

## Overcoming Misconceptions About U.S. Trademark Registration for International Businesses



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June 17, 2024 | **ARTICLES**

Did You Know: Owners of trademark registrations from outside of the United States do not need to be using their marks in the United States to obtain the corresponding U.S. trademark registrations.

After all my years of practice as a trademark and intellectual property attorney in the United States, I am still regularly surprised to learn from colleagues in other countries that in spite of their interest in eventually bringing their goods and services to the U.S. market, they are discouraged from even applying to register their trademarks in the United States. What has held them back is apparently a perception of complex U.S. rules and regulations about demonstrating use in the U.S. market before they can obtain their registrations here and about the costs that mount in the interim period before they have commenced such use. Even highly sophisticated trademark attorneys and agents outside of the United States often have an overly generalized perception that because they must claim either that a mark is actually in use in the United States or that the applicant has a bona fide intent to use the mark in order to file an application, they will need to satisfy the use requirement to obtain the registration. They believe that if they cannot do so promptly, they will incur significant costs in regularly obtaining extensions of the

deadline to show use or in refiling because they have not commenced use by the final extended deadline. This is a gross oversimplification and has been essentially incorrect for decades. I was surprised to learn from sophisticated colleagues at the most recent Annual Meeting of the International Trademark Association (INTA) that this misperception has been what holds them back from filing U.S. trademark applications.

Got a trademark in your home country (or in another country where the same entity has employees or offices)? Discouraged by the U.S. rules and requirements to prove use in order to obtain a U.S. trademark registration? You can obtain a U.S. trademark registration **BEFORE** even commencing use in U.S. commerce by relying on your home country registration for the same mark. My colleagues and I will be happy to help you to understand how to take advantage of the opportunity to obtain U.S. trademark registrations without use, and how to plan for the eventual use of the mark in the U.S. market. Our team of about 30 intellectual property attorneys and nearly 200 attorneys across over 15 North American offices stands ready to assist with your trademark needs, as well as nearly any U.S. legal matter.