

U.S. Trademark Registration Essentials III: How to Choose the "Four Bases" for U.S. Trademark Applications?

As mentioned in the previous article, why did some applicants forge specimens in the past when submitting U.S. trademark applications to file Statements of Use? This is closely tied to the topic we will explore in this article.

In the vast majority of countries, submitting a trademark application does not depend on whether the applicant has already started or is currently using the trademark in that country. This is because most countries adopt a "first-to-file" principle (i.e., "first come, first served"), determining examination priority primarily based on the filing date. However, aside from the filing sequence, the United States places an extremely strict requirement that a trademark must be "truly in commercial use within the United States."

When you and your lawyer or professional representative prepare to submit a trademark application to the United States Patent and Trademark Office (USPTO), the first thing to confirm is which "application basis" to choose. This decision directly impacts when you will need to submit specimens, Statements of Use, the overall examination timeline, and subsequent official fee costs.

Here is a detailed breakdown of the four different application bases for U.S.:

1. Use in Commerce – Section 1(a)
2. Intent to Use – Section 1(b)
3. Foreign Registration – Section 44(e)
4. Foreign Application – Section 44(d)

The Four Bases Are Not Strictly "Single Choice". It is worth noting that these four bases do not have to be selected exclusively. Kaizen recommends adopting a flexible approach. Applicants can choose different bases for different classes of goods or services, or even assign Section 1(a) to specific items and Section 44(e) to others.

Before deciding on an application basis, it is recommended to consult your lawyer or professional representative in detail to evaluate which basis (or combination of bases) best matches your current business development rhythm and cost-effectiveness!

Kaizen would like to provide a brief breakdown of the four different application bases for U.S. trademarks, analyzing their definitions, applicable scenarios, and pros and cons for the client's reference.

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1. Use in Commerce – Section 1(a)

Use in Commerce – Section 1(a)		
Definition	At the time the application is submitted, the goods or services covered by the trademark are already publicly sold or provided in the U.S. market.	
Application Scenario	Suitable for sellers whose products are already stocked in U.S. physical retail stores or reliably purchased by U.S.-based consumers via online stores, or applicants who can steadily provide services within the U.S.	
Pros	Fastest Process	Submitting specimens and the date of first use in the U.S. along with the application allows the applicant to obtain the registration certificate immediately after passing examination and publication.
	Lowest Cost	The cheapest option because there is no need to subsequently file a Statement of Use or go through extra administrative steps.
Cons	High Upfront Risk	You must introduce the market to the U.S. beforehand. If the trademark ultimately fails to register due to a likelihood of confusion with a prior mark, the upfront investment cannot be recovered. If you need to change the brand, products already printed with the original mark cannot be undone.
	Risk of Being Pirated/Squatted	Precisely because it was "used first," publicizing it in the U.S. without filing promptly could result in the trademark being pre-emptively registered by someone else.

2. Intent to Use – Section 1(b)

Intent to Use – Section 1(b)		
Definition	At the time of filing, the goods or services are not yet publicly sold or provided in the U.S. market, but the applicant has a bona fide intent to sell or provide them in the U.S. market in the future.	
Application Scenario	Suitable for applicants who want to secure a trademark name to prevent others from registering it, ensure the mark passes examination and publication before investing in production and use, or whose products are still in the R&D/stocking phase and expected to launch in the U.S. in a few months.	
Pros	Queue First, Prevent Squatting	Secures a priority filing position to prevent others from beating you to it.
	Lower Investment Risk	No need to use the mark in the U.S. upfront; you can ensure the mark is "capable of registration" before committing more resources to production and market launch.
Cons	Slower Process	Requires submitting a Statement of Use and specimens within 6 months of receiving the Notice of Allowance after publication (extensions can be requested up to 5 times for 6 months each, but each extension incurs an extra fee). Failing to provide specimens by the deadline means the registration certificate cannot be obtained.
	Increased Cost	Subsequent filing of a Statement of Use is mandatory, incurring extra fees.

3. Foreign Registration – Section 44(e)

Foreign Registration – Section 44(e)		
Definition	The trademark is already successfully registered in your home country (e.g., Hong Kong or Mainland China).	
Application Scenario	Suitable for applicants who have operated and owned a registered trademark in their home country for years and wish to expand into the U.S. market without having actual commercial sales locally in the U.S. yet.	
Pros	Exemption from U.S. Specimens	No need to submit U.S. domestic use specimens at the time of filing or after publication, bypassing the preliminary use examination.
	Simple Process and Lower Cost	Registration certificates can be obtained right after examination and publication conclude, making it as cost-effective as the actual use basis.
Cons	Restricted Scope	The U.S. application scope cannot exceed the scope approved in the home country registration certificate.
	Rigorous Official Examination	The U.S. review of the identification of goods/services is extremely strict. There is a high chance of receiving an Office Action requiring amendments to the description, which delays the process and incurs extra professional service fees for each response.

4. Foreign Application – Section 44(d)

Foreign Registration – Section 44(e)		
Definition	The trademark has already been filed in your home country, and a U.S. application is submitted within 6 months by claiming priority.	
Application Scenario	Suitable for applicants looking to launch and deploy new brands globally in sync.	
Pros	Priority Protection	Claiming priority within 6 months of filing in the home country effectively prevents competitors from squatting on the mark in the U.S. during this window.
	Temporary Relief from U.S. Use Pressure	No need for actual U.S. use right away, reducing losses if the trademark fails to register.
Cons	Restricted Scope	The U.S. application scope cannot exceed the scope approved in the home country registration certificate.
	Rigorous Official Examination	The U.S. review of the identification of goods/services is extremely strict. There is a high chance of receiving an Office Action requiring amendments to the description, which delays the process and incurs extra professional service fees for each response.
	Subsequent Transition Required	Most importantly, Section 44(d) serves merely as a "stepping stone" to claim priority. You must eventually pair it with Section 1(a) (filing a Statement of Use and specimens) or Section 44(e) (submitting the home country registration certificate) to formally complete registration.

If you wish to obtain more information or assistance, please visit the official website of Kaizen CPA Limited at www.kaizencpa.com or contact us through the following and talk to our professionals:

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