

Intent-to-use Trademark Applications: Make Sure your Intent is 'Bona  
Fide'  
by Matt Barlow

So you are thinking of starting a new business, and you have come up with the perfect name. Or, maybe you have thought up a name for the next must-have gadget. Much to your surprise, the name for your business or product is available right now. But, you are not actually ready to launch the business or the product right at this moment. Since trademark rights depend on use, are you out of luck?

### **USE-BASED APPLICATIONS VS. INTENT-TO-USE APPLICATIONS**

Two of the most common U.S. trademark application types are (1) actual use and (2) intent to use. An actual use trademark application requires that you are already using the mark in commerce. Alternatively, an intent-to-use application can be used if you haven't yet used the name in commerce, but plan on doing so in the future. The key benefit of the intent-to-use application is that your filing date becomes the "constructive use" date to establish nationwide priority in the mark. For example, let's say that you file an intent to use application on January 15 but haven't actually used the mark yet, and Company B files an actual use application for that same mark on March 1. You then put your product/service into commerce in June and file a statement of use that documents that use. You will then receive a registration on your mark and will have superior rights to the company that filed on March 1. Sounds great, right?

### **BONA FIDE INTENT TO USE THE MARK**

One major caveat is that in connection with your intent-to-use application, you must submit a verified statement that you have a bona fide intent to use the mark. As part of the application process, the United States Patent & Trademark Office will generally accept this statement without question. However, when your intent-to-use application publishes, Company B will have an opportunity to challenge your rights to the mark, and Company B will likely raise the issue of whether you can show that you actually had a bona fide intent to use the mark in question.

The Trademark Trial and Appeal Board ("TTAB"), the body that will hear this challenge of

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rights, requires objective evidence (usually some type of written documentation) to prove that the applicant had a bona fide intent to use the mark at the time the application was filed. The TTAB has stated that it will evaluate each bona fide intent to use challenge on a case-by-case basis and has not provided any bright-line rules for what constitutes a bona fide intent to use the mark. However, the decisions by the TTAB do give some guidance on what it considers to be probative evidence.

For example, the following are not considered evidence of a bona fide intent to use a mark (resulting in a denial of the application for registration):

- The filing of an application, by itself. (*See Swiss Grill Ltd., John Hartwig, Christopher Hartwig and Mathew Hartwih v. Wolf Steel Ltd.*, 115 USPQ2d 2001 (TTAB 2015)).
- A trademark clearance search. (*Id.*)
- Evidence that the applicant merely intended to reserve a mark, not actually had an intent to use it (such as emails or other correspondence filed “just in case the brand got bigger”; *see MZ Berger & Co., Inc. v. SWATCH AG*, 787 F.3d 1368 (Fed. Cir. 2015)).
- Oral testimony that the applicant intended to use the mark. (*See Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994)).

However, the following were found to be evidence of a bona fide intent to use the mark (resulting in registration of the mark):

- Email(s) to a potential licensing representative prior to the filing of the trademark application (*See Hard Candy Cases, LLC, v. Hard Candy LLC*, Opposition No. 91195328 (TTAB November 13, 2014))
- Evidence of an ongoing business of the type that would offer the goods listed in the application and the capability to manufacture and/or market the goods. (*See Lane Ltd.*, 33 USPQ2d at 1351 (TTAB 1994))
- Documentation showing the negotiation of a partnership and licensing agreement for the goods in question bearing the mark. (*See Donald Reid v. Monster, Inc.*, Opposition No. 91218973 (TTAB Jan. 26, 2017)).

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- Documents showing prototypes of the goods listed in the application. (*Id.*)
- Documents showing prototypes of packaging for the goods listed in the application. (*Id.*)
- Documents showing business plans and marketing plans for the goods listed in the registration. (*Id.*)

As such, it is important to remember that, should you decide to file an intent-to-use application, you must have some type of written documentation showing a bona fide intent to use the mark in question. Otherwise, you leave yourself vulnerable to a challenge, one that could result in your registration being denied absent documentary evidence of your intent to use the mark.

If you have any questions or require assistance, please contact the attorneys of Workman Nydegger.