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A Roadmap to Asserting (and Defending Against) Lack-of-*Bona Fide* Intent Claims at the TTAB

By Ari Feinstein and Charlene Azema

One looking to challenge registration of a trademark with the United States Patent and Trademark Office (USPTO) (either through opposition to an application or cancellation of a registration) has many tools at their disposal, several of which can be asserted before the USPTO's Trademark Trial and Appeal Board (TTAB or the Board).¹ One such ground—the focus of this article—is that the defendant lacked the requisite *bona fide* intent to use the mark as of the application filing date.² While this claim may appear straightforward, these proceedings regularly raise questions that every potential plaintiff (and defendant) should know about—such as which applications the claim can be asserted against, the shifting burden of proof, the evidence needed to prevail on or successfully defend against such a claim, and the relief available to a successful plaintiff.³ The case law shows that, while these claims remain fact intensive, the Board has supplied guideposts for navigating them.

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THE TYPE OF TRADEMARK APPLICATION

A trademark application filed or registration issued under Sections 1(b), 44(e), or 66(a) of the Trademark Act can be the subject of a claim for lack of *bona fide* intent to use. Each of these application filing bases requires the applicant to allege a *bona fide* intent to use the mark in U.S. commerce.⁴ Applicants therefore must balance filing early enough to secure priority with generating documentation showing *bona fide* intent at filing, while potential plaintiffs should scrutinize 1B, 44E, and 66A applications for vulnerability to such a challenge. Once such a challenge is brought, several recurring issues arise.

BURDEN SHIFTING

A plaintiff bears the initial burden of proving, by a preponderance of the evidence, that the defendant lacked a *bona fide* intention to use the mark on the applied-for goods or services.⁵ The plaintiff can satisfy this *prima facie* showing by pointing to defendant's lack of documentary evidence that proves such intent.⁶ Once that happens, the burden then shifts to the defendant to rebut that showing with evidence that explains or outweighs the failure to produce such documentation.⁷ The next question, of course, is what counts as “documentary evidence.”

DOCUMENTARY EVIDENCE

The Board has identified documentary evidence to include correspondence with prospective licensees, marketing or business plans, labels, and test marketing and promotional materials, as well as materials showing product design, manufacturing, and graphic design efforts.⁸

Not every document qualifies. Patents and meeting minutes that do not reference the mark at issue are not evidence of intent to use that mark in U.S. commerce at filing.⁹ Nor is a TSDR printout of the application itself probative of *bona fide* intent.¹⁰ The same is true of multiple applications for the mark or correspondence with counsel about those applications; if filing and prosecuting an application were enough, lack of *bona fide* intent would never be a viable TTAB claim.¹¹ And evidence referenced by the defendant but not made of record may be disregarded altogether.¹²

Registering a domain name that incorporates the word mark, without corresponding efforts actually to use the mark, is likewise insufficient.

If a plaintiff makes a *prima facie* showing and the defendant produces no rebuttal documentation, the Board typically finds that the defendant had no *bona fide* intent to use the mark.¹³ More often, however, defendants produce some evidence, and the real dispute becomes whether that evidence is enough.

EVIDENCE INSUFFICIENT TO REBUT A PLAINTIFF'S LACK OF *BONA FIDE* INTENT-TO-USE CLAIM

Even when a defendant produces documentary evidence, it must bear on intent *at the time of filing*.¹⁴ In *LinkedIn*, for example, the Board found a letter dated two years after filing—referring only to plans to “design” and “develop” future “plans”—irrelevant to the defendant’s intent when it filed the application.¹⁵

Even timely evidence must evidence real work. Promotional materials created solely for submission to the USPTO, rather than for actual promotional use, are likely insufficient to establish *bona fide* intent.¹⁶ Their nonuse is especially telling when such materials are ordinarily part of the defendant’s product-development process.¹⁷

Registering a domain name that incorporates the word mark, without corresponding efforts actually to use the mark, is likewise insufficient.¹⁸ A domain name that does not even incorporate the applied-for mark fares no better.¹⁹

Nor are vague business plans enough.²⁰ In *Lincoln Nat’l*, website statements about “building this corporation” and creating “global benefits” showed only “idealistic hopes,” not a *bona fide* intent to use the mark.²¹ And if plans are entirely contingent on a future event that may never occur—such as a sports team winning a championship—they do not establish *bona fide* intent.²²

Business plans may, of course, contemplate work with third parties such as manufacturers. But the Board has made clear that mere awareness of possible suppliers is not enough.²³

Finally, even “extensive documentary evidence” may not suffice.²⁴ In one precedential case, texts, emails, domain-name purchases, projections, a draft business plan, and property-purchase proposals were still inadequate because those efforts had ended well before filing, and the defendant later suggested she was finished pursuing the services.²⁵

EVIDENCE SUFFICIENT TO REBUT A PLAINTIFF'S LACK OF *BONA FIDE* INTENT-TO-USE CLAIM

What will suffice depends heavily on the facts, but the case law supplies recurring guideposts. Efforts tied to product design, manufacturing, graphic design, test marketing, correspondence with prospective licensees, and preparation of business or marketing plans, labels, and promotional materials are the kinds of evidence that favor a finding of *bona fide* intent.²⁶

A “credible business plan” may include operations strategies, identifying ingredient sources, packaging and labeling products, establishing manufacturing and distribution capabilities, or developing a sales and marketing campaign.²⁷

The Board has also treated evidence of prospective licensing agreements and research undertaken to implement a business plan—such as industry-appropriate clinical testing—as evidence favoring *bona fide* intent.²⁸

As noted above, filing the application itself is unsurprisingly not documentary evidence of *bona fide* intent. *Market America*, however, shows what additional evidence may suffice.²⁹ There, the

defendant applied to register VITAMINDFUL for “vitamins” on December 2, 2014.³⁰ Although the plaintiff pointed to a later email disclaiming any intention to use the mark, the Board emphasized an email the defendant sent to his counsel the day before filing that reflected a concrete plan to launch a vitamin line.³¹ In that email, the defendant told counsel that VITAMINDFUL was the name of a vitamin line he was considering launching, he would distribute the vitamins online, he had secured the URL, the line would include vitamins and herbal supplements, and that the product would include certain ingredients.³²

Counsel responded by recommending trademark searches, and the defendant authorized them.³³ Although the Board described the defendant’s plans as general, it found *bona fide* intent because the pre-filing email identified the proposed goods including their ingredients, their online distribution, and the matching URL.³⁴ On that record, the Board held the plaintiff had failed to establish a *prima facie* case and dismissed the claim with prejudice.³⁵

The Board has likewise found *bona fide* intent where a defendant’s business plan may have lacked detail but other documents filled the gap. In *Kate Spade*, for example, the defendant relied on materials showing a basic project budget, a prototype specification, and numerous renderings of the goods at issue.³⁶

DEFENDANT’S CAPACITY TO USE THE MARK—OR LACK THEREOF

A defendant may also rebut a lack-of-intent claim by showing it had the capacity to use the mark in U.S. commerce when it filed its application. The Board has explained that a defendant’s ability to market and manufacture the identified goods as a natural extension of its existing product line can rebut the absence of documentary evidence.³⁷ The Board and Federal Circuit likewise look favorably on prior experience in the relevant industry or prior production of the goods, and even an accepted statement of use for similar goods under a different mark may inferentially support capacity.³⁸ And a defendant that partnered with a non-U.S. company to launch its product in the United States can likely still show capacity if the defendant successfully used the same strategy for a prior launch in the United States.³⁹

By contrast, evidence that a defendant lacked capacity to market or manufacture the goods strengthens a lack-of-intent claim. An unsubstantiated assertion that nearly 150 different clothing items could be marketed “essentially overnight” and “with no forward planning” did not persuade the Board.⁴⁰ Nor is a defendant likely to establish its own capacity by relying on affiliated companies, particularly where the goods are heavily regulated in the United States and those affiliates are foreign entities with no history of producing the relevant goods for the U.S. market.⁴¹

ADDITIONAL CONSIDERATIONS

The Board and Federal Circuit have also found no requisite *bona fide* intent where a defendant filed as an individual owner but did not intend to use the mark in an individual capacity.⁴² In both *Sanders v. American Forests* and *Hole in 1 Drinks, Inc. v. Michael Lajtay*, the defendant filed in his or her own name even though the plan was to use the mark with a partner through a new entity.

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Filing across a large number of classes may likewise increase vulnerability to a lack-of-bona-fide-intent challenge.⁴³ So too may filing an excessive number of intent-to-use applications relative to the products the defendant is realistically likely to introduce while those applications are pending.⁴⁴

A prior intent-to-use application for the same mark that was abandoned for failure to file a statement of use may also suggest that the defendant long contemplated using the mark but never actually did so.⁴⁵

A defendant that says it is waiting for registration before developing, marketing, and offering its goods for sale has effectively admitted that it filed only to reserve rights in the mark—which is improper.⁴⁶

Finally, evidence that a defendant actually began to use the mark sufficiently contemporaneously with the filing of the application favors a finding of *bona fide* intent.⁴⁷

RELIEF

If the plaintiff prevails on all identified goods, the application will be refused—or, in a cancellation proceeding, the registration will be cancelled—in full; if the defendant prevails across the board, the challenged application or registration survives intact. But where the plaintiff proves lack of *bona fide* intent only as to certain goods or services, the Board may sustain the claim only in part and cancel or refuse registration only for those specific goods or services.⁴⁸

CONCLUSION

It is critical for all parties to understand this roadmap. Trademark applicants should formulate and document their pre-launch efforts on the assumption that they will face a lack-of-intent claim. And if a plaintiff asserts such a claim, each side should litigate the proceeding with the guideposts discussed above front of mind to try to reach a satisfactory resolution—either through settlement or on the merits—in a cost-effective manner.

Notes

1. T.B.M.P. 309.03(c)(1).
2. Trademark Act § 1(b), 15 U.S.C. § 1051(b); T.B.M.P. 309.03(c)(1)(5).
3. A party opposing a pending trademark application before the TTAB is typically referred to as the “opposer,” and a party seeking to cancel an existing registration before the TTAB is typically referred to as the “petitioner.” For the sake of simplicity, since we generally refer to both opposition and cancellation proceedings together (unless where otherwise noted), we generally refer herein to opposers and petitioners as “plaintiffs” and applicants and respondents as “defendants.”
4. The names “1B,” “44E,” and “66A” are shorthands for the statutes in the Trademark Act pursuant to which these applications are filed and, specifically, refer to applications filed under section 1(b) of the Act (codified as 15 U.S.C. § 1051(b)), section 44(e) of the Act (codified as 15 U.S.C. § 1126(e)), and section 66(a) of the Act (codified as 15 U.S.C. § 1141(f)); see also Trademark Manual of Examining Procedure (TMEP) § 806.01(b), (d), and (e).
5. Boston Red Sox Baseball Club LP v. Sherman, 88 U.S.P.Q.2d 1581, 1587 (T.T.A.B. 2008) (precedential).
6. Id.; Spirits Int’l, B.V. v. S.S. Taris Zeytin, 99 U.S.P.Q.2d 1545, 1547 (T.T.A.B. 2011) (precedential).
7. Id.
8. Rsch. In Motion Ltd., v. NBOR Corp., 92 U.S.P.Q.2d 1926, 1930 (2009) (precedential).
9. SmithKline Beecham Corp. v. Omnisource DDS, LLC, 97 U.S.P.Q.2d 1300, 1304 (T.T.A.B. 2010).
10. General Media Commc’ns, Inc. v. Imperia Holdings, Inc., Opposition No. 91227102, 33 TTABVUE 8 (T.T.A.B. 2018).
11. Rsch. In Motion, 92 U.S.P.Q.2d at 1930 (emphasis added).
12. Tasty Greens LLC v. Sylvio Campos, Opposition No. 91255119, 24 TTABVUE 33 (T.T.A.B. 2021).
13. See e.g., Boot Royalty Co. v. Shane Bieber, Opposition No. 91253331 (T.T.A.B. 2022); Justin Vineyards & Winery v. Fort Myers Brewing Co., Opposition No. 91249915 (T.T.A.B. 2020); Volvo TM Holding AB v. CKL Holdings N.V., Opposition No. 91241032 (T.T.A.B. 2020); Robert Bosch GMBH v. WGI Telecom Inc., Opposition No. 91225003 (T.T.A.B. 2020); Chicago Cubs Baseball Club, LLC v. Ronald Mark Huber, Opposition No. 91232736 (T.T.A.B. 2019) (finding an undated document with minimal content did not constitute documentary evidence).
14. LinkedIn Corp. v. Int’l Council for Educ. Reform & Dev., Opposition No. 91225285, 28 TTABVUE 13 (T.T.A.B. 2018).
15. Id., 28 TTABVUE 14.
16. Swatch AG v. M.Z. Berger & Co., Inc., 108 U.S.P.Q.2d 1463, 1473, 2013 WL 5655834, at *11 (T.T.A.B. 2013) (precedential).
17. Id.
18. Société des Produits Nestlé S.A., 2020 U.S.P.Q.2d at 10927, 2020 WL 4530518, at *15 (precedential) (citation omitted) (finding registration of domain names such as “nesport.com” and “nesport.net” by itself did not evidence a bona fide intent to use the mark NESPORT in U.S. commerce); The Saul Zaentz Company dba Tolkien Enterprises v. Joseph M. Bumb, 95 U.S.P.Q.2d 1723, 1727, 2010 WL 2783892, at *5 (T.T.A.B. 2010) (precedential) (finding registration of domain names such as “mithrilsilver.com, mithrilsilver.net, and mithrilsilver.org[,]” where the mark at issue was MITHRIL, was insufficient to establish bona fide intent given the absence of documentary evidence “relating to [defendant’s] adoption of or intent to use the MITHRIL mark in commerce.”).
19. A&H Sportswear Co. v. William W. Yedor, Opposition No. 91235843, 21 TTABVUE 11 (T.T.A.B. 2019).
20. Lincoln Nat’l Corp. v. Kent G. Anderson, Opposition Nos. 91192939, 91194817 (T.T.A.B. 2014).
21. Id., 61 TTABVUE 13–14.
22. A&H Sportswear Co., Opposition No. 91235843, at 12.

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23. L’Oreal S.A. et al. v. Marcon, 102 U.S.P.Q.2d 1434 (precedential) (emphasis added).
24. El Roblar Investment Property LLC v. Bianca Roe, Opposition No. 91272200, 2025 WL 2718983, at *29 (T.T.A.B. 2025) (precedential).
25. Id. at *30.
26. SmithKline Beecham Corp., 97 U.S.P.Q.2d at 1304; Rsch. in Motion, Ltd., 92 U.S.P.Q.2d at 1930.
27. Société des Produits Nestlé S.A., 2020 U.S.P.Q.2d at 10927, 2020 WL 4530518 (precedential).
28. Lane Ltd. v. Jackson Int’l Trading Co., 33 U.S.P.Q.2d 1351, 1357, 1994 WL 740491, at *7-*8 (T.T.A.B. 1994) (denying plaintiff’s motion for summary judgment of no bona fide intent to use the mark); Australian Therapeutic Supplies Pty. v. Naked TM, LLC, Cancellation No. 92056381, 148 TTABVUE 39, 44 (T.T.A.B. 2021) (denying petition to cancel registered mark based on lack of bona fide intent-to-use claim).
29. Market America, Inc. v. Luciano Sztulman M.D., Opposition No. 91224818 (T.T.A.B. 2018).
30. Id., 36 TTABVUE 1, 9.
31. Id., 36 TTABVUE 9.
32. Id.
33. Id.
34. Id., 36 TTABVUE 11.
35. Id., 36 TTABVUE 19.
36. Kate Spade LLC v. Wolv, Inc., Opposition No. 91241442, 70 TTABVUE 61-62 (T.T.A.B. Apr. 25, 2022).
37. Société des Produits Nestlé S.A., 2020 U.S.P.Q.2d at 10922, 2020 WL 4530518; Rolex Watch U.S.A., Inc. v. AFP Imaging Corp., 101 U.S.P.Q.2d 1188, 1198 (T.T.A.B. 2011) (precedential) (subsequently vacated on procedural grounds); Wet Seal Inc. v. FD Mgmt., Inc. 82 U.S.P.Q.2d 1629 (T.T.A.B. 2007); Hard Candy Cases, LLC v. Hard Candy, LLC, Opposition No. 91195328, at 18 (T.T.A.B. 2014) (precedential).
38. See Tiger Lily Ventures Ltd. v. Barclays Capital Inc., 35 F.4th 1352 (Fed. Cir. 2022), Wet Seal, Inc., 82 U.S.P.Q.2d at 1668; Dishoom Ltd., Opposition No. 91253283 at 7; Jerrick Ventures, LLC. V. Penthouse World Media, LLC, Cancellation No. 92063829, at 10 (T.T.A.B. 2020); Commodore Elec. Ltd., 26 U.S.P.Q.2d at 1507.
39. Lane, 33 U.S.P.Q.2d 1351, 1994 WL 740491, at *7.
40. Boston Red Sox, 88 U.S.P.Q.2d 1581, 2008 WL 4149008, at *7.
41. Tequila Cuadra S. De Rl De Cv v. Manufacturera De Botas Cuadra, S.A. De C.V., Opposition No. 91282327, 2025 WL 1431504, at *10 (T.T.A.B. 2025) (precedential).
42. See Sanders v. American Forests, 54 U.S.P.Q.2d 1860, 1999 WL 1713450, at *3 (T.T.A.B. 1999) (precedential); Hole in 1 Drinks, Inc. v. Michael Lajtay, Cancellation No. 92065860, 2018 WL 4358952, at *4 (T.T.A.B. 2018) (precedential).
43. Lincoln Nat’l Corp. v. Kent G. Anderson, Opposition Nos. 91192939, 91194817 (T.T.A.B. 2014); see also L’Oreal S.A., 102 U.S.P.Q.2d at 1445.
44. Lincoln National Corporation, Opposition Nos. 91192939, 91194817, at 41-43 (T.T.A.B. 2014).
45. Los Santos, LLC v. Johnny D. Gabriel & Rosalie Gabriel, 91223574 (T.T.A.B. 2019).
46. Volvo TM Holding AB v. CKL Holdings N.V., Opposition No. 91241032 (T.T.A.B. 2020); see M.Z. Berger & Co., 114 U.S.P.Q.2d at 1898.
47. Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC, Cancellation No. 92056381, 2021 WL 5983267, at *17 n.119 (T.T.A.B. Dec. 16, 2021).
48. See, e.g., Dishoom Ltd. v. Cheema Props. LLC, Opposition No. 91253283 (T.T.A.B. 2023); Sawstop, LLC v. Felder KG, Opposition No. 91255905, 2025 WL 2400134, at *20 (T.T.A.B. 2025) (precedential).

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