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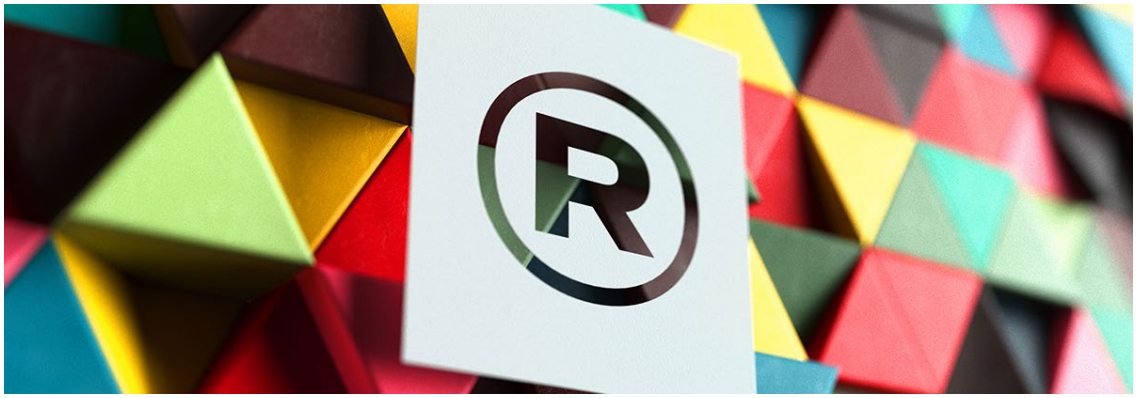
Client Alert

New USPTO Rules for Foreign Applicants Ensure Compliance With U.S. Use Requirements



The impetus for the August 3, 2019 rule change that now requires all foreign-domiciled trademark applicants and registrants to retain licensed counsel in the United States is an increase in foreign trademark applicants acting pro se and who are failing to comply with the rules of the United States Patent and Trademark Office ("USPTO"). Many countries do not require actual use to obtain or maintain a trademark registration, so it is common in many jurisdictions to file a trademark application that covers an incredibly broad scope of goods and services across multiple classes without evidence of any actual use. However, the United States does require evidence of use to obtain and maintain a registration, and many self-represented foreign applicants have struggled with this requirement.

In the United States, the term "use in commerce" means the bona fide use of a mark in the ordinary course of trade. A trademark application cannot be filed merely to reserve a right in a mark that an applicant may want to use someday, not can a trademark application be used to block others from using a mark.

- For goods, "use in commerce" means that the mark is placed on the goods themselves, or on product packaging or containers, or on displays associated with the sale of those goods, or on tags or labels affixed to the goods, or on documents associated with the sale of those goods, and the goods must be sold or transported in commerce in the United States.
- For services, "use in commerce" means that the mark is used or displayed in the sale or advertising of services and the services are rendered in commerce in the United States.

To prove use in commerce, applicants must provide a specimen of use for at least one good or service specified in each class. The USPTO has strict rules for what does and does not constitute an appropriate specimen of use, and failure to provide a specimen that complies with the USPTO's rules could result in refusal of the application. In recent years, the USPTO has seen an increase in fabricated or digitally

rendered specimens submitted by self-represented foreign applicants. Such specimens do not support a genuine claim of use, and may actually expose the applicant to a claim of fraud. The USPTO's new rules will better ensure that foreign applicants understand and comply with the USPTO's rules regarding use and specimens by requiring foreign applicants to retain a qualified U.S. attorney to handle the filing of a new application.

With the exception of registrations based on foreign filings, evidence of use is required in the United States to secure a trademark registration and use is always required to maintain a registration, but there are slightly different use requirements depending on what kind of application is filed.

- First, an applicant who is already using a mark in commerce in the United States can file an application under Section 1(a) of the Trademark Act. Under Section 1(a), the applicant must submit a specimen of use along with the application and provide a date of first use in commerce.
- Second, an applicant who has a bona fide intention to use a mark in commerce in the United States but has not yet commenced use can file an application under Section 1(b) of the Trademark Act. Under Section 1(b), the applicant does not need to submit a specimen or provide a date of first use to file the trademark application, but it must submit a specimen and provide a date of first use before the mark will register.
- Third, a party with a foreign trademark application or registration can extend protection into the United States through the Madrid Protocol or file a U.S. national application based on their foreign registration. If based on a foreign registration, a U.S. registration may issue without the need to submit a specimen of use or provide a date of first use. However, the registrant will need to provide a specimen and declaration of use after five years of registration in order to maintain the registration. For applications filed based on a foreign registration, the applicant will also have to provide a declaration that it has a bona fide intention to use the mark in commerce in the United States. Lack of a true bona fide intent could also expose the applicant to a claim of fraud.

The USPTO's rules regarding use and specimens can be difficult and demanding, but the qualified licensed attorneys at Lewis Roca Rothgerber Christie are prepared to advise foreign applicants and guide them through the application process. To ease the burden on foreign-domiciled parties that now have to retain local U.S. counsel under the new rules that went into effect on August 3, Lewis Roca Rothergeber Christie will waive its professional fees associated with recording itself as local U.S. counsel for foreign-domiciled parties with active pending applications, active registrations, or active TTAB proceedings.

For more information, please contact Jennifer Van Kirk, Oliver Bajracharya, or David Jackson, or reach out to your Lewis Roca Rothgerber Christie representative.

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