



Trademark applications filed by foreign entities may be void if applicant cannot document its intent to use

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Everyone filing a trademark application with the U.S. Patent and Trademark Office must affirm, under oath and penalty of perjury, that the mark is either in use in commerce or that the applicant has a bona fide (good faith) intent to use. Because of certain treaties to which the United States is a party, such as the Paris Convention and the Madrid Protocol, applicants from other countries may be able to obtain a registration from the USPTO without having to actually demonstrate that the mark is in use. However, a recent decision from the Trademark Trial and Appeal Board has confirmed that, while a trademark registration may issue for such applications without proof of use, a lack of objective proof of intent to use may nonetheless void the application, even if the applicant subjectively intends to use the mark.

In *Honda Motor Co., Ltd. v. Friedrich Winkelmann*, the Trademark Trial and Appeal Board held that a trademark application under Section 44 of the U.S. Trademark Act (which implements the Paris Convention) was void because the applicant, when challenged in an opposition, could not document or otherwise prove it had a *bona fide* intent to use the mark in U.S. commerce at the time it filed the application. In discovery, the opposer asked the applicant to produce documentary evidence of its intent to use the mark in the U.S. market, such as a business plan, contacts with potential customers or distributors, or the like. When the applicant could not produce such evidence, the opposer moved for and was granted summary judgment, even though the applicant submitted declarations in its defense attesting to its intent to use the mark in U.S. commerce.

The *Honda* decision continues a pattern of trademark case law holding that a *bona fide* intent to use must be demonstrated and supported by objective evidence. This rule presents a number of practical concerns for clients outside the United States. Applicants contemplating a global filing program for a new mark need to have pre-filing documentation of its business plans for the U.S. market in the event of a challenge. Applicants seeking to extend an International Registration to the United States under the Madrid Protocol need to be particularly mindful of this need, as such applicants will typically not consult U.S. counsel until they receive an Office Action, by which time it will be too late.

[*Honda Motor Co., Ltd. v. Friedrich Winkelmann*](#), Opp. No. 91170552 (TTAB April 8, 2009).

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