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Intent-to-Use Applications: Establishing Trademark Rights Prior to Trademark Use

A trademark or service mark may include any word, name, or symbol used to identify a provider of goods or services as the source of the goods or services. A trademark owner may prevent others from using the trademark if the owner establishes priority rights in the use of the trademark. A trademark owner may establish priority rights if the trademark owner sells a good marked with the trademark prior to another's similar use of the trademark. Simply put, trademark rights align with use of the trademark.

A trademark owner may establish priority use rights in a trademark prior to actual use of the trademark. A trademark owner may file an application to register a trademark with the United States Patent and Trademark Office (USPTO) as an In-Use application or an Intent-to-Use application. An In-Use application requires a showing of use of the applied-for trademark in commerce. In contrast, the Intent-to-Use application allows a trademark owner to stake a claim in a trademark associated with a product or service parallel to developing the product or service. Similar to the In-Use trademark application, the Intent-to-Use application is examined, and, if successful, the application is published for opposition.

If the Intent-to-Use application survives the opposition period, the USPTO issues a Notice of Allowance to the Intent-to-Use applicant. The Notice of Allowance gives the applicant time to file a Statement of Use, a component unique to the Intent-to-Use application that requires the applicant to show use of the applied-for trademark in commerce. The applicant files the Statement of Use within six months of the Notice of Allowance issue date, or within three years of the Notice of Allowance issue date with payment of fees to avoid abandonment of the trademark application. An Intent-to-Use applicant does not show use of the trademark in commerce when filing the trademark application. Rather, the Intent-to-Use applicant shows use of the trademark in commerce when filing the Statement of Use.

The benefit of the Intent-to-Use application is realized at registration. The trademark owner may assert prior use rights in the registered trademark as of the filing date of the Intent-to-Use application. Accordingly, the trademark owner is not limited to the actual first date of use to assert prior use right in the registered trademark.



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Applicants must be aware of distinct aspects of the Intent-to-Use application to avoid unnecessary cancellation of a registered trademark. At the core of an Intent-to-Use application is a bona fide intent to use the trademark in commerce. The bona fide intent to use must exist at the time of filing the Intent-to-Use application. Filing an Intent-to-Use application to merely reserve a right in a trademark is unacceptable. As with an In-Use application, during the time that the Intent-to-Use application is published for opposition, an Opposer may oppose registration of the Intent-to-Use trademark. With respect to an Intent-to-Use application, an Opposer may challenge the applicant's bona fide intent to use the trademark in commerce. For instance, an Opposer may argue that the applicant never had the capacity to provide any of the classes of services identified in the Intent-to-Use application. Additionally, an Opposer may argue that the applicant filed an excessive number of Intent-to-Use applications in relation to the number of products associated with the applied-for trademark. If the Opposer's arguments are persuasive, the USPTO Trademark Trial and Appeal Board (TTAB) may abandon registration of a trademark if the TTAB finds the applicant did not have the bona fide intent to use the trademark in commerce at the time of filing the Intent-to-Use application.¹

Another distinctive aspect of Intent-to-Use applications concerns transferring trademark rights. Trademark rights are similar to other property rights in that they may be transferred or assigned to another person or entity. Section 10 of The Lanham Act (15 U.S.C. §1060(a)(1)) provides that a trademark for which an In-Use application to register has been filed shall be assignable. However, Section 10 further provides that a trademark for which an Intent-to-Use application to register has been filed shall not be assignable prior to the filing of a Statement of Use. Indeed, the TTAB may cancel registration of a trademark if the TTAB finds that the rights in the trademark were transferred after the USPTO issued a Notice of Allowance, but prior to the applicant filing a Statement of Use.²

As described above, an Intent-to-Use application is a great tool for establishing trademark rights when an applicant intends to use the trademark in the not-too-distant future. Hutchison Law, LLC has experience preparing and filing Intent-to-Use

¹ See *Lincoln National Corp. v. Kent. G. Anderson*, No. 91192939 (T.T.A.B. February 21, 2014).

² See *Emerald Cities Collaborative, Inc. v. Sheri Jean Roese* 2016-1703 (Fed. Cir. December 13, 2016); *Emerald Cities Collaborative, Inc. v. Roese*, No. 91197060 (T.T.A.B. December 4, 2015).



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applications. To learn more about how we draft Intent-to-Use applications to support your marketing plans, please contact us at 410-978-7287.

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