

Use requirement not met without actual offering of services

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Cancellation
National procedures

In [Aycock Engineering Inc v Airflite Inc](#) (Case 08-1154, March 30 2009), a split panel of the US Court of Appeals for the Federal Circuit has upheld a decision to cancel a 35-year-old registration for the mark AIRFLITE for “arranging for individual reservations for flights on airplanes” on the grounds that the registrant had never used the mark.

In the late 1940s William Aycock conceived the idea of offering a service that would connect individuals desiring to charter flights with air taxi operators. Aycock intended to serve as a middleman between customers and air taxi operators. From the mid-1960s and onward, Aycock took steps to carry out his plan, including:

- forming Aycock Engineering Inc as the corporate entity to operate the service;
- obtaining toll-free telephone numbers that the public could use to schedule reservations;
- inviting virtually all certified air taxi operators to join his operation and actually entering into contracts with some of them; and
- filing and registering the trademark AIRFLITE for his service, which was the mark that he had used in advertising to air taxi operators.

However, Aycock’s operation never got off the ground, largely due to the lack of participation by a sufficient number of air taxi operators. His toll-free numbers were never used to book flights and not a single flight was ever arranged. Aycock never marketed his service to the general public.

In 2001 [Airflite Inc](#) initiated cancellation proceedings against the AIRFLITE mark on the basis that Aycock had never used the mark in connection with the services identified in the registration. The cancellation proceedings lasted six years, with the [Trademark Trial and Appeal Board](#) (TTAB) ultimately granting the cancellation petition in favour of Airflite. Aycock appealed.

The central issue on appeal was whether the steps taken by Aycock to carry out his plan satisfied the use requirement for federal registration. In resolving this issue, the court first defined what the service of “arranging for individual reservations for flights on airplanes” should entail. The TTAB construed it to mean operating a system to book flights, and not just setting up a network of air taxi operators. Aycock argued that the mere arranging of a network of air taxi operators should suffice. In siding with the TTAB, the court found Aycock’s interpretation to be contradicted by the prosecution records of his application, including his own representations.

The court next addressed whether Aycock had made sufficient use of the mark for federal registration purposes. Given that Aycock’s application was filed in 1970, the court looked to the use requirement that appeared in the [Lanham Act](#) in 1970. The act stated that a service mark was in use in commerce 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 or in this and a foreign country, and the person rendering the services is engaged in commerce in connection therewith."

Citing TTAB precedent, the court described the statutory use requirement as requiring more than:

- the mere adoption (selection) of a mark accompanied by preparations to begin its use; or
- the mere advertising or publicizing of a service that the applicant intends to perform in the future.

Rather, the court observed, there must be at least an open and notorious public offering of the services to those for whom the services are intended. It was the lack of such a public offering or rendering of his service that proved to be fatal to Aycock's claim. According to the court, Aycock had engaged only in preparatory activities towards his plan to operate a flight-arranging service, which were insufficient to support registration.

In her dissent, Judge Newman questioned the propriety of invalidating a registration based on a flawed service description when the registration was unchallenged for decades.

This decision demonstrates the importance of fully understanding and complying with the statutory use requirement relating to trademark and/or service mark applications. It also highlights the importance of describing accurately one's products or services in a trademark and/or service mark registration. An inaccurate description can render the resulting registration vulnerable to attacks by others.

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