

THE TRADEMARK TRIAL AND APPEAL BOARD (TTAB) REAFFIRMS THAT OWNERS OF A FOREIGN TRADEMARK CANNOT ENFORCE THEIR RIGHTS IN THAT MARK IN THE U.S. MERELY UNDER A "FAMOUS MARK" THEORY

By Alex Buttermann

In another recent precedential decision by the U.S. Patent and Trademark Office Trademark Trial and Appeal Board (TTAB), the TTAB rejected Bayer's attempt to cancel a registration for FLANAX for an analgesic medicine based upon its claim that its FLANAX mark was "well-known" from extensive use in many other countries. The TTAB held in *Bayer Consumer Care AG v. Belmora LLC*, 90 USPQ2d 1587 (TTAB 2009), that Section 44 of the Trademark Act, which implements the Paris Convention and permits trademark registration in the U.S. based upon foreign registration, does not afford the owner of a foreign trademark a separate legal basis for cancellation under a "famous mark" theory.

Non-U.S. companies that own a well-known, extensively used mark in their home country are repeatedly faced with the unwillingness of U.S. courts to stop infringers of famous marks in the U.S. because the non-U.S. companies cannot show earlier U.S. use or registration of the mark in the U.S. The unwillingness of U.S. courts to apply Article 6bis of the Paris Convention, which enables treaty members to refuse or cancel registration of a mark in their country that was copied or which is confusingly similar to the foreigner's famous mark, is problematic since American companies have been benefitting from Article 6bis in many foreign countries for decades.

Bayer ultimately prevailed in being permitted to proceed in its efforts to cancel the registration based upon a "palming off" theory actionable under the Trademark Act since the registrant obviously was aware of Bayer's mark from its international fame.