In a precedential decision, the Trademark Trial and Appeal Board (TTAB or Board) sustained a petition filed by City National Bank (City) to cancel a registration for the trademark TREASURYNET owned by OPGI Management GP Inc./Gestion OPGI Inc. (OPGI). City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc., Cancellation No. 92050730 (T.T.A.B. Apr. 26, 2013).

As grounds for cancellation, City alleged that OPGI both lacked the required bona fide intent to use the mark in commerce at the time of filing and abandoned the mark because it failed to use the mark in commerce in the United States.

OPGI obtained a U.S. trademark registration for TREASURYNET under Section 44(e) of the Trademark Act based on a Canadian registration of the mark for providing financial information via a global computer network. OPGI used the name to identify an intranet website database used by its employees to access information necessary for the performance of their jobs. Third parties were not allowed directly to access information in the TREASURYNET database, and OPGI did not advertise its services to others under the TREASURYNET mark.

The TTAB stated that, in determining whether a mark is used in commerce for a service, the controlling question is who primarily benefits from the activity for which registration is sought. If the activity primarily benefits the applicant, and not others, it is not a registrable service, even if others derive an incidental benefit. The Board distinguished cases in which programs targeted toward employees provided the employees with a valuable benefit useful outside of their employment and, therefore, satisfied the "benefit of another" test. It found that OPGI employees acquired no such benefit from TREASURYNET.

Under Section 45 of the Trademark Act, a mark is deemed to be abandoned, and its registration is subject to cancellation, when its use has been discontinued with the intent not to resume such use. Non-use for three consecutive years constitutes prima facie evidence of abandonment. The TTAB concluded that OPGI had not used TREASURYNET as a mark in commerce for the recited services since the 2007 date of registration and that, consequently, OPGI had abandoned its mark.

The TTAB granted the petition to cancel the TREASURYNET registration on grounds of abandonment. Because the Board found that OPGI had abandoned its mark and cancelled the registration, it did not address the issue of whether OPGI lacked a bona fide intent to use the mark at the time the application was filed.

Although every effort has been made to verify the accuracy of items in the INTA Bulletin, readers are urged to check independently on matters of specific concern or interest.

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