

Registering a Trademark That You Have Not Yet Used

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Introduction When you are developing a new product or service, you can apply for federal registration of a trademark even before you begin selling it. If you can show a bona fide intent to use the mark in commerce, you can file an Intent To Use (ITU) application. Because some applicants have overreached and tried to claim many products or services on which they may never use the mark, the U.S. Patent and Trademark Office (USPTO) has become increasingly strict as to the requirements for showing a “bona fide intent to use” the mark. This article offers guidance as to: (i) the types of documents required by the Trademark Trial and Appeal Board (TTAB) of the USPTO to demonstrate bona fide intent to use; and (ii) steps applicants can take to avoid running afoul of the requirement.

Background To understand the significance of the required bona fide intent to use the mark in commerce, you must understand a little about the process of registering a trademark. After a person files a trademark application with the USPTO, it will be examined, and the applicant and the USPTO trademark examining attorney must come to an agreement that the application is complete and approved for registration. Then the application is published, and any persons who believe they may be harmed by the registration have 30 days to respond to the USPTO. The response could involve filing an opposition proceeding to prevent registration. A claim that the applicant lacked a bona fide intent to use the mark on *all* of the goods or services at the time of filing might be one basis for an opposition. The opposition proceeding will be conducted before the TTAB. **Documentary Evidence of Bona Fide Intent To Use** If the applicant’s intent is challenged, the TTAB’s rules place the burden on the applicant to prove bona fide intent to use the mark on all the goods or services listed at the time of filing. For proof, this objective test requires actual, documentary evidence in existence not later than the date of filing the application. Under the TTAB’s standards, absence of such documentary evidence is objective proof sufficient to establish that the applicant lacked a bona fide intent to use the mark, and summary judgment may be entered against the application. The TTAB has given some guidance as to the sorts of documents that indicate a bona fide intent to use the mark. They include:

- A trademark availability search and report

- A product or service development plan
- A marketing plan to promote the brand
- Agreements with product developers or manufacturers
- Agreements with licensees and distributors, preferably identifying the mark

Steps to Take Before Filing To help ensure your ability to demonstrate a bona fide intent to use, take the following steps:

- Do not file an ITU application simply to reserve a mark. However, an ITU application may be properly filed if you honestly intend to use the mark on all listed products or services, and can show it.
- Be careful about including too many products or services in an ITU application.
- If you plan to plan to file an ITU application, be sure to obtain, and save, the following, or at least as many of them as possible: a product development plan, a marketing plan to promote the brand

If all these steps are taken, there is little likelihood of difficulty in proving your bona fide intent to use the mark. When you actually start using the mark on your goods or services, you can complete its registration.

Related Practices

[Intellectual Property](#)

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