

On My Mind Blog

Selling Your Own Goods Can Be a “Service” Under U.S. Trademark Law

08.22.2024 By [William M. Borchard](#)

At one time, retail store activities were not considered “services” when the store sold only its own goods. Today, however, the name of a retail store, whether brick-and-mortar or online, may be considered a service mark despite its sale of only its own goods.



Blizzard Entertainment, Inc. owns registrations of BLIZZARD and BLIZZARD ENTERTAINMENT in plain lettering for “electronic commerce services, namely, providing online retail store and mail order services, all featuring clothing, books, mouse pads, toys, games.” Its online store currently uses the mark BLIZZARD (in stylized type) followed by the word GEAR.

Blizzard opposed an application filed by Ava Labs, Inc. to register BLIZZARD for various business services, venture capital financing investment services and fund management services, all related to the crypto-asset and blockchain industries.

Ava counterclaimed for cancellation of Blizzard’s registrations. Ava asserted that Blizzard’s marks had never been used in commerce for the listed services, and thus, Blizzard had abandoned its marks.

Blizzard challenged that counterclaim, and the Trademark Trial and Appeal Board (TTAB), in a precedential decision, granted Blizzard’s motion for a judgment on the pleadings in its favor.

The issue presented was whether “online retail store or mail order activities featuring only a party’s own goods are ‘services’,” under the U.S. Trademark Act. Although that Act does not define “services,” the Federal Circuit Court of Appeals has applied the following criteria for assessing what constitutes “services”:

- (1) a service must be a real activity;

(2) a service must be performed to the order of, or for the benefit of, someone other than the applicant; and

(3) the activity must be qualitatively different from anything necessarily done in connection with the sale of the applicant's goods or the performance of another service.

The first criterion was not an issue in this case.

The second criterion concerns whether the mark's owner **primarily benefits** from the activity. For example, a contest promoting a party's own goods was not considered a "service," even though contest winners benefitted, and an intranet website meant solely for internal use was not considered a "service."

The third criterion focuses on whether activities offered only to purchasers of the trademark owner's product nevertheless are **separate services**. It has long been recognized that making a place available for purchasers to select goods, and providing any other necessary means for consummating purchases, constitute the performance of a separate service.

In this decision, the TTAB determined that the online retail store and mail order services featuring Blizzard's own goods primarily benefitted consumers, by providing "a central location to find, examine, and purchase various goods." This was the case even though Blizzard "derived the benefit of selling its own goods."

In other words, the use of the same mark for a retail store, and for the goods sold there, may support both a service mark use and a trademark use, and can be registrable for each activity.

[Blizzard Entertainment, Inc. v. Ava Labs, Inc., Opposition No. 91285851 \(T.T.A.B. July 18, 2024\).](#)

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Bill has handled domestic and international trademark and copyright matters at the highest level for over 60 years. He has counseled and represented clients on domestic and international trademark matters concerning clearance, registration, proper use, licensing, contested administrative proceedings and infringement claims. He became Senior Counsel in January

2024 and is now focusing on providing guidance and advice to other lawyers within our firm and writing informative and engaging articles on intellectual property law developments.