



TECH LAW
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It's Apparent that Trademark Shops Have Trouble Applying for Apparel Registrations

The apparel business is a big business– and it's growing. As of today, there are 70,262 pending U.S. federal trademark applications or active trademark registrations for goods and services connected to "apparel." And as e-commerce sites like Shopify, Etsy, and others continue to provide everyday entrepreneurs with the ability to launch a business and sell their own products, the number of t-shirt and other apparel businesses is skyrocketing.



Ser. No. 90065378 – "Plutocracy"
filed using trademarkengine.com

And if you're like many of those sellers, you're probably thinking that you need to secure some trademark protection for your new business. Perhaps you started where many people do...with a simple google search: "trademark application services" or "trademark application services for clothing business." If so, you'll find several results for trademark filing services who offer trademark application filings for as low as 99 dollars. The catch? Most of these services do not use trademark attorneys to prepare and file the application, and some, are even a "DIY" process-where you fill out the application yourself, and they merely transmit it to the United States Patent and Trademark Office (USPTO). Essentially, these "firms" are being paid to act as a middle man, without any thought or consideration

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for the legal implications of your trademark application. And here's what that is problematic....especially for clothing brands.

Trademark applications are examined by the USPTO, and one of the things that is required before a trademark registration issues is that the trademark be used in commerce. To show the USPTO this use in commerce, you have to submit a specimen, which is evidence of your use. And if you're a clothing brand, you may think that showing a picture of a shirt with your name or slogan on it is good evidence of that use. And a trademark filing firm that doesn't use an experienced trademark attorney to prepare your application might also think (and often do think) this is good evidence to show use. This is usually wrong—and the USPTO will reject your application for it.

A search of the USPTO federal trademark database returns a number of rejected applications that have what is called an “ornamental refusal,” which means the USPTO has rejected registration of the mark because the applied-for mark as used on the specimen is “merely a decorative or ornamental feature of the applicant's clothing and, thus, does not function as a trademark to indicate the source of applicant's clothing and to identify and distinguish applicant's clothing from others.” The following are examples of specimen from apparel-related applications that were refused on grounds that the use was merely ornamental:

And while this problem arises fairly often for t-shirts or other apparel items, ornamental refusals are not limited to these types of products. Here are some other example applications where registration was refused on the ground the specimen showing use of the mark was merely ornamental:

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For example, an application for registration of “I LOVE YOU” used in connection with bracelets (left) was rejected by the USPTO because the specimen showed a term of endearment (“I LOVE YOU”) that did not identify and distinguish the source of the bracelet, but rather that made up the entire bracelet itself. Registration refused.

Similarly, on an application for registration of “But First Wine” used in connection with tumblers, wine glasses, etc. (right), the USPTO found that the applicant’s use of the slogan on the product was ornamental and did not function as a mark.



No matter what your products are, when an ornamental refusal is issued in your application, the USPTO will send a notice of this rejection and if you filed your application alone, used a cheap filing service, or used an attorney who is not experienced in trademark law, you may end up losing your application altogether if a proper response fixing the issue is not submitted.

An experienced trademark attorney, on the other hand, will know how to avoid these ornamental refusals from the start, or if it comes to it, will know how to fix the issues that lead to the refusal. An experienced trademark attorney would know, for example, that not everything on the front of a clothing item will fall into the “merely ornamental” category of refusal. That is, an experienced trademark attorney knows that while a slogan prominently displayed on the front of a T-shirt is likely to be refused for being merely ornamental, a mark used on a sleeve or pocket of that same shirt may be sufficient to show the required use. In other words, an experienced trademark attorney understands that the significance of the mark based on its size and location may be a

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Ser. No. 88956440 – “Team Fat Kid”
filed using trademarkengine.com



Ser. No. 88836113
filed directly by owner

consideration in determining whether the use of the mark on the shirt itself is trademark use or merely ornamental use. Unfortunately, we also know that there's no precise answer to when such use is sufficient evidence of use and when it's merely ornamental, and that we must give your particular situation the individual attention you deserve.

Like a lot of things—a little effort at the beginning can save a lot of headache, and heartache, down the road. Our trademark attorneys have filed hundreds of federal trademark applications, including many for apparel related goods and services. We know what evidence is good evidence of use and how to put your application in a good position for registration. That's because we not only know trademark law, but we also work to know your business. We do the upfront work to determine whether your use is evidence acceptable by the USPTO, and if we don't think it is, then we can tell you how to fix it. Trademark law is about protection who you are. Who you are is what we do, and we're ready to work with you.