



Trademark Applicant's Failure to Submit Written Proof of Intent to Use May Be Fatal

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Brand owners in the United States need to focus on having adequate written proof of a "good faith intent to use" a trademark when filing an Intent-to-Use (ITU) trademark application before commercial use of a trademark begins. Under certain circumstances, failure to submit such written evidence can be fatal to the validity of an ITU trademark application in contested proceedings for opposing registration or cancelling a registration after being granted.


In a recent case, the Trademark Trial and Appeal Board of the United States Patent and Trademark Office sustained an opposition to registration of a mark in an ITU application for failure of the applicant to submit documentary evidence as proof of its intended use of its mark in commerce by the applicant or any authorized licensee, admitted that it had no such documentary evidence and failed to come forward with any evidence that would adequately explain or outweigh its failure to submit such documentary evidence. *Spirits International, B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birligi*, Opposition No. 91163779, 99 USPQ 2d 1545 (TTAB 2011) (precedential).

Lessons Learned

Brand owners and their attorneys may learn some lessons from this case:

- This case is a "wake up call" for filing ITU applications (although the Board's holding may be limited to the facts of the case, as the applicant failed to submit any evidence of intent to use the mark at the time of filing or a current intent to use the mark on any goods in any of the identified classes).
- In a contested proceeding, the applicant should submit some written evidence sufficient to establish a bona fide intent to use a mark or at least explain why there is no written evidence.
- At a minimum, if there is no such written evidence in existence, brand owners would be wise to create an affidavit summarizing all the concrete steps taken before filing or up to the time of the proceeding to prepare for use of the mark and launch of the product or service; for example, summaries of marketing meetings regarding the new product or service, arranging for any permits or licenses for the product or service, or creation of prototypes or marketing plans.
- The brand owner and its attorneys would be wise to keep all written documentation evidencing bona fide intent to use in the file because finding it later may be more difficult.
- Courts in trademark infringement actions may adopt the line of reasoning of the evolving law of the Board.

Facts of the Recent Case

In the recent case, the Board sustained an opposition to registration of the mark  for vodka for failure to prove its intent to use its mark in commerce, and declined to address the likelihood of confusion claims. The applicant, S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birligi, filed its intent to use (ITU) application



to register the mark *Mostovisi* for goods and services in nine classes, including alcoholic beverages. The opposer, Spirits International, B.V., filed an opposition in regard to alcoholic beverages based upon both likelihood of confusion with its prior pending ITU application for the mark MOSKOVSKEYA for Vodka, and on the applicant's alleged lack of bona fide intent to use the mark.



Opposer



Applicant

In its answer, the applicant denied all the material allegations in the Notice of Opposition including the lack of bona fide intent to use the mark. In the trial testimony period, the applicant failed to submit a brief or any written evidence of its bona fide intent to use the mark for vodka or any alcoholic beverages and had admitted in response to discovery requests that no such documents existed.

In answers to interrogatories, the applicant stated that only olive oil was being currently sold under the mark in the United States. The applicant did not address that part of the interrogatory asking what type of alcoholic products it intends to sell under the mark, or the channels of trade for those products. The applicant also admitted that it had not obtained an Importer's Basic Permit from the U.S. Alcohol and Tobacco Trade Bureau to import any alcoholic beverage into the United States; nor had it applied to register or registered with the U.S. Food and Drug Administration as an importer of any alcoholic beverage; nor had it applied for or obtained a license or permit from any state in the United States to sell any alcoholic beverage

The Board's Ruling

The Board held that the opposer has the initial burden of demonstrating by a preponderance of the evidence that the applicant lacked on the filing date of the application, or currently lacks, a bona fide intent to use the mark on the identified goods. The absence of any documentary evidence on the part of an applicant regarding such intent constitutes objective proof sufficient to establish that the applicant lacks a bona fide intention to use its mark in commerce.

In the testimony period, the opposer asserted that the applicant failed to produce during the discovery phase any evidence that might support the applicant's allegation of a bona fide intention to the mark. Namely, the applicant failed to produce any such evidence in response either to opposer's requests for production of documents or the opposer's interrogatories or admission requests seeking such information.

The Board held that the opposer's submission of these responses is sufficient for the opposer to satisfy its initial burden of proving that the applicant did not and does not have an intention to use its applied-for mark on or in connection with alcoholic beverages. The Board observed that the applicant "had submitted no evidence whatsoever..."

The Board held that the burden thus shifts to the applicant to come forward with evidence which would adequately explain or outweigh the failure to provide such documentary evidence. Therefore, the Board held that the applicant "has failed to rebut the opposer's evidence..."

Accordingly, the Board sustained the opposition on the ground that the applicant lacked a bona fide intent to use the mark on all of the goods identified in the opposed classes of its application.

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