In addition, for Section 1(b) applications, applicants actually must use the mark on all of the goods and services listed in the application before the USPTO will issue a Certificate of Registration.

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Although the trademark registration process in the U.S. can sometimes be complex, it need not be expensive. There are opportunities for international applicants and their counsel to save money and time in the U.S. registration process. Three ways to reduce costs are:

1. to draft the identification of goods and services more narrowly than is typically the practice in other countries, making sure it states the goods or services in common commercial terms, to avoid objections by the U.S. Patent and Trademark Office (USPTO) and third parties
2. to gather and retain contemporaneous documentation early in the process supporting the applicant's claim that it has an "intent to use" the mark in the U.S., to avoid possible loss of registration rights later, and
3. to confirm that the mark is in use on each item listed in the registration when filing a Declaration of Use or renewal application.

In a future post, we will provide you with tips on how to save time and money by drafting the identification of goods and services more narrowly.

Contact Us for Assistance

Partridge Snow & Hahn LLP assists non-U.S. based clients to protect trademark rights in the U.S. , and assists U.S. based clients to expand and protect trademark rights outside the U.S. For information or to request our assistance, please contact John E. Ottaviani, Chair of our Intellectual Property and Technology Practice, at +1-401-861-8200 or jottaviani@psh.com.

Learn how we can save you and your client time and money when filing trademark applications in the United States! Please submit information below to download our article.

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