

Proving Use of a Trade Mark in the USA

By Joanne Martin, FB Rice, Australia

First published on www.lexology.com

When is Proof of Use required?

There are three occasions when it is necessary for an owner of a US trade mark registration or application to prove use of the trade mark:

1. When “national” applications are filed directly into the US (rather than filed via the International Registration system), and the filing is on the basis of ‘intention to use’ the mark, it is necessary to prove use of the mark in the USA before the application will proceed to acceptance (allowance). For Australian companies, the need to prove use at the application stage is frequently avoided by filing in the US via the International Registration system.
2. The second time a trade mark owner needs to prove use is between the fifth and sixth year after registration. If Proof of Use is not filed, the registration is deemed to be abandoned, and is cancelled.
3. Thereafter, Proof of Use of the mark must be submitted every time the registration is renewed.

What constitutes Proof of Use?

The use referred to under the US provisions is “use in commerce in the USA”. This is use of the mark as part of an offer for sale or sale of the product or service. Therefore, uses such as part of company name, in correspondence, as part of a business plan or any other preparation for selling a product or service, is not considered to be commercial use of the mark.

Proving use of a mark for goods

The most common way of demonstrating use is by submitting a photo of the products bearing the mark. Some marks may not directly appear on the product, for example small items of hardware. If use is not on the product or packaging but can be found in brochures, promotional or technical materials or websites from which the products can be purchased, this will be sufficient to demonstrate use. Where products are promoted on websites which do not have a provision for ordering the product over the website, it will be sufficient to refer to use on the website, but only if the website provides product information together with contact details for customer support services.

Proving use of a mark for services

Use is generally demonstrated by providing examples of use of the trade mark in advertising or promotional materials or on a website accessible in the USA, and where the services are available.

Other matters to bear in mind

The Proof of Use must show use of the mark in the same form in which it is registered. Therefore, if a mark has been registered as a device or logo mark, which get up has been updated over the years, proof of use of the mark as registered may not be available. In these circumstances, lodgement of a new and updated application is usually required.

For applications or registrations in more than one class, it is necessary to prove use in respect of at least one item covered in every class.

For more information, please contact:



Joanne Martin
Partner
FB Rice
jmartin@fbrice.com.au
www.fbrice.com.au

Joanne has worked in trade marks for over 25 years, providing advice to local and overseas clients on a wide range of contentious and non-contentious issues. She specialises in development of international trade mark portfolios and policies for corporate clients, for creation, use and protection of trade marks. Her international clients include a major medical devices corporation, a USA consumer products group and an international electronic publishing company. Joanne also has close working relationships with leading IP law and attorney firms in Europe and the USA.