Check Trademark Application ID Categories Twice, File Once

Fender Musical Instruments Corp. v. Win-D-Fender, LLC, Case No. 91272326

(Jan. 12, 2023)

By: Mike Bregenzer & Alexa Tipton | January 23, 2023

On January 12, 2023, the Trademark Trial and Appeal Board ("TTAB") redesignated a decision as precedential, in which it denied a trademark based on nonuse because the Applicant applied using the TEAS Plus application under the category of "musical instruments," but sought to expand this identification category to "musical accessories" with an amendment to the application.

More specifically, Win-D-Fender ("Applicant") applied for a federal trademark in "En-D-Fender" based on its use in commerce within International Class 15—"musical instruments." Fender, a guitar manufacturer, who already has a registered trademark in "Fender" for "musical instruments" in International Class 15, filed a notice of opposition to registration of the mark on the grounds of nonuse, likelihood of confusion, and dilution by blurring. Applicant then sought to amend its identification of goods from "musical instruments" to "musical instrument accessories."

When using the TEAS application (trademark electronic application system), only the goods and/or services listed in the proper identification ID field will be considered part of the identification. The instructions noted that if the ID Manual does not contain an accurate listing for the goods, an applicant must use the TEAS Standard filing option, which is $100 more than the Plus application, to create his own ID using his own words. However, the TEAS Plus application did not contain a "musical accessories" category. Instead, Applicant, using the cheaper TEAS Plus application, chose the "musical instruments" category and submitted a miscellaneous statement explaining that the correct category was "For Musical Instrument Accessories namely a wind guard mounted to a flute."

The Board found that although an applicant can *limit* its identification of goods after filing, the Applicant's proposed amendment *expanded* the scope of the original identification since, by definition, an "accessory" is not an "instrument." Thus, the Board rejected Applicant's motion to amend its identification of goods, found that Applicant should have used the TEAS Standard application which would have allowed the input of the correct category of "musical accessories," and determined that due to the incorrectly identified category, there was no use of the mark "En-D-Fender" in commerce. Applicant will now have to file a TEAS Standard application and reincur the costs of the application and the time waiting for an approval.

Notably, the trademark application was filed by the managing director of Win-D-Fender, not an attorney experienced in trademark prosecution. This serves as a warning to those seeking to obtain trademark registrations: it is best to have an experienced attorney review the application prior to filing.