

**FILING AND PROSECUTING  
U.S. MULTIPLE-CLASS TRADEMARK APPLICATIONS**  
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The United States Patent and Trademark Office (“USPTO”) allows multiple-class, or combined, trademark applications. Trademark Manual of Examining Procedure (“TMEP”) § 801.01(b). An applicant filing a multiple-class application must pay for each class the same filing fee (for example, \$275) that the applicant would pay if filing a separate application for each class. *Id.* The international class numbers and the goods or services in each class must be listed separately from the lowest class number to the highest class number. *Id.*

The filing basis or bases for each class may be the same or they may be different. For example, a U.S. application for leather goods in Class 18 and clothing in Class 25 can be filed on the basis of:

1. Use of the mark for the goods in each class (a “Section 1(a) application”);
2. An intent to use the mark for the goods in each class (a “Section 1(b) application”);
3. The trademark owner’s pending application or applications that cover such goods or services in the owner’s home country if it is a member of the Paris Convention (a “Section 44(d) application”); and/or
4. The trademark owner’s registration that covers such goods in such foreign country (a “Section 44(e) application”).

37 Code of Federal Regulations § 2.86. An owner can also file a U.S. multiple-class application under the provisions of the Madrid Protocol (a “Section 66(a) application”). *Id.*

An application that claims use of a mark in more than one class can have the same dates of first use anywhere and first use in U.S. commerce for each class. TMEP § 1403.01. Alternatively, the dates of first use and first use in commerce can vary from class to class as long as the dates are stated separately. *Id.* An application filed under Section 1 or Section 44 of the U.S. Trademark Act may be amended during prosecution to delete, correct, or add classes. TMEP § 1403.02. In an application filed under Section 66(a) of the Trademark Act, however, classes may be deleted but not be added, and goods and services may not be transferred from one class to another *Id.*

One common practice with multiple-class applications is to divide such applications when an issue arises that delays registration of the mark in all of the classes listed in the application. For example, if a multiple-class application is based on use in one or more classes and intent to use in one or more other classes and the owner is not likely to put the mark into use in all such classes in the near future, the

owner can elect to divide the application into a “parent” application that covers the class(es) based on intent to use and a “child” application that covers the class(es) based on use. That way the owner can obtain sooner a registration for the class(es) based on use and still maintain an application for the class(es) based on intent to use. The USPTO fee for processing a request to divide an application is current \$100.

The USPTO can issue an Office Action that refuses to register a mark in one or more, but not necessarily all, of the classes listed in a multiple-class application. TMEP § 1403.05. In any such case the USPTO Examining Attorney “must expressly state that the refusal or requirement that applies only to certain class(es), and indicate the class(es) to which the refusal or requirement pertains.” *Id.* If an applicant fails to file a complete response to a refusal or requirement expressly limited to certain class(es), and if the application is otherwise in condition for publication, the application will be abandoned only with respect to those class(es). *Id.* If, however, the Office Action requires the payment of additional fees to cover all relevant classes and the applicant fails to file a response, the entire application will be abandoned. *Id.*

If a third party opposes a multiple-class application, the USPTO’s Trademark Trial and Appeal Board may, if it chooses, sustain the opposition only with respect to some class(es) in the application. In that event the application is returned to the Examining Attorney to ensure that a registration certificate issues only with respect to the remaining class(es). *Id.*

U.S. multiple-class trademark applications generally have the advantages of more efficient filing and prosecution, often including cost efficiency if outside counsel offers a volume discount for handling multiple-class applications or simply charges less per class for such applications than with respect to single-class applications. But U.S. multiple-class trademark applications sometimes have disadvantages too, being more complex than single-class applications and raising the possibility of needing to file one or more requests to divide. Because of these pros and cons, trademark owners from outside the United States, especially those from countries that do not permit multiple-class applications, should consult experienced U.S. trademark counsel before deciding whether to file single-class or multiple-class applications with the USPTO.

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**ARTICULO DE INTERES AMPPPI**  
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