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## Best Practices To Prove a Bona Fide Intent to Use a Mark In Commerce

Section 1(b) of the Trademark Law Revision Act of 1988 allows an applicant to file a trademark application based on an intent-to-use the mark in commerce. Assuming the application meets all other requirements of registration and proof of use of the mark in commerce is properly submitted, registration can be achieved. The applicant's priority rights would then be established back to the filing date of the application.

A U.S. trademark application filed on an intent-to-use basis must include a statement that the applicant has a "bona fide intention" to use the mark in commerce. Likewise, if a trademark applicant relies on a foreign registration under Section 44(e) of the Lanham Act as a basis for U.S. registration, it must declare a bona fide intention to use the mark in commerce. A request for extension of protection of an international registration to the U.S. under Section 66 of the Lanham Act is also subject to the bona fide intent to use requirement.

If an applicant has filed an intent-to-use trademark application under Section 1(b) (or under Sections 44(e) or 66), it's important to put itself in a position to be able to prove its bona fide intent to use the trademark in commerce as of the date the trademark application was filed.

The applicant's bona fide intent to use the trademark should be documented as much reasonably possible. For example, a system should be created to organize and store proof of any of the following:

1. trademark searches conducted;
2. logo design work;
3. proposed and preliminary marketing plans and test-marketing efforts;
4. steps to develop packaging;
5. product or service research or development;
6. steps to obtain required governmental approval;
7. steps to secure suppliers and/or acquire distributors;
8. business plans connected to the mark;
9. any executive feedback;
10. any related domain name registrations;

11. consumer surveys;
12. correspondence with third party vendors;
13. visits with realtors to view potential sites on which to offer the applied-for goods or services;
14. quotes for necessary equipment to deliver the applied-for goods and services;
15. web site development;
16. collaborators or potential investors;
17. any correspondence relating to the proposed goods or services;
18. any actual current uses of the mark; and/or
19. a list of any company personnel involved in the steps taken to effectuate use of the trademark in commerce.

If you have any questions about this advisory and how it may affect your business, please contact Darren M. Geliebter at [dgeliebter@lgtrademark.com](mailto:dgeliebter@lgtrademark.com) or G. Mathew Lombard at [mlombard@lgtrademark.com](mailto:mlombard@lgtrademark.com). By phone, we can be reached at (212) 551-1755.