

## Demonstrating Use in Commerce for Trademark Registration and Enforcement

Navigating Use in Commerce Requirements Under the Lanham Act and for Purposes of Registration

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TUESDAY, APRIL 12, 2022

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# Demonstrating Use in Commerce for Trademark Registration and Enforcement

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April 12, 2022

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& Plimpton**

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# Agenda

- Legal Framework
- Merely advertising or lawful use in commerce?
- What constitutes sufficient use for goods?
- What is a proper specimen for goods?
- What constitutes sufficient use for services?
- What is a proper specimen for services?
- How to establish rights without use?
- Abandonment
- Best Practices

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# Legal Framework

# Key Distinction of U.S. Trademark Law

In the United States, trademark rights are acquired by adoption and *actual use* in commerce, not by federal or state registration

*Exceptions based on §44 and §66*

# The Trademark Law Revision Act of 1988 (TLRA)

- Created a dual system for U.S. federal registration, allowing both the filing of a used-based application as well as an intent to use application based on a bona fide intention to use a mark in commerce
- Redefined “use in commerce” to abolish “mere token use” as a basis for qualifying for federal registration and renewal and avoiding a holding of abandonment for nonuse

*Trademark Law Revision Act P.L. 100-667, 102 Stat. 3935*

# Lanham Act “Use in Commerce”

- Proper use is required, not just any type of use
- Use in commerce must be “lawfully” regulated by Congress (compliance with other statutes)
- Applicant’s/registrant’s use must be open, public use
- If “used” correctly and continuously to designate the source or origin of a product or service, trademark rights never expire
- If the “use” is *not* proper and/or *not* continuous, trademark rights may be cancelled and/or considered abandoned

# The Definition of “Use in Commerce” under the Lanham Act

- The term “use in commerce” means the bona fide use of a mark in the *ordinary course of trade* and *not made merely to reserve a right* in a mark.
- The word “commerce” means all commerce which may lawfully be regulated by Congress.

15 U.S.C. §1127 (§45 of the Lanham Act) (*emphasis added*)

# Legislative History of Trademark Law Revision Act of 1988 (TLRA) (Public Law 100-667, 102 Stat. 3935)

Use in the “ordinary course of trade” will vary from one industry to the next:

While use made merely to reserve a right in a mark will not meet this standard, the Committee recognizes that ‘the ordinary course of trade’ varies from industry to industry. Thus, for example, it might be in the ordinary course of trade for an industry that sells expensive or seasonal products to make infrequent sales. Similarly, a pharmaceutical company that markets a drug to treat a rare disease will make correspondingly few sales in the ordinary course of its trade; the company’s shipment to clinical investigators during the Federal approval process will also be in its ordinary course of trade....

*H.R. Rep. No. 1028, 100<sup>th</sup> Cong. 2d Sess. 15 (1988)*

# Legislative History of Trademark Law Revision Act of 1988 (TLRA) (Public Law 100-667, 102 Stat. 3935)

The “use in commerce” requirement should be interpreted with flexibility to account for different industry practices:

The Committee intends that the revised definition of “use in commerce” be interpreted flexibly so as to encompass various genuine, but less traditional, trademark uses, such as those made in test markets, infrequent sales of large or expensive items, or ongoing shipments of a new drug to clinical investigators by a company awaiting FDA approval....

*S. Rep. No. 515, 100<sup>th</sup> Cong. 2d Sess. 44-45 (1988)*

# Bona Fide Use in the Ordinary Course of Trade

Factors the USPTO and the courts consider when determining compliance with the statutory requirement for a “bona fide use of a mark in the ordinary course of trade”:

- Nature of applicant’s business and what is typical use within its particular industry
- The extent of the “trade”
- The commercial circumstances
- The volume and frequency of sales
- Intent of the applicant

# Lanham Act – Definition of a Trademark

The term “trademark” includes any word, name, symbol, or device, or any combination thereof ---

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

*15 U.S.C. §1127 (§45 of the Lanham Act)*

# Lanham Act – Definition of a Service Mark

The term “service mark” means any word, name, symbol, or device, or any combination thereof ---

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish the services of one person, including a unique service from the services of others and to indicate the source of the services, even if that source is unknown.

*15 U.S.C. §1127 (§45 of the Lanham Act)*

# Lanham Act - Definition of Trademark “Use in Commerce”

A mark shall be deemed to be in use in commerce ---

(1) on goods when ---

(A) It is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale; ***and***

(B) the goods are sold or transported in commerce

*15 U.S.C. §1127 (§45 of the Lanham Act) (emphasis added)*

# Lanham Act - Definition of Service Mark “Use in Commerce”

A mark shall be deemed to be in use in commerce ---

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(2) on services when it is used or displayed in the sale or advertising of services ***and*** the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services

*15 U.S.C. §1127 (§45 of the Lanham Act) (emphasis added)*

# Nature of Use - Specimen Requirements Trademarks

- Trademark specimen must show “actual” use of the mark identified in the drawing on:
  - the goods;
  - labels or tags affixed to the goods;
  - containers/packaging for the goods; or
  - displays associated with the goods at their point of sale.
- In rare circumstances where the placement of the mark on the goods in a traditional manner and/or on the displays is **impracticable**, the mark may be placed on documents associated with the goods or their sale.

See *TMEP* §904.03

# Nature of Use - Specimen Requirements Displays Associated with the Goods

- Must be associated directly with the goods offered for sale
- Must bear the trademark prominently
- Not required for display to be in close proximity to the goods
- Point of sale material generally acceptable, such as banners, shelf-talkers, window displays, menus and similar devices
- Must be designed to catch the attention of purchasers and prospective purchasers as an inducement to make a sale

See *TMEP* §904.03(g)

# Nature of Use - Specimen Requirements

## Service Marks

- Service mark specimen must show a “direct association between the mark and the services” through use:
  - in the sale of the applied-for services;
  - in the performance/rendering of the services; or
  - in the advertising of the services.
- The services *must be rendered* in commerce at the time when use is claimed; merely using the mark in the advertising of the services without also rendering the services *does not meet* the Lanham Act’s definition of use in commerce for services.

See TMEP §1301.04

# Nature of Use - Specimen Requirements

- Photograph, photocopy, scanned copy, screen capture, web page printout or other similar reproduction of an “actual” specimen that meets the aforementioned requirements is acceptable
  - Web page specimens must show the URL *and* the access or print date
- Examples of service mark specimens: online advertising, television and radio commercials, marketing materials, business cards, letterhead, invoices, and signage if they show a direct association between the mark and services

*Specimens must be submitted through the USPTO’s online Trademark Electronic Application System (TEAS) unless the specimen is for a non-traditional mark (i.e., scent, flavor)*

# Nature of Use - Specimen Requirements

- The following are not proper specimens in “actual use in commerce” and will not support the use requirements under the Lanham Act:
  - Artist’s rendering of the mark
  - Printer’s proof
  - Computer illustration
  - Digital image or similar mockup of how the mark is displayed
  - Photocopy of the drawing of the mark

See <https://www.uspto.gov/trademarks/laws/specimen-refusal-and-how-overcome-refusal>

See also *USPTO Examination Guide 1-20 (Revised)* and *USPTO Examination Guide 3-19 [Revised October 2020]* for guidance regarding examination of digitally created or altered and mockup specimens

- Specimen requirements apply to specimens submitted for applications and post-registration filings

# Challenges to Use in Commerce after Registration

- Throughout the life of a registration, there are many situations that can arise in which a registrant's underlying use in commerce in support of registration is challenged, such as during:
  - post-registration proof of use audit
  - expungement proceeding
  - reexamination proceeding
  - opposition and cancellation proceedings and trademark enforcement actions
- A successful challenge resulting in a finding of a lack of bona fide use of the mark in commerce can result in the loss of registered trademark/service mark rights.

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Is it merely advertising  
or lawful use in  
commerce?

# Mere Advertising



**Guantanamera Cigar Co. v.  
Corporacion Habanos, S.A.,  
672 F. Supp. 2d 106 (D.D.C. 2009)**

# Unlawful Use (in Commerce)

## Unlawful activity = No lawful use in commerce

*In re JJ206, LLC, dba JuJu Joints*, 120 USPQ2d 1568 (TTAB 2016)

- Vaporizing devices for cannabis are illegal drug paraphernalia under federal law (the Controlled Substances Act), making it legally impossible for applicant to have a *bona fide* intent to use the marks POWERED BY JUJU and JUJU JOINTS in lawful commerce



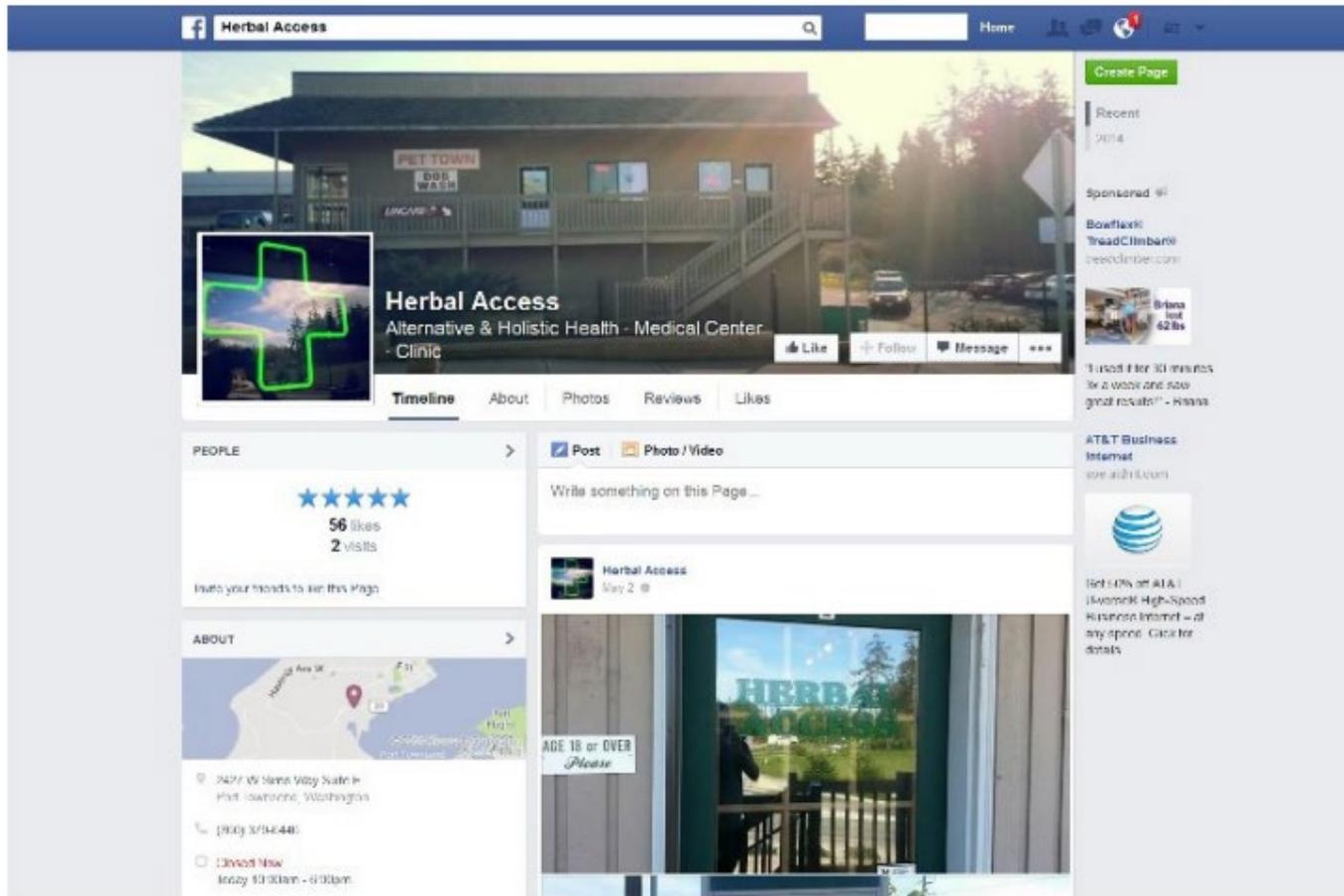
# Unlawful Use (in Commerce) (cont.)

**Unlawful activity = “bait-and-switch” attempt at the USPTO will likely be unsuccessful**

*In re Morgan Brown*, 119 USPQ2d 1350 (TTAB 2016)

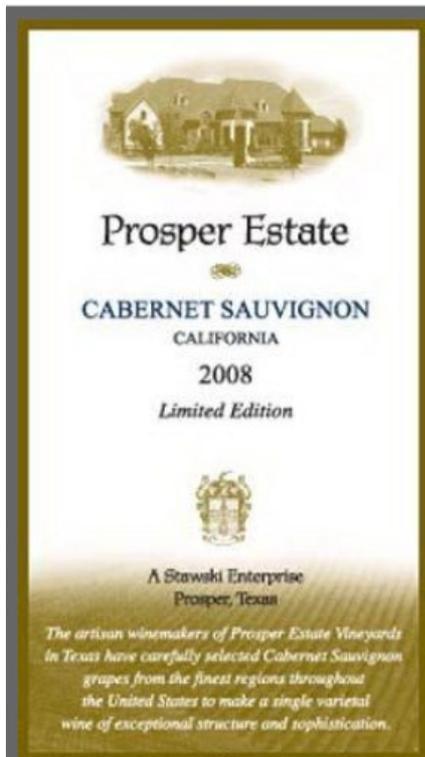
- TTAB affirmed refusal of application for lack of lawful use of the mark HERBAL ACCESS for “retail store services featuring herbs” where specimen of use (photo of Applicant’s retail store) showed marijuana sales
- That a product or service may be lawful in a given state is irrelevant in connection with federal registration of a mark, if the product or service is unlawful under federal law

# Specimen of Use – *In re Morgan Brown*



# Unlawful Use (in Commerce) (cont.)

**Activity generally lawful but applicant's activity not legally compliant = No lawful use**



# Not legally compliant = No lawful use (cont.)

*Stawski v. Lawson*, 129 USPQ2d 1036 (TTAB 2018) (concurrent use)

- **Lawful Prior Use in Commerce:** Applicant had to prove “technical use of his trademarks” in commerce prior to Registrant filing date (Analogous use not relevant in a concurrent use proceeding; Analogous use can be considered for establishing priority for likelihood of confusion purposes)
- **Asserted lawful activity:** Applicant placed its wine labels on bottled wine purchased from a third party and distributed (but failed to produce evidence of actual bona fide use in ordinary course of trade)
- **TTAB deemed unlawful activity:** Applicant did not comply with regulations of the Alcohol and Tobacco Tax and Trade Bureau (TTB) concerning the labeling of wine that is introduced into interstate commerce
  - Applicant admitted he did not obtain the TTB required Certificate of Label Approval (COLA) for his wines

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# Sufficient Use on Goods

# *Christian Faith Fellowship v. Adidas AG*

## **There is no *de minimis* exception to the use in commerce requirement**

*Christian Faith Fellowship v. Adidas AG*, 841 F.3d 986 (Fed. Cir. 2016)

- **January 2005:** A church in **Illinois** began selling caps and shirts with the phrase "Add A Zero"
- **February 2005:** The church made one sale of two hats bearing the ADD A ZERO mark to an **out-of-state resident** who purchased the hats with a **check bearing a Wisconsin** address
- **March 2005:** The church applied for federal registration of the ADD A ZERO mark for "Clothing, namely, shirts, pants and caps" in Class 25



# *Christian Faith Fellowship v. Adidas AG (cont.)*

- **2009:** Adidas applied for the mark ADIZERO for clothing and is refused by USPTO based on the church's ADD A ZERO marks
- **2010:** Adidas filed a petition to cancel the church's marks arguing, among other things, that the church failed to use the marks in commerce before registration
- TTAB sustained Adidas' claim, finding the church's February 2005 sale of two hats to one out-of-state party to be *de minimis* and not sufficient to satisfy the "use in commerce" standard under the Lanham Act

# *Christian Faith Fellowship v. Adidas AG* – Federal Circuit

The Federal Circuit reversed:

- **"[T]he Church's sale of two 'ADD A ZERO'-marked hats to an out-of-state resident is regulable by Congress under the Commerce Clause and, therefore, constitutes 'use in commerce' under the Lanham Act."**
- This transaction, taken in the aggregate, would cause a substantial effect on interstate commerce
- There is no *de minimis* exception to the use in commerce requirement

# *Tao Licensing, LLC v. Bender Consulting*

**Distribution of samples of product not sufficient use in commerce**

*Tao Licensing, LLC v. Bender Consulting Ltd. d/b/a Asian Pacific Beverages*, 125 USPQ2d 1043 (TTAB 2017)

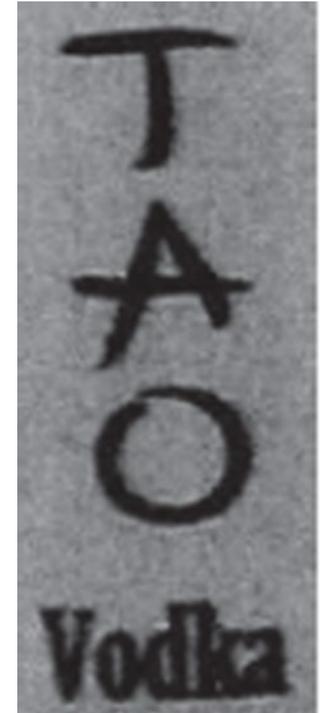


# *Tao Licensing, LLC v. Bender Consulting (cont.)*

- **2010:** Respondent's owner, Mr. Bender, visited a TAO venue in an unsuccessful attempt to sell KAI VODKA
- **July 11, 2011:** Respondent files an intent-to-use application for TAO VODKA for “alcoholic beverages excluding beer”
- **Mid-April 2012:** Vietnamese distillery ships one case of vodka samples bearing the TAO VODKA mark to “Mr. Marcus Bender of Kai Vodka,” Respondent's related entity

# *Tao Licensing, LLC v. Bender Consulting (cont.)*

- **Late April 2012:** Respondent provides free samples of TAO VODKA to three different parties:
  1. An out-of-state shareholder of Kai Vodka, LLC
  2. A restaurant in Hawaii located across the street from Mr. Bender
  3. A liquor distributor in Hawaii



# *Tao Licensing, LLC* – TTAB Holding

## **Respondent did not make bona fide use of the mark in commerce. Petition to cancel granted.**

- “We find Mr. Bender’s sharing of these samples with the three parties was *more in the nature of a preliminary advisory consultation* than bona fide use of the TAO VODKA mark in the ordinary course of trade. Thus, Respondent failed to make the requisite use of the mark in commerce prior to the Statement of Use deadline.”

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# Proper Specimen for Goods

# Proper Specimens for Goods

## Display Must be Directly Associated with Goods Offered for Sale

In re Mediashare Corp., 43 USPQ2d 1304 (TTAB 1997)

- “Fact sheet” brochures or “catalog pages” submitted as specimens with the application are unacceptable as evidence of actual trademark use because they were not point-of-sale displays, but **mere advertising** of mark in connection with software and manuals that **did not provide** all of the **information necessary to order goods** or the terms and conditions under which the software was available for license.

In re Anpath Grp., Inc., 95 USPQ2d 1377 (TTAB 2010)

- Pamphlet and flyer listing the URL of applicant’s website and a telephone number for contacting salesperson did not create the same point-of-sale as a detailed catalogue, a detailed web page, or on any other such **option of placing an order** based upon detailed information from the specimen.



# Proper Specimens for Goods

## Coupon as Point-of-Sale Display

In re Johnson & Johnson, 2015 WL 6121760 (TTAB 2015) (not precedential)

- Specimen consisting of coupon was **point-of-sale display** associated directly with the goods offered for sale where the coupon depicted the mark with the goods and the goods could be purchased in the same location where the purchaser was when presented with the coupon.

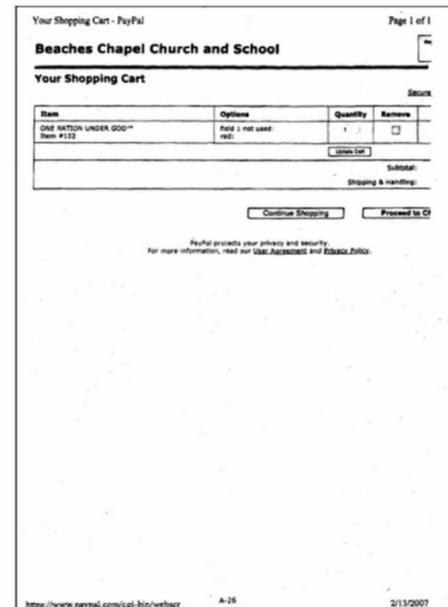
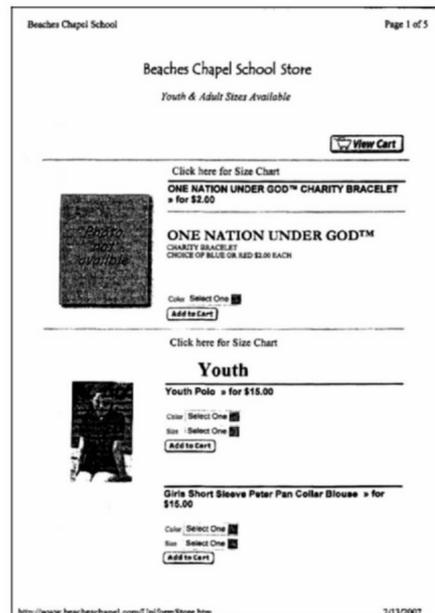


# Proper Specimens for Goods

## Electronic and Web-Based Displays

In re Sones, 590 F.3d 1282 (Fed. Cir. 2009)

- "A picture is not a mandatory requirement for a website-based specimen of use under trademark law, and the test for an acceptable website-based specimen, just as any other specimen, is simply that it must in some way evince that the mark is "associated" with the goods and serves as an indicator of source."
- Textual description of ONE NATION UNDER GOD charity bracelets on web page may be sufficient.



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# Sufficient Use for Services

# Sufficient Use for Services

## Offering Services Without Actual Provision Insufficient

Aycock Eng'g, Inc. v. Airflite, Inc., 560 F.3d 1350 (Fed. Cir. 2009)

- Registrant **did not use** the mark AIRFLITE in connection with “arranging for individual reservations for flights on airplanes.” **He only prepared to do so** by lining up air taxi operators and he never offered the services to potential passengers in an open or notorious way.

Couture v. Playdom, Inc., 778 F.3d 1379 (Fed. Cir.), cert. denied, 136 S. Ct. 88, 193 L. Ed. 2d 35 (2015)

- Holder of registered PLAYDOM mark failed to establish that he had used the mark in commerce as of his use-based application filing date, and thus the registration was void *ab initio*, even though the holder created a website offering writing and production services, absent evidence that he had actually provided services in connection with the mark.

# Sufficient Use for Services

## Services Promoted Online

Am. Residential Servs., L.L.C. v. Rescue Response Group Inc, 2016 WL 552611 (TTAB 2016) (not precedential)

- No use of Applicant's MR. RESCUE PLUMBING & DRAIN CLEANING mark in commerce where Applicant's services were rendered wholly in-state, and there was no proof that viewers had accessed Applicant's website (from out of state or otherwise) as of filing date of its use-based application, despite Applicant's assertion that it advertised "over the internet, across the US and the rest of the world."



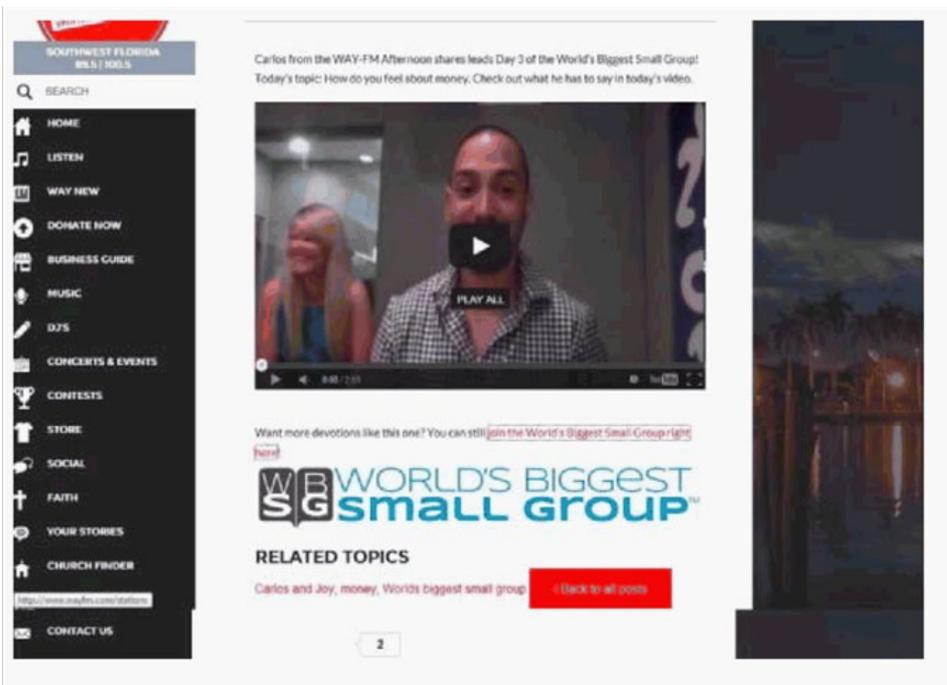
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# Proper Specimen for Services

# Proper Specimen for Services

## Radio Broadcasting Services

*In re WAY Media, Inc.*, 118 USPQ2d 1697 (TTAB 2016)



# *In re WAY Media, Inc.* — TTAB Holding

TTAB holding:

- Specimens included webpages from a third-party website (YouTube) referring to a radio program and that purportedly depicted the mark in a “radio broadcast booth environment”
- The Board found there was no direct association in the specimens between the WORLD’S BIGGEST SMALL GROUP mark and “radio broadcasting services”

# Proper Specimen for Services (cont.)

**Retail store services -- Specimens of use were unacceptable because they failed to show the mark used in connection with the services**

*In re Cardio Group, LLC*, 2019 USPQ2d 227232 (June 20, 2019)

Submitted specimens of use (all displaying the mark)

1. Website screenshot;
2. Confidential sales agreement; and
3. An invoice
  - Website specimen presented the results of an analysis from a medical device

# *In re Cardio Group, LLC* – TTAB Holding

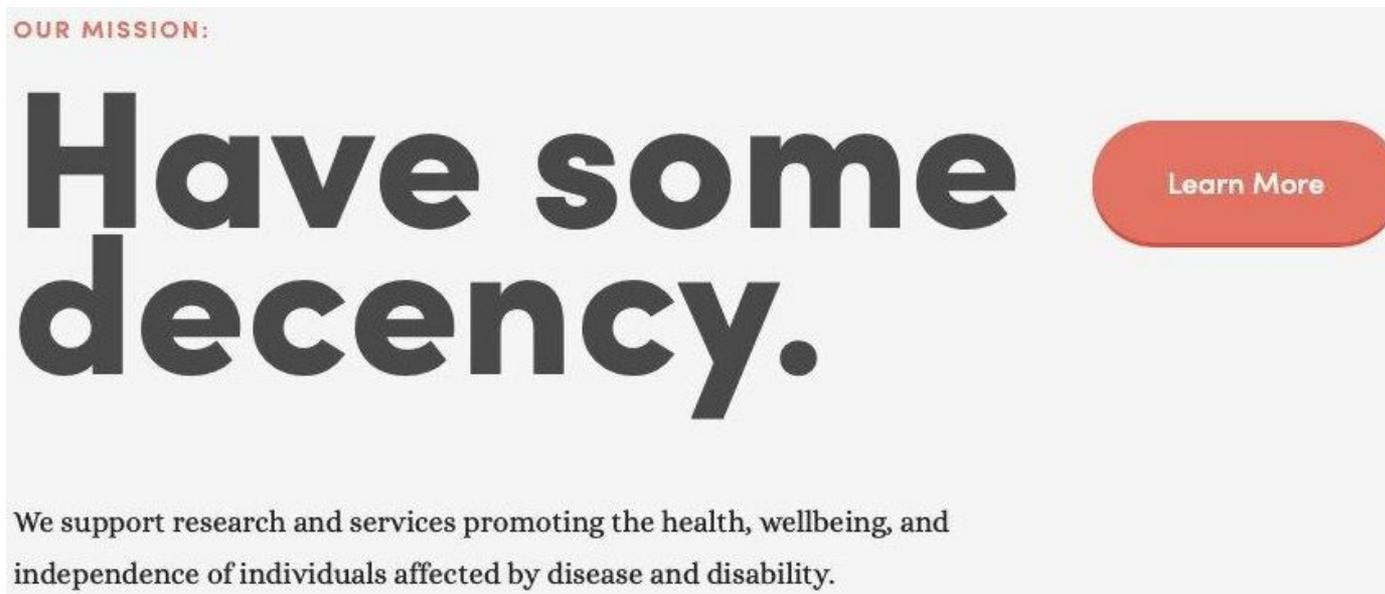
- Does the evidence of Applicant's use of its mark **create an association** between the mark and Applicant's retail store services?
- To create such a "direct association," the specimens must **both** contain a **reference to the service** and **identify the service and its source**
- TTAB = No, the specimens **did not** refer to any retail store services in any way
- **Specimens failed to demonstrate** that consumers would perceive Applicant's mark as a source indicator for "retail store services"



# Proper Specimen for Services (cont.)

**Use of a service mark requires rendering of the services, not just preparation**

*In re Alessandra Suuberg, 2021 USPQ2d 1209 (TTAB 2021)*



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# *In re Alessandra Suuberg (cont.)*

- Applicant filed use-based application for HAVE SOME DECENCY for various charitable fund raising services
- Specimen (website printout) stated that Applicant was ***not accepting donations*** but instead was looking for volunteers to “***get our organization off the ground.***”
- Applicant explained that, at the time of her trademark application filing, she had:
  1. recently completed a post-baccalaureate premedical program,
  2. incorporated a non-profit organization,
  3. applied for tax-exempt status, and
  4. registered a domain name

# *In re Alessandra Suuberg* – TTAB Holding

- Applicant was in the ***nascent stage*** of developing her business when she filed her application.
- She had ***just finished her education*** and had ***just formed an entity*** to develop her vision of “encouraging 'decency' in medicine and medical research.”
- Applicant’s preparatory activities ***did not accord*** her service mark rights.
- TTAB deemed the ***application void ab initio.***

# Proper Specimen for Services (cont.)

**TTAB sustains opposition for licensing services on ground of nonuse -- specimens failed to show use of the mark in connection with specified services**

*The Mars Generation, Inc. v. Albert G. Carson IV*, 2021 USPQ2d 1057 (TTAB 2021)

- Applicant filed for I AM THE MARS GENERATION and WE ARE THE MARS GENERATION for "licensing of advertising slogans and cartoon characters"
- Specimens of use were undated and identified in the applications as "advertising"

# *Mars Generation, Inc.* – TTAB Holding

- Applicant submitted a declaration that contained ***only conclusory statements*** about provision of services – and declaration ***did not provide any evidence*** to support those statements
- TTAB: Even if the “specimens could be found to be ***technically acceptable***” for advertising the service, this does not suffice to establish ***the mark was actually used in commerce for the service***, where “there is ***no corroborating evidence*** that applicant offered any of the services identified in the application[s] at the time he filed [them].”
- Opposition sustained

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# Establishing Rights Without Use

# Bona Fide Intent to Use in Commerce

- A good faith, genuine, authentic intention by a person or entity to use a trademark in commerce to sell certain goods or render certain services
- More than simply an intent to reserve a right in a mark
- Required for applications based on §1(b), §44 and §66(a)
- Applicant must have a bona fide intent to use the mark in commerce *as of the application filing date*
- Intended use of mark serving as the basis for this type of application must also be a lawful use

# Bona Fide Intent to Use in Commerce

- USPTO will not evaluate applicant's sworn statement of a bona fide intention to use the mark in commerce during the examination phase but issues related to good faith may arise during *inter partes* proceedings
  - Objective, documentary evidence of a bona fide/good faith intent to use a mark is needed to support applicant's sworn statement
  - Applicant's subjective state of mind, without more, is insufficient to establish an applicant's bona fide intent
  - Examples of evidence of bona fide intention to use include:
    - Prepared business plans, product prototypes, promotional/marketing materials, packaging for the products or proposed artwork for the packaging, emails or other documentation showing steps in furtherance of manufacturing the goods, documentation demonstrating steps toward acquiring governmental approval, licensing arrangements and/or written correspondence with prospective distributors or licensees, etc.

# Bona Fide Intent to Use in Commerce

- As the TTAB made clear in Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503, 1507 (TTAB 1993):

“the absence of any documentary evidence on the part of an applicant regarding such intent is sufficient to prove that the applicant lacks a bona fide intention to use its mark in commerce as required under Section 1(b).”
- Evidence should predate filing of application but post-filing documentary evidence can corroborate other evidence of record of applicant’s intent to use
- Obligation to produce documentary evidence of a bona fide intent to use applies even where the application is based solely on a foreign registration. See Honda Motor Co., Ltd. v. Friedrich Winkelman, Opposition No. 91170552 (4/8/09)

# Circumstances Negating an Applicant's Bona Fide Intent to Use a Mark

- The congressional history of the TLRA put forth several factors which may negate an applicant's bona fide intent to use a mark:
  - Filing numerous applications for the same mark for many more new products than are contemplated
  - Numerous applications for a variety of trademarks intended to be used on a single product
  - Numerous applications to register marks consisting of or incorporating descriptive terms relating to a contemplated new product
  - Numerous ITU applications to replace applications which lapsed because no timely statement of use was filed

# Circumstances Negating an Applicant's Bona Fide Intent to Use a Mark

- An excessive number of ITU applications to register marks which were never used
- An excessive number of applications in relation to the number of products the applicant is likely to introduce
- Applications lacking in specificity in describing the proposed goods/services
- As evidenced by the case law, inconsistencies in discovery responses, evidence and testimony can call into question the credibility of having a bona fide intent to use a mark in commerce. See [Swiss Grill Ltd. v. Wolf Steel Ltd.](#), 115 USPQ2d 2001 (TTAB 2015)

# Intent-to-use/bona fide intent – case law

**An “Objective” Determination - Whether an applicant had a “bona fide intent” to use the mark in commerce at the time of the application requires objective evidence of intent**

*M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368 (Fed. Cir. 2015)

- **Evidence of Intent at Time Filed:**

- Applicant demonstrated the general capacity to produce watches

- **Evidence Not Sufficient Because:**

- Documents submitted related to prosecution of the mark only
- Applicant did not actually make the watch
- Provided no evidence of further steps taken towards completing developing the watch

swatch+

# Intent-to-use/bona fide intent – case law (cont.)

**Applicant's mammoth but vague plans did not show “bona fide intent to use”**

*Lincoln Nat'l Corp. v. Kent G. Anderson*, 110 USPQ2d 1271 (TTAB 2014)

- Applicant (Kent G. Anderson) (<http://www.futurevisionaries.com>)
  - First ITU application for goods/services in 11 International Classes, including Classes 35 and 36
  - Second ITU application for goods/services in 8 International Classes, including Class 36

# *FUTURE*

# Lincoln Nat'l Corp. – TTAB Holding

- **TTAB Finds No Bona Intent to Use:**

- Applicant's applications for 8 and 11 classes of goods and services **casted doubt** on bona fide intent to use mark
- Created a website, but had ***no sales and no capacity to manufacture goods/provide services*** at the time of filing application
- TTAB ***rejected*** Applicant's ***vague plan*** to license the mark or partner with others at some "indefinite" time in the future
- TTAB ***rejected*** \$4,000 in ***handwritten/undated expenditures*** & undated ***advertising not for services in applications***

# Intent-to-use/bona fide intent – case law (cont.)

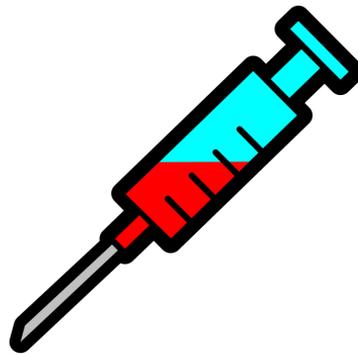
## Substantial documentary evidence supports “bona fide intent”

*Robert E. Beer, M.D., Inc. v. Kenneth Beer*, Opp. No. 91218552, 2016 TTAB LEXIS 571 (TTAB Nov. 28, 2016) (not precedential)

- **Nine days after** Applicant filed his application for DERMNOW for dermatology services, Opposer filed its application to register the **identical mark DERMNOW for identical services**
- Evidence of “bona fide intent” at filing:
  - Creation of two websites featuring DERMNOW mark
  - Registration of business entity Dermnow, P.A.
  - Documented contacts with dermatology supplier
  - Documented contacts with staffing company
  - Documented contacts with insurance company regarding business expansion

# Robert E. Beer, M.D., Inc. – TTAB Holding

- “In sum, consideration of the evidence as a whole supports a finding that Applicant had a bona fide intent to use the mark DERMNOW at the time he filed his application.
- Applicant’s testimony is credible;
- this clear and uncontradicted testimony, **supported by documentary evidence**, together comprise objective facts that establish his bona fide intention to the use the mark.”



# Analogous Use

- Prior use analogous to trademark use to **establish priority** under Section 2(d).
- Analogous use is non-technical use of a mark that is sufficient to create an association between the goods/services and their source in the minds of consumers.
- Analogous use is not a substitute for technical trademark use and does not support registration.
  - See *T.A.B. Sys. v. Pactel Teletrac*, 77 F.3d 1372 (Fed. Cir. 1996); *Malcolm Nicol & Co. v. Witso Corp.*, 881 F.2d 1063 (Fed. Cir. 1989); *Dyneer Corp. v. Automotive Products Pls*, 37 USPQ2d 1251 (TTAB 1995).

# Analogous Use

- **Substantial Impact on Purchasing Public**
  - more than a negligible portion of the relevant market
  - regular and reoccurring
- **Open and Notorious Use**
  - public use, not internal
- **Create an Association**
  - in the minds of the “purchasing public”
- **Take Place in a Commercially Reasonable Time Prior to Actual Use**
  - See *T.A.B. Sys. v. Pactel Teletrac*, 77 F.3d 1372 (Fed. Cir. 1996)

# Analogous Use

Sample 1:

**E.R.I.C.A**



**E.R.I.C.A**

Hello My Name Is E.R.I.C.A,  
Welcome To My24HourNews.Com.

I Can Offer You Varied News and  
Current Events of Your Region Or  
Country. In Addition, Specify Your  
Particular Interests, Such As,  
International Events, Political News,  
Financial World Markets, Weather,  
Sports, Or Entertainment.

*Underwood v. Bank of America Corp.,  
996 F. 3d 1038 (10<sup>th</sup> Cir. 2021)*

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# Abandonment

# Definition of "Abandoned" – Lanham Act

A mark shall be deemed to be “abandoned” if either of the following occurs:

(1) When its use has been **discontinued with intent not to resume** such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

(2) When any course of conduct of the owner, including acts of omission as well as commission, **causes the mark to become the generic name** for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph.

15 U.S.C.A. § 1127

# Establishing Sufficient Use in Commerce to Avoid Abandonment

Crash Dummy Movie, LLC v. Mattel, Inc., 601 F.3d 1387 (Fed. Cir. 2010)

Substantial evidence supported the Board's finding that Mattel intended to resume use of the CRASH DUMMIES marks for toys during its period of non-use.

- Mattel engaged in research and development efforts and entered into discussions with KB Toys about becoming the exclusive retailer for the product CRASH DUMMIES toys.
- That Mattel did not ultimately enter into the agreement was due to business concerns and did not suggest that it decided to abandon the mark.
- Intent to resume use also supported by substantial R&D efforts during period of non-use, even though actual use of the mark did not occur until years later.



# Establishing Sufficient Use in Commerce to Avoid Abandonment (cont'd.)

## Industry Practices

NetJets Inc. v. IntelliJet Grp., LLC, 602 F. App'x 242 (6th Cir. 2015)  
(not precedential)

- Mark owner not required to use the mark in the precise manner that it was initially used or registered to prevent abandonment.
- Given the dynamics of the private-plane industry and the nature of the software product, limited market involvement where NetJet sold software to two external customers was sufficient to show a *bona fide* use ... in the ordinary course of trade, and that NetJets had therefore not abandoned the mark.
- Original use and registration = software
- New use = software to support private plane services

# Establishing Sufficient Use in Commerce to Avoid Abandonment (cont'd.)

## Prospective Intent to Abandon

Am. Ass'n for Justice v. The Am. Trial Lawyers Ass'n, 698 F. Supp. 2d 1129 (D. Minn. 2010)

- Prospective intent to abandon a mark does not establish abandonment; rather, abandonment requires **complete cessation or discontinuance of trademark use**.
- AAJ's use of ATLA mark was *bona fide* where it identified itself as "formerly known as ATLA" on its website, in advertisements, in the e-mail signature blocks of some of its staff, and in mailings to prospective members.
- AAJ also continued to license the ATLA mark to at least one licensee who had continuously used the mark.



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# Best Practices

# Best Practices

- Use of mark must match drawing of mark in application
- Specimen of use must demonstrate use of mark for goods and/or services identified in the application/registration (goods are identified in the application but the specimens support the rendering of a service)
- In order to constitute a service, the activity must be primarily for the benefit of someone other than the applicant
- Make certain that shipments of the trademarked products comply with any applicable federal regulatory statute

# Best Practices

- Avoid mere internal shipments between various offices or plants of the prospective trademark owner. Shipment from a manufacturer to the trademark owner does not constitute use in commerce.
- Confirm that the trademark owner has documentary evidence to demonstrate a bona fide intention to use a mark in commerce prior to filing an intent to use application
- If filing a §1(a) application, confirm that the applicant is using the mark in commerce on or in connection with all the goods and/or services covered by the §1(a) basis as of the filing date. If not, move those goods and/or services that were not in use as of the filing date to a §1(b) basis.

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Questions?

## Contact Information

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