

Managing Intellectual Property™

Incorporating IP Asia
September 2006
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US: TRADE MARKS

Tips on using priority foreign filings

A company that has a trade mark filing in place in a foreign jurisdiction has multiple options when considering an expansion of its trade mark rights into the United States. Specifically, US trade mark law provides several mechanisms pursuant to which a foreign trade mark owner can use the priority established by a foreign trade mark filing when making a filing in the United States.

Section 44(d) of the US Trade Mark Act provides the trade mark owner with a basis for receipt of a priority filing date in situations where the US filing is made within six months of the filing date of the foreign application. A Section 44(d) filing is treated as if it were filed in the US on the same day as the filing in the foreign country and will receive priority over any application for a confusingly similar mark filed in the US after the priority date. The Section 44(d) filing only provides a basis for receipt of a priority filing date, however, and not a basis for publication or registration.

Section 44(e) of the US Trade Mark Act allows a foreign trade mark owner the luxury of relying on a registration granted by the applicant's country of origin as a basis for registration in the US. Although the Section 44(e) filing does not confer on the trade mark applicant a priority filing date, benefits of such a filing include that the applicant does not need to allege use or provide specimens of use in order to secure registration: all that is needed is an assertion of a *bona fide* intention to use the mark in commerce.

Although trade mark owners are entitled to certain benefits based upon their ownership of a foreign trade mark filing, it is recommended that they conduct a complete trade mark search in the US prior to proceeding with a trade mark filing. Regardless of the priority of the foreign filing, in order to obtain a federal trade mark registration, there must not be any third party applications or registrations for confusingly similar marks which predate the Section 44 filing which could be cited by the examining attorney as an impediment.

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