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US: TRADE MARKS

Expanding well-known brands to the US

When planning the introduction of a recognized foreign brand to the US marketplace, owners of a well-known trade mark outside of the US may find that an American company has attempted to take advantage of the renown of the foreign mark by making an earlier trade mark filing in the USPTO.

Generally, under US trade mark laws, a party seeking trade mark protection for a mark in the US enjoys an initial presumption of priority over a party owning only foreign registrations. Based on this concept (known as territoriality of priority), an American user of a particular mark may attempt to exploit its position by purporting to be the senior user of a mark in the US.

However, despite the initial presumptions, the owner of the well-known foreign mark would not be prohibited from entry into the US marketplace under its well-known mark. There are certain protections granted to the owner of a well-known international mark. Specifically, Article 6(bis) of the Paris Convention for the Protection of Intellectual Property recognizes that the USPTO has the right to refuse registration of a mark that is confusingly similar to a well-known foreign mark. The mark needs to be well known to the relevant sector of the public and this basis for refusal must be asserted by the foreign trade mark owner.

US case law recognizes that a foreign trade mark owner with substantial use of its mark outside the United States may argue that its foreign use serves as a basis for asserting and sustaining a claim of priority in the US. The reliance on the protections granted by the Paris Convention can therefore prevent a first-to-file US party from capitalizing on a well-known foreign mark, thereby reserving access to a much-desired source of revenue for the foreign trade mark owner.