

## **BONA FIDE INTENT TO USE THE APPLIED-FOR MARK BECOMES INCREASINGLY IMPORTANT FOR U.S. TRADEMARK APPLICANTS**

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In a precedential decision in *Honda Motor Co., Ltd. v. Friedrich Winkelmann*, 90 USPQ2d 1660 (TTAB 2009), the U.S. Patent and Trademark Office Trademark Trial and Appeal (TTAB) Board sustained an opposition to register the mark V.I.C. for vehicles which was based upon a German registration. The Board granted Honda's summary judgment motion sustaining the opposition because it found that the German applicant did not have sufficient evidence of a *bona fide* intent to use its mark in the U.S. even though the applicant presented evidence of use and advertising of the mark in Europe. While the U.S. has been permitting trademark and service mark applications for marks not yet used in U.S. Commerce since 1989, U.S. trademark rules require that such applicants, whether from the U.S. or a foreign country, declare under oath that they have a *bona fide* intent to use that mark in U.S. Commerce.

Subsequent U.S. case law has defined "a *bona fide* intent" as including "documentary evidence" of efforts to make use of the mark. This requirement can be more difficult than it seems when applied to intent-to-use applications, especially from non-U.S. applicants, because of the strictly interpreted and narrowly defined meaning of "use of a mark" and "U.S. Commerce." Note the following statement of the TTAB:

While the evidence necessary to support a *bona fide* intent to use may differ depending on the circumstances of each case, the evidence that applicant relies upon through its foreign registrations and Internet printouts does not demonstrate trademark use for the claimed goods. Further, these documents do not show that applicant has an intent to use the mark in the United States. The website printouts are not translated, but judging from the graphics, the mark seems to be used to identify car care packages or promotional material, not the vehicles themselves; and there is no evidence of a *bona fide* intent to use the mark in the United States as to the goods listed in the application. Any intention to use the mark may go to promotional services for dealerships, but not to "vehicles for transportation." Finally, because the arguments of counsel are not supported by any evidence of record related to applicant's *bona fide* intent, they are insufficient to raise a genuine issue of material fact. See, e.g., *Hornblower & Weeks Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1736 (TTAB 2001).

*Honda* seems significant for potentially establishing another TTAB procedural trap like the fraud doctrine that could cause trademark applicants to lose their ability to register their mark in the U.S. This may affect applicants from outside the U.S. the most, because often their home country does not require use of their mark to register and their U.S. mark usage may not be expected for some time.