US: TRADE MARKS

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Don't delay filing intent-to-use applications

The US Patent and Trademark Office's Trademark Trial and Appeal Board (TTAB) issued a decision in January in *Blast Blow Dry Bar v Blown Away d/b/a Blast Blow Dry Bar* which highlighted the importance for new businesses to seek protection of a mark that they plan on adopting as early as possible.

The applicant, an entity based in Minnesota called Blown Away d/b/a Blast Blow Dry Bar, had filed a trade mark application on an intent-to-use basis on December 10 2011 for the mark Blast Blow Dry Bar covering hair salon services. Absent a showing of an earlier date of first use, the date on which an applicant files an intent-to-use-based application serves as the applicant's priority date. This application was opposed by an entity in Texas called Blast Blow Dry Bar which claimed priority based on limited use of the Blast Blow Dry mark in connection with hair salon services commencing on December 8 2011, just two days earlier.

Although the opposer had only provided its hair salon services to four customers and had done so free of charge, the TTAB ruled that such limited use still constituted "use in commerce" for purposes of determining priority. Specifically, the TTAB held that services did not need to be sold in order to be categorised as a use in commerce, noting that the use of a mark "in conjunction with the rendering of free services still constitutes a use in commerce under the Trademark Act".

While rendering services to only four customers is often considered to be too limited to establish use of a mark, the TTAB took the position that it constituted use in the case at hand in view of the low cost and limited nature of the parties' hair styling services, the local nature of the businesses, and the fact that the opposer was paid for offering the services to a larger number of customers shortly thereafter and then continued to use the mark in commerce.

Interestingly, the applicant had claimed to be using the mark at issue on December 8 as well but the TTAB found an integral distinction between the applicant's use and the opposer's use. While the opposer offered limited services on December 8, the applicant merely advertised hair salon services that day but did not actually perform any hair styling on that date. Therefore, the TTAB held that the opposer had priority, sustained the opposition and refused registration of the applicant's mark.

Although the opinion in *Blast Blow Dry Bar* is not citable as TTAB precedent, the decision serves as an integral reminder to brand owners of the importance of proceeding with filing an intent-to-use-based trade mark application – and thereby reserving rights to a mark – as soon as they have decided to adopt a particular mark. Had the applicant filed its trade mark application when it first decided to adopt the mark, form a company and secure a lease for its salon, all of which was done before opposer's December 8 first use date, the determination of priority would have been different. Delaying the decision to file an application, even by a few days, can result in a loss of priority and the inability to obtain the advantages conferred by ownership of a federal trade mark registration.