



IP LAW ADVISORY

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Common Trademark Application Mishaps and How to Avoid Them

By Lisa E. Winsor, Esq. and Thomas J. McGinnis, Esq.

Deal with trademarks just infrequently enough to be dangerous? Then tuck away this *LL-A IP LAW ADVISORY* for safe-keeping. It may help you avoid blunders that, judging from recent Trademark Trial and Appeal Board (TTAB) decisions, others encounter all too often.

Identify the true trademark owner... or else.

Fail to identify the true trademark owner and your application may be void. So says a long line of legal authority, including Federal regulations and TTAB decisions.

Take a recent TTAB case for example. In *Tracie Martyn, Inc. v. Artman*, Tracy Artman filed an application to register the mark TRACY'S TREATS NATURAL PRODUCTS FOR REMARKABLE SKIN for various soaps and related products. Unfortunately, she admitted in her answer to an opposition that Tracy's Treats, Inc. was the owner of the mark. She is the President of Tracy's Treats Inc., but filed the application in her own name. The TTAB held her application void because the company, not Tracy Artman the individual, was the owner of the mark when the application was filed.

While some errors in identification are remediable by amending the application – for example a typographic error in the name of the owner – others are not. If

your application includes a non-correctable error in identification, you have but one avenue to remedy the situation: file a new application. So better to get it right the first time.

Make sure to submit a proper specimen of use.

More often than anyone would care to admit, a specimen may not constitute proper use of the mark for the goods and/or services identified in the application. One way to run afoul of the specimen requirement is to provide advertising material or fact sheets when a trademark is involved. The safest bet is to provide a specimen showing the mark on the goods or on packaging for the goods. Advertising materials do not work for a trademark application.

For a service mark, make sure the specimen shows some direct association between the mark and the services. In *In re wTc Corporation*, a return shipping label was found inadequate to show use of a service mark because it did not refer to the services being offered. Acceptable specimens for service marks may include brochures and computer screen shots.

While checking your specimen of use, you can also avoid another trouble spot. Make sure that the mark is being used on

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all the goods and services included in the application. If you find that the mark has not been used on some of the goods or services, delete them before filing, or you may jeopardize the validity of any registration that issues.

Submit a specimen of the mark that matches the application drawing.

Now this point may seem a bit obvious, but a specimen may be rejected if the mark on the specimen does not match the drawing in the application. If the difference is inconsequential, the specimen will be accepted. However, whether a mark shown in a drawing is a substantially exact representation of the

mark shown in the specimen is a subjective determination, and you do not want to fall on the wrong side of the line. In *In re wTc Corporation*, a stylized "C" which could be interpreted as an "O" or a "C" resulted in the Examining Attorney's rejection of the specimen as not matching the mark on the drawing for the mark "SPECTRAMET." Fortunately, on appeal the TTAB found the stylized mark not to be a significant variation of the word mark in the drawing.

If you would like to discuss these issues, you may contact Lisa Winsor at LWinsor@LL-A.com or Thomas McGinnis at TMcGinnis@LL-A.com.