

On My Mind Blog

How to Establish a Bona Fide Intent to Use for a Trademark Application

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September 26, 2019

You normally should take affirmative steps to satisfy the requirements for filing an intent to use trademark application.



Background

Before 1988, the U.S. Trademark Law (known as the Lanham Act) required an applicant to have begun to use a mark in commerce before applying to register it. This use requirement was loosely interpreted to permit owners to obtain rights by making “token use” of their marks.

In 1988, the Law was changed to permit an application to be filed before use if, at the time the applicant applies for registration, the applicant has a good faith “bona fide intention” to use the mark in commerce. At the same time, the definition of “use” was tightened up to mean “the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.” So “token use” was OUT and either actual commercial use of the mark, or a bona fide intention to use the mark, in commerce was IN as a basis for filing an application.

Unless the application is based on a foreign registration, a U.S. trademark registration still will be issued only after the applicant has begun to make actual use of the mark in commerce as currently defined.

Evidence

How do you establish your bona fide intention to use a mark?

The evidence of intent is not the applicant's subjective state of mind. Rather, there must be a firm intention to use the mark in a commercial sense, not just a hope of possible future use, and there must be objective evidence of facts and actions that show this intent.

An opposer may challenge an applicant's bona fide intent if the applicant has no documentary evidence before filing its application to support its intent allegation. The burden of production of evidence then shifts to the applicant to provide credible documentary evidence or testimony that adequately explains or outweighs the failure to provide such pre-filing documentary evidence.

A Case in Point

Jonny D. Gabriel and his wife Rosalie ("Applicants") filed an intent-to-use application to register MEZQUILA for "alcoholic beverages except beers." This application was cited against a later intent-to-use application filed by Los Santos, LLC to register SANTO MEZQUILA for the same goods. Los Santos opposed in the Trademark Trial and Appeal Board, claiming that the Applicants did not have a bona fide intention to use their mark in commerce at the time they filed their application.



The TTAB ruled in favor of Los Santos based on the following:

- The Applicants had no documentary evidence as of the application's filing date, which was inadequately explained by arguing that the 82-year-old Mr. Gabriel does business "the old fashioned way," primarily over the phone or in person.
- The earliest documents were created over a year later and only after the opposition proceeding had commenced.
- Gabriel testified that he wanted to have the mark "in case I wanted to bring in my own Tequila."
- The Applicants had filed an earlier application to register the same mark, but they had abandoned it for failure to file a statement of use. This suggested that they had the idea for many years but had not pursued it.
- After the current application was filed, the Applicants had meetings with distilleries in which inquiries about creating a MEZQUILA product were raised but immediately dropped.
- Two years later, the Applicant's did arrange for one shipment of MEZQUILA branded tequila to be imported into the United States, but they received no royalties or other compensation for those sales and the Mexican distiller stopped production because it was not profitable for any of the parties.

Accordingly, the TTAB concluded that the Applicants' intention at the time they filed their application was merely to reserve a right in the MEZQUILA mark. The opposition was sustained and the application blocking Opposer's application was refused registration. ***Los Santos, LLC v. Jonny D. Gabriel and Rosalie Gabriel***, Opposition No. 91223574 (T.T.A.B. June 10, 2019).

Takeaway

At the time you file a U.S. trademark or service mark intent-to-use application, you preferably should have at least some documents on hand that establish your bona fide intention to use the mark in commerce. In some situations, documents may postdate the application's filing date if they show a continuing effort to have the product or service created and brought to market.

Such documents can take various forms, including:

- a file memorandum stating the concrete steps proposed to be taken, or that have been taken;
- emails or other written communications that name the mark and are to prospective suppliers, distributors and retailers; and
- notes of meetings or phone conversations discussing the current plans for the product or service for which the mark is to be adopted, and the current status of those plans.

Author's Note: When a non-U.S. applicant designates the U.S. under its Madrid Protocol International Registration, that applicant must state, as part of its designation, that it has a bona fide intention to use the mark in commerce (meaning either within the U.S. or between another country and the U.S.). If the International Registration, and the corresponding U.S. application, covers a large range of goods or services, this bona fide intention may be especially subject to challenge. It would be desirable for this applicant to have the same evidence as any other U.S. applicant of its intention to use its mark in commerce.