

## **HONEST INTENTION to Use Trademarks in U.S. Commerce IS REQUIRED!**

### **A U.S. Trademark Application Is Subject to Attack When a Bona Fide Intention to Use Does Not Exist at the Time of Filing**

The Trademark Trial and Appeal Board (TTAB) has just handed down a decision that affects every trademark application and registration that is based upon foreign registration rights (Section 44) rather than upon use of the mark in US commerce. These include applications and registrations that are “national” US applications based upon foreign applications/registrations as well as Madrid Protocol extensions to the US.

Unless a US application at the outset is filed with a claim that the mark has been used in US commerce on every good and service recited in the application (a Sec. 1(a) “use” application), the US Trademark Act requires the applicant to state that it has a *bona fide* intent to use the mark in connection with those goods and services (a Sec. 1(b) the “intent-to-use” application). This intent-to-use statement is also required in national applications that rely on foreign application priority, Sec. 44(d), on foreign registrations, Sec. 44(e), and on treaty-based filings invoking the Madrid Protocol, Sec. 66(a).

The decision in *Honda Motor Co., Ltd. v. Friedrich Winkelmann*, an opposition that specifically addressed a foreign applicant’s intent to use a mark in the US, even though the underlying trademark application actually relied on foreign trademark rights as the filing basis. The April 8, 2009 decision fundamentally challenges the validity of all applications and registrations based upon foreign applications and registrations.

In order to defend against a charge of a false intent to use, the applicant will need to provide objective evidence (such as a business plan or strategy documents) to prove the requisite credible intent. Without objective evidence to support the asserted intention to use the mark in US commerce, the application/registration may be invalidated.

- Even before the *Honda v. Winkelmann* decision was handed down, Lackebach Siegel cautioned its clients that they need to be very careful about the products and activities that are recited in new applications. If an applicant is unable to prove that it has a genuine intention, as of the date of filing an application, to manufacture and/or sell the goods or perform the services listed in the application, then the validity of the application could be attacked in an opposition or cancellation action.
- Because foreign registrations often cover a wide variety of goods and/or services that may be far broader than what an applicant is really likely to use/sell, the *Honda* decision is a serious warning against “over-reaching” in an identification of goods/services in a US application.
- *Honda* is a very important decision from an offensive strategy standpoint as well, as it can be used to attack third party applications or registrations based on foreign application/registration rights.

## **Honda v. Winkelmann**

Honda opposed Mr. F. Winkelmann’s US application for “**V.I.C.**” covering “vehicles for transportation” that was based upon a Sec. 44(e) home-country German registration. Honda contended that Winkelmann’s application should be refused because Winkelmann’s responses to discovery interrogatories established that he had no *bona fide* intent to use his mark in connection with the claimed goods at the time the application was filed. He admitted that he “has not had activities in the U.S. and has not made or employed a business plan, strategy, arrangements or methods there,” and “has not identified channels of trade that will be used in the United States.”

**Such statements and the failure to produce evidence of manufacturing of the goods recited in the application anywhere in the world enabled the TTAB to conclude that Winkelmann had no *bona fide* intent to use the mark in the US at the time the application was filed.**

The critical fact is that there was no documentation - no proof of intent to use - as of the date the application was filed. Applicant’s inability to substantiate genuine intent is the takeaway lesson for existing registrants, current applicants, and future applicants who plan on relying on foreign registration rights or the Madrid Protocol, as ground for being granted a US trademark registration. The danger comes at the opposition phase or after a registration is granted but is attacked as invalid in a cancellation proceeding. The absence of materials to establish a *bona fide* intent to use a mark on the date a Sec. 44(d), Sec. 44(e) or Madrid Protocol application is filed could be exploited in an opposition or cancellation action.

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