

ALERT

SYNOPSIS OF RECENT TRADEMARK-RELATED COURT DECISION

Posted: February 27, 2017

**BORN UNDER A BAD SIGN: USE OF A MARK ON A DOOR SIGN
– WITHOUT MORE – NOT SERVICE MARK USAGE**

The Trademark Trial and Appeal Board has found that the use of a mark on the front door of a business location – without any references to the services being offered inside - does not constitute a valid service mark usage for the purposes of registration. *In re Republic National LLC*, Serial No. 86513101 (February 23, 2017) [not precedential]. There must be some reference to services used in conjunction with the mark sufficient to associate the mark with the services being offered.

Applicant sought to register REPUBLIC NATIONAL for various real estate services. For its service mark specimen, Applicant submitted digital photographs showing use of the mark on the front door of the business: (See below)



There was nothing on the door that described or referenced the services being offered inside.

The Trademark Examining Attorney refused registration under Sections 1 and 45 of the Trademark Act (15 U.S.C. §§ 1051 and 1127) finding the specimens failed to show use of the mark in connection with the identified services.

The Board affirmed.

(continued)

As the Board found, an acceptable service mark specimen must create “some direct association” between the services and the mark sought to be registered. Specimens consisting of business signs or advertising must, in some way, reference the nature of the services to create that association. A sign on the front door of a business establishment that merely displays a mark with no association to the services is not enough. This does not mean there must always be an explicit reference to the services but there must at least be “something that creates an association in the mind of the purchaser between the mark and the service activity.” (Supporting citations omitted).

It is not entirely clear what that means but it was clear to the Board that it wasn’t happening here.

Applicant argued its existing customers would recognize REPUBLIC NATIONAL as displayed on the door as identifying the services provided on the other side of the door. As a practical matter, Applicant’s existing customers undoubtedly did have knowledge of Applicant’s services and the sign did tell them the location of those services. But that is not enough, the Board found, to create a sufficient association or “proximity” with the mark.

Taking a somewhat longer and more technical view, the Board also noted that Applicant’s argument does not resolve the question of whether *potential* consumers would associate the mark with the services. In answering that question in the negative, the Board concluded a [hypothetical] potential consumer could not immediately identify the services at issue upon seeing the REPUBLIC NATIONAL mark on the door.

Thus, the use of the mark on a sign – without more – may indicate the location of a business and may even be an trade name usage (trade names are not entitled to registration under US trademark law) but it is probably not a service mark usage for the purpose of supporting a service mark application.

This is not an entirely uncommon problem with service mark specimens. But there is often a simple solution. Care should be taken to insure that the service mark specimens in some way describe or reference the services offered.

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