

PUBLICATION

New Decision Expands Protection for Foreign Brand Owners

Authors: Catherine F. Hoffman

March 18, 2025

A recent precedential decision enlarges the protection for foreign trademark owners. *Plumrose Holding Ltd. v. USA Ham LLC*, Opposition No. 91272970 (January 17, 2025). The decision is a nod to foreign trademark owners to control their reputation and consider the "misrepresentation of source" as a claim in an opposition or cancellation proceeding when a defendant is deliberately copying and intentionally misleading consumers. The question was when is it acceptable to use a trademark in the U.S. that is the same as another company's trademark used *outside* the U.S.

The United States Patent and Trademark Office (USPTO) denied an application filed by a U.S. company for meat products sustaining an opposition by a foreign company that had not even used the trademark in the U.S. The opposition was based on a "misrepresentation of source" claim under §14(3) of the Trademark Act. The foreign company had used its mark in Venezuela for 75 years, but not yet used the trademark in the U.S. The USPTO found that despite the lack of use by the foreign brand owner in the U.S., the U.S. company had deliberately tried to pass off its goods as those of the foreign company. The U.S. company's improper conduct included: (1) adoption of the same mark; (2) use of very similar packaging; (3) sale of the products in stores focused on Venezuelan Americans who would be familiar with the Venezuelan original; and (4) persistent conduct despite knowledge that a retail customer believed the product was the Venezuelan original. In focusing on the reputational injury, the Court opined that the extension of a foreign company's reputation to the U.S. was not dependent on the intent-to-use application or any business plans pointing out that "the deception caused by misleading use of marks about which Congress is concerned may occur even when the source is not yet using the mark in the U.S. but its commercial reputation extends to the U.S."

The importance of monitoring potential trademark misuse in the U.S. is highlighted with this decision even without sales or registrations in the U.S. Foreign trademark owners should consider launching monitoring programs and documenting evidence of their reputation among U.S. consumers, including social media, consumer inquiries, and any occurrences of confusion. It is important to note that the USPTO has jurisdiction only over the right to register trademarks and a separate court proceeding must be brought to stop the use of a trademark, even if the USPTO determines the other party's conduct is reprehensible.

This case paves the way for brand owners who have not yet entered the U.S. market to protect their brands under the right circumstances and evidence.

If you have any questions or need guidance, please reach out to [Catherine F. Hoffman](#) or a member of Baker Donelson's [Trademark and Branding Team](#).