

Goodman

United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Mailed: March 21, 2007

Opposition No. 91122045<sup>1</sup>

Educational Media Foundation

v.

Univision Radio, Inc.<sup>2</sup>

Cancellation No. 92042649

Univision Radio Inc.

v.

Texas CBS Radio  
Broadcasting L.P.

Before Kuhlke, Cataldo and Bergsman, Administrative  
Trademark Judges.

By the Board:

Pursuant to a settlement agreement, the parties filed  
in Opposition No. 91122045 and Cancellation No. 92042649,

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<sup>1</sup> For administrative convenience, we have issued a joint order with regard to these opposition and cancellation proceedings since all the parties involved have entered into an agreement to join in a "consolidated" concurrent use proceeding. The papers filed in both the opposition and cancellation proceedings seeking a concurrent use proceeding are identical. Univision Radio, Inc. is the applicant in the opposition proceeding and the petitioner in the cancellation proceeding.

<sup>2</sup> The parties' consented motion to amend the title of the proceedings to reflect the current names of the parties is granted. In accordance with the parties' motion, we have

"consented motions" "to dismiss the opposition and cancellation proceedings and to institute a concurrent use proceeding involving all of the parties listed above."<sup>3</sup>

Opposition No. 91122045

In Opposition No. 91122045 the parties Educational Media Foundation (hereinafter EMF) and Univision Radio Inc. (hereinafter Univision Radio) seek to amend Univision Radio's involved application, Serial No. 75430440, to an application for concurrent use with EMF and Texas CBS Radio (hereinafter CBS Radio) being cited as exceptions to Univision Radio's claim of exclusive right to use its mark in commerce, and to dismiss the opposition without prejudice in favor of a concurrent use proceeding.

EMF and Univision Radio's joint motion to amend and dismiss is granted. Univision Radio's application Serial No. 75430440 is amended to one for a concurrent use registration, claiming use in the geographic area specified, and Opposition No. 91122045 is dismissed without prejudice.

Cancellation No. 92042649

In Cancellation No. 92042649, the parties Univision Radio and CBS Radio seek to dismiss the proceeding without prejudice and to institute a concurrent use proceeding with registrant CBS Radio citing Univision Radio and EMF as its exceptions to its claim of exclusive use.

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substituted Univision Radio, Inc. for applicant in the opposition proceeding and petitioner in the cancellation proceeding.

<sup>3</sup> Although the parties titled the filings as "consented motions" the motions have been signed by all parties.

In appropriate situations, a cancellation proceeding may be terminated in favor of a concurrent use proceeding, if one party has a concurrent use application reciting the adverse party in the cancellation proceeding as an exception to its claim of exclusive use; the application is published in the Official Gazette for opposition; and no opposition is filed, or all oppositions filed are dismissed. TBMP Section 1113.02.

In this case, petitioner Univision Radio has amended the involved application in Opposition No. 91122045 (application Serial No. 75430440) to one for concurrent use and has cited CBS Radio as an exception to its claim of exclusive use in the state of Texas. As indicated above, we have dismissed the opposition without prejudice.

In view thereof, we find it appropriate to dismiss this cancellation and to institute a concurrent use proceeding. Accordingly, Univision Radio and CBS Radio's motion is granted, and Cancellation No. 92042649 is dismissed without prejudice.

A concurrent use proceeding, namely, Concurrent Use No. 94002217 is hereby instituted.

This concurrent use proceeding involves the following parties:

Univision Radio, Inc.  
Serial No. 75430440  
Serial No. 76525621  
Serial No. 76525622  
Serial No. 78159861

v.

Educational Media Foundation  
Serial No. 75771362

v.

Texas CBS Radio  
Registration No. 2326583

Applicant:

Univision Radio

Applicant's marks:

K-LOVE  
(Serial No. 75430440)



(Serial No. 78159861)



(Serial No. 76525621)

KLOVE  
(Serial No. 76525622)

Filing dates:

February 6, 1998 (Serial No.  
75430440)

April 30, 2002 (Serial No.  
78159861)

June 18, 2003 (Serial Nos.  
761525622 and 761525621)

Territory of Use:

for the area comprising the  
follow counties in California:  
Los Angeles County, Orange  
County, Ventura County, Inyo  
County, San Bernardino County,  
Eastern Portions of Kern  
County, Western Portions of  
Riverside County, and San  
Diego County; and the  
following counties in Texas:  
Houston County, Trinity  
County, Polk County, Tyler  
County, Jasper County, Newton  
County, Orange County,  
Jefferson County, Hardin  
County, Chambers County,  
Liberty County, San Jacinto  
County, Walker County, Madison  
County, Brazos County, Grimes  
County, Burleson County,  
Washington County, Fayette  
County, Colorado County,  
Lavaca County, Jackson County,  
Wharton County, Matagorda  
County, Calhoun County, Austin  
County, Waller County,  
Montgomery County, Hanis  
County, Fort Bend County,  
Brazoria County, and Galveston  
County.

Services:

designing and developing  
advertising for others; and  
promoting the goods and  
services of others through the  
distribution of printed  
material, promotion events,  
contests and by broadcast of  
radio commercials  
(Serial No. 75430440)

advertising services, namely,  
promoting the goods and  
services of others by  
preparing and placing  
advertisements through  
telecommunications channels,  
including, on-line, radio, and  
the global computer network

and through distribution of  
printed materials  
(Serial No. 78159861)

advertising services, namely,  
promoting the goods and  
services of others through the  
distribution of printed  
material and providing  
advertising for others on  
radio and a global computer  
network  
(Serial Nos. 76525621 and  
76525622)

radio broadcasting services  
(Serial nos. 75430440,  
78159861, 76525621, 76525622)

entertainment services in the  
nature of radio programming  
featuring news and talk shows,  
music, traffic reports, and  
listener call-in shows  
(Serial No. 75430440)

entertainment services in the  
nature of on-going audio  
programs provided via, on-  
line, radio and the global  
computer network, featuring  
music, news, talk shows,  
listener call-ins, traffic  
reports, and events, namely,  
grand openings, remote  
broadcasts, sports, charities,  
festivals, and listener  
contests  
(Serial No. 78159861)

entertainment services in the  
nature of ongoing radio  
programs provided by  
telecommunication channels,  
featuring music, news, talk  
shows, listener call-ins,  
traffic reports, and events,  
namely grand openings, remote  
broadcasts, sports, charities,  
festivals and listener  
contests  
(Serial No. 76525621)

entertainment services in the nature of ongoing audio programs provided via radio and a global computer network, featuring music, news, talk shows, listener call-ins, traffic reports, and events, namely grand openings, remote broadcasts, sports, charities, festivals and listener contests  
(Serial no. 76525622)

Attorney: Rami S. Yanni  
McDermott Will & Emery LLP

Applicant: Educational Media Foundation

Applicant's Mark: K-LOVE (Serial No. 75771362)

Filing Date: August 9, 1999

Services: radio broadcasting services;  
radio programming services

Territory of Use: for the area comprising the entire United States and its territories and possessions, with the exception of the follow counties in California: Los Angeles County, Orange County, Ventura County, Inyo County, San Bernardino County, Eastern Portions of Kern County, Western Portions of Riverside County, and San Diego County; and the following counties in Texas: Houston County, Trinity County, Polk County, Tyler County, Jasper County, Newton County, Orange County, Jefferson County, Hardin County, Chambers County, Liberty County, San Jacinto County, Walker County, Madison County, Brazos County, Grimes County, Burleson County, Washington County, Fayette County, Colorado County, Lavaca County, Jackson County, Wharton County, Matagorda County, Calhoun County, Austin

County, Waller County, Montgomery County, Harris County, Fort Bend County, Brazoria County, Galveston County, and the following counties in Texas: Cooke County, Jack County, Wise County, Denton County, Collin County, Fannin County, Lamar County, Red River County, Hunt County, Delta County, Hopkins County, Palo Pinto County, Parker County, Tarrant County, Dallas County, Rockwall County, Kaufman County, Rains County, Van Zandt County, Erath County, Hood County, Johnson County, Ellis County, Henderson County, Comanche County, Hamilton County, Bosque County, Somervell County, Hill County, Navarro County, Freestone County, and Anderson County

Attorney: William Merone  
Kenyon & Kenyon

Registrant Texas CBS Radio

Registration No. 2326583

Issued: March 7, 2000

Service Mark: KLUV

Services: radio broadcasting services

Territory of Use: for the area comprising the following counties in Texas: Cooke County, Jack County, Wise County, Denton County, Collin County, Famin County, Lamar County, Red River County, Hunt County, Delta County, Hopkins County, Palo Pinto County, Parker County, Tarrant County, Dallas County, Rockwall County, Kaufman County, Rains County, Van Zandt County, Erath County, Hood County, Johnson County, Ellis County, Henderson

County, Comanche County,  
Hamilton County, Bosque  
County, Somervell County, Hill  
County, Navarro County,  
Freestone County, and Anderson  
County

Attorney: Rebecca Borden  
CBS Radio, Inc.

Univision Radio's application Serial Nos. 78159861,  
76525621, 76525622 and EMF's Serial No. 75771362 are  
currently in examination and have not yet been published in  
the Official Gazette. The applications are unrestricted and  
presently suspended.

We note that the Univision and EMF seek to amend these  
applications (Univision Radio's Serial Nos. 78159861,  
76525621, 76525622 and EMF's Serial No. 75771362) to  
concurrent use applications by their motion filed in the  
opposition and cancellation proceedings. However, inasmuch  
as these applications are still in examination, the request  
to amend to a concurrent use application must be filed with  
the examining operation as these applications are still  
under the jurisdiction of the examining attorney. Moreover,  
until these applications are published and survive the  
opposition period, they cannot be added to the concurrent  
use proceeding. Accordingly, proceedings herein are  
suspended until application Serial Nos. 78159861 76525621,

76525622 and Serial No. 75771362 are published in the Official Gazette and survive the opposition period.<sup>4</sup>

When proceedings herein are resumed, and if it is otherwise appropriate at that time, Univision Radio's application Serial Nos. 78159861, 76525621, 76525622 and EMF's Serial No. 75771362 will be added to this proceeding.

The Board notes that the parties advise in their stipulations that they have entered into a confidential settlement agreement with regard to the concurrent use of their marks. Inasmuch as a settlement agreement may be considered as a potential means of resolving this proceeding, the parties may submit that agreement for consideration by the Board at the appropriate time.<sup>5</sup> The Board understands that the agreement is confidential, and that such submission may be made under seal after entry of an agreed protective agreement in the concurrent use proceeding.

The parties also should advise the Board if there are any other pending trademark applications and/or registrations which should be included in this proceeding.

Proceedings herein are suspended.

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<sup>4</sup> At the time of filing the amendments to these applications, the parties may want to notify the examining attorney of the dismissal of the opposition and institution of the concurrent use proceeding so that the applications are removed from suspension.

<sup>5</sup> The Board will consider any agreements worked out between the parties in determining whether concurrent registrations are to be granted, and if so, the geographic area to be covered by the registrations. See *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431 (CCPA 1970).