UNIVERSAL STATES: Advertising Alone Does Not Constitute Use of Service Mark

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In a non-precedential decision, the Trademark Trial and Appeal Board (TTAB or Board) granted a petition filed by Playdom, Inc. to cancel a registration owned by David Couture for the service mark PLAYDOM on the ground that Couture had not actually used his mark in commerce at the time he filed a use-based application with the U.S. Patent and Trademark Office (USPTO). Couture’s registration had been cited by the USPTO as a bar to registration of the same mark by Playdom for related services. Playdom, Inc. v. Couture, Cancellation No. 92051115 (T.T.A.B. Feb. 3, 2014).

On May 30, 2008, Couture filed a use-based application under Section 1(a) of the Trademark Act to register the mark PLAYDOM for certain entertainment and educational services in Class 41, which included film concept and script development. He alleged that he was using the mark in commerce at the time the application was filed. The mark was registered on January 13, 2009 (Reg. No. 3560701).

The facts showed that at the time he filed his application, Couture was advertising his services and stood ready, willing and able to provide those services. He did not, however, acquire his first customer and actually render any of the services covered by the registration until approximately two years after his application was filed. Couture asserted that his advertising of the services combined with his ability and willingness to render them constituted use in commerce.

In evaluating whether Couture had satisfied the use-in-commerce requirements of Section 1(a), the TTAB turned to Section 45 of the Trademark Act, which provides that a mark is used in commerce “on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State.”

The Board confirmed that, under Section 45, the mere display of a mark in the advertising or promotion of services is insufficient to constitute use of the mark in commerce within the meaning of the Trademark Act. It explained that the statute requires not only the display of the mark in advertising but the actual rendering of the services covered for the registrant’s use to constitute use in commerce.

The TTAB concluded that Couture had not used the PLAYDOM mark for the identified services at the time his application was filed with the USPTO and that he had inappropriately filed his application alleging actual use of the mark in commerce.

Accordingly, the Board granted Playdom’s petition for cancellation and held that Couture’s registration was void ab initio.

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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