

Honda Motor Co. v. Winkelmann:
A Hard Stance Regarding the Bona Fide Intent to Use Requirement

April 14, 2009

On April 8, the U.S. Patent and Trademark Office Trademark Trial and Appeal Board (the Board) issued a precedential opinion denying trademark registration to a foreign trademark applicant on the ground that he lacked the requisite bona fide intent to use the applied-for mark in commerce for the goods identified in the application. *Honda Motor Co. v. Winkelmann*, Opposition No. 91/170,552 (T.T.A.B. 2009). The Board's decision in *Honda Motor* will be of interest to anyone filing a trademark application in the United States that requires a declaration under oath that the applicant has a bona fide intent to use the mark in commerce. This decision will also be of interest to parties to disputes involving such applications.

The Board's refusal to register the applied-for mark in *Honda Motor* came as the result of an opposition filed by Honda Motor Co. against Friedrich Winkelmann, who had applied to register the mark V.I.C. (Serial No. 76/587,840) for land, air, and water vehicles and parts for vehicles in Class 12. Winkelmann based his application for V.I.C. on Section 44(e), a provision of the Lanham Act that allows a foreign applicant to register a mark in the United States that has been registered in the applicant's country of origin without first showing actual use in the United States, so long as the applicant states under oath that the applicant has a bona fide intent to use the mark in U.S. commerce.

While the issue of bona fide intent has been addressed in a few Board decisions recently, *Honda Motor* is the first case involving a Section 44(e) application rather than a Section 1(b) "intent to use" application. It is also the first one decided in favor of the opposer that does not, on its face, have facts suggesting that the applicant was aware of the opposer's mark and intentionally selected a mark that was the same or similar.

In 2006, Honda Motor opposed Winkelmann's application, alleging a likelihood of confusion between V.I.C. and Honda's registrations for CIVIC. Following discovery, Honda amended its notice of opposition to add, as a basis for the opposition, Winkelmann's lack of a bona fide intent to use the V.I.C. mark in commerce for the goods listed in the application. Honda argued that Winkelmann failed to provide any objective evidence that he possessed the bona fide intent to use the V.I.C. mark at the time the application was filed (the operative date for determining the existence of a bona fide intent).

Specifically, Honda argued that that Winkelmann failed to provide any documentary evidence of intent such as current business plans, ongoing development discussions, promotional activities, or any other

objective corroboration of his claimed bona fide intent to use the mark in the United States. In support of its argument, Honda submitted Winkelmann's written responses to various Honda discovery requests, including interrogatory responses in which Winkelmann stated that he had no activities in the United States and had no business plan or strategy in place to transact business there. Honda also pointed out that Winkelmann failed to provide any adequate explanation as to why no such documentation existed. In response, Winkelmann argued that evidence of his bona fide intent could be demonstrated by his non-U.S. registrations (which he did not translate) and claimed use of the V.I.C. mark on a website in German (which the applicant also did not translate). Winkelmann also relied on statements of subjective intent submitted by his counsel, to which the Board gave little weight.

Agreeing with Honda, the Board granted summary judgment on the issue of applicant's lack of the requisite intent and refused registration on that basis. In reaching its decision, the Board stressed that an applicant's subjective claim of intent, without more, is not sufficient; rather, the focus of the analysis must be whether the evidence of record demonstrates an objective, good-faith basis for finding such intent. Absent documentary evidence of intent, an applicant is required to present other facts to explain or outweigh the absence of documentary evidence. In the current case, the Board found that applicant lacked any objective documentation or facts demonstrating an intent to use the mark in the United States at the time the application was filed.

The *Honda Motor* decision provides a strong warning to non-U.S. trademark applicants, whose home countries may have vastly different requirements regarding use of or intent to use trademarks as a prerequisite for registration. In addition, even though the Board's decision in *Honda Motor* concerned an applicant who relied on a foreign registration to support its U.S. filing, the Board specifically noted that the same objective, good-faith standard applies to any party filing a trademark application based on a bona fide intent to use.

As with other applicants in the recent cases on this issue, the applicant in *Honda Motors* offered no objective evidence demonstrating an intent to use the mark in the United States in conjunction with the goods listed in the application. The Board's decisions have therefore provided limited guidance regarding how much and the specific nature of evidence that the Board will require to support a claim of bona fide intent, so that remains an open question. It is clear, however, that any trademark applicant filing under any section of the Lanham Act that requires an asserted bona fide intent to use must be diligent in making sure that, if challenged, it will be in a position to provide objective evidence in support of its intentions to use the applied-for mark. A subjective intent, absent documentation or other corroborating evidence, will not be sufficient to withstand a challenge.

If you have any questions regarding this issue and its impact on trademark prosecution or litigation strategy, then please contact any of the following Morgan Lewis attorneys:

San Francisco

Carla B. Oakley

415.442.1301

coakley@morganlewis.com

Washington, D.C.

Anita B. Polott

202.739.5397

apolott@morganlewis.com

Kristin H. Altoff

202.739.5093

kaltoff@morganlewis.com

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