

Understanding Some of the Benefits and Risks of Intent-to-Use
Trademark Applications in the USPTO
by David Dellenbach

INTRODUCTION

The United States Patent and Trademark Office ([USPTO](#)) employs a system that is unique in requiring both: (1) trademark use; and (2) the filing of trademark specimens to obtain a trademark registration. In the USPTO, a trademark applicant must articulate a “basis” for filing a trademark application. Two of the five potential filing bases identified in Section 806 of the Trademark Manual of Examining Procedure (TMEP) include: (1) use of a mark in commerce under §1(a) of the Lanham Act (“use-based application”); and (2) bona fide intention to use a mark in commerce under §1(b) of the Act (“intent-to-use application”).

The second of these filing bases, namely, intent-to-use applications, provides the most flexibility in terms of initial filing, but also presents certain risks and additional fees. Filing a use-based application requires that a mark be in use in commerce prior to filing and that a trademark specimen of use and dates of first use be provided upon the initial filing. By contrast, however, intent-to-use applications do not require prior use, dates of first use, or a trademark specimen at the time of filing.

REQUIREMENTS FOR INTENT-TO-USE APPLICATIONS

The requirements for establishing a filing basis and a filing date with an intent-to-use application are provided in TMEP §806.01(b) and in TMEP §202. These include an application in the English language that contains the following: “(1) The name of the applicant; (2) A name and address for correspondence; (3) A clear drawing of the mark; (4) A listing of the goods or services; and (5) The filing fee for at least one class of goods or services.” TMEP §202 (July 2015). It is useful to note that the phrase “a clear drawing of the mark” can be satisfied simply by indicating the requested mark in standard characters without requiring the characters to be drawn in any particular format, font or style, unless a particular logo or style is an inherent aspect of the applied-for mark.

VERIFIED STATEMENT REQUIRED

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As indicated in TMEP §806.01(b), an intent-to-use application must also include a verified statement that the applicant “has a bona fide intention to use the mark in commerce.” In other words, the applicant really must intend to use the mark “in commerce,” such as by, for example, transporting products bearing the mark from one state to another with the real intent to sell the products in a commercial transaction, or other uses that satisfy the requirement of use “in commerce,” the definition of which should be carefully considered.

USE ULTIMATELY REQUIRED - WITH AN EXTRA FEE

Thus, an intent-to-use trademark application can be initially filed if the applicant has the “intent” to use the mark and does not necessarily require prior use or specimens upon filing. This enables an applicant who decides to use a valuable trademark to file and obtain a filing date before the actual use has started.

However, the apparent simplicity of an intent-to-use trademark application can be misleading. After filing and prior to registration, the applicant must demonstrate that it has actually used the mark in commerce. This allegation of use can be in the form of an amendment to allege use, which occurs during the substantive examination process (i.e., prior to approval for publication of the application), or a statement of use, which is filed after issuance of a notice of allowance. Both an amendment to allege use and a statement of use must be supported by a declaration of use under oath and include dates of use, a specimen evidencing use, and the filing fee for each class. By contrast, if the application had been filed as a use-based application, the applicant would not have been required to pay the additional fee for the statement of use or the amendment to allege use. The avoidance of the work and fees associated with the statement of use or amendment to allege use are reasons to file a use-based application if the mark is in use prior to filing.

SUPPLEMENTAL REGISTER NOT AVAILABLE

Another downside to intent-to-use applications is that they are not entitled to amendment to the Supplemental Register until an allegation of use is filed. The Supplemental Register can

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sometimes be used as a back-up to register marks that have been rejected based on descriptiveness, ornamentality, geographic descriptiveness or other rejections if the filed marks are nevertheless “capable” of distinguishing goods and services and otherwise qualify. However, in order for an intent-to-use application to be amended onto the Supplemental Register, an application originally filed on the Principal Register must first be “converted” to a use-based application by filing an allegation of use. Importantly, upon filing the allegation of use, the effective filing date of the trademark application for purposes of the Supplemental Register changes to the date on which the allegation of use is filed (see TMEP §§815.02, 816.02).

As a result of the change in effective filing date, the applicant may lose its position ahead of a competitor’s filing date. Thus, if a §1(b) applicant files an allegation of use and then amends to the Supplemental Register, in order to obtain registration of a descriptive trademark, for example, the applicant risks receiving an effective filing date that is later than an application filed by a competitor. In other words, it is possible that the intent-to-use applicant starts with an earlier effective filing date, but loses the earlier date upon filing an allegation of use and amending to the Supplemental Register. The loss of the original §1(b) filing date and the amendment to the effective filing date of the allegation of use could potentially be the difference between originally predating a similar trademark application and later postdating the similar trademark application and being rejected based on the similar trademark application.

In U.S. trademark law, there are many procedural advantages (e.g., burdens of proof) associated with having an earlier filing date than a similar trademark application. Thus, there are potentially some disadvantages to filing intent-to-use trademark applications on the Principal Register that might need to be amended to the Supplemental Register, particularly with respect to trademark applications that might be rejected for descriptiveness, ornamentality, etc. and that ultimately might need to be filed on the Supplemental Register.

RESTRICTIONS ON ASSIGNABILITY

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Another consideration with respect to an intent-to-use trademark application includes restrictions on the assignability of intent-to-use applications. Under 15 USC §1060, trademark applications are assignable in connection with the good will of the application. However, an intent-to-use application is not assignable until after an allegation of use has been filed, except to a successor to all of an applicant's business or that part of the business "to which the mark pertains, if that business is ongoing and existing" (see TMEP §501.01(a)). Thus, the trademark practitioner is cautioned when filing assignments with respect to intent-to-use applications and should ensure that any such assignment is in compliance with 15 USC §1060 and TMEP §501.01(a).

SUMMARY

Intent-to-use trademark applications can be an effective tool to enable an applicant to quickly receive a filing date for a trademark application for marks that have not yet been used in commerce. However, the filing of a use-based application may be preferred, even though trademark specimens and use dates are required and may initially require a bit more time to prepare. Although the intent-to-use application enables a practitioner to file without initial trademark use, an allegation of use in the form of a statement of use and/or amendment to allege use will ultimately be due. A potential amendment to the Supplemental Register from an intent-to-use application would require a later effective filing date based on the date of the filing of an allegation of use. A practitioner should also exercise caution with respect to assigning intent-to-use trademark applications, which are only assignable to a successor in a business or that portion of the business to which the mark pertains.

Of the available options for filing [trademark](#) applications in the United States, intent-to-use trademark applications can be the most useful when an applicant for a non-descriptive mark has not yet used the mark in U.S. commerce, but there are additional fees, procedures and potential complications associated with intent-to-use trademark filings that arise after filing that the careful trademark applicant and practitioner should not take for granted.