

## Trademark Law Alert

### Who can object to a Trademark Registration?

May 19, 2020

By [Joel Karni Schmidt](#)

The Trademark Trial and Appeal Board (“TTAB”) in a precedential decision has indicated what may be the outer limits of standing to oppose a trademark application or to cancel a trademark registration.

After Cingular Wireless LLC changed its name to AT&T Mobility LLC and marketed itself under the AT&T name and logo, another company filed intent to use applications to register the term CINGULAR in standard characters, and also in combination with a logo and with the disclaimed word “wireless,” for a large list of goods relating to cell phones.



AT&T Mobility LLC opposed these applications on various grounds, the principal one being that Applicant’s marks would create a false suggestion of a connection with Opposer.

Applicant asserted that Opposer had abandoned its mark, among other defenses, one of which was that Opposer lacked standing to oppose because it did not use the mark at issue. The TTAB agreed to decide the standing issue before the others.

#### The Law

The Trademark Law provides that a trademark opposition may be filed by “[a]ny person who believes that he would be damaged” by registration of the mark, Section 13 (a), 15 U.S.C. §1063 (a), and that a trademark cancellation may be filed by “any person who believes that he is or will be damaged” by registration of the mark, Section 14, 15 U.S.C. §1064.

To establish standing, an opposer has to prove that it has a “real interest” in the proceeding beyond that of a “mere intermeddler” and a “reasonable basis” for its belief of damage.

In this case, the TTAB held that Opposer had met this standing requirement even though neither Opposer nor its subsidiaries were continuing to use the term CINGULAR as a trademark.

#### The Facts

Opposer’s initial name had been Cingular Wireless LLC, and it had offered wireless telecommunications goods and services under a combination mark identical to that for which Applicant applied. Opposer purchased AT&T Wireless Services, Inc., started co-branding the Cingular and AT&T names and logos to educate the public that they were now part of the same company, and legally changed Opposer’s name to AT&T Mobility LLC. Opposer then began marketing itself solely under the AT&T name and logo.

The evidence established that, after various corporate ownership and name changes, Opposer, owns a majority interest in a direct subsidiary that is the sole owner of an indirect subsidiary named New Cingular Wireless PCS, LLC (New Cingular). New Cingular uses the name “Cingular” in its corporate name, and in over 8,000 active FCC

wireless licenses, 20 spectrum leases, 270 active antenna structure registrations, contracts with wholesale wireless customers, and leases with property owners.

Applicant argued that Opposer's "public-facing" business with wireless retail customers was conducted only under the assumed name AT&T Mobility, and that the trade name uses by Opposer's indirect subsidiary did support Opposer's standing.

### **The Decision**

The TTAB did not define "public" so narrowly, finding that the contracts, leases, and licenses were in the wireless communications field where Opposer and Applicant were would-be competitors. Further, the TTAB held that, in the context of a false suggestion of a connection claim, standing does not require proprietary rights in a term; rather, standing relates to the plaintiff's "persona." The TTAB saw no categorical legal bar precluding a plaintiff in a TTAB proceeding from claiming a false suggestion of a connection with its trade name, and it held that the parent corporation of an indirect subsidiary "can reasonably believe that damage to the subsidiary will naturally lead to financial injury to itself."

Thus, the TTAB upheld Opposer's standing and ordered the parties to proceed with discovery, briefing and trial on the merits.

***AT&T Mobility LLC v. Mark Thomann and Dormitus Brands LLC***, Opposition No. 91218108 (T.T.A.B. 2020).

### **Takeaway**

Normally, a complainant has standing because it is using, or may wish to use, the term at issue as a mark for goods or services.

But this AT&T decision suggests that standing also may be recognized by the TTAB even though:

- The term is being used only as part of a company name, not as a mark.
- The term is being used only as the name of a direct or indirect subsidiary of the complainant, not by the complainant itself.
- The term appears only in the subsidiary's contracts, leases and licenses in the field at issue, not in connection with goods or services coming from the complainant or subsidiary.

For further information, contact [Joel Karni Schmidt](#) or your CLL attorney.

### **[Joel Karni Schmidt](#)**



### **Partner**

[Email](#) | 212.790.9244

Joel handles U.S. and international intellectual property counseling, protection and enforcement matters.

His clients include lifestyle and fashion companies, start-ups, hotels and restaurants, financial services firms, wine and food companies, game publishers, a major sports organization, global charitable organizations and foundations, and prominent artists and designers.