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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Titan Music, Inc.

Serial No. 77344197

Daniel A. Johnson of Sullivan Johnson for Titan Music, Inc.

Andrew Rhim, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

Before Quinn, Mermelstein and Gorowitz,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Titan Music, Inc., doing business as Titan Tribute Media ("Applicant"), filed an application to register the mark FAB AGAIN for "entertainment in the nature of visual and audio performances, namely, musical band, rock group, gymnastic, dance, and ballet performances" in International Class 41.[1]

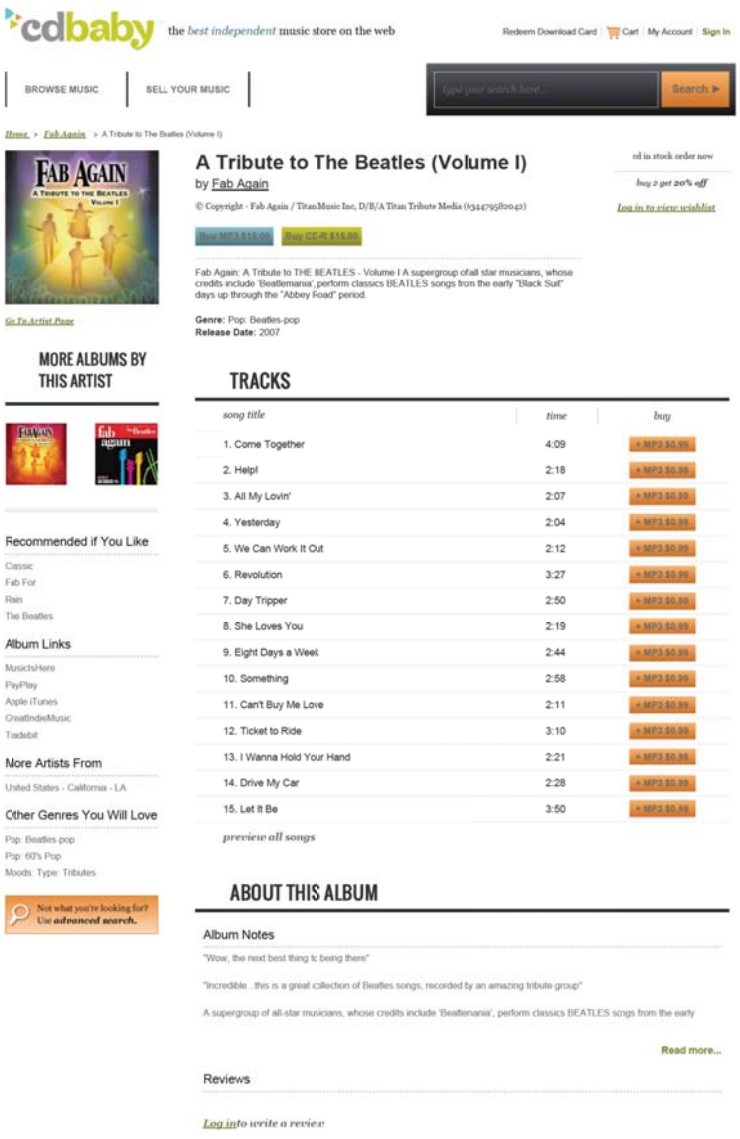
The Trademark Examining Attorney refused registration under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1127, based on Applicant's failure

[1] Application Serial No. 77344197, filed December 4, 2007, alleging a bona fide intention to use the mark in commerce. Applicant subsequently filed a statement of use, alleging first use anywhere and in commerce on December 20, 2007.

to provide a specimen that shows use of the mark in connection with the services recited in the application.

Applicant appealed the final refusal. Applicant and the Examining Attorney filed briefs.

The specimen accompanying Applicant's statement of use filed on October 2, 2012, described as a "print out from CDBaby.com website," is reproduced below.



The Examining Attorney indicated that the specimen shows use of the mark only in connection with a compact disc sound recording, with no reference to any services. (Office Action, 10/15/12).

When the Examining Attorney refused to accept the original specimen, Applicant filed, on December 13, 2012, a substitute specimen, indicating that it is a "printout from Last FM's internet website." The Examining Attorney refused to accept the substitute specimen, indicating that "performances captured on a musical sound recording constitute goods and are not the same as the service of providing or conducting visual and audio performances." (Office Action, 1/9/13). The specimen is reproduced below.

In the accompanying response, Applicant stated the following:

> In the alternative, Applicant wishes to advise the Examining Attorney that the original application was filed on or about December 4, 2007, without the assistance of counsel. Had counsel been involved at the time the application was filed, it is likely that Applicant would have applied for registration in Class 9 either in

> addition to or in lieu of Class 41. Therefore, to the extent that it is determined that the specimen remains improper, Applicant respectfully requests leave to amend the application to seek registration in Class 9.[2]

Applicant states that it provides musical performances to "internet streaming and webcasting services like Spotify, Last FM and Rdio." According to Applicant:

> In turn, these intermediaries provide Applicant's musical services to the public via internet streaming and webcasting sites. Although Applicant has the option of directly providing the public with these musical performance services directly, for business reasons Applicant chooses to do so through the various streaming and webcasting intermediaries. This, however, does not alter the fact that Applicant is providing musical performances services under the mark Fab Again.

(Brief, p. 1). Applicant goes on to argue:

> The streaming of Applicant's musical performances does not result in the distribution of any "physical" product or "hard goods" or transfer of ownership of "physical" product or "hard goods." There is no transfer of ownership of any "physical" product from Applicant to the streaming services. The streaming services operators, like movie theatre or television station operators, are licensed to provide the performances to the public until the Applicant terminates the license and demands removal of the performances from the streaming services' websites. The fact that Applicant also engages in distribution of physical product through other channels does not change the fundamental nature of its non-physical distribution of musical performances though streaming services or webcasters (just as a movie studio's distribution of DVDs of films does not transform the studio's distribution of the films in theatres from a service into distribution of goods).

[2] In response, the Examining Attorney pointed out that any proposed amendment to the identification to include goods in Class 9 would exceed the scope of the identification of services that is set forth in the application. Although an applicant may amend the application to clarify or limit the identification, adding to or broadening the scope of the identification is not permitted. *See* Trademark Rule 2.71(a); TMEP §§ 1402.06, 1402.07(d).

(Brief, p. 2). Further, Applicant contends:

> A performance that is captured on a tangible medium of expression does not lose its character as a performance. This is true for musical recordings or audiovisual recordings of performances. For example, broadcasts of television programs or exhibitions of a motion picture do not somehow convert the performances captured in such media into "goods." The broadcast of a television program is not the broadcast of a "good" it is the broadcast of a performance of dramatic art (and that broadcast is a service). Producers of television programs do not produce "goods," they provide production services (even though tangible copies of their programs (i.e., goods) may also be available for purchase by consumers). At most the tangible copies of a television program and/or a film may be goods but the performances captured thereon remain performances and providing these performances for the further service of broadcast or exhibition constitutes a service. No one suggests that television or film producers, television networks or movie theaters provide "goods."
>
> This is precisely the same situation with Applicant's performances. Like television networks or movie theaters with dramatic audiovisual works, streaming services like Last FM, provide the public with the service of access to musical performances not access to "goods." Applicant, like a television or film producer, provides the service of supplying the broadcaster/webcaster with content (musical performances) and the streaming services pass on these performances to the public.
>
> We note that Last FM does provide links to websites where the user can purchase tangible copies of Applicant's recordings. However, this is no different from the fact that tangible video or DVD copies of broadcast dramatic performances may be sold after a television broadcast. The fact that these Applicant's tangible goods may also be for sale does not alter the fact that Applicant has used the mark FAB AGAIN in providing a service (the supply of musical performances) to broadcasters and webcasters

> who provide the public with the service of access to Applicant's musical performances.

(Response to Office Action, 6/21/13).

The Examining Attorney maintains that the original specimen shows a music retailer's webpage through which the retailer sells the recorded musical performances of a musical group. Regarding the original specimen, the Examining Attorney asserts that the mark is displayed on the cover packaging of a compact disc with recorded musical performances, and that a consumer may purchase either a compact disc of the entire recorded musical performances or buy electronic MP3 files of individual recorded musical performances. According to the Examining Attorney, the specimen does not show the mark used in the sale or advertising of "services" where a musical group is performing in front of an audience: "Use of the mark in connection with recorded entertainment goods does not constitute use of the mark in association with 'performance' as an entertainment service by performers … the recording of a live concert or studio performance is not considered a service of the performing group. Similarly, performances for the sole purpose of recording are not considered services." (Brief, p. 4). As for the substitute specimen, the Examining Attorney contends that it likewise does not show use of the mark in connection with providing "performances" as a service rendered live by entertainers or performers; rather, the specimen "show[s] an internet website where the mark FAB AGAIN is used in connection with recorded entertainment goods where a consumer can either buy or stream the Applicant's recorded musical performances." (Brief, p. 5). The Examining Attorney goes on to argue:

> The streaming of its musical performances does not result in the distribution of any "physical" product or transfer of ownership of any "physical" product from applicant to the streaming services. Applicant states that the fact that it also engages in distribution of physical product via other channels does not change the fundamental nature of its non-physical distribution of musical performances via streaming services or webcasters (just as a movie studio's distribution of DVDs of films does not transform the studio's distribution of the films in theaters from a services into distribution of goods). (Appeal Br. at 2). The examining attorney understands that the applicant's services in this case are "Entertainment in the nature of visual and audio performances, namely, musical band, rock group, gymnastic, dance, and ballet performances." Contrary to the applicant's contention, these particular services are not, nor do they include, the production and/or distribution of "visual and audio performances" where applicant is involved in the actual creation of a visual and/or audio performance product and the accompanying activity of distributing that product to a third party for display to or for listening by the public. In this case, as stated in its Statement of Use, the services are the provision of "performances" rendered by a musical band, rock group, gymnastic, dance or ballet performers. "Performance" in the context of services involves the act of performing and is done in front of an audience. Furthermore, as stated in the Final Office action sent to applicant on July 9, 2013, the Trademark Manual of Examination Procedure Section 1402.11(g) states that "For entertainment services in the nature of performances, such as those rendered by a musical group, the performance must be live." The evidence of record does not show use of the applicant's proposed mark in commerce in connection with giving live performances by a musical band, rock group, gymnastic performers, dance performers, or ballet performers. Consumers encountering the applicant's specimens are more likely to view and understand the mark as being used in connection with recorded entertainment goods.

(Brief, pp. 5-6).

Section 1402.11(g) (2014) of the Trademark Manual of Examining Procedure provides as follows with respect to "Recorded Entertainment Services" (emphasis added):

> For entertainment services such as those rendered by a musical group, *the performance must be live. The recording of a live concert or studio performance is not considered a service of the performing group.* Similarly, performances for the sole purpose of recording are not considered services. The production by another entity of a performance by a musical group for recordation would be a service, but an identification such as "live and recorded performances by a musical group" could not be accepted as a valid service identification unless the words "and recorded" were deleted.
>
> Recorded entertainment usually takes the form of goods in Class 9, such as videotapes, audio cassettes, DVDs, CD-ROMs, etc. This is consistent with the treatment of "distribution" of these products as goods and not services as discussed in §1402.11(f).

We agree with the Examining Attorney's assessment of his requirement for Applicant to submit acceptable specimens showing use of the mark in connection with the services identified in the application for which registration is sought. Applicant's specimens may show use of the mark on or in connection with goods (compact discs featuring music) or services (streaming of audio material via a global computer network); however, the specimens do not show use of the mark in connection with "entertainment in the nature of visual and audio performances, namely, musical band, rock group, gymnastic, dance, and ballet performances." It is not enough for Applicant to be a provider of services; Applicant also must have used the mark to identify the identified services for which registration is sought. *See In*

re Advertising & Marketing Development Inc., 821 F.2d 614, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987). As indicated above, for entertainment services such as those rendered by a musical band, the performance must be live. And while a performance can be recorded, the recording is not itself a performance.

This decision should not be read as finding that the mark FAB AGAIN, as actually used on the specimens, would not be perceived by potential purchasers as a trademark (for compact discs featuring music) or a service mark (for streaming of audio material via a global computer network). The problem is that the specimens of record fail to show use of the mark FAB AGAIN in connection with the services identified in the application, that is, "entertainment in the nature of visual and audio performances, namely, musical band, rock group, gymnastic, dance, and ballet performances."

Decision: The refusal to register is affirmed.