

“USE” of a Mark In the U.S.



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Intellectual Property Practice

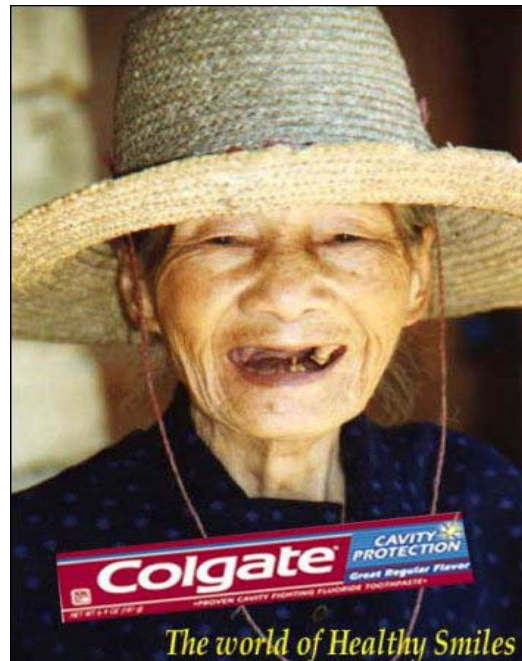
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What is “USE”

- Application of the Mark physically or in relation to the goods at the “time of its sale or delivery”;
- Association of the Mark with goods, which is “visible” at the time of purchase of the good;
- Unilever (*striped tooth paste*) Tm. [1980] FSR 280

So what constitute 'use'.....

- *Physical application of the Mark on the packaging goods*



Mark may appear physically on the goods





Mark may appear in relation to the goods like:

Invoices;

Pamphlets;

Brochures;

Advertisement

Provided the goods for which the ad is being displayed are offered for sale

What must a US TM application include

- 1) Name of the Applicant
- 2) Name and Address for Correspondence
- 3) Description of the Mark
- 4) Goods/Service
- 5) Application Fee
- 6) **Basis of Filing**
- 7) Specimen &
- 8) Signature

What is “Use” in United States

Basis of Filing

Any US Trademark application must include the applicant’s “basis” for filing

- 1) Use in Commerce (under section 1(a) of the Act)
- 2) Intend-to-use (under section 1(b) of the Act)
- 3) Application based on the International Agreements (although not very common basis) Section 44(d) & 44(e)
- 4) Extension of protection of an international registration under section 66(a) of the Act – under Madrid Protocol

Creating Trademarks Right

Use in Commerce : Provisions under the Act

Application based on Section 1(a) of the Act

A verified statement that the trademark is used in commerce or in connection with the goods and services.

Next Obvious Question!!

What is “Use in Commerce”?

Power of the Federal Government - Commerce Clause of the Constitution.

Section 1 of the Act

Section 45 of the Act defines what is “Commerce”

Section 45

Commerce :

all commerce lawfully regulated by Congress

Use in Commerce:

means the bonafide use of a Mark in the ordinary course of trade

Lets discuss this in parts.....

Bonafide Use of the Mark:

“Token use” not allowed (Trade Marks Law Revision Act, 1988)

i.e. use of the mark only to reserve the right in the Mark

Ordinary Course of Trade??

- Legislative history of the TLRA
- meaning of “use of ordinary course of trade” varies from industry to industry
- eg. Expensive & Seasonal Products
 - Drug for curing a rare disease – Shipment to clinical investigators is ordinary course of trade
 - Senate Judiciary Committee: the definition of the “Use of Commerce” be flexible.
- *Paramount Pictures Corp v. White*, 31 USPQ2d 1768 (TTAB 1994)

Intend-to-Use

Rest remaining the same, if the application is filed on the basis of Section 1(b) of the Trade Marks Act i.e. the

Basis of filing is “intent-to-use”

An "intent to use" application must include a sworn statement that applicant have a bona fide intention to use the mark in commerce.

A declaration is included in the USPTO standard application form.

The applicant or a person authorized to sign on behalf of the applicant must sign the statement

Allegation of Use for 1(b) Applications

Before registration, the applicant must file an allegation of use of the Statement of use under 15U.S.C. 1051(d)

First to Use Doctrine

Unlike many countries US follows:

- First to use principle; rather than
- First to Register

Senior User and Junior User – Conflicts possible, difficult to ascertain

2 Important Dates

Date of First Use Anywhere

When goods were first sold, transported or service rendered

Can be local or national, intrastate or interstate, within US or anywhere

Date of First Use in Commerce

When the goods were first sold, transported or service rendered under the Mark, for the type of commerce regulated by Congress

Use of commerce after Larry Harmon Pictures Corp. v. The Williams Restaurant Corp.

- At first glance, this issue of what constitute the “use” in commerce seems tricky
- Section 45 v. the US Constitution

Cases that made the difference

- Gibbons v. Ogden* (commerce clause strictly construed)
- A.L.A. Schester Poultry Corp v. U.S.* (close and substantial relationship with interstate commerce)
- National Labour Relations Board v. Jones* (all appropriate legislations for protection & advancements of interstate commerce)
- Heart of Atlanta Motel, Inc. v. US* (if it is interstate commerce that feels the pinch, it does not matter how local the operation which applies the squeeze)

TMEP

Federal Trademark Jurisdiction includes interstate, territorial and between United States and a foreign Country

It is better to have Federal Registration, and take a wide protection rather than going for a State Registration.

Now something procedural.....

After the opposition phase, the USPTO sends the Registrant a document called a "Notice of Allowance" (NOA).

The applicant has six months from the mailing date of this document to either:

File an extension of time (because he is still **not** using the mark in commerce).

or

File a "Statement to Allege Use" (SOU) in which he must give the date of first use and provide a sample.



If the 6 month filing date from the NOA is missed.

The USPTO does not have any sort of grace period or late filing provisions on ITU's.

Once the date is missed, mark will be declared abandoned.

Some noteworthy points

Offering service via internet has been held to constitute use in commerce, since the services are available to national and international audience - *Parenthood Federation of America, Inc. v. Bucci*

Use of a Mark in foreign country does not give rise to rights in the United States if the goods or services are not sold or rendered in the United States – *Buti v. Impresa Persona*



THANK YOU