

"Mark Your Place" With Bona Fide Intent to Use Trademark Application

Amundsen Davis Intellectual Property Alert
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If you haven't yet used your new brand, but you intend to launch it within the next three years, you may want to claim an earlier priority date with the U.S. Patent and Trademark Office (USPTO) by filing an application for registration of your mark based on "intent to use" (ITU) rather than an application based on use.

An application based on use requires that the mark be in use in commerce on all of the goods or services described in the application on the date of filing the application. The date of first use in commerce and a specimen showing use of the mark in each class of goods or services applied for must also be included. If you are unable to meet these requirements, then filing an ITU may be the best option.

An ITU provides a priority date upon filing, without any use or specimens required at the time of filing. The application goes through the usual application process at the USPTO, including publication for opposition; however, instead of receiving a registration certificate once the opposition period expires, the applicant receives a Notice of Allowance (NOA). Once the applicant receives a NOA, it must file, within six months, either a Statement of Use showing that the mark is being used in commerce or a Request for Extension of Time in Which to File the Statement of Use. Both of these filings require the payment of additional fees.

The filing of an ITU and a Request for Extension also requires the declaration of the applicant that it has a bona fide intent to use the mark in commerce on all of the goods and services in the application. An applicant may only file five such requests, at regular six month intervals, from the date of the NOA; therefore, the applicant can extend the deadline for actual use of the mark for up to three years from the date of the NOA. Failing to do so, or failing to file the Statement of Use before the last extension period expires, results in abandonment of the application. However, the applicant may convert the ITU to a used based application by filing the necessary documents and declaration supporting use at any time during the application process up until publication or after the NOA issues.

Because of the filings needed after an NOA, the ITU application is slightly more

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expensive in filing fees than an application based on use, but filing an ITU is particularly beneficial where you expect there to be some delay between searching the availability of a mark and the brand launch date or where use has been initiated on some, but not all, of the goods or services in a particular product category. It is also a helpful tool if a “home country” application is needed to support an International Registration filing under the Madrid Protocol.

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