

How Much “Intent” is Enough to Support an “Intent to Use” Trademark Application?

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For many years now, the **US Trademark Office** has accepted trademark applications based upon a “bona fide intent to use” the applied-for mark on all the goods and/or to provide all of the services listed in the application at the time of filing. Unlike in many other countries, a US application based on “intent to use” will not mature to registration until proof of use of the mark on all the goods and to provide all the services in the application has been filed with and accepted by the Trademark Office. The legislative history behind these statutory requirements makes clear that **Congress** wanted to prevent the warehousing of marks that no one had any real plans to use.

When an application is filed, the applicant must have an authorized representative sign, under penalty of criminal perjury, a declaration attesting to the fact that it has a “bona fide” intent to use the mark. The Trademark Office does not require proof of this intent at any point during the prosecution of the application. However, an application can be opposed by a third party with standing to do so on grounds that there was no “bona fide” intent to use the mark at the time the application was filed, rendering the application void. This is precisely what PRL USA Holdings, owner of the RALPH LAUREN POLO marks, did successfully in opposing two applications owned by Rich C. Young to register marks which PRL believed were confusingly similar to marks the company owned.

In these [non-precedential opinions](#), the **Trademark Trial and Appeal Board** made clear that the “bona fide intent” required under the Trademark Act “must reflect an intention that is firm, though it may be contingent on the outcome of an event (that is, market research or product testing).” Citing to prior case law, Section 45 of the Trademark Act, and the Senate Judiciary Committee Report for the relevant statutory provisions, the Board stated that there must be an intention to use the mark “in the ordinary course of trade” and not “merely to reserve a right in the mark.” Such an objective determination to be is made based upon all of the circumstances of each individual case.

The Board stated that one way of proving a lack of a bona fide intent is to demonstrate that an applicant has no documentary evidence, such as business plans, marketing or promotional activities, or evidence of discussions with manufacturers or licensees, to substantiate its allegations of intent. Applicant Young’s responded to PRL’s discovery requests for evidence of activities involving the mark, that he was “in an intention to use status,” “did not have any business planning yet,” and “did not have business activities yet.” In noting that it had “repeatedly found a lack of bona fide intent to use a mark by individuals who lack the demonstrated capacity to produce the goods identified in the

application,” the Board held that the evidence in the cases demonstrated that Applicant only intended to “reserve a right in the mark” in case it was later approved for registration by the Trademark Office and that Applicant Young would only “at some unspecified future time begin developing a business.” Thus, PRL’s oppositions were sustained and both applications were refused registration.

So what is the take away here? First, coming up with a clever mark for a product or service that does not yet exist in any form other than in the imagination of an individual is not a proper candidate for an intent to use application. Thus, all applicants and their attorneys should ensure that there has been some demonstrated business efforts involving a mark before filing an application. For those applicants who might intend to use the mark only through a licensee, there should be some evidence to support this claim. Although the lack of intent will only surface if an application is challenged by a third party, the opposer need not have grounds to allege a lack of bona fide intent at the time the opposition is filed if it can, as PRL did, amend its application after discovery has uncovered no evidence to support claimed intent. Moreover, applications filed under Section 44 based upon a foreign registration are not immune from these requirements since all such applicants must also allege and declare under penalty of criminal perjury a bona fide intent to use the applied-for mark in US commerce despite the fact that proof of use need not be filed in order for the registration to issue.

Accordingly, although dreams can come true, be sure that clever ideas for a mark are backed up by evidence of plans to use the mark before filing an application.

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