

Trademark Registration: The Distinction Between "First Use" and "First Use in Commerce"

© 2013 Don V. Kelly

1. WHAT DOES "FIRST USE" MEAN IN REFERENCE TO TRADEMARKS?

a. For purposes of an application to register a trademark with the United States Patent & Trademark Office (USPTO), there are two important dates:

- i) Date of first use; and
- ii) Date of first use in commerce.

The distinction between the two dates is significant for trademark applications.

b. In the United States, an application to register a trademark can be filed based upon the "intent to use" the trademark in the future or based upon the fact the applicant actually used the trademark before filing the application. In either case, an application to register will not be granted until the applicant shows proof of using the mark "in commerce."

c. "First use in commerce" refers to commerce that Congress may regulate. This type of commerce is "interstate commerce" or commerce between the states or between the United States and a foreign country.

d. Section 45 of the Trademark Act, 15 U.S.C. §1127, defines "use in commerce" as follows:

The term "use in commerce" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this Act, a mark shall be deemed to be in use in commerce--

(1) on goods when--

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services

e. The date of first use in commerce is the date of the first sale or transportation in commerce. The USPTO has often taken the position in applications that only if a sale has taken

place can there be "actual use." Case law is not so clear and some courts have found that "use in commerce" has occurred without a sale

f. The bottom line is that proof that a good or service has been sold and there has been a continual attempt to sell such goods or services will generally be sufficient that there has actual use of a mark. Advertising alone is not enough to constitute "use in commerce." Activities in preparation of making sales (i.e., press releases, advertising) constitute "first use," but not "use in commerce."

g. The second important consideration is distinguishing the date of first use from the date of first use in commerce. This distinction between "first use in commerce" and "first use" is important for registration only.

h. "First use" anywhere can include pre-sale advertising as long as it is directed to the specific goods and services at issue and not some other goods or services. The date of "first use" will be important in the event of any claims of infringement and a court must determine who the first mark user is.

2. WHAT AMOUNT OF SALES CONSTITUTES "FIRST USE"?

The minimum amount of "use" depends on the circumstances, but it must be bona fide and not token use. Generally, if sale is the first provision of services /goods in a series in the normal course of business, then that one instance is enough. One isolated sale followed by a period of no sales, may not be enough to establish "first use in commerce."

3. BEST PRACTICES FOR BUSINESSES

As indicated above, evidence of overall first use is important in establishing priority when enforcing trademark rights against infringers. Evidence of first use in commerce is necessary to obtain a federal mark registration.

Hence, any company that uses or registers marks should document and save copies of materials proving the date of first use of any kind (e.g., press releases, advertising) for each of its marks and also the date of first sale of any goods or services sold in connection with the marks.

Don V. Kelly
Evans & Dixon, LLC
Suite 2500
211 North Broadway
St. Louis, Missouri 63102
dkelly@evans-dixon.com