

U.S. Trademark Trap

Don't Forget To Preserve Evidence Of Your Bona Fide Intention To Use The Mark

Businesses often have misconceptions about trademark issues in the United States. One very common “trap for the unwary” results from the ability to file a trademark application without having to demonstrate that the mark is in use at the time the application is filed. A recent decision from the Trademark Trial and Appeal Board (TTAB) highlights the issue.

Applicants may file an application to register a mark with the U.S. Patent and Trademark Office (USPTO) based on a “bona fide intention” to use the mark, and then submit evidence of use later to obtain a registration. In addition, applicants can file a U.S. application based on a registration in another country or based on an international registration, and obtain a U.S. registration without ever having to demonstrate use. These applications also require the applicant to state that it has a “bona fide intention” to use the mark in commerce in the United States.

Applicants unfamiliar with the U.S. trademark registration process often run into problems when they cannot provide objective documentary evidence of their “bona fide intention” to use the mark. A third party can oppose the application, or can petition to cancel a registration at any time, on the grounds that the applicant did not have the requisite “bona fide intention” to use the mark in the United States. The TTAB does not require a great deal of evidence, but more is required than the applicant’s subjective belief that it intends to use the mark. Courts and the TTAB routinely sustain oppositions and cancel registrations when the applicant can provide little or no objective evidence of a bona fide intent to use the mark at the time the application is filed.

Recently, the TTAB sustained an opposition to an application for exactly this reason. The opposer learned in the discovery process that the applicant had no evidence of its intent to use the mark other than an 11-year-old photo of a prototype T-Shirt. The applicant had no other documents that showed use of, or steps toward using, his mark on any products, or that showed advertising, promotions, media, marketing plans, or business plans. The applicant also had no documents identifying any distributors, resellers or stores through which he intended to offer his clothing goods. Although the applicant had purchased an Internet domain name using the trademark, he had no website to display his products. Based on this lack of evidence, the TTAB found that the applicant could not demonstrate his bona fide intent to use the mark on clothing items at the time of the application, and sustained the opposition.

We strongly recommend that applicants or their counsel collect and retain documentation to support the “bona fide intention” to use the mark contemporaneously with the filing of the application. Documentation to support the “bona fide intention” includes business plans, marketing materials, documents regarding product development, or any other materials corroborating the applicant’s intent to use the mark in the United States for the products or services listed in the application. Collecting these documents during the application process ensures that they will be available later if needed. If few or no documents exist, the applicant and its attorney also have the opportunity to prepare documents contemporaneously that evidence the applicant’s “bona fide intention” to use the mark. Gathering and preserving these documents could be the difference between ending an opposition or cancellation proceeding early with minimal cost, or engaging in a long, protracted and expensive proceeding.

Contact Us for Assistance

Partridge Snow & Hahn LLP assists U.S.-based and non-U.S. based clients to protect trademark rights in the U.S., and assists U.S. based clients to expand and protect trademark rights outside the U.S. For information or to request our assistance, please contact John E. Ottaviani, Chair of our Intellectual Property and Technology Practice, at +1-401-861-8200 or jottaviani@psh.com.

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