

## On My Mind Blog

### How to Register a merely descriptive foreign mark in the U.S. without use

By William M. Borchard



A non-U.S. applicant cannot use the Madrid Protocol to register a merely descriptive English word (or its foreign-language equivalent) as a trademark in the United States. But another strategy may be available.

#### The Closed Avenue

This case exemplifies a strategy that will **not** work.

A Swiss company named S. Malhotra & Co. AG filed two applications to extend International Registrations under the Madrid Protocol to the Principal Register in the U.S. The marks were GÁMOS in standard characters and Greek characters that transliterated to GÁMOS, which means “wedding, matrimony or marriage” in English. The goods were jewelry and watches.

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The Examining Attorney refused registration on the ground that the marks were merely descriptive of a type of jewelry worn at weddings. On appeal, the U.S. Trademark Trial and Appeal Board affirmed the mere descriptiveness refusal.

The TTAB explained that under the doctrine of foreign equivalents, a foreign word from a common language, such as Greek, is translated into English when it is likely that the ordinary American purchaser would translate the word into English. The applicant argued that its mark had well-established alternative meanings such as “union,” “small deer,” “buck” and a sexual ritual, but the TTAB found that these meanings were for different Greek words, and moreover, that a term may be considered merely descriptive if it has any one descriptive meaning relevant to the goods. The applicant also argued that the mark conveyed a double meaning in that it could mean “a combination of multiple parts” or a “marriage of metals’ technique,” but the TTAB said there was no evidence that this would be readily apparent to consumers. So the mark was held not registrable on the Principal Register.

***In re S. Malhotra & Co. AG, Consolidated Application Nos. 79194076 and 79194077 (T.T.A.B. September 27, 2018).***

### **The U.S. Supplemental Register**

A different, somewhat complicated, strategy involves the U.S. Supplemental Register, which is for merely descriptive marks, surnames and geographically descriptive names that are capable of acquiring distinctiveness as a source indicator (known as acquiring “secondary meaning”) but have not yet done so. A Supplemental Register registration is not evidence of validity, ownership or exclusive rights, but it does prevent others from registering the same mark on the Principal Register, and the registration symbol ® may be used.

There is no provision in U.S. law for an International Registration under the Madrid Protocol to be extended to the Supplemental Register. Thus, the Madrid Protocol cannot be used to extend the International Registration of a merely descriptive foreign mark to either the Principal Register or the Supplemental Register in the U.S.

However, a non-U.S. applicant can base an application for the U.S. Principal Register or Supplemental Register on a valid national registration in a country where the applicant is domiciled or has a bona fide and effective industrial or commercial establishment (known as a “country of origin”). That country must have a treaty or agreement with the U. S. that provides for registration based on ownership of a foreign registration or that extends reciprocal registration rights to nationals of the U.S. Most countries satisfy this requirement. Also, the applicant must state that it has a bona fide intention to use the mark in U.S. commerce.

Further, under the Paris Convention, of which most countries are members, it is possible to claim the filing priority of the first-filed application in a member country if it was filed within 6 months before the U.S. application’s filing date.

### **The Open Avenue**

Instead of trying to extend an International Registration to the U.S., here is a strategy that **will** work for a non-U. S. applicant to register a merely descriptive word or its foreign equivalent in the U.S. without use in U.S. commerce:

1. Apply to register the mark in an appropriate country of origin (which likely is also a Paris Convention member).
2. If the country of origin application is the first-filed Paris Convention application, you may apply for a U.S. registration claiming the 6-month Paris Convention priority date. The U.S. application may seek registration on the Principal Register (in the hope that it will be

accepted by the Examining Attorney), or it may seek registration directly on the Supplemental Register. In either case, a non-U.S. applicant need not allege use of the mark anywhere in the world, but must state that it has a bona fide intention to use the mark in U.S. commerce. When a country of origin registration has been issued, you may convert the basis of the then-existing U.S. application to the country of origin registration.

3. Alternatively, if you did not make the priority filing noted above, you may apply for a U.S. registration based on an issued country of origin registration without an allegation of use, again either on the Principal Register or the Supplemental Register. However, you must state that you have a bona fide intention to use the mark in U.S. commerce.
4. If you applied for a U.S. Principal Register registration based on a country of origin registration, but the Examining Attorney insists that the mark is merely descriptive, you may amend the application to the Supplemental Register. A Supplemental Register registration normally is issued in due course without being published for opposition.
5. After the mark has been used in U.S. commerce and has acquired secondary meaning (usually after five consecutive years of substantially exclusive and continuous use in U.S. commerce), you may file a new U.S. application to register the mark on the Principal Register based on that use and secondary meaning.