

This Opinion is Not a
Precedent of the TTAB

Mailed: August 27, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Mixed in Key LLC
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Serial No. 87789666
—————

Susan Latham of Trailblazer,
for Mixed in Key LLC.

Ahsen Khan, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

—————

Before Zervas, Dunn and Hudis,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

Mixed in Key LLC (“Applicant”) seeks registration on the Principal Register of the following design:



(“Applicant’s Applied-For Design”) for “computer software for music analysis and processing; computer software for manipulating, mixing, and performing music and

sounds” in International Class 9, and for “providing advice and information in the field of DJ’ing methodology and the analysis, selection and arrangement of music and sound recordings” in International Class 41.¹

The following is a description of Applicant’s Applied-For Design as recited in the Application:

The color(s) white, black, greenish-aqua, bright green, bright yellowish green, yellowish orange, orange, pinkish orange, bright pink, pinkish purple, violet, bluish purple, bluish aqua and aqua is/are claimed as a feature of the mark. The mark consists of [t]hree concentric circles. The outer and middle circles are shaded with various colors, and the inner circle is white. The outer circle is sub-divided into twelve adjacent boxes of the same size, which are consecutively numbered from 1B, 2B, 3B, 4B, 5B, 6B, 7B, 8B, 9B, 10B, 11B and 12B, with each alpha-numeric value in black. The middle circle contains 12 smaller but equally divided boxes, which are consecutively numbered 1A, 2A, 3A, 4A, 5A, 6A, 7A, 8A, 9A, 10A, 11A and 12A, with each alpha-numeric value in black. There are 24 boxes total. The overall design looks like a small clock positioned inside a larger clock, both sharing the same center. The position of each smaller box in the middle circle lines up with the larger box in the outer circle. Color is a feature of the mark. Starting from top and slightly to the right of center and moving in a clockwise direction on the outer-circle, the color of the first box 1B is greenish-aqua; the color of the second box 2B is bright green; the color of the third box 3B is a bright yellowish green; the color of the fourth box 4B is a yellowish orange; the color of the fifth box 5B is orange; the color of the sixth box 6B is pinkish orange; the color of the seventh box 7B is bright pink; the color of the eighth box 8B is pinkish purple; the color of the ninth box 9B is violet; the color of the tenth box 10B is bluish purple; the color of the eleventh box 11B is bluish aqua and the color of the twelfth outer box 12B is aqua. The colors of the boxes in the middle circle 1A-12A are lighter versions of the colors of the corresponding boxes in the outer-circle 1B-12B.

The Trademark Examining Attorney refused registration under Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C §§ 1051-1053, 1127, on the ground that Applicant’s

¹ Application Serial No. 87789666, filed on February 8, 2018 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and first use in commerce since June 5, 2007 for the Class 9 goods, and since April 21, 2002 for the Class 41 services.

Applied-For Design, as applied to the goods and services identified in the Application, does not function as a trademark or service mark to identify and distinguish Applicant's goods or services from those of others and to indicate their source.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. Both Applicant and the Examining Attorney filed briefs. We affirm the refusal to register.

I. Evidentiary Record

With the Application, Applicant submitted the following specimens of use:

Class 9 Specimen (1):



Description in Application: Screen shot of the computer software bearing the mark.

Description in Applicant's Brief: Internet Advertisement announcing a new version of the software which features an image of the software in operation.

Class 9 Specimen (2):



Description in Application: Screen shot of the computer software bearing the mark.

Description in Applicant's Brief: Internet advertisement for the software, which features a video presentation of the software in operation.

Class 9 Specimen (3):



Description in Application: Screen shot of the computer software bearing the mark.

Description in Applicant's Brief: Image of the software while in operation.

Class 41 Specimen:



Description in Application: Screen shot of the computer software bearing the mark.

Description in Applicant's Brief: Portion of the website homepage, at mixedinkey.com, where the services are advertised.

The Class 9 specimens show Applicant's Applied-For Design on screenshots of Applicant's software in operation, in the upper left corner immediately below the word mark MIXED IN KEY. On the bottom two-thirds of each software screenshot are columns titled: "Cover Art," "Artist," "Name," "Key Result," "Tempo," "Energy," and "Cue Points." The information provided in the rows of each column is derived from the metadata of the digital file for each musical composition ("song") processed and analyzed through an electronic algorithm within Applicant's software.²

The Class 41 specimen shows text juxtaposed next to Applicant's Applied-For Design states: "Become a Master of Harmonic Mixing" and "We'll teach you all the cool tricks used by pro DJs. Explore this website to learn DJ techniques like Energy Boost mixing and Power Block mixing. The How-To Guide covers a bunch of DJ techniques that were secret before we published them."³

With the first Office Action, the Examining Attorney submitted the following evidence in support of the refusal:

1. An "Official Harmonic Mixing Guide" from Applicant's website at MIXEDINKEY.COM;⁴

² Application and Class 9 specimens (with their descriptions) filed on February 8, 2018 at TSDR 2 and 8-9. Applicant's Brief, specimen descriptions and discussion of how Applicant's software functions. 11 TTABVUE 5-7, 18-20. Page references herein to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval ("TSDR") system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents. References to the briefs on appeal refer to the Board's TTABVUE docket system. Coming before the designation TTABVUE is the docket entry number; and coming after this designation are the page references, if applicable.

³ Application and Class 41 specimen (with its description) filed on February 8, 2018 at TSDR 2 and 10. Applicant's Brief, specimen description 11 TTABVUE 7.

⁴ Office Action of March 8, 2018 at TSDR 6-11.

2. A column entitled “The Circle of Fifths Explained” from the website LEDGERNOTE.COM;⁵ and
3. An article entitled “The Ultimate Guide to the Circle of Fifths” from the website MUSICAL-U.COM.⁶

With its Response to the first Office Action, Applicant submitted the following evidence to traverse the refusal:

1. The Declaration of Yakov Vorobyev, the founding Member of Applicant who signed the Application,⁷ including the following exhibits:
 - a. Screenshots from homepage of Applicant’s mixedinkey.com website and an introductory video for the Mixed In Key Software;⁸ and
 - b. Full screenshot of the homepage of Applicant's mixedinkey.com website.⁹

With the Final Office Action, the Examining Attorney submitted the following evidence in support of the refusal:

1. An “Official Harmonic Mixing Guide” from Applicant’s website at MIXEDINKEY.COM;¹⁰
2. An article entitled “Scales and Key Signatures” from the website METHOD-BEHIND-THE-MUSIC.COM;¹¹
3. An article entitled “Advanced Key Mixing Techniques for DJs” from the website DJTECHTOOLS.COM;¹²
4. A product offering on the AMAZON.COM website for “Circle of Fifths Chart Treble Clef (Notebook Size) (English, Spanish, French, Italian and German Edition);¹³
5. An article entitled “How to Master the Circle of Fifths and Key Signatures” from the website INSTRUCTABLES.COM;¹⁴
6. An article entitled “Relationships Between Keys – The Circle of Fifths” from the website MUSICCRASHCOURSES.COM;¹⁵

With its Request for Reconsideration, Applicant submitted the following evidence to traverse the refusal:

1. A second, and largely duplicative, Declaration of Mr. Vorobyev,¹⁶ with additional exhibits including the following:
 - a. Screenshots from homepage of Applicant’s mixedinkey.com website and an introductory video for the Mixed In Key Software;¹⁷

- b. Full screenshot of the homepage of Applicant's mixedinkey.com website;¹⁸
- c. A product offering on the AMAZON.COM website for “Circle of Fifths Chart Treble Clef (Notebook Size) (English, Spanish, French, Italian and German Edition);¹⁹ and
- d. An article entitled “Advanced Key Mixing Techniques for DJs” from the website DJTECHTOOLS.COM.²⁰

With the Denial of Applicant’s Request for Reconsideration, the Examining Attorney submitted the following evidence in support of the refusal:

1. A “How-To Guide (to Harmonic Mixing)” from the website HARMONIC-MIXING.COM (which, from its content, which appears to be affiliated with Applicant);²¹

⁵ *Id.* at TSDR 12-27.

⁶ *Id.* at TSDR 28-48.

⁷ Response to Office Action of June 28, 2018 at TSDR 18-21.

⁸ *Id.* at TSDR 23-25.

⁹ *Id.* at TSDR 27-31.

¹⁰ Office Action of July 23, 2018 at TSDR 6-11. This appears to be an updated or revised version of Applicant’s online Official Harmonic Mixing Guide Office provided with the first Office Action of March 8, 2018 at TSDR 6-11.

¹¹ Office Action of July 23, 2018 at TSDR 12-19.

¹² *Id.* at TSDR 20-33.

¹³ *Id.* at TSDR 34-38.

¹⁴ *Id.* at TSDR 39-49.

¹⁵ *Id.* at TSDR 50-52.

¹⁶ Request for Reconsideration of October 19, 2018 at TSDR 15-18 – a duplicate of Applicant’s Response to Office Action of June 28, 2018 at TSDR 18-21.

¹⁷ *Id.* at TSDR 20-22 – a duplicate of Applicant’s Response to Office Action of June 28, 2018 at TSDR 23-25.

¹⁸ *Id.* at TSDR 24-28 – a duplicate Applicant’s Response to Office Action of June 28, 2018 at TSDR 27-31.

¹⁹ *Id.* at TSDR 30 – a duplicate of the Office Action of July 23, 2018 at TSDR 34.

²⁰ *Id.* at TSDR 32-35 – a duplicate of the Office Action of July 23, 2018 at TSDR 20-33.

²¹ Denial of Request for Reconsideration of December 3, 2018 at TSDR 4-5.

2. An article entitled “What is the difference between the Circle of Fifths and the Camelot Wheel?” from the website MUSIC.STACKEXCHANGE.COM;²²
3. An article entitled “Using the Camelot Wheel for Harmonic Compatibility” from the website LOOPMASTERS.COM;²³
4. An article entitled “Advanced Key Mixing Techniques for DJs” from the website DJTECHTOOLS.COM;²⁴
5. An article entitled “How to Mix Harmonically” from the website DJINGTIPS.COM;²⁵
6. A blog posting entitled “Harmonic Mixing w/ DJ Endo Pt. 1: What Is Harmonic Mixing?” from the website DUBSPOT.COM;²⁶ and
7. An article entitled “Harmonic Mixing Tips for DJs and Musicians” from the website Ask.Audio.²⁷

II. Background: The Circle of Fifths, The Mixed in Key Software, The Camelot Wheel, and Applicant’s Applied-For Design

A. The Circle of Fifths and Music Theory

The following facts regarding the Circle of Fifths and music theory, which come from industry publications made of record by the Examining Attorney, are undisputed by Applicant.

²² *Id.* at TSDR 6-10.

²³ *Id.* at TSDR 11-13.

²⁴ *Id.* at TSDR 14-28 – a duplicate of the Office Action of July 23, 2018 at TSDR 20-33.

²⁵ *Id.* at TSDR 29-34.

²⁶ *Id.* at TSDR 35-40.

²⁷ *Id.* at TSDR 41-48.

The Circle of Fifths was invented by Nikolai Diletskii in his late 1670's treatise on musical composition called the **Grammatika**. In 1728, Johann David Heinichen improved upon the design to develop the modern version used today.²⁸ The Circle of Fifths is comprised of numerous building blocks derived from music theory. The first of these building blocks is the **key signature**. A **key** is a set of seven notes collectively called a **scale**. The scale is built by a specific relationship between the notes. These relationships are different depending on whether one plays a musical instrument in a major or minor scale, for instance.²⁹ When the musician plays the eighth note of a scale, she is back to the start of the scale on the first note which is called the **tonic**, but now one **octave** higher. If the musician plays the tonic and the first octave above it, the listener hears the same tone twice with one higher in frequency in **unison**, and they sound pleasing together to the listener's ears. This is called **consonance**. It is called **dissonance** when the two tones seem to clash.³⁰

²⁸ "The Circle of Fifths Explained," Office Action of March 8, 2018 at TSDR 14.

²⁹ *Id.* at TSDR 16.

³⁰ *Id.*

Chords are built with a grouping of notes played together that are all consonant and pleasing. The basic form of a chord is the **root** of the chord, plus the **third** above it, and then the **fifth** above the root as well.³¹ Within chords, there are three types of fifths based on the number of **semitones** above the root the fifth lies: (a) Perfect Fifths (7 semitones), (b) Diminished Fifths (6 semitones), and (c) Augmented Fifths (8 semitones). In the Circle of Fifths, one is only concerned with **perfect fifths** going clockwise around the circle. Moving counter-clockwise one finds the perfect fourth from the root.³² There are **major chords** and **minor chords**, which are denoted with capital letters and lower-case letters, respectively.³³ Every **major key** has a **relative minor key**. What this means is that both keys use the exact same notes, including any **accidentals (sharps or flats)**. The difference is they have a different tonic and the distance relationship between the notes is changed slightly.³⁴ The naming convention for major keys will usually use a flat accidental, such as *E_b* (to be read as “E-flat”), except for *F[#]* (“F-sharp”). Minor keys largely use sharp accidentals to name the keys except for *B_b* (“B-flat”). This has to do with the count of semitones when constructing the chords.³⁵

³¹ *Id.*

³² *Id.* at TSDR 17.

³³ *Id.* at TSDR 18.

³⁴ *Id.* at TSDR 19.

³⁵ *Id.* at TSDR 20.

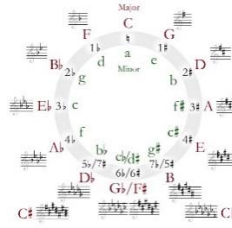
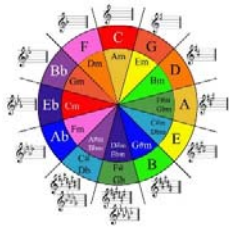
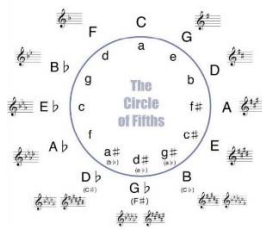
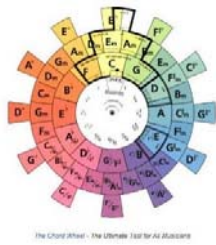
The Circle of Fifths helps with the task of memorizing which of these major or minor keys has what number of flats or sharps and on which notes. If the musician knows the melody of a song and needs to figure out the chords on a piano or a guitar so a group of friends can sing along, she can **transpose** a song quickly if needed, all in her head. For example, if a song is a bit out of range for a vocalist, all that the musician needs to do is find the tonic of the key she wants to use, and she can find the chords right off of the Circle.³⁶ Whether the musician needs a chord progression, to transpose a song, to help transcribing music, or remember which keys have which accidentals, the Circle of Fifths is the catch-all tool for these tasks.³⁷

Although the basic format is the same, over time the Circle of Fifths has been represented in varied configurations, several examples of which were made of record by the Examining Attorney:³⁸

³⁶ *Id.* at TSDR 21-22; *see also* Office Action of July 23, 2018 TSDR at 14: “Transposition: Scale patterns can be duplicated at any pitch. Rewriting the same scale pattern at a different pitch is called **transposition**. ... All the notes of a piece can be modified in this way, by finding a note’s counterpart in the modified scale.”

³⁷ *Id.* at TSDR 26 *see also* Office Action of July 23, 2018 TSDR at 40-41: “The Circle of Fifths in music is like the King Road Atlas for understanding how to ‘read’ (like a book) music and being able to identify our Key names and signatures. ... [It] is a lovely visual tool that teaches you exactly what is in each key of our music that we play! ... It lists all of the major keys, minor keys, and how many sharps and flats you have in each key.”

³⁸ The Circle of Fifths images are from the Office Action of March 8, 2018 at TSDR 25, 39 and 38, Office Action of July 23, 2018 and TSDR 15, 40-41 and 50, and the Denial of Request for Reconsideration of December 3, 2018 TSDR at 6.



As shown in the examples of the Circle of Fifths above, color is sometimes used to graphically differentiate the major key and minor key segments within the Circle.

B. Applicant's Applied-For Design and the MIXED IN KEY Software

Applicant submitted Mr. Vorobyev's First and Second Declarations to explain the MIXED IN KEY software and the presence of Applicant's Applied-For Design therein. MIXED IN KEY is software that processes and analyzes music with respect to musical key, energy, and cue points so that DJs may manipulate, mix and perform music and sounds in an optimal manner. At the heart of the MIXED IN KEY software is a sophisticated electronic algorithm that is used in the scanning of a user's music files and detecting of, among other things, their musical key so that each file can be

assigned a value in two different formats: (i) musical key (e.g., C Minor); and (ii) the Camelot System's notation (e.g., 12B)³⁹ – which we explain further below.

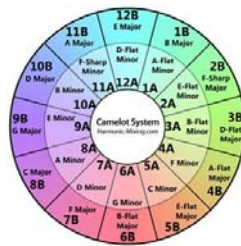
The Camelot Wheel

The following discussion on Applicant's harmonic-mixing.com website regarding Harmonic Mixing of musical tracks enabled by the so-called "Camelot Wheel" is instructive:

Harmonic Mixing is an advanced technique used by top DJs ... By **mixing tracks that are in the same or related keys**, harmonic mixing enables long blends and mash-ups. **The goal is to eliminate key clashes.**

Harmonic mixing consists of two elements: **knowing the key of every song that you play and knowing which keys are compatible.** To get started, find the keys of your songs. ... To save time, you can use professional DJ software such as Mixed In Key. Mixed In Key scans your MP3 and WAV files, and shows you the key of every song.

To help DJs learn harmonic mixing, Mark Davis created the Camelot [W]heel, a **visual representation of which keys are compatible with each other.**



On the Camelot wheel, each key is assigned a keycode number from one to twelve, like hours around a clock.

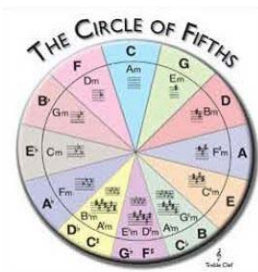
Many professional DJs move around the Camelot [W]heel with every mix. To select a compatible song, choose a keycode within one "hour" [clockwise or counterclockwise] of your current keycode. ... This mix will be smooth every time.

³⁹ Vorobyev Decls. submitted with Response to Office Action of June 28, 2018 TSDR at 19, ¶¶ 8-9 and with Request for Reconsideration of October 19, 2018 at 16, ¶¶ 8-9. From Mr. Vorobyev's Declarations and Applicant's specimens of use made of record, it is apparent to us that the MIXED IN KEY software discussed in his Declaration is the same as the "computer software for music analysis and processing; computer software for manipulating, mixing, and performing music and sounds" identified in Class 9 in the subject Application.

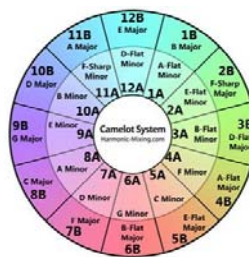
You can also mix between inner and outer wheels if you stay in the same “hour” ... and notice the change in melody as you go from Minor to Major. Harmonic mixing is a simple technique, but it opens up a world of creativity. You will play creative DJ sets and discover interesting song combinations. It’s easy to get started with any music genre.⁴⁰ (Emphasis added).

With this explanation in mind, below are side-by-side renditions of the Circle of Fifths, the Camelot Wheel, and Applicant’s Applied-For Design:

Circle of Fifths



Camelot Wheel



Applicant’s Applied-For Design



In its brief, Applicant contends that the Camelot Wheel is not Applicant’s Applied-For Design sought for registration, but rather is Applicant’s “**much more elaborate** chart, which has both traditional musical notes in plain text surrounding the chart and traditional musical keys in each cell of the chart along with [Applicant’s] ... own notations.” (Emphasis original).⁴¹ Thus, Applicant concedes that Applicant’s Applied-For Design is a stripped down version of Applicant’s Camelot

⁴⁰ Denial of Request for Reconsideration of December 3, 2018 TSDR at 4-5; *see also* Applicant’s website provided with the Office Action of March 8, 2018 TSDR at 7-8: “When Mixed in Key scans your files, it shows you results using the Camelot Wheel notation.... **We’ll teach you how to use those results.** ... On this wheel, musical keys can be seen as “hours” on a clock. For example, 4 o’clock corresponds to 4B or 4A. The letter B represents Major keys, and letter A represents Minor keys. Mixed in Key detects these Camelot values for every MP3 and WAV file, and you’ll see them in your favorite DJ software.” (Emphasis added).

⁴¹ 11 TTABVUE 11.

Wheel. This concession, we find, is consistent with the understanding of the DJ mixing industry (for example, in a STACKEXCHANGE article):

What is the difference between the Circle of Fifths and the Camelot Wheel?: I understand the Camelot Wheel is used by DJs to mix songs of different keys together by using adjacent and relative major/minor keys. Can't this same information be deduced from the Circle 3 of Fifths? I don't understand the need for a separate tool for this.

Answer: **They represent the same exact system it's just presented in a different way. The only differences are it uses colors instead of a key signature to show relationship between keys**, spun to have E major/C# minor on top, and labeled with letters and numbers which is presumably to abstract from the concept of a circle related by movements of 4ths and 5ths and think of it more like a clock. **A DJ doesn't need to know how many sharps or flats a key has, just know the relationship to other key which seems to be the reason for the changes you see.** (Emphasis added).⁴²

Similarly (in a LOOPMASTERS article):

Here is a great tool for you to use if you're unsure of what keys are complimentary with each other. This simple chart is referred to as the "Camelot Wheel". The Camelot Wheel is very simple to use. You can step from one key into the next either clockwise or anti clockwise, and between inner and outer circles. The only stipulation is that you can only move one step in any direction to stay in complimentary key with your current selection. **This is a simple and great method if you are no[t] too familiar with music theory or don't know what keys will work together in your productions.** (Emphasis added).⁴³

Specifically relating to the usefulness of the Circle of Fifths as represented by the Camelot Wheel within the MIXED IN KEY software (in a DJTECHTOOLS article):

There is one simple way to mix from major to minor harmonically: match the number, and change the letter from A to B or vice versa. Check out **the [C]amelot [S]ystem created by Mixed in Key below which makes it easy to visualize.** In this case D minor (7A) contains the same notes as F major (7B) so the two can be mixed together ... Key matched mixing,

⁴² Denial of Request for Reconsideration of December 3, 2018 TSDR at 6-8.

⁴³ Denial of Request for Reconsideration of December 3, 2018 TSDR at 11.

including major/minor or minor/major flips, present an exciting way to truly “mix” music.⁴⁴

Again (in a DUBSPOT article):

In order to mix harmonically, DJs must know the musical keys of all of the records they play. Once they know the key of all their tracks, they can then sort their music collection by key and play tracks that are in the same or complementing keys so that the songs they play will appear to “sing” together. **Mixing harmonically allows DJs to have full control over the energy of the room because they can pick keys that boost and lower the energy of the crowd.** Not only will harmonic mixing help you choose records that are musically compatible quicker and make your DJ sets flow better, but it will also sonically improve your sound since you are playing tracks that complement each other. When you mix harmonically, your vocals, melodies, and basslines will be in key, and will blend musically, making your tracks appear to “sing” with one another.

One thing you might be saying to yourself at this point is “this is all great, but I don’t know anything about music theory.” Well, fear not. Today there is technology that will actually go through your entire music collection and write the musical keys into the metadata of your songs, so you can then view the different keys in ... whatever your DJ program of choice is.

The most popular harmonic mixing software is called “Mixed in Key.” This software allows you to analyze all your music folders and label your songs tags ...

Once you’re done scanning all of your music, there is a simple chart you can follow called the “Camelot Wheel” that will tell you which keys are compatible. The Camelot Wheel lists musical keys that are displayed as “hours” on a clock. ... To follow the chart, you can mix between songs by subtracting one “hour” (-1) adding one “hour” (+1) or staying in the same “hour.” ...

Music theory wise, the Camelot [W]heel represents the “Circle of Fifths.” The Circle of Fifths shows the relationships among the twelve tones of the chromatic scale, their corresponding key signatures, and their associated relative minor and major keys. ... **For DJs, it is just a handy chart that will guide you to choose what tracks will go well together better.**⁴⁵ (Emphasis added).

⁴⁴ Denial of Request for Reconsideration of December 3, 2018 TSDR at 15.

⁴⁵ Denial of Request for Reconsideration of December 3, 2018 TSDR at 35-37.

C. Applicant's Applied-For Design and Applicant's Services

As noted, Applicant's Class 41 specimen shows text juxtaposed to Applicant's Applied-For Design that states: "Become a Master of Harmonic Mixing" and "We'll teach you all the cool tricks used by pro DJs. Explore this website to learn DJ techniques like Energy Boost mixing and Power Block mixing. The How-To Guide covers a bunch of DJ techniques that were secret before we published them."

Concerning Applicant's Class 41 services, Mr. Vorobyev, in his Declaration, states: (1) Applicant's Applied-For Design is featured prominently on the portion of the homepage of Applicant's website where Applicant's advice and information services are advertised, (2) Applicant's Applied-For Design is not utilized and does not appear upon the interior webpages where Applicant's advice and information services are actually rendered, (3) Applicant did not submit the interior webpage cited by the Examining Attorney, <http://mixedinkey.com/harmonic-mixing-guide/>, as a specimen in support of the Application, (4) this interior webpage relied upon by the Examining Attorney is only one of many pages wherein Applicant renders its advice and information services, and those other webpages do not utilize Applicant's Applied-For Design in the rendering of the services, and consequently (5) Applicant's Applied-For Design is not used in the rendering of Applicant's advice and information services.⁴⁶

Notwithstanding Mr. Vorobyev's protestations, in addition to Harmonic Mixing, we find that one of the other DJ techniques which Applicant advertises on its website

⁴⁶ Vorobyev Decl. submitted with Response to Office Action of June 28, 2018 TSDR at 20-21, ¶¶ 18-21.

homepage in connection with its “advice and information services” is Energy Boost Mixing. We already discussed above how Applicant’s Applied-For Design is used in connection with Harmonic Mixing.

As noted by another industry publication made of record by the Examining Attorney (DJING TIPS):

There’s yet **another secret weapon in the arsenal of harmonic mixing**, however, and that’s **energy boost mixing**. In this approach, you forget about compatible keys and **pick the next song so its key is one or two semitones above the current one**. For example, if the currently playing track is Martin Solveig - Rejection (Ian Carey Mix), which is in *E^b m* [E-flat minor], then the next one should be in either *Em* [E-minor] or *Fm* [F-minor). A key change like this is very dramatic and gives an energy lift to the dancefloor.

In Camelot numbers, energy boost mixing translates into adding 7 or 2 to your current Camelot number to go 1 or 2 semitones higher, respectively. In the example above, E-flat minor is 2A, which means that the next track has to be either 9A or 4A.

As opposed to “classic” harmonic mixing, energy boost mixing isn’t so favorable for long blends because the records’ keys are incompatible. Use the EQs [“equalizers” that boost or reduce certain frequencies in an audio signal] to cut out conflicting melody elements and avoid key clashes during energy boost transitions.⁴⁷

⁴⁷ Denial of Request for Reconsideration of December 3, 2018 TSDR at 31.

D. Applicant's Arguments

Applicant contends that its design functions as a mark, relying on Mr. Vorobyev declaration who asserts that: (1) the circular design reflected in Applicant's Applied-For Design is not used in the operation of the software, as it is incapable of detecting musical keys, energy, and/or cue points in music, (2) the colors reflected in Applicant's Applied-For Design have no bearing upon the operation of or results achieved by the MIXED IN KEY software, (3) the alpha-numeric designations within Applicant's Applied-For Design are not the traditional music keys (e.g., B-major, C-minor, etc.), (4) there are no energy notations or cue points reflected within Applicant's Applied-For Design, and (5) the results of the MIXED IN KEY software's scanning of a user's musical files are not displayed in the form of, or within, Applicant's Applied-For Design; instead, the results of the MIXED IN KEY software's scanning of a user's musical files are displayed in a row and column format, with columns entitled: "Tempo, "Key Result," "Energy," and "Cue Point."⁴⁸

⁴⁸ *Id.* TSDR at 19-20, ¶¶ 10-15.

Regarding the proposed mark's placement, Mr. Vorobyev observes that: (1) Applicant's Applied-For Design is prominently featured at the top of the screen during use of the MIXED IN KEY software, (2) Applicant's Applied-For Design enjoys that prominent position so that it may be directly associated with Applicant's software, (3) images of that screen, prominently featuring the Applicant's Applied-For Design, also dominate the advertising for the MIXED IN KEY software, including but not limited to on Applicant's website and YouTube, and (4) enhancing its prominent position on the screen, the size of Applicant's Applied-For Design appears much larger than any other text, icon or menu item on the MIXED IN KEY screen.⁴⁹

In addition, Applicant asserts that a term or design, including in this case Applicant's Applied-For Design, may be found to be **both** a symbol, process, technology or costume, on the one hand, and a trademark, service mark or trade dress on the other hand,⁵⁰ citing, for example, *In re Osmotica Holdings Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010); *In re Moody's Inv'r Serv., Inc.*, 13 USPQ2d 2043, 2049 (TTAB 1989); *In Re Red Robin Enter., Inc.*, 222 USPQ 911, 912 (TTAB 1984); *Liquacon Corp. v. Browning-Ferris Indus., Inc.*, 203 USPQ 305, 318 (TTAB 1979); and *In re Produits Chimiques Ugine Kuhlmann SA*, 190 USPQ 305, 306 (TTAB 1976). We agree that a term or design **may** be both a symbol, process, technology or costume, on the one hand, and a trademark, service mark or trade dress on the other hand. We also note, however, that careful attention must be paid to the specimens of record in

⁴⁹ *Id.* TSDR at 20, ¶¶ 16-17.

⁵⁰ 11 TTABVUE 12-16.

each case and the manner in which the proposed mark appears in the specimens of record to determine whether the proposed mark indeed functions as a mark. Because none of the marks in the cited cases are similar to the proposed mark before us, we find the cited cases unhelpful in resolving this appeal.

In *Osmotica Holdings*, the Board affirmed the refusal to register the applicant's proposed OSMODEX mark, stating "[a]lthough the [specimens of use] ... both include [Applicant's mark] and purportedly make reference to applicant's consulting services, we conclude that the mark would be perceived by the relevant public as identifying only applicant's drug delivery technology, and not as identifying consulting services." 95 USPQ2d at 1669. In *Moody's Investors Service*, the Board again affirmed the refusal to register, stating "applicant's various rating symbols, including the designation 'Aaa', are used in the specimens of record to identify and distinguish not applicant's rating services, but rather the ratings themselves, and that they would be so perceived by the public ..., not service marks." 13 USPQ2d at 2049.

In *Red Robin*, the Board reversed the refusal to register a bird (costume) for entertainment services in the nature of in-person performances. The Board was concerned:

whether the costume, so employed, would be perceived as a service mark (and not merely as a comic character), especially in light of the scanty details as to use revealed by the record, we believe this was a legitimate and important issue for the Examining Attorney to raise. However, we conclude that this problem is obviated by applicant's evidence of its ownership of a preexisting registration of the identical mark for restaurant services, ... thereby demonstrating, on the facts of this case, that the mark's distinctive features would be perceived as more than a mere ornamental design.

Red Robin, 222 USPQ at 914. Here, however, there is no prior registration of Applicant's Applied-For Design for other goods or services on which Applicant can rely to demonstrate that the design functions as a trademark or service mark.

In *Produits Chimiques*, the Board affirmed the refusal to register the applicant's proposed CELUKA service mark, stating:

The material relied on by applicant in support of its assertion that [its mark] is, in fact, used to identify services as distinguished from a process consists of two different brochures. ... The [mark] ... is used therein merely to refer to ... process[es], ... materials, ... plastics, ... technique, ... profiles, ... polystyrene, ... extrusion line, ... moldings, ... licenses, ... products ..., and the like. **As used, [the applicant's mark] does not function as a service mark to identify the services claimed. That is, on the record presented, it is not being used as a mark in the sale or advertising of services rendered by applicant.** (Emphasis added).

Produits Chimiques, 190 USPQ at 308.

In *Liqwacon*, the opposer alleged prior common law rights to applicant's LIQWACON mark for substantially identical services. The Board found the applicant had priority, rejecting the opposer's argument that the applicant was referring to its mark as a "process" on certain specimens. However, the Board found that on other specimens, applicant made service mark use of the mark. . 203 USPQ at 318. Here, on the other hand, we consider the same set of specimens having only a single rendering of use of the proposed mark for each of the Class 9 goods and Class 41 services.

Applicant argues that its Applied-For Design functions as a trademark for its software and as a service mark for its advice and information services because of the way the mark appears during the functioning of the software and the advertising of

its services on the homepage of Applicant's website – appearing prominently in vivid colors, set-off and apart from the surrounding text and other graphical matter.⁵¹

E. The Examining Attorney's Arguments

The Examining Attorney, in his brief, posits that:

[A]pplicant's musical chart [Applicant's Applied-For Design] has not been perceived as functioning as a source indicator by parties that have used its goods/services. Instead, **the chart has been perceived as a tool used to understand how applicant's software works or how its services are rendered.** This reinforces the argument that applicant's circular chart does not create a commercial impression consistent with its use as a source identifier for its goods/services. ... Applicant's argument that certain symbols can function as a trademark or service mark while simultaneously functioning as "a symbol, process, technology or costume" is legally correct. ... However, the mark at issue in the present case does not meet these standards because, as illustrated by the evidence discussed above, the musical chart adopted by applicant does not create a commercial impression consistent with its use as a trademark or service mark. Instead, its use in operating applicant's software and its close resemblance to other commonly used musical charts indicates that it is unlikely to be perceived as a trademark or service mark by consumers.⁵² (Emphasis added).

The Examining Attorney cites *Moody's Inv'r Serv.*, 13 USPQ2d at 2048-49 (already discussed above) and *In re Keep a Breast Found.*, 123 USPQ2d 1869, 1879-80 (TTAB 2017) in support of the refusal to register. In *Keep a Breast Found.*, the Board affirmed to the refusal to register the applicant's mark, a three-dimensional cylindrical cast of female breasts and torso for association and educational services, because the specimens made of record by the applicant did not show use of the applied-for mark in connection with any of the services specified in the application. *Id.*, 123 USPQ2d at 1870 and 1885. The Board stated: "the ... specimens ... all fail to

⁵¹ 11 TTABVUE 15-18 and 20-21.

⁵² 13 TTABVUE 10.

associate the proposed mark with any of the recited services, thus making it unlikely that the relevant consumers will perceive the casts as indicating source.” *Id.*, 123 USPQ2d at 1880.

The Examining Attorney, in his brief, further states:

The values in the chart [Applicant’s Applied-For Design] represent musical keys and their relationship to each other as depicted in the chart [that] is meant to show which tracks would blend well together. ... Despite applicant’s arguments to the contrary, **the prominent placement of the chart on applicant’s software** is not likely to lead applicant’s consumers [DJs] to believe the chart is a source indicator for applicant’s goods/services. Instead, its prominent placement **is a direct result of the need to quickly refer to the chart when mixing tracks in order to understand the relationship between the various tracks as depicted in the chart.** Consumers are therefore likely to perceive the chart as a tool used to understand how to operate the software or use the services, not as a source indicator for applicant’s software⁵³ (Emphasis added).

Based on the evidence of record, we are constrained to agree with the Examining Attorney.

⁵³ 13 TTABVUE 7.

III. Applicable Law

It has often been said that: “[b]efore there can be registration, there must be a trademark.” *In re Aerospace Optics Inc.*, 78 USPQ2d 1861, 1862 (TTAB 2006) (quoting *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1978)).⁵⁴ The starting point for our analysis is Section 45 of the Trademark Act, where “trademark” is defined in relevant part as “any word, name, symbol, or device, or any combination thereof used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” As the Board stated in *American Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 USPQ 149, 154 (TTAB 1973):

It is settled that not every designation that is placed or used on or in connection with a product necessarily functions or is recognized as a trademark for said product; not every designation adopted with the intention that it performs a trademark function and even labeled as a trademark necessarily accomplishes that purpose; and there are certain designations that are inherently incapable of functioning as trademarks to identify and distinguish the source of the products in connection with which they are used.

Similarly, a service mark is “a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others.” Trademark Act Section 45, 15 U.S.C. § 1127. The fundamental function of a service mark is to identify the source of services in commerce and to distinguish them from the services of others. Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051, 1052,

⁵⁴ See also *In re Int’l Spike, Inc.*, 196 USPQ 447, 449 (TTAB 1977) (The law pronounced in the *Bose* case is just as applicable to pictures and illustrations as it is to words. The Trademark Act is for the registration, not the creation, of trademarks).

1053 and 1127. From this premise it directly follows that subject matter presented for registration as a service mark must function as such; that is, if potential purchasers do not perceive a proposed mark as identifying a single source of origin (whether or not the identity of that source is known), the mark may not be registered.

A. The Critical Question, Whether Applicant's Applied-For Design would be Perceived as an Indicator of Source for Applicant's Goods or Services

The key question here is whether Applicant's Applied-For Design would be perceived as a source indicator for Applicant's goods or services. *See In re Brass-Craft Mfg. Co.*, 49 USPQ2d 1849, 1852 (TTAB 1998), *aff'd mem.*, 217 F.3d 855 (Fed. Cir. 1999); *In re Volvo Cars of N. Am. Inc.*, 46 USPQ2d 1455, 1459 (TTAB 1998). "The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public. To make this determination we look to the specimens and other evidence of record showing how the designation is actually used in the marketplace." *In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010).⁵⁵

The TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1202.04 (Oct. 2018) instructs that:

Matter is merely informational and does not function as a mark when, **based on its nature and the context of its use by the applicant and/or others in the marketplace**, consumers would perceive it as

⁵⁵ As noted above, Applicant and the Examining Attorney argue by analogy to marks and specimens in other Board cases as to whether Applicant's specimens of record show use of Applicant's Applied-For Design as a trademark for Applicant's software or as a service mark for Applicant's advice and information services. However, the registrability of each mark must be decided on a case-by-case basis. *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("The Board must decide each case on its own merits.") (citing *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 424 (Fed. Cir. 1985)).

merely conveying general information about the goods or services or an informational message, and not as a means to identify and distinguish the applicant's goods/services from those of others. (Emphasis added).

Evidence of the public's understanding of a term includes materials showing Applicant's manner of use and the manner of use by third parties (e.g., Applicant's specimens of use, website pages, Internet excerpts where sufficient text surrounding the designation is provided to enable the context to be understood, and promotional and advertising materials). See *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987) (any competent source suffices to show the relevant public's understanding of a contested term, including purchaser testimony, trade publications, and other publications).

Applicant's intent that Applicant's Applied-For Design function as a trademark or service mark does not make it so. *In re Vertex Group LLC*, 89 USPQ2d 1694, 1701 (TTAB 2009) (“[M]ere intent that a word, name, symbol or device function as a trademark or service mark is not enough in and of itself.”). Moreover, the mere fact that Applicant's Applied-For Design appears on its specimens and in its advertising, even separate and apart from other indicia which appear on them, does not make it a trademark or service mark. See *D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016).

B. Our Review of the Specimens and Other Evidence Made of Record

The Board has stated that a trademark “must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods” and this is determined “by examining the specimens of use along with any other relevant material submitted by applicant during prosecution of the application”,

Aerospace Optics, 78 USPQ2d at 1862 (citing *In re Safariland Hunting Corp.*, 24 USPQ2d 1380 (TTAB 1992)). Similarly, “a service mark must be ‘used in such a manner that it would be readily perceived as identifying’ the services, which is ‘determined by examining the specimens of record in the application’” *Keep a Breast Found.*, 123 USPQ2d at 1876 (citing *Moody’s Inv’r Serv.*, 13 USPQ2d at 2047), including any other relevant material the applicant makes of record.

As confirmed by industry publications that the Examining Attorney made of record, we find that Applicant’s Applied-For Design is a stripped down version of the Camelot Wheel, which in turn is a reinterpretation of the Circle of Fifths, used by DJs (i) as a graphic tool⁵⁶ necessary to the functioning of Applicant’s MIXED IN KEY software to quickly discern the harmonic compatibility of music tracks (a/k/a “Harmonic Mixing”), and (ii) in connection with Energy Boost Mixing, the very advice and information service advertised in connection with Applicant’s Applied-For Design on the homepage of its website.

We conclude that the design does not serve as an indicator of source for the goods set forth in the application. Our conclusion is supported by Mr. Vorobyev’s statements regarding how the MIXED IN KEY software operates and in the DJ industry articles provided by the Examining Attorney. Without a DJ’s reference to Applicant’s Applied-For Design, the music track “Key Result” data column provided during the operation

⁵⁶ We find that the “graphic tool” elements of Applicant’s Applied-For Design include the circle, the internal segments visually differentiated by color, and the use of an alpha-numeric in each segment representing the equivalentents of the major and minor keys of the Circle of Fifths.

of Applicant's software would be meaningless to a DJ using the software for Harmonic Mixing or Energy Boost Mixing – unless the DJ was to memorize the alpha-numeric designations and their relationships within Applicant's Applied-For Design.

Turning to Applicant's advice and information services in the field of DJ'ing methodology and the analysis, selection and arrangement of music and sound recordings include the techniques of Harmonic and Energy Boost Mixing. As promoted by Applicant, a DJ would most easily employ these techniques using Applicant's Applied-For Design as a graphic tool. Applicant's mere prominent inclusion of Applicant's Applied-For Design next to a brief explanation of Applicant's advice and information services, without more, does not turn a graphical tool for DJ techniques into a mark indicating the source of Applicant's services. We conclude that the proposed mark does function as a mark for the services recited in the application.

IV. Decision

The refusal to register Applicant's Mark under Trademark Act Sections 1, 2, 3, and 45 on the ground that it does not function as a trademark or service mark for Applicant's Class 9 goods or Class 41 services is **affirmed**.