

US Trademark Registration Introduction

A trademark is a word, phrase, or logo that identifies the source of goods or services. United States trademark law is mainly governed by the Lanham Act. Common law trademark rights are acquired automatically when a business uses a name or logo in commerce and are enforceable in state courts. Marks registered with the U.S. Patent and Trademark Office are given a higher degree of protection in federal courts than unregistered marks—both registered and unregistered trademarks are granted some degree of federal protection under the Lanham Act 43(a).

Frequently asked questions

Q: What is “Basis for filing” in the USA?

A: A “filing basis” is the basis upon which you have filed your trademark application with the United States Patent and Trademark Office (USPTO). You must include one or more filing bases in an application. Each “filing basis” has different requirements. There are four possible bases:

1. Use-in-commerce basis;
2. Intent-to-use basis;
3. Foreign registration basis;
4. Foreign application basis.

Q: What is “Use-in-commerce” basis?

A: If you have already used your mark in commerce with all the goods or services in your application, you may file under the “use-in-commerce” basis. For this basis, you must be using the mark in the sale or transport of goods or the rendering of services in interstate or territorial commerce or commerce between U.S. and another country. You are required to provide an acceptable specimen of use when you file the application on this basis.

Q: What is a “specimen of use”?

A: A specimen of use is a real-life sample of how you are actually using your trademark in commerce with your goods or services. The specimen shows your trademark as purchasers would encounter it in the marketplace. For example, the specimen shows the mark on the entire product and/or packaging or a web page featuring the mark to advertise services.

Q: What is a proper specimen of use of a mark with goods?

A: A specimen for goods could show the trademark on or attached to the goods themselves or on packaging for the goods. For example, your specimen could be a photograph of the goods with a tag or label attached or a photograph of packaging showing your trademark.

Q: What is a proper specimen of use of a mark with services?

A: A specimen for services must show the trademark used in providing or advertising the services. For example, your specimen could be a brochure about or advertisement for the services.

Q: What should I do if I cannot provide proper specimen of use?

A: It is advisable to file the application under “Intent-to-use” basis. The USPTO will proceed with the examinations and publication as normal. It will then suspend further procedure and request the applicant to provide a proper specimen of use within six months from the date of receipt of the notice. The applicant may request a time extension for filing specimen of use. Each extension is 6 months, up to 5 times, maximum 36 months. The registration will proceed once the applicant provides an acceptable specimen of use.

Q: What is “Intent-to-use” basis?

A: If you have not yet used your mark in commerce with all the goods or services in your application, but intend to do so in the near future (within three years), you must file your trademark application under an “intent to use” basis. This means you have a bona fide intent to use the mark in commerce; that is, you have more than just an idea but are less than market ready (for example, having a business plan, creating sample products, or performing other initial business activities).

Q: What is “Foreign Application” basis?

A: If you own an earlier-filed foreign application that was filed within six months of your U.S. application for the same mark and the same goods and/or services, you may file under the “foreign application” basis. This basis is also called a “foreign priority basis” because you are requesting a “priority” filing date for your U.S. application that is the same date as that of the foreign application filing date.

Q: What is “Foreign Registration” basis?

A: If you own a foreign registration of the same mark for the same goods and/or services from your country of origin, you may file under the “foreign registration” basis.

Q: Does it mean I do not need to provide specimen of use if I file the application on “Foreign Application basis” or “Foreign Registration basis”?

A: No specimen of use is required when submitting the application if it bases on “Foreign Application basis” or “Foreign Registration basis”. However, you are required to submit a Declaration of Use between 5th and 6th years and every 10 years after registration and a specimen of use should be submitted with it.

Q: Which basis should I specify?

A: Most applicants base their application on either their current use of the mark or their intent to use the mark in commerce in the future. The difference between these two filing bases is whether you have started to use the mark on all the goods or services. If you have already used your mark in commerce with all the goods or services listed in your application, you may file under the “use-in-commerce” basis. If you have not yet used your mark, but intend to use it in the future (within three years), you must file under the “intent-to-use” basis.

Q: Is there any information that I should provide when I file applications in the USA?

A: The applicant shall provide the “Date of first use anywhere” and “Date of first use in commerce” when filing the application with “Use-in-commerce” basis. For foreign applicants, you may use your trademark much earlier in your home country. The “Date of first use anywhere” is the date on which the goods were first sold to transported or the services were first provided under the mark. The “Date of first use in commerce” is the date on which the mark is used in commerce in the USA.