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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Broadcast Architecture, Inc.

Serial No. 77153461

Pamela B. Huff of Cox Smith Matthews Incorporated for Broadcast Architecture, Inc.

Gina M. Fink, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).

Before Bucher, Holtzman and Rogers, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Applicant, Broadcast Architecture, Inc., seeks to register the mark SMOOTH JAZZ TOP 20 COUNTDOWN (in standard character form) for "radio broadcasting services" in Class 38; and "radio programming services" in Class 41.

The application was filed on April 10, 2007 based on applicant's assertion of a bona fide intention to use the mark in commerce. Applicant filed an amendment to allege use, together with a specimen of use, on September 17, 2007, asserting dates of

first use and first use in commerce for both classes on June 9, 2007.¹

The examining attorney accepted the specimen submitted with the amendment to allege use as to the "radio programming services" in Class 41, but refused registration of the mark as to the Class 38 "radio broadcasting services" under Sections 1, 2 and 45 of the Trademark Act on the ground that the specimen does not show use of the mark for the services as required by Trademark Rules 2.56 and 2.76. Applicant subsequently submitted additional specimens, none of which, according to the examining attorney, show use of the mark for the Class 38 services.

When the refusal was made final, applicant appealed. Briefs have been filed.

Section 1 of the Trademark Act and Trademark Rule 2.76(b)(2) provide that an amendment to allege use must be accompanied by a specimen of the mark as actually used in commerce. Trademark Rule 2.76(b)(2) refers to Trademark Rule 2.56 for the requirements for specimens, which in turn requires a specimen showing the mark as actually used in the sale or advertising of the identified services. See Trademark Rule 2.56(b)(2).

¹ In response to the examining attorney's initial refusal to register the mark under Section 2(e)(1) of the Trademark Act, applicant amended the application to seek registration of the mark, in part, under Section 2(f) of the Act. Specifically, applicant claims acquired distinctiveness as to "TOP 20." After this amendment, the Section 2(e)(1) refusal was withdrawn. The terms SMOOTH JAZZ and COUNTDOWN have been disclaimed.

The question of whether a designation functions as a mark for the identified services is determined based on the specimens and other information of record. In order to show service mark use, the specimen must show use of the mark in a manner that would be perceived by the relevant public as identifying applicant's services and indicating their source. See in re Universal Oil Products Co., 476 F.2d 653, 177 USPQ 456 (CCPA 1973).

The original specimen submitted with the amendment to allege use (shown below) is described by applicant as a "screen shot from Applicant's website." The top section of the page displays "SMOOTH JAZZ TOP 20 COUNTDOWN" and indicates that the program is hosted by Allen Kepler. A "WHERE TO LISTEN" link is prominently displayed to the right of the program name. Additional links in that section will take users to the "HOST" and "OTHER COOL SHOWS" pages of the website.

Smooth Jazz TOP 20 countdown with Allen Kepler

WHERE TO LISTEN...GO

ABOUT US | NEWS | ARTISTS | PHOTO GALLERY | OTHER COOL SHOWS | HOST | SPANNING THE GLOBE | WHERE TO LISTEN | CONTACT

Rate The Music RESULTS

RYAN SHAW
"WE GOT LOVE"

#3
Boney James
"Hypnotic"

In The News

Etta James is at Cedars-Sinai Medical Center in Los Angeles hospital after suffering... click for more

SMOOTH JAZZ TOP 20 SONGS OF THE WEEK

THIS WEEK	LAST WEEK	+/-	ARTIST & SONG TITLE	BUY
1	1		NORMAN BROWN "LET'S TAKE A RIDE"	
2	2		EDGE GROOVE "BORN 2 GROOVE"	
3	3		BONEY JAMES "HYPNOTIC" F/George Benson	
4	4		PAUL BROWN "THE RHYTHM METHOD"	

The next specimen, submitted on October 29, 2007, is a "WHERE TO LISTEN" page for the program "SMOOTH JAZZ TOP 20 COUNTDOWN with Allen Kepler." This page, shown below, notifies listeners of the various radio stations, such as "WNUA 95.5 Smooth Jazz," on which the program can be heard, along with the day and time the program will be aired. Applicant explains that these radio stations are applicant's licensees, and that mark is being used by these stations under applicant's direction and control.



WHERE TO LISTEN



Chicago, IL | Sun 7-9 am



Trinidad, West Indies
Fri. 4-6 pm, Sun 3-5 pm



Miami, FL | Sat 10pm-12mid



Tampa, FL | Sun 6-8 pm



Baltimore, MD | Sun 9-11 am



Palm Springs, CA | Sat 7-9 pm

Several additional specimens were submitted with applicant's request for reconsideration on February 11, 2008. One specimen consists of a "WHERE TO LISTEN" page with additional station listings, including "KKSF 103.7" and "The Breeze 97.9 KBZN." The specimens which follow are advertisements from the websites of these two radio stations.

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The "KKSF" website announces that the program "SMOOTH JAZZ TOP 20 COUNTDOWN with Allen Kepler" can be heard on that station "Every Sunday Afternoon from 4 to 6pm," and states in part:

The Smooth Jazz Top 20 Countdown features the hits each week, based on monitored airplay on stations across the U.S. Hosted by Allen Kepler, there are artist interviews and commentary from the likes of George Benson, John Legend..."

The screenshot shows the KKSF 103.7 website. At the top, there is a navigation bar with links for Music, On-Air, Newsletter, Contests, Concerts/Events, Lifestyle, Go Green, About KKSF, and HD Radio. Below this is a search bar with the text "Keyword > Search/Keyword/Artist" and a "GO" button. To the right of the search bar is a "Select Category" dropdown menu and a "Enhanced by Google" logo. Below the search bar is a "CONCERTS" section with a "Navigation:" bar and a "HOME" link. To the right of the navigation bar is a "PsPrint" advertisement with the text "Gift Code: MAR7" and "Save 25% on business cards". Below the navigation bar is a large promotional banner for the "Smooth Jazz TOP 20 countdown with Allen Kepler" program. The banner features a photo of Allen Kepler, a smiling man in a black shirt, sitting on the floor. To his right is the "Smooth Jazz TOP 20 countdown" logo, which includes a stylized sun and the text "Every Sunday Afternoon from 4 to 6pm". Below the banner is a paragraph of text: "The Smooth Jazz Top 20 Countdown features the hits each week, based on monitored airplay on stations across the U.S. Hosted by Allen Kepler, there are artist interviews and commentary from the likes of George Benson, John Legend, Kenny G and many more. Tune in each week for updates on all the latest news from the Smooth Jazz world, and a special 'Chartbound' track destined to be a hit." Below this paragraph is another paragraph: "The weekly Smooth Jazz Top 20 Countdown™ will offer listeners a chance to follow the development of new artists and familiar artists' brand-new projects. The program will be loaded with the latest information on musicians featured as well as insights from the smooth jazz performers themselves." On the left side of the banner, there is a vertical list of links: "Free Samples", "Grocery Coupons", "Baby Coupons", "Pet Coupons", "Beauty Coupons", "Movies & Music", "Free Stuff", and "View All".

"The Breeze" website, shown below, announces its "Weekend Programming" and features the "Sunday Lineup" of "some of the most popular" programs. The website identifies the program

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"Smooth Jazz Top 20 Countdown with Allen Kepler" along with other weekend programs including "Quiet Music" and "Jazz Trax."

The Breeze 97.9 KBZN
Smooth Jazz

Menu

- Event Calendar
- Weekend Programming**
- The Breeze Welcomes
- Advertiser Directory
- Breeze Photos
- Smooth Operators
- Comments
- Contact Us
- About The Breeze
- Contest Rules
- Check Your Email
- Home

Weekend Programming

At 97.9 The Breeze, our weekend programs are some of the most popular!
Here's what you'll hear

Sunday Lineup

QUIET MUSIC
6 a.m. - 8 a.m.
[Quiet Music with Nick Francis](#)

Smooth Jazz TOP 20 countdown with Allen Kepler
4 p.m. - 6 p.m.
[The Smooth Jazz Top 20](#)

JAZZ TRAX
6 p.m. - 8 p.m.
[JazzTrax with Art Good](#)

The Breeze 97.9
(801) 364-9836

The last specimen, submitted by applicant on May 23, 2008 with its second request for reconsideration, is a page from the website of radio station "Smooth Jazz 95.5 KYOT," showing use of the mark in a manner similar to the radio station advertisements above.

We agree with the examining attorney that, as used on each of the specimens of record, the designation SMOOTH JAZZ TOP 20 COUNTDOWN would be perceived as a mark identifying a radio program, and not as a mark identifying Class 38 "radio broadcasting services."²

The program SMOOTH JAZZ TOP 20 COUNTDOWN is indeed "broadcast" over the radio. However, this activity in itself is not the equivalent of a "broadcasting" service, at least for purposes of proper classification. The U.S. Patent and Trademark Office recognizes the distinction between the two types of services by classifying them in two separate classes. See Acceptable Identification of Goods and Services Manual which lists, for example, "entertainment, namely, a continuing [e.g., variety] show **broadcast over** television, satellite, audio, and video media" in Class 41 (emphasis added) and "broadcasting of radio programs" in Class 38. Moreover, this classification is based on the Nice Agreement Concerning the International Classification of Goods and Services (9th ed. 2006),³ to which the United States is a party, and "each of the countries party to the

² The question of whether designations other than the mark for which registration is sought, such as "Smooth Jazz" or "Smooth Jazz Top 20," are used on the specimens to identify broadcasting services, is not before us.

³ The full title of the agreement is Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks.

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Nice Agreement is obliged to apply the Nice Classification in connection with the registration of marks." (Preface to Nice Classification.)

As stated in the "explanatory notes" of the Nice Classification, Class 38 "includes mainly services **allowing** at least one person to communicate with another by a sensory means" (emphasis added); and this class includes, in relevant part, "services which consist essentially of the diffusion of radio or television programmes." This is distinguished from Class 41 which, based on the Nice Classification, "covers mainly [inter alia]... services intended to entertain or to engage the attention"; and "includes, in particular: ...services having the basic aim of the entertainment, amusement or recreation of people."

With the above guidelines in mind, it seems clear that for purposes of proper classification, Class 38 services involve the means or medium of broadcasting, not the subject matter of the broadcast. In this case, the mark is used on the specimens to identify the subject matter of the broadcast. Every specimen advertises SMOOTH JAZZ TOP 20 COUNTDOWN as the entertainment provided by the radio stations, identifying the host of the program, and informing the public as to when and where the program can be heard. Based on the specimens, applicant is providing, or is licensing others to provide, the radio program

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SMOOTH JAZZ TOP 20 COUNTDOWN, the "basic aim" of which is to entertain the public.

Applicant states that it licenses the mark to others to use in their radio broadcasting services and that "these radio broadcasting services are conducted by Applicant's licensees under Applicant's direction and control." Applicant contends that because it licenses the mark to radio stations to use in connection with the radio station's broadcasting services, this use inures to applicant's benefit. Applicant maintains that consumers viewing the advertisements, "which comprise references to radio frequencies and broadcast times will immediately understand that the mark is used in connection with radio broadcasting services."

There is no question that applicant's licensees render broadcasting services. The problem with applicant's argument is that the mark SMOOTH JAZZ TOP 20 COUNTDOWN as it appears on the specimens is not used by the licensees to identify their broadcasting services. Rather, the mark is used by the licensees in a manner that would be perceived by the listening audience as identifying a program that is broadcast on their radio stations,

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which as discussed above is a Class 41 "entertainment" service, not a Class 38 "broadcasting" service.⁴

In view of the foregoing, we find that the specimens do not show use of SMOOTH JAZZ TOP 20 COUNTDOWN in commerce as a mark for the Class 38 services.

Decision: The refusal to register as to Class 38 is affirmed. The application will proceed in Class 41.

⁴ We are not saying that the mark could not be used on the same specimen to identify both services, but only that in this case it is not.