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US Trademark Briefing

Four precedents from June to September 2026, with the marks as filed, and one page on what the USPTO does

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Each decision is a precedent of the Trademark Trial and Appeal Board. The mark images are the drawings on file at the USPTO; each panel links to the decision.

APPLIED FOR

TOUCH MOBILE

TOUCH MOBILE, Serial No. 98231457, standard characters; phones (Class 9) and telecom services (Class 38), among others; Sections 1(b) and 44(e)

refused over

CITED REGISTRATION

MOBILE TOUCH

Reg. No. 4224659, standard characters; text messaging services among others

TTAB · 23 JUNE 2026 · EX PARTE APPEAL

USPTO won

A lapsed Section 44(e) registration gives the new application nothing

In re TextNow Inc., Serial No. 98231457

WHAT HAPPENED

TextNow, a Canadian company, had registered TOUCH MOBILE in 2017 under Section 44(e) on its Canadian registration. No Section 8 declaration of use was filed, so the registration was cancelled. Its new application for the same mark drew a Section 2(d) refusal over MOBILE TOUCH in Classes 9 and 38. The Board affirmed: the cancelled registration gave no benefit; the years the two marks sat together on the register meant nothing, because nothing showed TOUCH MOBILE had ever been used in the United States; the examiner's earlier approval was not a prior adjudication; and the two words transposed carry the same meaning. The same classes were also refused as indefinite, because the applicant would not amend the goods to keep them identical to the old registration.

BEFORE YOU FILE

Calendar Section 8 (or Section 71 for a Madrid registration) the day a US registration issues, and tell the client that a registration with no US use is lost at year six. Do not hold an identification indefinite to match an old registration; the examiner's wording wins.

Decision (USPTO PDF)

APPLIED FOR

O EL CIELO VALLE DE GUADALUPE

Serial No. 97425137, standard characters, VALLE DE GUADALUPE disclaimed; wine

opposed by the owner of

OPPOSER'S REGISTRATION

CIELO

Reg. No. 2384406, standard characters; wines, sold in the US since 1978

TTAB · 3 SEPTEMBER 2026 · OPPOSITION

Opposer won

A place name added to someone else's word is still that word

Cielo e Terra, S.p.A. v. Hoteles y Viñedos del Valle de Guadalupe S.A. de C.V., Opposition No. 91287216

WHAT HAPPENED

A Mexican resort applied for O EL CIELO VALLE DE GUADALUPE for wine; an Italian winery opposed on CIELO. The goods were identical, so channels and buyers were presumed the same. CIELO was found of average strength, and the applicant's weakness evidence (cancelled registrations, an abandoned application, SKY registrations, six composite registrations and five website uses) fell short of the "voluminous" use the Board requires in the vast US wine market. EL CIELO was the dominant part of the applied-for mark, the O meaningless and VALLE DE GUADALUPE disclaimed, and the Board found it "probably inevitable" that buyers ordering by name would shorten the mark to El Cielo. Opposition sustained.

BEFORE YOU FILE

Search the English equivalent of a foreign word as well as the word itself. If the plan is to argue that the cited mark is weak, collect third-party uses with US reach before filing, not screenshots after the refusal. An article or a place name creates no distance for identical goods.

Decision (USPTO PDF)

Also in this issue. Page 2: who owns the mark when an employee brought the idea, and when a stripe pattern is only decoration. Page 3: the life of a US registration, what the examining attorney checks, who can reopen a file, and how the Board weighs confusion.

Who owns the mark, and when a pattern is only decoration

Two more precedents of the Board from the same months.

APPLICANT'S APPLICATION



Serial No. 90387461, filed 16 December 2020 in the associate's own name; BIRTH JUSTICE disclaimed; legal services

opposed by the firm, which filed

OPPOSER'S APPLICATION



Serial No. 97062312, filed 6 October 2021 by the firm

TTAB · 10 SEPTEMBER 2026 · OPPOSITION

Opposer won

The associate had the idea; the firm owned the mark

Olsman, MacKenzie, Peacock & Wallace, P.C. v. Emily Grace Thomas, Opposition No. 91272167

WHAT HAPPENED

The associate conceived the brand, sketched it and registered the domain name before joining the firm. The firm paid the designer who finished the logo, and the first use was on her firm business cards at a conference. While still employed, she applied in her own name. The Board held that inventing a symbol or registering a domain creates no trademark rights; rights come from use, and the first use inured to the employer because it promoted the firm's services. An implied-licence theory that was never pleaded was not considered. The application was void for non-ownership, so the fraud and likelihood of confusion claims were not reached.

BEFORE YOU FILE

Confirm who controls the services and whose use the first specimen shows. When a founder or employee brings a mark into a company, document ownership before the US filing; an application in the wrong name cannot be corrected by amendment or assignment (37 C.F.R. § 2.71(d)).

Decision (USPTO PDF)

APPLIED FOR



Serial No. 90302728, repeating blue and white vertical stripes, colours claimed; frozen desserts, drinks, restaurant and franchising services (six classes), Section 2(f) claimed in the alternative

TTAB · 25 JUNE 2026 · EX PARTE APPEAL

USPTO won

A stripe pattern is ornamental until the 2(f) file says otherwise

In re Ralph's Famous Italian Ices Franchise Corp., Serial No. 90302728

WHAT HAPPENED

On a large record of third-party stripes on ice cream shops, restaurants and drinks, the Board found the pattern to be ornamentation in every class. The Section 2(f) claim failed: the five-year declaration did not say "substantially exclusive", press coverage never mentioned the stripes, sales and advertising figures lacked market context and were not split by class, there was no "look for" advertising, and photographs of foreign shops did not count. One reversal: a franchisee portal log-in page, with a declaration explaining it, was an acceptable specimen for franchising services.

BEFORE YOU FILE

For a colour or pattern mark, build the 2(f) file first: "look for" advertising, a survey, class-by-class figures with market share, and a declaration in the statutory words. Use outside the United States counts only if US consumers saw it.

Decision (USPTO PDF)

Also decided

1. **In re Wemby Corporation** (TTAB, 24 June 2026): WEMBY for sportswear refused under Sections 2(a) and 2(c) as basketball player Victor Wembanyama's nickname, after a letter of protest; the application predated his draft, but evidence arising during examination counts (In re Foster, Fed. Cir. 2025). PDF
2. **International Medical Devices, Inc. v. Cornell** (Fed. Cir., 17 April 2026): advertising "Penuma" surgeries without the mark owner's permission was counterfeiting; $1 million in statutory damages affirmed. PDF

What the USPTO does, on one page

The life of a US registration, what the examining attorney does, who can reopen a file, and how the Board weighs confusion. Section numbers are to the US Trademark Act.

The life of a US registration

1 Filing

Basis: use (1(a)), intent to use (1(b)), a home registration (44(e)) or a Madrid designation (66(a)). An applicant domiciled abroad must have a US-licensed attorney (37 C.F.R. § 2.11(a)).

2 Examination

Office action to be answered in 3 months, plus one paid 3-month extension (since 3 Dec 2022). A 66(a) designation keeps 6 months. A 66(a) basis cannot be changed (37 C.F.R. § 2.35(a)).

3 Publication

30 days for an opposition, extendable. Letters of protest can arrive before this point.

4 Registration

A 1(b) applicant must first file a statement of use with a specimen. 44(e) and 66(a) applicants register without US use.

5 Years 5 to 6

Sworn declaration of use with a specimen for every item (Section 8; Section 71 for Madrid). Unused items are deleted; a missed filing cancels the registration. This is where 44(e) and 66(a) registrations without US use end.

6 Year 10, and every 10 after

Renewal with a declaration of use (Sections 8 and 9). Madrid: a Section 71 declaration at the USPTO plus renewal of the international registration at WIPO.

What to expect from the examining attorney

Earlier marks

The examiner searches and refuses under Section 2(d) without any opposition. The refusal is argued in the Office action, then at the Board on appeal.

Goods and wording

No class headings. Every item must be definite (the ID Manual sets the wording) and can be narrowed, never broadened. Descriptive words in the mark must be disclaimed (Section 6).

The specimen

Goods: the mark on the product, its packaging, or a web page showing the goods with a way to order them. Services: advertising that shows the mark with the services. Mock-ups and altered images are refused.

The clock

Three months to answer, six for a Madrid designation. A missed deadline abandons the application; revival is possible only within two months of the notice of abandonment, for a fee.

Who can reopen a file after examination

Letter of protest

Anyone, during examination: evidence of an earlier mark or descriptiveness handed to the examiner. One started the WEMBY refusal.

Post-registration audit

The USPTO, since 2017: a sample of Section 8 and 71 filings is asked for proof of use on more items; unproven items are deleted.

Expungement

Anyone, since December 2021: the registered mark was never used for some or all of the listed goods. The registration loses those items or falls.

Reexamination

Anyone, since December 2021: the mark was not in use by the relevant date (the Everwise registration, April 2026, fell this way on a website tagline).

Confusion, as the Board weighs it

The marks

Look, sound and meaning, judged by the dominant word. Disclaimed words, single letters and place names weigh little, and long marks are assumed to be shortened in speech.



The goods

Compared as written in the application and the registration, not as sold. Identical wording means identical goods, presumed to travel the same channels to the same buyers.

Weakness is proved with use. Third-party registrations show at most that a word is suggestive; only third-party use in the US market shows commercial weakness, and a handful of examples is not enough.

Foreign words are translated. Under the doctrine of foreign equivalents a word in a common modern language is usually compared through its English meaning, for confusion and for descriptiveness.

About this briefing. Written from the decisions themselves (public records of the USPTO and the courts); mark images are the drawings on file at the USPTO. General information for trademark professionals, not legal advice on any matter; reading it creates no attorney-client relationship. Attorney advertising. To receive no further issues, reply "stop".

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