

ESTTA Tracking number: **ESTTA1326620**
Filing date: **12/05/2023**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

Petitioner information

Name	National Public Radio, Inc.		
Entity	nonprofit corporation	Incorporated or registered in	District of Columbia
Address	1111 NORTH CAPITOL STREET NE WASHINGTON, DC 20002 UNITED STATES		

Attorney information	JUDD LAUTER COOLEY LLP 1299 PENNSYLVANIA AVE NW STE 700 WASHINGTON, DC 20004 UNITED STATES Primary email: jlauter@cooley.com Secondary email(s): jwilliams@cooley.com , trademarks@cooley.com No phone number provided
Docket no.	

Registration subject to cancellation

Registration no.	7083243	Registration date	06/20/2023
Register	Principal		
Registrant	Tastemade, Inc. 3019 OLYMPIC BOULEVARD, STAGE C SANTA MONICA, CA 90404 UNITED STATES		

Goods/services subject to cancellation

Class 041. First Use: Mar 5, 2016 First Use In Commerce: Mar 5, 2016 All goods and services in the class are subject to cancellation, namely: Educational services, namely, providing online instruction in the field of recipes, food, food preparation, food presentation and how-to; Educational and entertainment services, namely, a continuing program about entertainment by celebrities, celebrity interviews, recipes, food, food preparation, food presentation and how-to accessible by means of television, cable, satellite, the internet, web-based applications, downloadable applications, computer networks and wireless communication networks; Entertainment services, namely, conducting contests; Entertainment services, namely, production and distribution of ongoing television programs in the field of entertainment by celebrities, celebrity interviews, recipes, food, food preparation, food presentation and how-to; Entertainment services, namely, providing ongoing television programs in the field of entertainment by celebrities, celebrity interviews, recipes, food, food preparation, food presentation and how-to via a global computer network; Entertainment services, namely, providing ongoing webisodes featuring entertainment by celebrities, celebrity interviews, recipes, food, food preparation, food presentation and how-to via a global computer network; Entertainment services, namely, an ongoing multimedia program featuring entertainment by celebrit-
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ies, celebrity interviews, recipes, food, food preparation, food presentation and how-to distributed via various platforms across multiple forms of transmission media; Entertainment services, namely, an ongoing series featuring entertainment by celebrities, celebrity interviews, recipes, food, food preparation, food presentation and how-to provided through television, cable, satellite, the internet, web-based applications, downloadable applications, computer networks and wireless communication networks; Entertainment services, namely, the provision of continuing television, internet TV, segments, shows and an ongoing web series featuring entertainment by celebrities, celebrity interviews, recipes, food, food preparation, food presentation and how-to delivered by television, cable, satellite, the internet, web-based applications, downloadable applications, computer networks and wireless communication networks; Providing entertainment services in the nature of ongoing Internet Protocol Television (IPTV) television programming segments in the field of entertainment by celebrities, celebrity interviews, recipes, food, food preparation, food presentation and how-to; Providing on-line videos featuring entertainment by celebrities, celebrity interviews, recipes, food, food preparation, food presentation and how-to, not downloadable

Grounds for cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
No use of mark in commerce before application, amendment to allege use, or statement of use was due	Trademark Act Sections 14(1) and 1(a), (c), and (d)

Marks cited by petitioner as basis for cancellation

U.S. registration no.	4786227	Application date	12/10/2012
Register	Principal		
Registration date	08/04/2015	Foreign priority date	NONE
Word mark	TINY DESK		
Design mark			
Description of mark	NONE		
Goods/services	Class 041. First use: First Use: May 22, 2008 First Use In Commerce: Apr 22, 2008 Entertainment services, namely, providing non-downloadable videos of live musical performances via the internet; providing audio podcasts in the field of music		

U.S. registration no.	5166374	Application date	08/18/2016
Register	Principal		
Registration date	03/21/2017	Foreign priority date	NONE
Word mark	TINY DESK		
Design mark			
Description of mark	NONE		
Goods/services	Class 009. First use: First Use: Mar 11, 2010 First Use In Commerce: Mar 11, 2010 Downloadable audio and video podcasts featuring music and live musical performances; downloadable videos featuring music and live musical performances		

	Class 041. First use: First Use: Dec 2, 2014 First Use In Commerce: Dec 2, 2014 Entertainment services, namely, arranging and conducting of competitions for musical performers; entertainment, namely, live music concerts; arranging and conducting events featuring live music
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U.S. registration no.	6950428	Application date	02/20/2020
Register	Principal		
Registration date	01/10/2023	Foreign priority date	NONE
Word mark	EL TINY		
Design mark			
Description of mark	NONE		
Goods/services	Class 009. First use: First Use: Feb 15, 2022 First Use In Commerce: Feb 15, 2022 Downloadable audio and video podcasts featuring music and live musical performances; downloadable videos featuring music and live musical performances Class 041. First use: First Use: Sep 15, 2021 First Use In Commerce: Sep 15, 2021 Entertainment services, namely, live music concerts; arranging and conducting events featuring live music; entertainment services, namely, providing non-downloadable videos of live musical performances via the internet; providing audio podcasts in the field of music		

Attachments	NPR - Pet. to Cancel TINY Registration.pdf(109640 bytes)
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Signature	/Jessica M. Williams/
Name	Jessica M. Williams
Date	12/05/2023

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 7,083,243
For the Trademark TINY
Registered on June 20, 2023

NATIONAL PUBLIC RADIO, INC.,)	
)	
Petitioner,)	
)	Cancellation No.
v.)	
)	
TASTEMADE, INC.,)	
)	
Registrant.)	
)	
)	
)	

PETITION FOR CANCELLATION

Petitioner National Public Radio, Inc. (“NPR”), a District of Columbia non-profit corporation having its principal place of business at 1111 North Capitol Street NE, Washington, D.C. 20002, believes that it will be damaged by the continued registration of the mark TINY (the “TINY Mark”) in connection with the services identified in U.S. Registration No. 7,083,243 (the “Registration”) issued to Tastemade, Inc. (“Registrant”), a Delaware corporation with an address of record at 3019 Olympic Boulevard, Stage C, Santa Monica, California 90404. NPR hereby petitions to cancel the Registration pursuant to Section 14 of the Lanham Act, 15 U.S.C. § 1064.

NPR AND THE NPR TINY MARKS

1. Established by way of the Public Broadcasting Act in 1967, NPR began broadcasting news stories in 1971. Since its establishment, NPR has grown from 90 public radio stations in the U.S. to over 1,000, with over 44 million weekly listeners across radio and streaming platforms.

2. Shortly after the founding of NPR Music, NPR music producer Bob Boilen hosted the first “TINY DESK” concert at NPR headquarters on April 22, 2008, which was published in an online video—the first in what has become a cultural phenomenon and one of NPR’s flagship series: TINY DESK. Since that time, NPR has prominently used the trademark TINY DESK in connection with online videos and, later, podcasts, music contests, and events. Performers on the program range from independent artists and amateurs to household names like Taylor Swift, Sting, Alicia Keys, and Natalia Lafourcade. Today, the TINY DESK series receives more than 50 million views per month.

3. As a result of the immense popularity of the TINY DESK series, the TINY DESK trademark has come to embody the substantial and valuable reputation and goodwill that NPR has earned in the marketplace

4. In addition to owning common law rights in the TINY DESK mark, and in order to protect the TINY DESK mark for its exclusive use, NPR owns two incontestable U.S. trademark registrations for the TINY DESK mark (the “TINY DESK Mark”), which are in full force and effect on the Principal Register of the U.S. Patent & Trademark Office (“PTO”):

- TINY DESK (Reg. No. 4,786,227) registered on August 4, 2015, and covering “Entertainment services, namely, providing non-downloadable videos of live musical performances via the internet; providing audio podcasts in the field of music” in Class 41.
- TINY DESK (Reg. No. 5,166,374) registered on March 21, 2017, and covering “Downloadable audio and video podcasts featuring music and live musical performances; downloadable videos featuring music and live musical performances” in Class 9 and “Entertainment services, namely, arranging and conducting of competitions for musical performers; entertainment, namely, live music concerts; arranging and conducting events featuring live music” in Class 41.

The filing and registration dates of these registrations predate the filing date associated with the Registration. The first use dates of these registrations similarly predate the first use associated with the Registration.

5. To better serve its ever-expanding Spanish-speaking audience, NPR more recently launched related goods and services under the trademark EL TINY in 2021.

6. NPR applied for the EL TINY mark on February 20, 2020, which matured to registration on January 10, 2023 (Registration No. 6,950,428), for use in connection with “Downloadable audio and video podcasts featuring music and live musical performances; downloadable videos featuring music and live musical performances” in Class 9 and “Entertainment services, namely, live music concerts; arranging and conducting events featuring live music; entertainment services, namely, providing non-downloadable videos of live musical performances via the internet; providing audio podcasts in the field of music” in Class 41 (the “EL TINY Mark” together with the TINY DESK Mark, “NPR TINY Marks”).

7. Since the launch of EL TINY in 2021, there have been 152 EL TINY concerts, with YouTube videos receiving millions of views.

8. Because of NPR’s continuous use of the NPR TINY Marks, as well as its extensive advertising and promotion of its goods and services under the marks and the large and devoted following that NPR enjoys, the NPR TINY Marks have become well-known throughout the United States.

REGISTRANT AND THE PURPORTED TINY MARK

9. Registrant is a digital media company that publishes a variety of web-based video series, including the program TINY TALK.

10. Registrant owns U.S. Registration No. 6,332,805 for the TINY TALK trademark covering services in Classes 35 and 41 (the “TINY TALK Mark”):

- “Advertising and promotional services; On-line advertising services for others; Online advertising on a computer network; Providing information in the field of the food and entertainment industry; Rental of advertising space; Rental of advertising space on the internet and in videos, web series and Internet Protocol Television (IPTV) programming segments” in Class 35; and
- “Educational services, namely, providing online instruction in the field of food, food preparation, food presentation and how-to; Entertainment services, namely, providing ongoing webisodes featuring content in the fields of entertainment by celebrities, celebrity interviews, food, food preparation, food presentation and how-to via a global computer network; Entertainment services, namely, an ongoing multimedia program featuring content in the fields of entertainment by celebrities, celebrity interviews, food, food preparation, food presentation and how-to distributed via various platforms across multiple forms of transmission media; Entertainment services, namely, an ongoing series featuring content in the fields of entertainment by celebrities, celebrity interviews, food, food preparation, food presentation and how-to provided through the internet and wireless communication networks; Entertainment services, namely, the provision of continuing television, internet TV, online video programming segments and an ongoing web series featuring entertainment by celebrities, celebrity interviews, food, food preparation, food presentation and how-to delivered by the internet and wireless communication networks; Providing entertainment services in the nature of ongoing Internet Protocol Television (IPTV) television programming segments in the field of entertainment by celebrities, celebrity interviews, food, food preparation, food presentation and how-to” in Class 41.

Registrant’s application for the TINY TALK Mark matured to registration on April 27, 2021 and claims a first use date of March 5, 2020.

11. On October 27, 2021, Registrant filed Application Serial No. 97/096,262 (the “Application”) for the trademark TINY in connection with services in Class 41:

Educational services, namely, providing online instruction in the field of recipes, food, food preparation, food presentation and how-to; Educational and entertainment services, namely, a continuing program about entertainment by celebrities, celebrity interviews, recipes, food, food preparation, food presentation and how-to accessible by means of television, cable, satellite, the internet, web-based applications, downloadable applications, computer networks and wireless communication networks; Entertainment services, namely, conducting contests; Entertainment services, namely, production and distribution of ongoing television programs in the field of entertainment by celebrities, celebrity

interviews, recipes, food, food preparation, food presentation and how-to; Entertainment services, namely, providing ongoing television programs in the field of entertainment by celebrities, celebrity interviews, recipes, food, food preparation, food presentation and how-to via a global computer network; Entertainment services, namely, providing ongoing webisodes featuring entertainment by celebrities, celebrity interviews, recipes, food, food preparation, food presentation and how-to via a global computer network; Entertainment services, namely, an ongoing multimedia program featuring entertainment by celebrities, celebrity interviews, recipes, food, food preparation, food presentation and how-to distributed via various platforms across multiple forms of transmission media; Entertainment services, namely, an ongoing series featuring entertainment by celebrities, celebrity interviews, recipes, food, food preparation, food presentation and how-to provided through television, cable, satellite, the internet, web-based applications, downloadable applications, computer networks and wireless communication networks; Entertainment services, namely, the provision of continuing television, internet TV, segments, shows and an ongoing web series featuring entertainment by celebrities, celebrity interviews, recipes, food, food preparation, food presentation and how-to delivered by television, cable, satellite, the internet, web-based applications, downloadable applications, computer networks and wireless communication networks; Providing entertainment services in the nature of ongoing Internet Protocol Television (IPTV) television programming segments in the field of entertainment by celebrities, celebrity interviews, recipes, food, food preparation, food presentation and how-to; Providing on-line videos featuring entertainment by celebrities, celebrity interviews, recipes, food, food preparation, food presentation and how-to, not downloadable.”

12. However, Registrant does not use TINY as a standalone trademark—registrant’s “TINY”-formative mark is TINY TALK.

13. This is underscored by the specimen submitted by Registrant in support of the application, which reflects use of TINY TALK (not “TINY”) as the name of Registrant’s celebrity interview series.

14. To the extent that Registrant claims use in TINY as a standalone mark, such mark is likely to cause confusion with the registered NPR TINY Marks.

**FIRST GROUND FOR CANCELLATION
LIKELIHOOD OF CONFUSION**

15. NPR incorporates the preceding paragraphs as if fully set forth herein.

16. NPR owns trademark rights in the NPR TINY Marks that predate Registrant’s filing of the Application and any purported actual use of the purported TINY Mark by Registrant.

17. Registrant's TINY Marks is substantially similar in appearance, sound, meaning, and overall commercial impression to the NPR TINY Marks. Indeed, the "mark" is incorporated in its entirety within the NPR TINY Marks.

18. The services identified in the Registration are highly related to and overlapping with the goods and services NPR offers under the NPR TINY Marks. For many years prior to the filing of the Application, and prior to any use of TINY as a purported standalone mark by Registrant, NPR has offered a wide variety of educational and entertainment services under the NPR TINY Marks, including video series featuring interviews with celebrities and conducting contests.

19. On information and belief, the parties target related classes of consumers for their respective goods and services.

20. As the Registration's description of services contains no restrictions or limitations as to Registrant's channels of trade, the Board and NPR may assume the purported TINY Mark will be used in all accepted channels of trade, including those overlapping with NPR and its offerings under the NPR TINY Marks.

21. NPR is not affiliated or connected with Registrant or its services, nor has NPR endorsed or sponsored Registrant or its services.

22. NPR has no control over the nature and quality of the services that Registrant offers or intends to offer under the purported TINY Mark.

23. Continued registration of the purported TINY Mark will damage NPR because the purported mark, when used in connection with the services identified in the Registration, is likely to cause confusion, mistake, or deception as to the affiliation, connection, or association of Registrant with NPR, or as to the origin, sponsorship, or approval of Registrant's offerings and

commercial activities by NPR. Thus, the Registration should be canceled under 15 U.S.C. §§ 1052, 1064, 1114, and 1125.

**SECOND GROUND FOR CANCELLATION
LACK OF *BONA FIDE* USE**

24. NPR incorporates the preceding paragraphs as if fully set forth herein.

25. The Registration claims use of the purported TINY Mark since at least as early as March 5, 2016, but this is false. On information and belief, Registrant never made *bona fide* use of TINY as a standalone mark. As depicted in Registrant's marketing materials, on its website, and in the specimen Registrant submitted in support of the Registration, Registrant uses the trademark TINY TALK, which is not the equivalent of TINY as a standalone mark.

26. Accordingly, on information and belief, there was no *bona fide* use of the TINY Mark in interstate commerce at the time of filing the Statement of Use associated with the Application, and the Registration should be cancelled on that basis.

WHEREFORE, NPR respectfully requests that the Petition for Cancellation be granted and that Registration No. 7,083,243 be cancelled.

Respectfully submitted,

Date: December 5, 2023

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