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URGENT NOTIFICATION TO CLIENTS & ASSOCIATES

Practical Tip to non-US Applicants

When applying for a US trademark registration with an Intent-to-Use basis, and claiming priority to a non-US registration, the applicant should have, and be prepared to provide and document, strategies and plans for using of the mark in the United States.

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Clark A. D. Wilson is a USA intellectual property attorney whose practice involves registration and prosecution, commercial transactions, opinions and litigation regarding patent, trademark and copyright law. Mr. Wilson frequently works with non-US attorneys to protect the IP rights of clients in the USA and throughout the world.

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Nigam Acharya is an experienced intellectual property lawyer representing corporations and individuals in intellectual property matters. His practice includes assisting technology and brand owners in protecting their intellectual property and aiding venture capital sources in due diligence matters related to intellectual property. He also assists law firms outside of the US in protecting their client's intellectual property in the US.

In *Honda Motor Co., Ltd. V. Friedrich Winkelmann*, Opposition No. 91170552 (T.T.A.B., April 8, 2009), the Trademark Trial and Appeal Board (“T.T.A.B.”) of the United States Patent and Trademark Office provided a precedential opinion further defining the bona fide intention requirement for intent to use trademark applications. This decision will be of interest to anyone filing a trademark application in the United States using a prior foreign trademark application as a basis.

Briefly, United States trademark law requires an applicant applying for a registration under Section 44(e) of the Lanham Act and claiming priority based on its non-U.S. registration, to verify that he has a bona fide intent to use the mark in U.S. commerce. Bona fide intent is determined using the same objective, good-faith analysis used in determining whether an applicant has the bona fide intent to use the mark in U.S. commerce.

In this case, Mr. Winkelmann filed a United States trademark application claiming priority on the application for his mark V.I.C. registered and used in Europe. The application was the mark V.I.C. for vehicles in Class 12. After the application was published for opposition, Honda Motor Co., Ltd. (“Honda”) then opposed the application initially alleging a likelihood of confusion between its mark CIVIC for vehicles and the mark V.I.C.

In discovery requests related to Mr. Winkelmann’s intent to use its mark in the US, Mr. Winkelmann stated he had not prepared any business plan or strategy to use the mark in the U.S. and he had not identified any trade channels in the United States. While Mr. Winkelmann did respond affirmatively to his intent to use the mark, he provided no explanation or substantiation of his intent. The only evidence offered was untranslated printouts from Applicant’s website, Applicant’s German, European and WIPO trademark registrations, official correspondence with the USPTO, and statements from counsel.

On summary judgment and after Honda amended the complaint to add a count of fraud, the TTAB concluded that the evidence failed to show that Mr. Winkelmann had the requisite bona fide intent to use the mark in the U.S. The TTAB noted that the same objective good standard applies to all parties filing intent to use application. After determining that the evidence failed to support a bona fide intent to use the mark, the TTAB sustained the opposition sustained the opposition.