

NIESAR & VESTAL LLP

Law Alert

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Failure to Document Evidence of Intent to Use a Trademark May be Fatal to Application

In a recent Trademark Trial and Appeal Board (the “TTAB”) precedential decision, *El Roblar Investment Property LLC v. Bianca Roe*, 2025 USPQ2d 1210 (TTAB 2025), the TTAB sustained an opposition on the ground that the applicant did not have a bona fide intent to use the mark at the time of filing her application.

Significance

Suppose you came up with a name you would like to use in connection with a product or service and would like to reserve it for future use. You might think that by simply filing a so called “intent-to-use” application you have reserved the name for your future use. However, the *El Roblar* decision demonstrates that this is not the case.

Background

An applicant may file a trademark application with the USPTO under what is called an “intent-to-use” basis when such applicant has not yet actually used the mark in commerce but intends to use it in the future. To file on an “intent-to-use” basis, the applicant is required to have a *bona fide intent* to use the mark in commerce, meaning that the applicant possesses more than a mere idea, but is not quite yet ready to market the good or service in commerce.

TTAB’s Decision

In the *El Roblar* case, the applicant had not produced evidence supporting her position that she had a bona fide intent to use the mark at the time of filing. The TTAB emphasized that while the evidentiary standard is not high, applicants must show more than subjective belief. Intent must be demonstrated through objective evidence—real actions and concrete facts, not merely the applicant’s uncorroborated testimony about their state of mind. Simply testifying “I intended to use the mark” is insufficient.

What Should I Do?

Given the TTAB’s decision, an applicant who files an intent-to-use application should take affirmative steps to document its actual intent to use the mark in the future. While the TTAB did not specify exactly what evidence is required, we believe that a *combination* of some of the following should be sufficient:

- (a) Trademark search report on the proposed mark;
- (b) Registration of domain names and creation of a website;
- (c) Business plans for the product or services to be marketed using the mark;
- (d) Patent applications, should this apply, or at least evidence that the applicant considered patentability, including consulting an attorney;
- (e) Copyright applications for any artistic or literary works associated with the proposed product or service;
- (f) Applications for governmental approvals (e.g., TTB approval for wine labels);
- (g) Internal communications about the product or service launch (emails, memos, correspondence);
- (h) Product development materials referencing the mark (renderings, descriptions, pricing);
- (i) Marketing and advertising planning documents;
- (j) Evidence of manufacturing or service capacity, including outreach to third-party manufacturers if you don't produce the goods yourself.

We recommend preserving all documents relating to steps taken shortly after filing an intent to use application as this *may* support a finding that you had a bona fide intent to use your mark at the time of filing.

The sufficiency of evidence will vary case-by-case. However, the TTAB's decision makes clear that securing trademark rights requires more than simply filing an application—applicants must actively document their preparation for actual use in commerce.

Note as to filings by foreign applicants under the Madrid Protocol: The Trademark Act Sections 60(5) and 66(a) require applicants to verify that they have a bona fide intent to use the mark in U.S. commerce as of the application filing date. 15 U.S.C. §§ 1141(5), 1141f(a). Therefore, lack of bona fide intent is a proper statutory ground on which to challenge a request for extension under Section 1141f.

If you have any questions relating to this law alert or other trademark or copyright issues, please contact Jay Begler (jbegler@nvlawllp.com) or Carolina Aricu (caricu@nvlawllp.com).

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