

# Chapter 1000

## Applications Under Section 44

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## **1001 Section 44 Applications - General**

The United States has assumed certain obligations from agreements adopted at the Paris Convention for the Protection of Industrial Property of 1883 and subsequent revisions to these agreements. The United States is also a member of the Inter-American Convention for Trademarks and Commercial Protection (also known as the “Pan-American Convention”), the Buenos Aires Convention for the Protection of Trade Marks and Commercial Names, the World Trade Organization, and certain other treaties and agreements. See TMEP 1002.03 and Appendix B of this Manual for additional information about treaties and international agreements.

Section 44 of the Trademark Act, 15 U.S.C. §1126, implements these agreements. Section 44 applications fall into two basic categories: (1) United States applications relying on foreign applications to secure a priority filing date in the United States under §44(d); and (2) United States applications relying on ownership of foreign registrations as a basis for registration in the United States under §44(e). See TMEP §§1003 *et seq.* regarding §44(d), and TMEP §§1004 *et seq.* regarding §44(e).

Section 44(d) of the Act provides only a basis for receipt of a priority filing date, *not* a basis for publication or registration. See TMEP §1003.03.

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An applicant may file an application based solely on §44, or may claim §44 in addition to §1(a) or §1(b) as a filing basis. An applicant who claims more than one basis must comply with all application requirements applicable to each basis asserted. 37 C.F.R. §2.34. See TMEP §§806.02 *et seq.* regarding multi-basis applications.

In an application based solely on §44, the applicant must submit a verified statement that the applicant has a bona fide intention to use the mark in commerce, but use in commerce is not required prior to registration. TMEP §1009.

In limited circumstances, applicants domiciled in the United States may be entitled to file under §44, if they meet the requirements of the Act. See TMEP §1002.05.

See TMEP Chapter 1900 regarding international registration under the Madrid Protocol.

### **1002 Eligible Applicants Under §44**

#### **1002.01 Eligible Applicants Under §44(e)**

To be eligible for registration under §44(e), an applicant must meet the following requirements:

- (1) The applicant's country of origin must either be a party to a treaty or agreement with the United States that provides for registration based on ownership of a foreign registration, or extends reciprocal registration rights to nationals of the United States (15 U.S.C. §1126(b)); and
- (2) The applicant must be the owner of a valid registration *in the applicant's country of origin* (15 U.S.C. §1126(c) and (e)).

See TMEP §1002.04 regarding the applicant's country of origin, and TMEP §1002.03 and Appendix B for information about how to determine whether a particular country is a party to a treaty or agreement, or provides reciprocal registration rights to United States nationals.

If an applicant does not meet the above requirements, the examining attorney must refuse registration under §44(e). The applicant may amend the application to claim §1(a) or §1(b) as a basis. See TMEP §§806.03 *et seq.* regarding amendment of the basis.

An applicant domiciled in the United States cannot obtain registration under §44(e) unless the applicant is the owner of a registration from an eligible country other than the United States *and* the applicant can establish that the foreign country is the applicant's country of origin. See TMEP §1002.05.

See TMEP §§1004 *et seq.* for additional information about the requirements for registration under §44(e).

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### 1002.02 Eligible Applicants Under §44(d)

To be eligible for a priority filing date under §44(d), an applicant must meet the following requirements:

- (1) The applicant's country of origin must be a party to an international treaty or agreement with the United States that provides a right of priority, or must extend reciprocal rights to priority to United States nationals; and
- (2) The foreign application that is the basis for the priority claim must be filed in a country that is a party to a treaty or agreement with the United States that provides a right of priority, or must extend reciprocal rights to priority to United States nationals.

15 U.S.C. §§1126(b) and (d).

See TMEP §1002.04 regarding the applicant's country of origin, and TMEP §1002.03 and Appendix B for information about how to determine whether a particular country is a party to an international treaty or agreement that provides a right of priority to United States nationals.

If an applicant does not meet these requirements, the examining attorney must refuse registration under §44 and advise the applicant that it is not entitled to priority. The applicant may amend the application to claim another basis. See TMEP §§806.03 *et seq.* regarding amendment of the basis. The examining attorney should ensure that the priority claim is deleted from the TRAM database, and conduct a new search of Office records for conflicting marks.

To obtain a priority filing date under §44(d), the foreign application does *not* have to be filed in the applicant's country of origin. However, to obtain registration under §44(e) based on the foreign registration that will issue from the application on which the applicant relies for priority, the applicant must establish that the country in which the application was filed is its country of origin. TMEP §1002.01. Therefore, if the applicant files under §44(d) and identifies an application from a treaty country other than the country in which the applicant is domiciled, the examining attorney should advise the applicant that if the applicant intends to rely on the registration issuing from the identified foreign application as its basis for registration, the applicant must establish that the country where the foreign application was filed is its country of origin.

It is important to keep in mind that while §44(d) provides a basis for filing and a priority filing date, it does not provide a basis for publication or registration. A party who files under §44(d) must establish a basis for registration. 37 C.F.R. §2.34(a)(4)(iii); TMEP §1003.03. For example, a French corporation may rely on a first-filed application in Canada for its priority claim under §44(d), regardless of whether Canada is the applicant's country of origin. However, before the mark can be published for opposition in the United States the French corporation must do one of the following: (1) establish Canada as its country of origin and rely on the

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prospective Canadian registration as its basis for registration in the United States (see TMEP §§1002.01 and 1002.04); (2) assert use in commerce under §1(a) and/or a bona fide intention to use in commerce under §1(b) as its basis for publication in the United States; or (3) rely on a registration in France as its basis for registration in the United States.

An applicant domiciled in the United States may claim priority under §44(d) based on ownership of an application *in a treaty country other than the United States*. See TMEP §1002.05.

See TMEP §§1003 *et seq.* for additional information about the requirements for obtaining a priority filing date under §44.

### 1002.03 Establishing Entitlement Under a Treaty

In a §44 application, the examining attorney must confirm that (1) both the applicant's country of origin and the country where the applicant has filed the application or obtained registration are parties to a treaty or agreement with the United States (or that they extend reciprocal rights to United States nationals by law), *and* (2) the specific benefit that the applicant is claiming under §44 (*i.e.*, the right to a priority filing date under §44(d) and/or the right to registration under §44(e)) is provided for under the treaty or agreement. See TMEP §§1002.01 and TMEP §1002.02.

To determine whether a particular country has a treaty with the United States that provides for the benefit that the applicant is claiming under §44, examining attorneys should consult Appendix B of this manual. Appendix B lists the members of the Paris Convention, Inter-American Convention, Buenos Aires Convention, World Trade Organization, European Community and certain countries entitled to reciprocal treatment under other international agreements, as well as websites where examining attorneys can obtain updated information about these treaties or agreements.

If a qualified applicant filed an application or obtained a registration in a country that is a member of the Paris Convention, Inter-American Convention, World Trade Organization or European Community, the applicant can claim the benefits of *either* §44(d) or §44(e), if the applicant meets the requirements of those sections. A qualified applicant may also file under either §44(e) or §44(d) based on an application filed or registration obtained in Taiwan. On the other hand, if the applicant filed an application or obtained a registration in a country that is a member of the Buenos Aires Convention, the applicant may seek registration under §44(e), but may *not* obtain a priority filing date under §44(d). See Appendix B for additional information.

In the case of agreements not covered in Appendix B, an applicant can establish its eligibility for the benefits of §44 by providing evidence of statutes or agreements establishing reciprocity between the United States and the relevant country.

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Examining attorneys may also consult sources such as *Trademarks Throughout the World* and *World Trademark Law and Practice*, available to Office employees in the Trademark Law Library, for information about the trademarks laws of foreign countries.

See TMEP §1002.01 for information about how the examining attorney should handle an application in which the applicant is not entitled to registration under §44(e), and TMEP §1002.02 for information about how the examining attorney should handle an application in which the applicant is not entitled to priority under §44(d).

### **1002.04            Establishing Country of Origin**

To obtain registration under §44(e), the applicant must be the owner of a valid registration from the applicant's country of origin. TMEP §1002.01. To obtain a priority filing date under §44(d), the applicant's country of origin must be a treaty country, but the foreign application that is the basis for the priority claim does not have to be filed in the applicant's country of origin. TMEP §1002.02.

Section §44(c) of the Trademark Act defines the applicant's country of origin as "the country in which he has a bona fide and effective industrial or commercial establishment, or if he has not such an establishment, the country in which he is domiciled, or if he has not a domicile in any of the countries described in paragraph (b) of this section, the country of which he is a national." Under this definition, an applicant can have more than one country of origin.

If a §44 applicant is domiciled or incorporated in the relevant country, the examining attorney should presume that the country is the applicant's country of origin, and should not issue any inquiry about the applicant's country of origin.

If a §44(e) applicant is not domiciled or incorporated in the relevant country (or if a §44(d) applicant is not domiciled or incorporated in a treaty country), the examining attorney should require the applicant to establish that the country is its country of origin. Normally, a statement by the applicant or the applicant's attorney that the applicant has a bona fide and effective industrial or commercial establishment in the relevant country will be sufficient to establish that the country is the applicant's country of origin. This statement does not have to be verified. However, if there is any evidence in the record that contradicts the applicant's assertion that it has a bona fide and effective industrial or commercial establishment in the relevant country, the examining attorney has the discretion to require the applicant to set forth the specific circumstances that establish that the applicant maintains a bona fide and effective industrial or commercial establishment in the country. Relevant factors include the presence of production facilities, business offices and personnel. The presence of an applicant's wholly-owned subsidiary in a country does not, by itself, establish country of origin. *In re Aktiebolaget Electrolux*, 182 USPQ 255 (TTAB 1974). See also *Ex parte Blum*, 138 USPQ 316 (Comm'r Pats. 1963).

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The United States, by definition, is not a country that has a treaty with the United States. Therefore, the term “country of origin” in §§44(b) and (c) means some country other than the United States. *In re Fisons Ltd.*, 197 USPQ 888 (TTAB 1978). See TMEP §1002.05.

See TMEP §1002.01 for information about how the examining attorney should handle an application in which the applicant is not entitled to registration under §44(e), and TMEP §1002.02 for information about how the examining attorney should handle an application in which the applicant is not entitled to priority under §44(d).

### 1002.05 United States Applicants

Section 44(b) of the Trademark Act provides that, “Any person whose country of origin is a party to any convention or treaty relating to trademarks, trade or commercial names, or the repression of unfair competition to which the United States is also a party, or extends reciprocal rights to nationals of the United States by law, shall be entitled to the benefits of this section....”

Section 44(i) of the Act provides that “[c]itizens or residents of the United States shall have the same benefits as are granted by this section to persons granted by this section to persons described in subsection [44(b)].” However, §44(i) does not provide an independent basis for a United States applicant to register a mark under §44(e). *In re Pony International Inc.*, 1 USPQ2d 1076 (Comm’r Pats. 1986).

The United States, by definition, is not a country that has a treaty with the United States. Therefore, the term “country of origin” in §44(b) means some country other than the United States, and the term “person” in §44(b) means a person who can claim a country of origin other than the United States. *In re Fisons Ltd.*, 197 USPQ 888 (TTAB 1978).

An applicant domiciled in the United States may claim priority under §44(d) based on ownership of an application in a treaty country *other than the United States*, even if the other country is not the applicant’s country of origin. See *In re ETA Systems Inc.*, 2 USPQ2d 1367 (TTAB 1987), *dec. withdrawn on other grounds* (TTAB, November 28, 1988); *In re International Barrier Corp.*, 231 USPQ 310 (TTAB 1986). See TMEP §1002.02.

However, an applicant domiciled in the United States may not obtain registration under §44(e) unless the applicant is the owner of a registration from an eligible country other than the United States *and* the applicant can establish that the foreign country is the applicant’s country of origin. *In re International Barrier Corp.*, *supra*; *In re Fisons*, *supra*. See TMEP §1002.01.

For example, a Texas corporation may assert a priority claim under §44(d) based on ownership of an application in Mexico, regardless of whether Mexico is its country of origin. However, this applicant must also assert a valid basis for registration (see

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TMEP §1003.03). The applicant may do so by asserting use in commerce under §1(a) and/or a bona fide intention to use in commerce under §1(b) as its basis for publication. The applicant cannot obtain registration in the United States under §44(e) unless the applicant establishes that Mexico is one of its countries of origin.

See TMEP §1002.04 regarding the applicant's country of origin, and TMEP §1002.03 and Appendix B for information about how to determine whether a particular country is a party to an international treaty or agreement that provides for priority and/or registration based on ownership of a foreign registration.

See *also* TMEP §1002.01 for information about how the examining attorney should handle an application in which the applicant is not entitled to registration under §44(e), and TMEP §1002.02 for information about how the examining attorney should handle an application in which the applicant is not entitled to priority under §44(d).

### **1003                    Section 44(d) - Priority Filing Date Based on a Foreign Application**

Section 44(d) of the Trademark Act, 15 U.S.C. §1126(d), grants a priority filing date to qualified applicants (see TMEP §1002.02) who have filed an application in a treaty country as defined by §44(b) (see TMEP §1002.03). If a qualified applicant files the United States application claiming §44(d) priority within six months of filing the first application to register the mark in a treaty country, the United States application will receive an effective filing date as of the filing date of the foreign application.

The requirements for receipt of a priority filing date under §44(d) are:

- (1) The applicant must file a claim of priority within six months of the filing date of the first-filed foreign application. 15 U.S.C. §1126(d)(1); 37 C.F.R. §§2.34(a)(4)(i) and 2.35(b)(5); TMEP §§1003.01 and 1003.02.
- (2) The applicant must: (a) specify the filing date and country of the first regularly filed foreign application; or (b) state that the application is based upon a subsequent regularly filed application in the same foreign country, and that any prior-filed application has been withdrawn, abandoned or otherwise disposed of, without having been laid open to public inspection and without having any rights outstanding, and has not served as a basis for claiming a right of priority. 15 U.S.C. §1126(d); 37 C.F.R. §§2.34(a)(4)(i)(A) and (B).
- (3) The applicant must verify that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. 15 U.S.C. §1126(d)(2). If the verified statement is not filed with the initial application, the verified statement must allege that the applicant has had a bona fide intention to use the mark in commerce since the filing date of the application. 37 C.F.R. §2.34(a)(4)(ii).

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- (4) Both the applicant's country of origin and the country where the foreign application is filed must be a party to an international treaty or agreement with the United States that provides a right of priority, or must extend reciprocal rights to priority to United States nationals. 15 U.S.C. §1126(b) and (d); TMEP §§1002.02, 1002.03 and 1002.04.
- (5) The scope of the goods covered by the §44(d) basis cannot exceed the scope of the goods or services in the foreign application. 37 C.F.R. §2.32(a)(6); TMEP §1402.01(b).
- (6) The applicant must specify the serial number of the foreign application. 37 C.F.R. §2.34(a)(4)(i)(A); Paris Convention Article 4(D)(5).

If the applicant is not domiciled in the United States, the applicant may designate a domestic representative, *i.e.*, a person residing in the United States on whom may be served notices or process in proceedings affecting the mark. 15 U.S.C. §1051(e); TMEP §604. This can be done through the Trademark Electronic Application System ("TEAS"), at <http://www.uspto.gov/teas/index.html>.

The priority filing date also constitutes a constructive date of first use in the United States under 15 U.S.C. §1057(c) (see TMEP §201.02), if the application matures into a registration. See *SCM Corp. v. Langis Foods Ltd.*, 539 F.2d 196, 190 USPQ 288 (D.C. Cir. 1976).

Section 44(d) of the Act provides only a basis for receipt of a priority filing date, *not* a basis for publication or registration. See TMEP §1003.03.

In a §44(d) application, both the actual date the application was received in the Office and the priority date will appear in the TRAM database.

### **1003.01            The "First-Filed" Requirement**

The application relied on under §44(d) must be the applicant's first application in a treaty country for the same mark and for the same goods or services. If the foreign country denominates an application in the foreign country as "An Application to Extend the Wares" or in some similar fashion, but the application is, in substance, the equivalent of a new application in the United States, the foreign application will be considered the first-filed for the purpose of meeting the requirements of §44(d) in the United States. However, the goods or services must be different from those covered by any previous application for the mark in a treaty country.

The §44(d) priority claim may be based upon a subsequently-filed application in the same foreign country, if the first-filed application was withdrawn, abandoned or otherwise disposed of without having any rights outstanding, and did not serve as a basis for claiming a right of priority.

The Office will presume that the application identified as the basis for the priority claim was the first-filed, unless there is contradictory evidence in the record.

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If the examining attorney determines that the application relied on was not the first-filed, the examining attorney must refuse registration under §44 and advise the applicant that it is not entitled to priority. The applicant may amend the application to claim another basis. See TMEP §§806.03 *et seq.* regarding amendment of the basis. The examining attorney should ensure that the priority claim is deleted from the TRAM database, and should conduct a new search of Office records for conflicting marks.

### **1003.02            Priority Claim Must Be Filed Within Six Months of Foreign Filing**

An applicant must file a claim of priority within six months after the filing date of the foreign application. 15 U.S.C. §1126(d)(1); 37 C.F.R. §§2.34(a)(4)(i) and 2.35(b)(5). The applicant can submit the priority claim after the filing date of the United States application, as long as it is within six months of the foreign filing.

*Example:* If an eligible applicant files in France on December 6, 2004, and in the United States on January 12, 2005, the applicant can add a priority claim to the United States application on or before June 6, 2005, if the applicant meets the requirements of §44(d). The applicant cannot add a priority claim to the United States application after June 6, 2005.

If an applicant claims priority under §44(d), but does not specify the filing date of the foreign application, the examining attorney must require that the applicant specify the date of the foreign filing.

If the applicant submits a claim of priority more than six months after the date of the foreign filing, the examining attorney must refuse registration under §44 and advise the applicant that it is not entitled to priority. 15 U.S.C. §1126(d); 37 C.F.R. §§2.34(a)(4)(i) and 2.35(b)(5). The applicant may amend the application to claim another basis. See TMEP §§806.03 *et seq.* regarding amendment of the basis. The examining attorney should ensure that the priority claim is deleted from the TRAM database, and should conduct a new search of Office records for conflicting marks.

If the priority period ends on a Saturday, Sunday or Federal holiday within the District of Columbia, the priority claim may be filed on the following day that is not a Saturday, Sunday or a Federal holiday within the District of Columbia. Paris Convention Article 4(C)(3); 35 U.S.C. §21(b); 37 C.F.R. §2.196.

### **1003.03            Basis for Registration Required**

Section 44(d) of the Act provides a basis for receipt of a priority filing date, but not a basis for publication or registration. Before the application can be approved for publication, or for registration on the Supplemental Register, the applicant must establish a basis under §1(a), §1(b), or §44(e) of the Act. 37 C.F.R. §2.34(a)(4)(iii). If the applicant claims a §1(b) basis, the applicant must file an allegation of use (*i.e.*,

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either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d)) before the mark can be registered. See TMEP §806.01(b) regarding the requirements for a §1(b) basis.

The Office will generally presume that the applicant is asserting §44(e) as a basis for registration (based on the foreign registration that will issue from the application that the applicant relied on for priority) in an application that includes a proper claim of priority under §44(d). Unless the applicant specifically indicates that it is claiming more than one basis, the Office will presume that §44(e) is the only basis being asserted. See TMEP §1002.02 regarding applications that are entitled to a priority filing date under §44(d), but are not entitled to registration under §44(e), because the foreign application was filed in a treaty country that is not the applicant's country of origin.

See TMEP §§1004 *et seq.* regarding the requirements for registration under §44(e).

A §44(d) applicant may not assert a basis under §66(a) of the Trademark Act, based on an extension of protection of an international registration to the United States. 37 C.F.R. §§2.34(b)(3) and 2.35(a).

### **1003.04            Suspension Awaiting a Foreign Registration**

#### ***Suspension Required When Application in Condition for Approval or Final Refusal***

In a §44(d) application, if a copy of the foreign registration has not been submitted at the time of filing in the United States, the examining attorney will require submission of a copy of the foreign registration before approving the United States application for publication, or for registration on the Supplemental Register.

If, on initial examination of the application, there are no other issues or requirements outstanding, the examining attorney will suspend action on the application pending receipt of a copy of the foreign registration.

If the examining attorney must issue any refusals or requirements, the examining attorney will take appropriate action to place the application in condition for either approval or for final action on all other issues, and will then suspend further action pending receipt of a copy of the foreign registration. In the notice of suspension, the examining attorney should reference any continued refusals or requirements. See TMEP §716.01.

#### ***Inquiry Required Before Suspension of Multi-Basis Applications***

If an applicant claiming priority under §44(d) asserts more than one basis for registration, before suspending the application, the examining attorney must inquire whether the applicant wishes to retain §44(e) as a second basis for registration

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(based on the foreign registration that will issue from the application on which the applicant relied for priority) before suspending the application. This inquiry should be made in the first Office action, or by telephone if no Office action is issued. If the examining attorney is unable to reach the applicant by telephone, the examining attorney should issue an Office action requiring a copy of the foreign registration, advising applicant that it may retain the priority filing date even if it does not perfect the §44(e) basis, and inquiring as to whether the applicant wishes to retain §44(e) as a second basis for registration. The applicant may elect not to perfect a §44(e) basis and still retain the priority filing date. 37 C.F.R. §§2.35(b)(3) and (4); TMEP §806.04(b).

### ***Periodic Inquiries Issued as to Status of Foreign Application***

Examining attorneys issue inquiries as to the status of the foreign application in applications that have been suspended for more than six months. See TMEP §716.05. If the applicant does not respond to this inquiry within six months of the mailing date, the application will be abandoned.

If the applicant is still unable to furnish a copy of the foreign registration at the time of the inquiry, the applicant should advise the examining attorney of this fact. This may be done by telephone. The examining attorney will issue a new notice of suspension.

### **1003.05 Section 44(d) and Priority for Publication**

To determine priority for publication under 37 C.F.R. §2.83, an application filed in the United States under §44(d) will be treated as if it were filed in the United States on the same date as the filing in the foreign country. The §44(d) application will receive priority over any application filed after the §44(d) applicant's priority filing date that might otherwise be a possible bar to registration under §2(d) of the Trademark Act due to a likelihood of confusion. See TMEP §§1208 *et seq.* regarding conflicting marks in pending applications.

In some cases, another United States application filed after the §44(d) applicant's priority date may proceed to publication or registration because the §44(d) applicant had not yet filed in the United States when the examining attorney searched the Office records for conflicting marks. If the Office learns that a §44(d) application is entitled to priority over another pending application before the other mark registers, the Office will take appropriate action to give the §44(d) application the priority to which it is entitled.

If an examining attorney discovers a conflicting application entitled to priority under §44(d) after taking action in a case, the examining attorney should issue a supplemental action correcting the situation. If the mark has been published, the examining attorney must request jurisdiction before issuing the action, unless a

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notice of allowance has issued. See TMEP §§1504.01 and 1504.04(a) regarding the examining attorney's jurisdiction.

However, if the conflicting mark has already registered, the Office does not have the authority to cancel the registration *sua sponte*. The §44(d) applicant must take action to enforce its priority rights, e.g., by filing a petition to cancel the registration with the Trademark Trial and Appeal Board.

### **1003.06 Applicants May File Under Both §44(d) and §44(e)**

In some cases, a §44 applicant may have already received, before filing in the United States Patent and Trademark Office, a foreign registration as a result of the same foreign application upon which the applicant relies for a §44(d) priority claim. This may occur in countries that do not examine applications prior to registration. In this situation, the applicant may file under both §44(d) and §44(e).

An applicant may also claim priority under §44(d) based upon a foreign application, and proceed to registration under §44(e) based upon a different foreign registration.

### **1003.07 Application May be Based on More Than One Foreign Application**

An applicant may file an application in the United States based on more than one foreign application for different goods or services, or for different classes, if the applicant meets the requirements of §44(d) with respect to each foreign application on which the United States application is based. The applicant must specify which goods or services, or which classes, are covered by which foreign application.

### **1003.08 Abandonment of the Foreign Application**

If the foreign application relied on under §44(d) is abandoned during the prosecution of the United States application, the applicant may amend the application to rely on another basis. See TMEP §§806.03 *et seq.* If the applicant met the requirements of §44(d) on the filing date of the United States application, the applicant will retain the priority filing date even if the foreign application is abandoned. 37 C.F.R. §2.35(b)(4).

In this situation, the Office will presume that the applicant had a continuing valid basis because the applicant had at least a bona fide intention to use the mark in commerce as of the application filing date, unless there is contradictory evidence in the record. See 37 C.F.R. §2.35(b)(3) and TMEP §806.03(h).

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### 1004 Applications Based on Foreign Registrations under §44(e)

If a qualified applicant (see TMEP §1002.01) owns a valid registration from the applicant's country of origin, the applicant may base its United States application on that foreign registration under §44(e).

A §44(e) application must meet the following requirements:

- (1) The applicant must be the owner of a valid registration in the applicant's country of origin. 15 U.S.C. §§1126(c) and (e). See TMEP §§1002.01 and 1002.04 regarding country of origin.
- (2) The applicant's country of origin must be a party to a treaty or agreement with the United States that provides for registration based on ownership of a foreign registration, or extends reciprocal registration rights to nationals of the United States. 15 U.S.C. §1126(b). See TMEP §§1002.03, 1002.04 and 1002.05.
- (3) The applicant must submit a true copy, a photocopy, a certification, or a certified copy of the registration in the applicant's country of origin. 15 U.S.C. §1126(e); 37 C.F.R. §2.34(a)(3)(ii); TMEP §1004.01.
- (4) The applicant must verify that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. 15 U.S.C. §1126(e). If the verified statement is not filed with the initial application, the verified statement must allege that the applicant has had a bona fide intention to use the mark in commerce since the application filing date. 37 C.F.R. §2.34(a)(3)(i).
- (5) The scope of the goods covered by the §44(e) basis cannot exceed the scope of the goods or services in the foreign registration. 37 C.F.R. §2.32(a)(6); TMEP §1402.01(b).

If the applicant is not domiciled in the United States, the applicant is encouraged to designate a domestic representative, *i.e.*, a person residing in the United States on whom may be served notices or process in proceedings affecting the mark. 15 U.S.C. §1051(e); TMEP §604. This can be done through TEAS, at This can be done through TEAS, at <http://www.uspto.gov/teas/index.html>.

Applicant may not file an application under §44(e) before the registration in the applicant's country of origin has issued. An applicant can file under §44(d) within six months after the filing date of an application in the applicant's country of origin (see TMEP §§1003 *et seq.*). However, once this six-month priority period has passed, an applicant cannot file an application in the United States based on the pending application.

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### 1004.01 Copy of Foreign Registration Required

Section 44(e) of the Trademark Act, 15 U.S.C. §1126(e), requires “a true copy, a photocopy, a certification, or a certified copy of the registration in the country of origin of the applicant.” If a copy of the foreign registration is not included with the application as filed, the examining attorney will require submission of a copy of the foreign registration in the first Office action. The copy must show the name of the owner, the mark, and the goods or services for which the mark is registered.

If an applicant files more than one application in the United States based on the same foreign registration, the applicant must file a copy of the foreign registration for each of the United States applications.

In a §44(e) application, the examining attorney will not suspend the application pending submission of a copy of the foreign registration, unless the applicant establishes that it cannot obtain a copy of the foreign registration due to extraordinary circumstances (e.g., war or natural disaster). However, the examining attorney may suspend the application pending receipt of proof of renewal of the foreign registration (see TMEP §1004.01(a)).

#### 1004.01(a) Status of the Foreign Registration

The foreign registration must be in force at the time the United States issues the registration based on that foreign registration. *In re Societe D'Exploitation de la Marque Le Fouquet's*, 67 USPQ2d 1784 (TTAB 2003); *Marie Claire Album S.A. v. Kruger GmbH & Co. KG*, 29 USPQ2d 1792 (TTAB 1993); *Fioravanti v. Fioravanti Corrado S.R.L.*, 230 USPQ 36 (TTAB 1986), *recon denied* 1 USPQ2d 1304 (TTAB 1986). Appendix B of this manual lists the terms of registration in various foreign countries.

If the record indicates that the foreign registration will expire before the United States registration will issue, the examining attorney must require that an applicant submit a copy of the foreign registration that shows that the foreign registration has been renewed and will be in force at the time the registration issues in the United States. 37 C.F.R. §2.34(a)(3)(iii). If the applicant states that renewal is pending in the foreign country, the examining attorney should suspend the application pending receipt of proof of renewal.

If an applicant submits a certified copy or certification of the foreign registration that is certified by the foreign government agency that issued the foreign registration, the examining attorney should inquire concerning renewal only if the certified copy of the foreign registration indicates that the registration will expire *after* the date on which the foreign government agency issued the certified copy or certification of the foreign registration. For example, if a certified copy of a foreign registration was issued by the trademark agency in the foreign country on January 5, 2005, and the certified copy indicates that the registration expired on June 1, 2004, no inquiry is necessary. The Office presumes that the foreign country would not have issued a certified copy

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of the registration unless the registration had been renewed. This applies *only* to a certified copy or certification issued *by the foreign trademark agency*. If the copy of the registration is not certified by the foreign trademark agency, and the record indicates that the foreign registration will expire before the United States registration will issue, the examining attorney must require that the applicant submit a copy of the foreign registration showing that the registration has been renewed.

If the examining attorney determines that the foreign registration is not in force, the examining attorney will refuse registration under §44(e). The applicant may amend the application to claim another basis. See TMEP §§806.03 *et seq.* regarding amendments to the basis.

For information about recent changes in the term of registration in a foreign country, examining attorneys may consult sources such as *Trademarks Throughout the World* (J. M. Politi) and *World Trademark Law and Practice* (Ethan Horwitz), available to Office employees in the Trademark Law Library.

### **1004.01(b) Translation of the Foreign Registration**

If the foreign registration is not in English, the applicant must provide a translation. 37 C.F.R. §2.34(a)(3)(ii). The translator should sign the translation, but does not have to swear to the translation.

### **1004.02 Application May be Based on More Than One Foreign Registration**

An application may be based on more than one foreign registration. The applicant must meet all requirements of the Act and rules for each foreign registration upon which the application is based, and must specify which goods/services are covered by which foreign registration.

If a §44 applicant amends an application to rely on a different foreign registration, this is considered a change in basis. See TMEP §§806.03 *et seq.* regarding amendments to add or substitute a basis.

### **1005 Ownership of the Foreign Application or Registration**

#### ***Section 44 Claimed in Original Application***

If an applicant claims §44 as a filing basis in the original application, or if the applicant omits the basis from the original application and subsequently amends the application to claim §44 as the sole basis, the applicant must be the owner of the foreign application or registration on the filing date of the United States application. See *In re De Luxe, N.V.*, 990 F.2d 607, 26 USPQ2d 1475 (Fed. Cir. 1993); *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689 (TTAB 1991). If the foreign application or registration identifies a party other than the §44 applicant as the owner, the

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examining attorney must require the applicant to establish that the applicant was the owner of the foreign application or registration on the date of filing in the United States.

Proof of ownership may consist of a copy of an assignment document recorded in the foreign country, or a statement from the agency administering the trademark register in the foreign country establishing that the applicant was the owner of the foreign application or registration as of the United States application filing date. Other forms of proof may also be acceptable. If the transfer of ownership took place before the United States application filing date, the §44 basis will be considered valid even if the change in ownership was not yet recorded in the foreign country on the United States application filing date.

If the applicant was not the owner of the foreign application or registration on the United States application filing date, the examining attorney must refuse registration under §44. The applicant may amend the application to claim §1(a) or §1(b) as a basis. See TMEP §§806.03 *et seq.* regarding amendment of the basis.

If a §44(d) applicant was not the owner of the foreign application on the United States application filing date, the examining attorney should advise the applicant that it is not entitled to priority, ensure that the priority claim is deleted from the TRAM database, and conduct a new search of Office records for conflicting marks. TMEP §1002.02.

### ***Section 44 Added to or Substituted for Valid Section 1 Basis***

If an application is properly filed based on §1(a) or §1(b), and the applicant later amends the application to add or substitute §44 as a basis, the applicant must be the owner of the foreign application or registration as of the filing date of the amendment adding or substituting §44 as a basis for registration. See TMEP §§806.03 *et seq.* regarding amendments to change the basis.

If the applicant owned the foreign application or registration on the filing date of the amendment, but did not own the foreign application or registration on the filing date of the United States application, the applicant will retain the original filing date in the United States, as long as there was a continuing valid basis since the application filing date. 37 C.F.R. §2.35(b)(3); TMEP §806.03(h).

If the foreign application or registration identifies a party other than the §44 applicant as the owner, the examining attorney will require the applicant to establish that applicant was the owner of the foreign application or registration on the filing date of the amendment adding or substituting §44 as a basis. If the applicant was not the owner of the foreign application or registration on the filing date of the amendment, the examining attorney must refuse registration under §44.

See TMEP §1006 regarding assignment of §44 applications.

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### 1006 Assignment of §44 Applications

A §44 applicant may assign the foreign application or registration and/or the United States application from the original applicant to another party.

#### ***Assignee Must Be Eligible for the Benefits of §44***

In order to continue to claim the benefits of §44 after such an assignment, the assignee of the United States application must be eligible for the benefits of §44. *Nestle Co., Inc. v. Grenadier Chocolate Co., Ltd.*, 212 USPQ 214 (TTAB 1981); *In re Fisons Ltd.*, 197 USPQ 888 (TTAB 1978). See TMEP §1002.01 regarding applicants eligible for registration under §44(e), and TMEP §1002.02 regarding applicants eligible for a priority filing date under §44(d).

To be eligible for registration under §44(e), the assignee must establish that the country that issued the relevant registration is the assignee's country of origin. TMEP §§1002.01 and 1002.04. See also TMEP §1004 regarding the requirements for registration under §44(e).

To be eligible for a priority filing date under §44(d), the assignee must establish that the assignee's country of origin is a party to an international treaty or agreement with the United States that provides a right of priority, or extends reciprocal rights of priority to United States nationals. See TMEP §§1002.02, 1002.03 and 1002.04. See also TMEP §1003.

In any §44 application, if the assignee is not entitled to registration under §44(e), the examining attorney must refuse registration under that basis. The applicant may amend the application to claim §1(a) or §1(b) as a basis. See TMEP §§806.03 *et seq.* regarding amendment of the basis.

In a §44(d) application, if the assignee is not eligible for a priority filing date, the examining attorney should advise the assignee that it is not entitled to priority, ensure that the priority claim is deleted from the TRAM database, and conduct a new search of Office records for conflicting marks. TMEP §1002.02.

#### ***Assignee Does Not Have To Be the Owner of the Underlying Foreign Application or Registration***

The Trademark Act requires that an applicant own the underlying application or registration at the time of filing in the United States (or as of the filing date of the amendment adding or substituting §44 as a basis, for an application originally based on §1(a) or §1(b), and later amended to add or substitute §44 as a basis). TMEP §1005. However, if the applicant was the owner of the foreign application or registration on the filing date of the United States application (or amendment adding or substituting §44 as a basis), the applicant may assign the United States application to another party without assigning the underlying foreign application or

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registration to that party. *In re De Luxe N.V.*, 990 F.2d 607, 26 USPQ2d 1475 (Fed. Cir. 1993). Therefore, examining attorneys should not require proof of assignment of the underlying foreign application or registration when an applicant assigns the United States application.

### ***Designation of Domestic Representative Encouraged***

If the United States application is assigned to a party who is not domiciled in the United States, the assignee may file an appointment of a domestic representative with the assignment of the United States application. 15 U.S.C. §1060(b); 37 C.F.R. §3.61. See TMEP §604. The Office encourages parties who do not reside in the United States to designate domestic representatives. This can be done through TEAS, at <http://www.uspto.gov/teas/index.html>.

### **1007 Standards for Registration Under Section 44**

Although §44 exempts qualified applicants from the use requirements of §1 of the Trademark Act, §44 applicants must meet all other requirements for registration set forth in the Trademark Act and relevant rules. Registration in a foreign country does not automatically ensure eligibility for registration in the United States. *In re Rath*, 402 F.3d 1207, 74 USPQ2d 1174, 1179 (Fed. Cir. 2005) ("[I]t is impossible to read section 44(e) to require the registration of foreign marks that fail to meet United States requirements for eligibility. Section 44 applications are subject to the section 2 bars to registration..."); *In re Mastic Inc.*, 829 F.2d 1114, 4 USPQ2d 1292 (Fed. Cir. 1987); *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); *Order Sons of Italy in America v. Marofa S.A.*, 38 USPQ2d 1602 (TTAB 1996).

The foreign registration that is the basis for the United States application may include disclaimers or may be on a secondary register, equivalent to the Supplemental Register. The United States application will be reviewed according to the standards for registrability in the United States, and the examining attorney will not require a disclaimer, amendment to the Supplemental Register or any other amendment unless it is required under United States law and Office policy.

See TMEP §1306.08 regarding the registration of certification marks under §44.

### **1008 Bona Fide Intention to Use the Mark in Commerce**

Any application filed under §44(d) or §44(e) on either the Principal or the Supplemental Register must include a verified statement that the applicant has a bona fide intention to use the mark in commerce. See TMEP §1101 for additional information about this requirement. If the verified statement is not filed with the initial application, the verified statement must allege that the applicant has had a bona fide intention to use the mark in commerce since the application filing date. 37 C.F.R. §§2.34(a)(3)(i) and 2.34(a)(4)(ii).

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The allegation of the applicant's bona fide intention to use the mark in commerce is required even if use in commerce is asserted in the application. *In re Paul Wurth, S.A.*, 21 USPQ2d 1631 (Comm'r Pats. 1991). See also *In re Unisearch Ltd.*, 21 USPQ2d 1559 (Comm'r Pats. 1991) (requirement for verified statement of bona fide intent to use the mark in commerce held not contrary to Paris Convention).

### **1009 Allegation of Use and Specimen of Use Not Required Prior to Registration**

Although §44 applicants must assert a bona fide intention to use the mark in commerce, §44 applicants do not have to allege use or provide specimens or dates of use prior to registration on either the Principal or Supplemental Register in an application based solely on §44. *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909 (TTAB 1984). However, if a §44 applicant wishes to assert use in commerce under §1(a) or a bona fide intention to use the mark in commerce under §1(b) as an additional basis, then the applicant must comply with *all* applicable requirements related to the second basis asserted.

If the applicant provides specimens gratuitously in a §44 application, the examining attorney may refer to the specimens to determine issues unrelated to use, such as whether the mark is merely descriptive.

When the §44 application, as submitted, raises questions concerning the registrability of the mark, the examining attorney may request an explanation, information, literature or other materials to assist in consideration of the application. 37 C.F.R. §2.61(b); TMEP §814.

### **1010 Proof of Acquired Distinctiveness in §44 Applications**

A §44 applicant may assert that a mark has acquired distinctiveness under 15 U.S.C. §1052(f) if the applicant establishes that the mark has become distinctive of its goods or services *in commerce* in the same manner that any other applicant must. For these purposes, the applicant may not rely on use other than use in commerce that may be regulated by the United States Congress, that is, the applicant may not rely on use solely in a foreign country. See TMEP §1212.08 and cases cited therein for further information about claims of acquired distinctiveness in §44 applications.

### **1011 Drawings**

#### **1011.01 Substantially Exact Representation of Mark in Foreign Registration**

Applicants filing under §44 must comply with the drawing requirements of 37 C.F.R. §§2.51 through 2.54. The drawing of the mark must be "a substantially exact representation of the mark as it appears in the drawing in the registration certificate

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of the mark duly registered in the country of origin of the applicant.” 37 C.F.R. §2.51(c); TMEP §807.12(b).

The “substantially exact representation” standard is construed narrowly. Only slight, inconsequential variations between the mark in the United States application and the mark shown in the foreign registration are permitted. *In re Hacot-Colombier*, 105 F.3d 616, 41 USPQ2d 1523, 1525 (Fed. Cir. 1997); *In re Larios S.A.*, 35 USPQ2d 1214, 1216 (TTAB 1995); *United Rum Merchants Ltd. v. Distillers Corp. (S.A.) Ltd.*, 9 USPQ2d 1481, 1484 (TTAB 1988). For example, non-material informational matter such as net weight or contents may be deleted. Beyond such limited exceptions, however, any difference between the mark on the drawing and the mark in the foreign registration requires the examining attorney to refuse registration. *In re Hacot-Colombier*, 105 F.3d at 619, 41 USPQ2d at 1525.

The standard for determining whether the mark in the drawing agrees with the mark in the foreign registration is stricter than the standard used to determine whether specimens support use of a mark in an application under §1 of the Trademark Act. In *United Rum Merchants*, the Trademark Trial and Appeal Board reasoned that a stricter standard is appropriate in §44 cases because §44 applications represent an exception to the use requirements of the Act, and that this exception should be construed narrowly to ensure that a foreign applicant cannot obtain a registration in the United States of matter that could not have been registered in the foreign country. 9 USPQ2d at 1483-84.

If the mark in the foreign registration is in special form, the mark in the United States application must appear in the same special form. Likewise, if the mark in the foreign registration is in standard characters, the mark in the United States application must also be in standard characters. If the foreign registration certificate does not indicate that the mark is in standard characters (or the equivalent), the examining attorney must inquire whether the foreign registration includes a claim that the mark is in standard characters. The applicant must either submit an affirmative statement that the foreign registration includes a claim that the mark is in standard characters (or the equivalent), or delete the standard character claim in the United States application. See TMEP §807.03(f) for further information.

The mark on the drawing in the United States application may not be a translation or transliteration of the mark in the foreign registration.

If the United States application is based on both a foreign registration and use in commerce, the mark in the drawing in the United States application may not differ in a material way from either the mark shown on the foreign registration or the mark shown on the specimen(s) of record. See TMEP §§807.12(b) and 807.14 *et seq.*

### **1011.02 One Mark Per Application**

If the foreign application or registration covers a series of distinct marks, the applicant must file separate applications in the United States to register each of the

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marks the applicant wishes to register in the United States. For example, some countries permit registration of several versions of a mark in a single application. In the United States, separate applications are required. The drawing in the United States application must show only one mark. 37 C.F.R. §2.52; TMEP §807.01.

### 1011.03 Amendment of Drawing

Section 44 applicants often try to amend the mark in the United States application to overcome an objection that the mark in the drawing does not agree with the mark in the foreign registration. Amendments to drawings in §44 applications are governed by 37 C.F.R. §2.72(c). An applicant cannot amend the drawing in the United States application to conform to the mark in the foreign registration if the amendment would result in a material alteration of the mark on the drawing submitted with the original application in the United States. *In re Hacot-Colombier*, 105 F.3d 616, 41 USPQ2d 1523 (Fed. Cir. 1997); *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989). Thus, when a §44 applicant proposes to amend its drawing, the examining attorney must consider: (1) whether the proposed amendment of the drawing would result in a material alteration of the mark on the original drawing; and (2) whether the proposed amendment is a substantially exact representation of the mark in the foreign registration. In *In re Larios S.A.*, 35 USPQ2d 1214, 1216 (TTAB 1995), the Trademark Trial and Appeal Board held that the mark “GRAN VINO MALAGA LARIOS” and design on the drawing originally filed with the United States application was not a substantially exact representation of the mark “VINO DE MALAGA LARIOS” with a similar design in the foreign registration; however, the Board found that amendment of the drawing to conform to the foreign registration was *not* a material alteration within the meaning of 37 C.F.R. §2.72. The Board noted that “[t]he material alteration test ... is not quite as rigorous as the substantially exact representation standard and thus allows for a bit more leeway or flexibility with respect to ... amendment of the drawing...” *Larios*, 35 USPQ2d at 1217. See TMEP §§807.14 *et seq.* regarding material alteration.

### 1012 Identification of Goods and Services

The identification of goods and services in a §44 application must comply with the same standards that govern other applications.

If the application is based on §44, the identification of goods and services covered by the §44 basis may not exceed the scope of the goods and services identified in the foreign registration. 37 C.F.R. §2.32(a)(6). See *Marmark Ltd. v. Nutrexpa S.A.*, 12 USPQ2d 1843 (TTAB 1989); *In re Löwenbräu München*, 175 USPQ 178 (TTAB 1972).

See TMEP §1402.01(b) for more information about the identification of goods or services in a §44 application.

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### **1013                    Designation of Domestic Representative by Applicants Not Domiciled in the United States**

An applicant not domiciled in the United States may file a document designating the name and address of a person residing in the United States on whom may be served notices or process in proceedings affecting the mark. 15 U.S.C. §1051(e); 37 C.F.R. §2.24; TMEP §604. The Office encourages parties who do not reside in the United States to designate domestic representatives. This can be done through TEAS, at <http://www.uspto.gov/teas/index.html>.

### **1014                    Section 44 Applications for the Supplemental Register**

A §44 applicant may apply to register a mark on the Supplemental Register, and a §44 applicant may amend an application from the Principal Register to the Supplemental Register without filing any allegation of use. It is not necessary to change the application filing date after an amendment to the Supplemental Register in a §44 application. See TMEP §1008 regarding the requirement for an allegation of the applicant's bona fide intention to use the mark in commerce in a §44 application.

### **1015                    Section 44 Registration Independent of Underlying Foreign Registration**

Once issued, the United States registration issuing from a §44 application exists independent of the underlying foreign registration and is subject to all provisions of the Trademark Act that apply to all other registrations, such as affidavits of use, renewals, amendments under 15 U.S.C. §1057(e), assignments, and similar matters. 15 U.S.C. §1126(f). See *Imperial Tobacco Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990); *Exxon Corp. v. Oxon Italia S.p.A.*, 219 USPQ 907 (TTAB 1982); *Reynolds Televator Corp. v. Pfeffer*, 173 USPQ 437 (TTAB 1972); *Sinclair v. Deb Chemical Proprietaries Ltd.*, 137 USPQ 161 (TTAB 1963).

### **1016                    International Registration As Basis for §44 Application**

An international registration issued by the International Bureau of the World Intellectual Property Organization ("IB") can be the basis for a §44(e) application only if the international registration shows that there is an extension of protection of the international registration to applicant's country of origin. See TMEP Chapter 1900 regarding international registration. A request for an extension of protection of the international registration to applicant's country of origin is not sufficient.

An applicant should submit a copy of the registration (or certificate of extension of protection) issued by the national trademark office in the applicant's country of origin. 15 U.S.C. §1126(e); 37 C.F.R. §2.34(a)(3)(ii). If the applicant's country of origin does not issue registrations or certificates of extension of protection, the

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applicant may submit a copy of the international registration, showing that protection of the international registration has been extended to applicant's country of origin. A copy of a request for an extension of protection of the international registration to applicant's country of origin is not sufficient.

If the applicant is not domiciled or incorporated in the relevant country, the examining attorney must require the applicant to establish that the country is its country of origin. See TMEP §1002.04.

The applicant must meet all the requirements of the Trademark Act and the Trademark Rules of Practice for §44(e) applications. The requirements for §66(a) applications are not applicable.

The identification of goods/services covered by the §44(e) basis may not exceed the scope of the goods/services identified in the registered extension of protection in the applicant's country of origin. 37 C.F.R. §2.32(a)(6); TMEP §1012.

An extension of protection of an international registration cannot be the basis for a §44(d) application, because neither the international application nor the request for extension of protection is the first application filed in a treaty country for the same mark for the same goods or services. 15 U.S.C. §1126(d); 37 C.F.R. §§2.34(a)(4)(i)(A) and (B); TMEP §1003.01. The basic application or basic registration upon which the international registration is based was the first-filed application.

If an applicant wants to base a §44(e) application on the basic registration that was the basis for the international registration, the applicant must submit a copy of the basic registration issued by the Office of Origin, *i.e.*, the country or intergovernmental organization who issued the registration which provided the basis for the international registration (see TMEP §1901 regarding the Office of Origin). The applicant cannot submit the international registration, because an international registration does not provide protection in the territory of the Contracting Party whose office is the Office of Origin. Madrid Protocol Article 3<sup>bis</sup>.