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**THIS DISPOSITION
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Paper No. 30
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **The FitzSimons Company**

Serial No. 75/185,899

Joseph H. Taddeo, Esq. for The FitzSimons Company.

**Henry Zak, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).**

Before **Seeherman, Bottorff and Rogers**, Administrative
Trademark Judges.

Opinion by **Bottorff**, Administrative Trademark Judge:

Applicant has filed an application¹ seeking
registration on the Principal Register of the mark THE
PUPPY CHANNEL (PUPPY is disclaimed), in typed form, for
"production of programming for entertainment media,

¹ Serial No. 75/185,899, filed October 23, 1996 on the basis of
intent-to-use under Trademark Act Section 1(b), 15 U.S.C.
§1051(b). The mark was published for opposition on February 17,
1998, and a Notice of Allowance was issued on May 12, 1998.
Applicant filed its Statement of Use on June 11, 1998, alleging
November 6, 1996 as the date of first use of the mark and first
use of the mark in commerce.

particularly pre-recorded videotapes and video disks for television and motion pictures."²

The Trademark Examining Attorney has refused registration pursuant to Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051, 1052, 1053 and 1127, on the ground that applicant's recited services are not "services" for which service mark registration may be obtained. Specifically, the Trademark Examining Attorney contends that applicant is not performing the recited services for the benefit of, or to the order of, persons other than applicant, and that the services are merely an ancillary activity to applicant's main business, which, according to the Trademark Examining Attorney, is the creation and operation of applicant's own cable channel or network featuring applicant's own programming.³

² Both applicant and the Trademark Examining Attorney, in their respective appeal briefs, have treated the recitation of services as it was published, i.e., "production of programming for entertainment media, particularly pre-recorded videotapes and video disks for television and motion pictures," as the operative recitation of services in the application for purposes of this appeal. In view thereof, we shall do likewise. To the extent that the Trademark Examining Attorney's September 13, 2000 office action might be construed as having included a requirement for amendment of the recitation of services, we deem the requirement to have been withdrawn.

³ The original Trademark Examining Attorney initially refused registration on the ground of mere descriptiveness under Trademark Act Section 2(e)(1), but subsequently withdrew that refusal. After the filing of applicant's Statement of Use, the present Trademark Examining Attorney initially refused registration (in an August 7, 1998 office action) on the ground

Applicant has appealed the Trademark Examining Attorney's refusal. Applicant and the Trademark Examining Attorney filed main briefs; applicant did not file a reply brief. Applicant initially requested an oral hearing, but then withdrew that request, and no oral hearing was held. After careful consideration of the briefs and the evidence of record, we reverse the refusal to register.

The original specimens submitted with the Statement of Use provide the following background information about the nature of applicant's activities and programming. In an "Executive Summary" sent to potential investors/venture partners in 1998, applicant states:

The Puppy ChannelSM is a 24 hour, 7 day cable television network-in-development featuring

that it appeared from the original specimens submitted with the Statement of Use that applicant had not used the mark in connection with the recited services as of the date of the filing of the Statement of Use. *Cf. In re Kronholm*, 230 USPQ 136 (TTAB 1986). The applicant responded to that refusal on November 11, 1998 with a supplemental declaration and supporting materials, whereupon the Trademark Examining Attorney, in his April 7, 1999 office action, withdrew the refusal: "Based on such material [in applicant's November 11, 1998 response], it appears that the applicant was producing programming for various forms of electronic media on the dates alleged in the Statement of Use." However, in the same action, the Trademark Examining Attorney issued the refusal which is at issue in this appeal. In view of this history, we deem both of the previous refusals, which were based, respectively, on mere descriptiveness and on applicant's alleged non-use of the mark in commerce as of the Statement of Use filing deadline, to have been withdrawn, and those issues are not before us in this appeal.

video of puppies at play, accompanied only by relaxing, instrumental music...

...

The research-indicated market is an audience interested in relaxing, short-form entertainment; diversion between favorite TV shows; and a "background" for other activities. Other confirmed viewing occasions include being with children, entertaining pets, waiting for a program, and during commercial breaks...

Strategy calls for this network to be a basic channel. When viewers are offered 150-plus cable channels - through digital technology soon to be available - we will offer cable operators unique programming with opportunities to sell local sponsorships, and to build relationships with community organizations. Community relations are very important to renewals of cable franchises and subscribers.

...

The competition is everything else on TV, which is easily characterized as "talk-TV," in that human speech pervades the medium. We are not especially in competition with other pet programming currently on TV or in development (veterinarian shows, pet features, etc.) because of its "talk" nature. Our advantage is the "relaxing" feature, which is perceived by research subjects as a welcome relief from regular TV fare.

In his March 9, 1998 cover letter accompanying that Executive Summary, applicant's president states as follows, inter alia:

The Puppy ChannelSM is a cable/satellite/Internet network in

development. The research-validated concept is to show a variety of scenes of puppies at play, around the clock, accompanied by relaxing instrumental music. No talk and virtually no people are in the video plans, and sponsored messages are anticipated to appear as integral to the video programming, as shown on the one hour videocassette of our test show.

In his declaration in support of applicant's November 11, 1998 supplemental Statement of Use, applicant's president states as follows, inter alia:

THAT beginning in November, 1996 and through the summer of 1997, your Applicant, The FitzSimons Company, produced more than twelve hours of videotape content for THE PUPPY CHANNEL, which content was identified as THE PUPPY CHANNEL;

THAT concurrently, The FitzSimons Company created and/or produced and recorded seven musical productions to accompany the video, which we registered separately for copyright;

THAT in March, 1997, THE PUPPY CHANNEL was introduced to the cable television industry at the cable television national convention in New Orleans, by personal representation of THE PUPPY CHANNEL, distribution of THE PUPPY CHANNEL business cards, and follow-up correspondence on the letterhead of THE PUPPY CHANNEL to solicit opportunities to telecast THE PUPPY CHANNEL programs that were in production;

...

THAT...reports of marketing research for THE PUPPY CHANNEL were distributed at the cable television industry national convention, that was held in Anaheim, CA, December 7th to 11th, 1997;

THAT at the same convention, fifty to seventy-five copies of THE PUPPY CHANNEL video/audio programming production were distributed to cable operating companies and other cable television industry officials.

The record includes additional evidence made of record by applicant, as well as the arguments of applicant and the Trademark Examining Attorney as to the relevance and/or persuasiveness of that additional evidence. We need not and do not discuss this additional evidence or the arguments pertaining thereto, because we find that the excerpts from the original specimens and from applicant's supplemental declaration, quoted above, constitute evidence sufficient to warrant reversal of the Trademark Examining Attorney's refusal, and because nothing in the additional evidentiary materials would affect or detract from that result.

It is settled that the determination of whether a particular activity constitutes a service for which service mark registration may be obtained involves consideration of three criteria: "(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) a service cannot be merely an ancillary activity or one which is necessary to the applicant's larger business (i.e., 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)." See TMEP §1301.01(a); *In re Betz Paperchem, Inc.*, 222 USPQ 89 (TTAB 1984). In this case, the Trademark Examining Attorney contends that applicant's activities undertaken in connection with the mark sought to be registered fail to meet the second and third of the above-stated criteria. We disagree.

With respect to the second criterion, i.e., "a service must be performed to the order of, or for the benefit of, someone other than the applicant," we find that applicant's activities in fact are provided for the benefit of others, i.e., for the benefit of third-party broadcasters and cablecasters who can obtain applicant's programming content to provide to their own subscribers/viewers. Contrary to the Trademark Examining Attorney's contention, it is not necessary, under the second criterion, that applicant be providing "custom" programming at the specific request of, or to the specific order of, a particular third party. See *In re U.S. Home Corporation of Texas*, 199 USPQ 698 (TTAB 1978). In any event, we must presume that applicant is able to provide any such custom-tailored programming that might be specifically requested by a third-party

broadcaster or cablecaster, e.g., two hours and fifteen minutes of programming depicting only black labrador retriever puppies.⁴

We also find that applicant's activities under the mark, as evidenced by the record, meet the third "service" criterion, i.e., "a service cannot be merely an ancillary activity or one which is necessary to the applicant's larger business (i.e., 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)." In analyzing this factor, it is settled that:

... we should first ascertain what is an applicant's principal activity under the mark in question, i.e., the sale of a service or the sale of a tangible product, and then determine whether the activity embraced by the description of services or goods in the application is in any material way a different kind of economic activity than what any purveyor of the principal service or tangible product necessarily provides. In order to determine when an activity is necessarily

⁴ At unnumbered page 4 of his brief, the Trademark Examining Attorney states: "While the applicant, in its brief, states that the intent is to create custom videos to the order of cable companies, in certain program specific ways, no material is currently of record to indicate that such activity has ever occurred." (Emphasis added.) To the extent that the Trademark Examining Attorney, by this argument, is attempting to resurrect his previously-withdrawn refusal based on applicant's alleged failure to have used the mark in commerce in connection with the recited services as of the Statement of Use filing deadline, see *supra* at footnote 3, we reject the attempt.

related to an applicant's principal business, consideration should be given to the customs and practices of the industry or business, the history of the applicant, any Federal or state laws or regulations which control the principal business activity, and possibly other factors.

In re Landmark Communications, Inc., 204 USPQ 692, 695 (TTAB 1979).

The Trademark Examining Attorney contends that applicant's "production of programming" is merely ancillary to, and not separable from, applicant's primary business activity which, according to the Trademark Examining Attorney, is the operation of applicant's own cable television channel or network.⁵ As he argues in his April 7, 1999 office action:

Furthermore, such production activities are ancillary to the main business of the applicant - the creation of its own broadcast channel programming, for use by third party broadcasting or cable companies, as part of the entertainment presented by such companies. It is clear that, before such programming is

⁵ We note that the Trademark Examining Attorney has never based his refusal on the ground that applicant's mark is used only as a trademark on goods, i.e., videotapes and disks, and not as a service mark in connection with services. See, e.g., *In re Billfish International Corporation*, 229 USPQ 152 (TTAB 1986) (mark used as a trademark for magazines, not a service mark for publishing the magazines); *In re Landmark Communications, Inc.*, *supra* (same, with respect to a newspaper section). Rather, the Trademark Examining Attorney contends that applicant's main business is the provision of a service, i.e., operation of a cable channel or network, and that the activity recited in the application, i.e., "production of programming," is merely ancillary and incidental thereto.

available for broadcast on the applicant's channel, it must be produced and marketed. The material of record clearly shows that such production, rather than serving as an end in itself, is merely ancillary to the applicant's proposed main business - operation of a broadcast channel, available for use by other third party broadcasters or cable operators, showing puppies and other animals at play in various humorous situations.

We find that the Trademark Examining Attorney's argument is based on an incorrect premise, i.e., that applicant's "principal activity" (for purposes of the *Landmark Communications* analysis) is the operation of its own cable channel or network. Applicant does not operate its own cable channel or network. It appears from the record, rather, that applicant's principal activity at this time is the production and of programming content for third-party cable operators. Applicant's services, as recited in the application and as performed by applicant, are not ancillary to that principal activity. Whether those services might be ancillary to the applicant's possible future operation of its own cable channel or network is a hypothetical question which is not before us in this case.

In summary, we find that applicant's "production of programming" activities undertaken in connection with the mark constitute a "service" for purposes of service mark

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registration, under *In re Betz Paperchem, Inc., supra.*
Applicant's service is a real activity, it is performed to
the order of or for the benefit of persons other than
applicant (i.e., for third-party broadcasters and
cablecasters), and it is not merely an ancillary or
incidental activity.

Decision: The refusal to register is reversed.