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Peter J. Bilinski, Co-Chair  
315.425.2856

[pbilinski@hblaw.com](mailto:pbilinski@hblaw.com)

Mark I. Peroff, Co-Chair  
212.784.5806

[mperoff@hblaw.com](mailto:mperoff@hblaw.com)

Christopher E. Blank

Keith E. Danish

Nicholas J. Gallo

Thomas R. FitzGerald

Joseph M. Geller

Ronald S. Kareken

John Kelepurovski, Jr.

Robert D. Lott

Thomas I. Mandelbaum

Joseph B. Milstein

Alpa V. Patel

Richard J. Paul

Robert E. Purcell

Stephen R. Rosenholm

Darren W. Saunders

Joel Stettenheim

Monika A. Tashman

Thomas J. Wall

Jason Wormer

Duan Wu

Peter J. Mikesell

Patent Agent

Christopher D. Southgate

Patent Agent

## Recent Decision Highlights Pitfalls Of “Intention To Use” Trademark Applications

A recent decision by the United States Trademark Trial and Appeal Board (“TTAB”) highlights the need for strict compliance with the laws relating to trademark applications based on “intention to use” the mark in the United States. An inaccurate or overbroad allegation of such an intention, or one that cannot be supported by evidence, may result in a denial of the application or a loss of the ensuing registration. Foreign trademark applicants are particularly susceptible to this trap, for the reasons discussed below. An inaccurate allegation of an “intention to use” can be just as harmful as an inaccurate allegation regarding actual use of a mark.<sup>1</sup>

A German citizen applied to register “V.I.C.” as a trademark for “vehicles for transportation”, and similar goods. The application was approved by the Examiner, but when published for opposition purposes, Honda Motor Co., Ltd. opposed registration of the mark on the ground that it was likely to cause confusion with Honda's trademark “CIVIC”. After engaging in discovery, Honda moved to amend its complaint to assert that the applicant lacked a bona fide intention to use its mark in commerce<sup>2</sup> at the time he filed his application. Honda also moved for summary judgment and its motion was granted by the TTAB, thereby refusing registration of the applicant's proposed trademark. *Honda Motor Co., Ltd. v. Winkelmann*, \_\_\_\_ USPQ2d \_\_\_\_ (TTAB, 4/8/09).

While it is possible to apply for a federal trademark registration on the basis of current, ongoing use of a mark in commerce, many applications are filed before use has begun, in order to test the registrability of the mark and learn whether it will be opposed by others in the trade before proceeding to invest heavily in the mark. In support of such an application, one must submit a verified allegation of a “bona fide intention . . . to use [the] trademark in commerce . . .” The proof of commencement of use need not be filed until after the application has been allowed. Foreign and domestic applicants can file such “intention to use” (“ITU”) applications, and the foreign applicant can also take advantage of international trademark treaties by applying in the United States on the basis of a national trademark registration in its country of origin (or an “International” trademark registration obtained under the Madrid Protocol).

<sup>1</sup> While the subject of this Client Alert is the “intention to use” trademark application, trademark applicants must also make accurate allegations concerning actual “use in commerce” in connection with trademark applications, renewals and affidavits of use, or risk losing the benefits of their federal registration.

<sup>2</sup> “Commerce” generally means interstate commerce or commerce between the United States and another country.

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In the latter cases, the foreign applicant can obtain a United States trademark registration without having to show any use of the mark in this country.<sup>3</sup> However, its application must still include an allegation of a bona fide intention to use the mark in commerce for the goods set forth in the application, and it was such an allegation by a foreign applicant that came under attack in the *Honda* decision under review and resulted in the loss of the application.

Proof of the applicant's intention to use the mark need not be submitted to the Examiner during the *ex parte* examination process. Whether or not an applicant possessed such an intention is an issue that will arise only in a contested proceeding such as an opposition or cancellation action, or a court action involving the alleged rights in the mark. If the applicant is called upon to substantiate his allegations of a bona fide intention to use his trademark in commerce, the proofs must be "objective", evidenced by facts, and not merely by his "subjective" testimony that he intended to use the mark at the time he applied for registration. In fact, an applicant who cannot produce any documentary evidence of his intention to use a mark, *e.g.*, a written business plan, is presumed to lack a bona fide intention to use the mark and bears the burden of coming forward with an explanation as to why no such documents exist and with other evidence of his intention to use. The fact that an applicant may have registered his trademark in other countries also does not tend to prove an intention to use the mark in United States commerce.

The decision in *Honda* makes it clear that a foreign trademark applicant's allegation of a bona fide intention to use its mark in United States commerce must be as truthful and defensible as one made by a United States applicant, even if the foreigner relies on a home-country trademark registration in lieu of proving any actual use of the mark in this country. Unfortunately, foreign applicants are predisposed to claim a wide range of goods, or even "all goods in the class", which is permissible under trademark registration practices in many countries, so they should be especially careful to narrowly tailor their allegations of intended use in United States applications to be objectively and demonstrably accurate. All ITU applicants should be prepared to produce a written business plan or some other tangible evidence of their intention to use the mark in this country, or they will risk losing the substantial advantages that come with federal trademark registrations. ■

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<sup>3</sup> If the mark is not put into use in the United States within three years after registration, the registration becomes vulnerable to attack by an interested party on the ground of *prima facie* abandonment.

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