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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Boise State University

Serial No. 77574816

Brad R. Frazer of Hawley Troxell Ennis & Hawley LLP for Boise State University.

Teresa Rupp, Trademark Senior Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Bucher, Holtzman and Cataldo, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Applicant, Boise State University, has filed an application to register the mark BLUE TURF in standard characters for services ultimately identified as "entertainment services, namely, the presentation of intercollegiate sporting events and sports exhibitions" in Class 41.

The application was filed on September 19, 2008 seeking registration on the Principal Register based on applicant's assertion of a bona fide intention to use the mark in commerce.

The Senior Attorney initially refused registration of the mark under Section 2(e)(1) of the Trademark Act on the ground

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that the mark is merely descriptive of applicant's services. Then, on April 14, 2009, applicant filed an amendment to allege use, asserting dates of first use and first use in commerce on April 13, 2009, together with an amendment of the application to the Supplemental Register. The Senior Attorney accepted the amendment to allege use, and in view of the amendment to the Supplemental Register, she withdrew the refusal to register based on Section 2(e)(1).

However, upon consideration of the specimen submitted with the amendment to allege use, as well as the subsequent specimens submitted by applicant, the Senior Attorney issued and ultimately made final a refusal to register under Sections 1, 2, 3 and 45 of the Act on the ground the mark, as used on the specimens, fails to function as a service mark.¹

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

The determination of whether a designation is used in the manner of a mark to identify the services is made based upon the specimens of record. The original specimen, shown below, is a

¹ The appropriate question for an application to register on the Supplemental Register is not whether the designation functions as a mark under Sections 1, 2, 3 and 45 of the Act, but rather whether it is capable of functioning as a mark under Section 23 of the Act. For this reason (among others), to the extent that the Senior Attorney has argued that the term does not function as a mark because it would be perceived as merely descriptive of the services, the argument is not well taken. Furthermore, we construe the Senior Attorney's position to be that the asserted mark is not capable of functioning as a mark because it is not used appropriately, that is, in a manner that will be perceived as identifying applicant's entertainment services.

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printout of a page from applicant's Boise State University website, www.boisestate.edu.



We agree with the Senior Attorney that as used on this specimen the proposed mark BLUE TURF is part of the unitary phrase ROLL OUT THE BLUE TURF and does not serve in and of itself to identify the services. It is well settled that a particular element of a composite mark is registrable only if that element creates a separate and distinct commercial impression as a mark. See *In re Berg Electronics, Inc.*, 163 USPQ 487 (TTAB 1969) citing *In re Schenectady Varnish Company, Inc.*, 126 USPQ 395 (CCPA 1960). The wording BLUE TURF does not create a commercial impression apart from the phrase as a whole.

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Furthermore, in order to be perceived as a mark identifying the source of the services, the specimens must show a direct association between the services and the mark sought to be registered. See *In re Advertising & Marketing Development*, 821 F.2d 614, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987) ("The 'direct association' test ... is implicit in the statutory definition of a [service mark]."); and *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973). The mark as used on this page identifies only the educational services provided by applicant, inviting prospective students to "Sign Up for a Campus Visit" and to "Register Now for Summer Classes." Although an "A-Z Index" along the sidebar provides links to various departments of the University including a link to "Athletics," an arguable reference to applicant's intercollegiate sporting events, there is no clear association of the mark with those services. See *Universal Oil Products*, 177 USPQ at 457 (term that identified only a process not registrable as service mark, even though applicant was rendering services and the proposed mark appeared in the same brochure in which the services were advertised).

Applicant's second set of specimens consists of two screen shots of the BLUE TURF BLOG from applicant's website, www.broncosports.com, one of which is displayed below.

FOOTBALL

BLUE TURF BLOG

News

Roster *Courtesy: Staff Release: 09/16/2009*

Coaches

Schedule

Statistics

Depth Chart

2009 Media Guide

Tradition

Top 25

Wallpapers

Camps

Prospective Athletes

Archives

MEN'S SPORTS

Basketball

Cross Country

Football

Golf

Tennis

Track & Field

Wrestling

WOMEN'S SPORTS

Basketball

Cross Country

Golf

Gymnastics

Soccer

Softball

Swimming & Diving

Tennis

Track & Field

The equipment truck is being loaded up this morning and about ready to make the drive to Fresno. The truck will leave Wednesday afternoon and arrive around the same time as the team, on Thursday afternoon/night.

The Broncos will wear their new white uniforms for the first time ever on Friday night. Bulldog Stadium has a natural grass playing surface, so expect Equipment Manager Dale Holste and staff to be prepared with a few gallons of bleach to help get the grass stains out of the white uniforms.

Through two games, the Boise State defense is allowing only 4.0 points per game. The fewest points the Broncos have ever given up in a season was in 1969 when they only allowed 10.5 points per game. Last years defense ranks fourth on that list given up a modest 12.6 points per game.

41-6 is the Broncos record when they are ranked in the Top 25. Including a perfect 4-0 against the Fresno State Bulldogs.

Both specimens contain the banner headline "BOISE STATE FOOTBALL" and "The Official Athletics Website of Boise State University," along with symbols and indicia of the University's football team, the Broncos, and an announcement for "LIVE GAME DAY COVERAGE - GET IT NOW." The term BLUE TURF BLOG appears directly below the announcement followed by the text of the blog. As displayed on these specimens, the term BLUE TURF, which is

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featured prominently near the top of the page in capital letters, is used in the manner of a mark. The generic term BLOG is not essential to the commercial impression conveyed by the term BLUE TURF. See *In re Raychem Corp.*, 12 USPQ2d 1399 (TTAB 1989).

The Senior Attorney does not dispute the technical manner of use of the mark, and she also acknowledges that the web page clearly shows that applicant renders entertainment services, with the numerous references to the football team and collegiate football games played by the University. The Senior Attorney maintains, however, that there is no direct association between the football team and the words BLUE TURF, arguing that BLUE TURF as used on this specimen only identifies a "blog" or online journal, a service that is totally different from the service of presenting intercollegiate sporting events. The Senior Attorney submitted with her brief a definition of "blog" as "a biographical web log: a type of diary (+record of what someone does each day) on a website that is changed regularly, to give the latest news. The page usually contains someone's personal opinions, comments, and experiences."² Contending that the blog "is used to comment on the activities of others and to express one's opinions about those activities," the Senior Attorney

² *Macmillan Dictionary* (macmillandictionary.com). The Board may take judicial notice of dictionaries, including online dictionaries which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002). See also *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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argues that "the 'blue turf blog' would not be perceived as an advertisement for the entertainment services," but rather merely "as a place to submit a comment or to read the comments of others." We disagree.

The purpose of applicant's blog, at least as it appears on these specimens, is to provide continuing updates on game day preparations and to report on pre-game highlights and activities. The blog is produced on the University's website, it is maintained and hosted by the University, and moreover, it is authored by the University "staff." Although the "blog" is not an advertisement in the traditional sense, it nonetheless is clearly used by the University as a marketing device, that is, as a means to generate interest in and to promote and market upcoming sporting events conducted by the University. We find that the specimen shows use of applicant's mark to identify the services specified in the application.³

Decision: The refusal to register is reversed.

³ In making this determination we have not considered the untimely affidavit which was submitted by applicant for the first time with its appeal brief. See Trademark Rule 2.142(d). Furthermore, in view of our decision herein, applicant's request in its reply brief to suspend the appeal and remand the application for consideration of the affidavit is moot.