



INTELLECTUAL PROPERTY DEPARTMENT

ALERT

INTENT TO USE A TRADEMARK MUST BE SUPPORTED BY DOCUMENTARY EVIDENCE

By Christopher Kinkade

Trademark applicants filing intent-to-use applications under Section 1(b) of the Lanham Act must possess documentary evidence of their “bona fide intention” to use the applied-for mark in connection with the claimed goods and services. Failure to do so may result in a successful opposition of the application or cancellation of a resulting registration, as a recent decision by the Trademark Trial and Appeal Board confirmed (*Spirits Int'l B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birliđi*, Opposition No. 91163779, 99 U.S.P.Q.2d 1545 (T.T.A.B. 2011)). In particular, the Board held: “The absence of any documentary evidence on the part of an applicant regarding such intent constitutes objective proof sufficient to establish that the applicant lacks a bona fide intention to use its mark in commerce.” (Slip op. at 9.)

To meet the “bona fide intention” requirement, applicants should have reasonably concrete plans to commercialize all of the claimed goods and services under the mark, and applicants should be taking steps to implement those plans, such as product research and development, market research or development of promotional materials. A mere hope or desire that business will expand at some point in the future to encompass additional goods or services is not sufficient. And when an applicant does have a bona fide intention to use a mark, the applicants should produce documentary evidence of that intention, such as photographing product prototypes,

preserving draft promotional materials and product specifications, saving draft business plans and keeping a record of all meetings, whether internal board meetings or presentations to potential investors. This written record could be key in saving an application or registration.

Trademark owners and applicants should also be careful in selecting the goods and services for listing in an application. It is sometimes very tempting, especially with goods such as clothing, to list a broad array of goods the applicant hopes to sell at some point in the future (or does not want someone else selling under the same mark). But without a bona fide intention to use the mark for those goods, supported by documentary evidence, the entire application or registration could be in jeopardy. It is also important to keep in mind that applicants must continue to have a bona fide intention to use the mark on all listed goods and services throughout prosecution of the application, and upon filing of a statement of use, the applicant must submit a sworn statement that the mark is used with all listed goods and services. There are procedures to divide out goods and services not yet in use so applicants can obtain a registration on the active goods and services and maintain a pending application on the remainder.

If you have questions about this Alert, please contact Christopher Kinkade at 609.844.3023 or ckinkade@foxrothschild.com or any member of Fox Rothschild’s Intellectual Property Department.

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