

Sheppard Mullin Secures Sweeping Victory Before Trademark Trial and Appeal Board

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On October 13, the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office ruled in favor of client, multi-media artist N. Johnson, in a legal proceeding brought by the publisher of *SELF* magazine, which opposed the registration of our client's trademark for her multimedia artworks, "THE SELF PUBLICATION".

Background on the Case

Advance Magazine Publishers Inc., the owner of *SELF* magazine and Conde Nast publications, attempted to block a trademark application for THE SELF PUBLICATION filed by Texas-based artist N. Johnson. Johnson is a black multi-media artist and author and creator of a photographic book and video series, THE SELF PUBLICATION. This work is intended to reflect her own experience as a person of color, as well as, in her words, "celebrate the voices, resilience and beauty of the Black community." She sought to register the trademark THE SELF PUBLICATION for educational and entertainment services related to her artwork.

SELF magazine, which focuses on women's health and related wellness topics, opposed Johnson's application, arguing that registering Johnson's mark constituted trademark infringement and diluted *SELF*'s brand. In attempting to block the issuance of a trademark registration for THE SELF PUBLICATION, *SELF* magazine argued that consumers would be confused between Johnson's creative art and *SELF* magazine. *SELF* magazine also argued that its "SELF brand could be immensely damaged" and even "tarnished" by THE SELF PUBLICATION.

The Trademark Trial and Appeal Board of the United States Patent and Trademark Office rejected *SELF*'S opposition in a 45-page decision, dismissing all of the claims raised by *SELF*, finding no likelihood of confusion and that *SELF* failed to prove it was a famous trademark. The Board also found no likelihood of confusion because *SELF*'S trademark, "SELF" "has been weakened by third-party registrations and was conceptually weak due to its 'suggestive nature'" and further finding that *SELF* failed to show that the parties' goods and services are related.

The Sheppard Mullin team who represented Johnson was led by partner Laura Chapman and associates Irene Choe and Chante Westmoreland.

[Click here to read the decision.](#)

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Practice Areas

Intellectual Property

Trademark Applications and Prosecution

Industries

Entertainment, Technology and Advertising