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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tichenor Media System, Inc.

Serial Nos. 74/697,240; 75/091,780;
75/091,962 and 75/096,409

Gregory W. Carr of Carr & Storm, LLP for Tichenor Media System, Inc.

Thomas W. Wellington, Trademark Examining Attorney, Law Office 104 (Janice O'Lear, Managing Attorney)

Before Seeherman, Quinn and Bottorff, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

This appeal involves four applications filed by Tichenor Media System, Inc.[1]

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[1] In a declaration filed in connection with Application Serial No. 75/096,409, Dan Wilson states that Tichenor Media System, Inc. has merged into Heftel Broadcasting Corporation. Applicant is advised that unless applicant records the merger document with the Patent and Trademark Office, any registrations which may issue in these applications will be in the name of Tichenor Media System, Inc.

On July 5, 1995, applicant filed Application Serial No. 74/697,240 for the mark GO-KART CARLOS for radio broadcasting and entertainment services, based on an asserted bona fide intention to use the mark in commerce. The services were subsequently amended to "radio broadcasting services" in Class 38, and "radio entertainment services, namely, radio programs featuring performances by a radio reporter using the pseudonym 'GO-CART CARLOS'" in Class 41. Subsequent to the publication of the application applicant submitted a statement of use, and asserted use of the mark in connection with the Class 38 services on April 22, 1997 and in connection with the Class 41 services in May 1993. Registration was finally refused on the ground that applicant's specimens were not acceptable to show use of the mark in commerce in connection with the Class 38 services, and the substitute specimens submitted by applicant were not acceptable because they were not in use as of the last date on which applicant could have filed a statement of use. Applicant thereupon filed the instant notice of appeal, along with a request that the Class 41 services (for which the specimens had been found acceptable) be divided out of this application. This was done, as a result of which only the question of the acceptability of the specimens for the

Class 38 application is before us. That question involves a determination of whether specimens showing use of a mark for radio entertainment services, namely radio programs, support use for radio broadcasting services, "because a 'radio program' is simply a limitation within the scope of the broader recitation 'radio broadcasting services.'" Applicant's brief, p. 2..

Application Serial No. 75/091,780 for the mark TEJANO MONEY SONG OF THE DAY was filed on April 22, 1996, claiming first use and first use in commerce in February 23, 1993. The word TEJANO is translated as "Texan." The services were originally identified as "radio broadcasting services" in Class 38. After registration was initially refused on the basis that the specimens were unacceptable to show evidence of use of the mark for the identified services, applicant attempted to amend its identification from "radio broadcasting services" in Class 38 to "entertainment services in the nature of on-going radio contest events" in Class 41. This proposed amendment was refused by the Examining Attorney, and the refusal was ultimately made final, because the new identification would exceed the scope of the original identification, Trademark Rule 2.71(a).

Applicant filed Application Serial No. 75/091,962 for the mark EL PULSO DE SAN ANTONIO (translated as "the pulse of San Antonio") on April 22, 1996, claiming first use and first use in commerce in March 1990. The application, as originally filed, identified the services as "radio broadcasting services." The prosecution history of this application is similar to that of Application Serial No. 75/091,790. Specifically, after the Examining Attorney required substitute specimens because he determined that the original specimens did not support use of the mark on the identified services, applicant attempted to amend the identification to, first, "entertainment services in the nature of on-going radio programs" and subsequently to "entertainment services in the nature of on-going radio programs in the field of variety." The Examining Attorney refused to accept the amendments because each exceeded the scope of the original identification.

Application Serial No. 75/096,409, filed April 22, 1996, is for the mark TEJANO MUSIC MARATHON. TEJANO is translated as "Texan"; the words "Music Marathon" are disclaimed. Applicant originally identified its services as "radio broadcasting services," and asserted first use and first use in commerce in February 1993. In the first Office action the Examining Attorney refused registration

pursuant to Section 2(e)(2) of the Act, a refusal which was later amended to Section 2(e)(1), and required acceptable specimens. In response, applicant requested, inter alia, that the identification be amended to "entertainment services in the nature of on-going radio programs." The Examining Attorney refused to accept the amendment because the proposed new identification exceeded the scope of the original identification, and repeated the requirement for acceptable specimens. Eventually applicant amended its application to the Supplemental Register and "amended" its identification to "radio broadcasting services," the original identification, although the amendments to the identification which applicant had proposed during the course of examination had never been accepted by the Examining Attorney. The Examining Attorney accepted the amendment to the Supplemental Register and withdrew the refusal under Section 2(e)(1), but made final the requirement for specimens showing use of the mark in connection with the identified radio broadcasting services. We note that in its brief, despite the fact that in its request for reconsideration applicant withdrew its proposals to amend the identification from the original identification of "radio broadcasting services," applicant has requested that the Board "reverse the Examining

Attorney's refusal to amend the description of services only if the board first determines that the current recitation of 'radio broadcasting services' is not supported by the specimens of record." Brief, p. 4. Because the Examining Attorney addressed, in his brief, the question of whether the identification "entertainment in the nature of on-going radio program"[2] is beyond the scope of the original identification, we have, as with Application Serial Nos. 75/091,780 and 75/091,962, considered this issue with respect to this application.

Thus, the issues before us in connection with the latter three applications are whether the specimens are acceptable to show of the particular mark for the identified radio broadcasting services or, if not, whether applicant's proposed amendments to the identification of services are acceptable.

Applicant filed appeals in all four applications. After the appeals were briefed applicant requested that the appeals be consolidated, and the Board granted this request

[2] In fact, the Examining Attorney referred to the proposed amendment as "entertainment in the nature of ongoing radio contests," but this was apparently a misstatement caused by the fact that the Examining Attorney also prepared the brief in the application for TEJANO MONEY SONG OF THE DAY, in which the latter identification had been proposed by the applicant.

on October 6, 1999. A single oral hearing was held, and the appeals are hereby decided in a single opinion.

The first issue we will consider, because it affects all four applications, is whether the specimens submitted show use of the involved marks in connection with "radio broadcasting services." The specimens consist of audio cassettes and/or a transcription of radio broadcasts. Relevant portions of the transcripts for each application follow.

> **GO CART CARLOS**
> Hi, this is Jon Ramirez of the KXTN Tejano 107.5 FM Morning Show inviting you to accompany us tomorrow in the morning. Gifts, entertainment, plus, of course, let's not forget Mike Pacina with news, Go-Cart Carlos with traffic and Mike Hernandez will be standing by in the KXTN Weather Center.
>
> **TEJANO MONEY SONG OF THE DAY**
> K-X-T-N… Tejano 107 FM, San Antonio's Numero Uno Tejano Hit Station. Congratulating _____ our latest $1,007 KXTN Cash Winner with the Tejano Money Song of the Day. You could be next. Listen tomorrow morning to the Johnny Ramirez show at 7:20 for information on how you can be our next $1,007 KXTN Cash winner only on KXTN.
>
> **EL PULSO DE SAN ANTONIO**
> La Romantica FM 93 presents "El Pulso De San Antonio." A special program with topics of interest, informative, controversial and educational. The opinion expressed in this program doesn't necessarily represent that of FM 93. This is El Pulso De San

> Antonio, with you is Frank Cortez in FM 93.
>
> **TEJANO MUSIC MARATHON**
> It's *(time)*. I'm *(jock)* and we're in the middle of another 107 minute Tejano Music Marathon. Coming up this hour you'll hear the latest KXTN Tejano hits from *(title and artist)* y en sigida *(title and artist)*.

It is clear from the specimens that the various marks identify a radio personality (GO-CART CARLOS), a radio contest (TEJANO MONEY SONG OF THE DAY), a radio program (EL PULSO DE SAN ANTONIO) and a radio feature (TEJANO MUSIC MARATHON). These uses are in the nature of radio entertainment services.

Applicant, however, argues that its specimens show use of the marks for radio broadcasting services because "applicant is providing an entertainment **service** via **broadcasting** over the **radio**." Brief, p. 3, Serial No. 75/092,780. Applicant points to dictionary and statutory definitions of "broadcast," and federal regulations concerning radio broadcast services.

We agree with the Examining Attorney that the specimens do not show use of the mark in connection with radio broadcasting services. Simply because the words "radio," "broadcasting" and "services" can be used in a sentence describing the entertainment services rendered by

means of a radio broadcast does not change such entertainment services into radio broadcasting services.

The U.S. Patent and Trademark Office recognizes the distinction between radio broadcasting services and entertainment services in the nature of radio programs or features by classifying them in two separate classes. See ID Manual. Moreover, this classification is based on the Nice Agreement Concerning the International Classification of Goods and Services, to which the United States is a party,[3] which lists "radio broadcasting" services in Class 38, and "radio entertainment" services in Class 41. Each of the countries party to the Nice Agreement is obliged to apply the Nice Classification in connection with the registration of marks.

Although programs or entertainment features which are broadcast over the radio certainly are related to radio broadcasting services, since their reception by a listening audience is dependent on an entity's providing the service of broadcasting the radio programs and features, that does not mean that the entertainment services in the nature of

[3] Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, initially concluded by the Nice Diplomatic Conference June 15, 1957, entered into force April 8, 1961. The seventh edition of the Nice Classification was published in 1996, and entered into force on January 1, 1997.

radio programs or features are the equivalent of radio broadcasting services. As stated in J. Marshall, Guide to the Nice Agreement Concerning the International Classification of Goods and Services, © 2000, pp. 185-86:

> Simply because a service is conducted using telecommunication contact does not mean that the service is classified in Class 38. Services in Class 38 provide the means to communicate, not the communication itself.
>
> …Perhaps the most important thing to keep in mind in considering whether a service is classified in Class 38 is whether the service is providing the means of communication or is merely using telecommunications as a tool in performing its function. The services in Class 38 usually involve the actual wires or satellite connections that effectuate the activity of telecommunications. The functioning of those wires or satellites in ways that are usable by businesses and individuals are also Class 38 activities. The services of the broadcasting industry are in Class 38 unless those services involve the content of the programs being broadcast on radio or television. …The common thread in these services is the transmission or diffusion of any kind of audio or visual content. The nature of the content or the production and control of that content are not activities that fall into Class 38.

Ms. Marshall points to the Explanatory Note for Class 38 in the Nice Classification, p. 186:

> This note clarifies the difference between services that diffuse radio or

> television programs, which fall within Class 38, and services that create or produce those programs, which fall within Class 41. It defines the line between the two classes; the diffusion or transmission of content is in Class 38, while the production of content itself is not.
>
> With this simple Explanatory Note, the Nice Agreement establishes the pattern to be followed in classifying services in Class 38. The diffusion of radio programs in included in Class 38; however, as indicated above, the content of those programs is not.[4]

Applicant points to certain registrations to show that the Office has registered "radio broadcasting services" in Class 41, or has accepted the identification of "radio broadcasting services" for marks which are used as the names of radio programs.[5] We do not have the records of these registrations, and therefore cannot ascertain whether

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[4] Applicant has asserted that radio broadcasting services include the services of broadcasting radio programming or programs to listeners and the services of broadcasting commercials to listeners on behalf of advertisers. Brief, p. 4, Ser. No. 75/091,780. The difficulty with this position is shown by the fact that the Explanatory Note to Class 38 of the Nice Classification specifically states that Class 38 does not include "radio advertising services." As stated by Ms. Marshall: "Advertising is a classic Class 35 service. The fact that the advertising may be presented on the radio does not change the classification. It should not be classified in Class 38 simply because the advertising uses a channel of telecommunication in order to be disseminated to the public." pp. 186-87.

[5] Not all of applicant's application files contain each of these registrations, but for purposes of this discussion we will treat the records of all the applications to include all the registrations.

the specimens submitted show that the various marks are used in connection with radio broadcasting services. We can only say that the specimens in the present applications do not support use of the marks in connection with radio broadcasting services. Moreover, whether or not a registration has issued which indicates "radio broadcasting services" to be in Class 41, it is clear under both the Office's Identification Manual and the Nice Classification that radio broadcasting services are, at the present time, classified in Class 38.

Applicant itself has, to some extent, recognized the distinction between radio broadcasting and radio entertainment services, in that when it filed its application for GO-CART CARLOS (Ser. No. 74/697,240) it identified its services as "radio broadcasting and entertainment services." Although applicant now argues that radio broadcasting services encompasses radio entertainment services (an argument we discuss infra), there is an inconsistency in applicant's position in that applicant originally treated radio entertainment services as separate from, rather than included within, radio

broadcasting services, and has divided out from its application these separate radio entertainment services.[6]

Having found that applicant's specimens do not support the registration of the various marks for radio broadcasting services, we turn to the question of whether, in the applications for TEJANO MONEY SONG OF THE DAY, EL PULSO DE SAN ANTONIO and TEJANO MUSIC MARATHON, applicant may amend its identification of services from radio broadcasting services to entertainment services, i.e., to "entertainment services in the nature of on-going radio contest events" for TEJANO MONEY SONG OF THE DAY; to "entertainment services in the nature of on-going radio programs in the field of variety" for EL PULSO DE SAN ANTONIO; and "entertainment services in the nature of on-going radio program" for TEJANO MUSIC MARATHON.

Trademark Rule 2.71(a) provides that the applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services. See also, **In re Swen Sonic Corp.**, 21 USPQ2d 1794 (TTAB 1991). As we have previously discussed, although there is a relationship between radio broadcasting services and

[6] A child application, Serial No. 75/977,674, identifying the services as "radio entertainment services, namely radio programs featuring performances by a radio reporter using the pseudonym 'Go-Cart Carlos'" was created on August 7, 1998.

entertainment services in the nature of radio programs or radio contests, the latter services are different from radio broadcasting services. Because they are not encompassed within the general rubric of radio broadcasting services, it would be an impermissible expansion of applicant's original identification to allow the amendments proposed by applicant.

There is one additional issue we must consider, which affects only the application for GO-CART CARLOS. As indicated above, after the Examining Attorney found that applicant's specimens did not show use of the mark in connection with radio broadcasting services, applicant submitted substitute specimens. The Examining Attorney rejected these specimens on the basis that they did not show use of the mark as of the filing date of applicant's Statement of Use, nor use as of the last date on which applicant was entitled to file a Statement of Use. Applicant has not addressed this issue in its brief or its reply brief, and therefore it would seem that applicant has conceded that the substitute specimens are unacceptable. In any event, it is clear that the substitute specimens, which are a media information kit dated June 11, 1997, were

not in use as of April 22, 1997, the date by which applicant's Statement of Use was due.[7]

Decision: We affirm the refusals to register the four subject applications on the basis that applicant has not provided acceptable specimens showing use of the marks on the identified radio broadcasting services, and we affirm the refusals to allow the proposed amendments of the identifications for Application Serial Nos. 75/091,780; 75/091,962; and 75/096,409.

E. J. Seeherman

T. J. Quinn

C. M. Bottorff
Administrative Trademark Judges
Trademark Trial and Appeal Board

[7] The notice of allowance for this application was mailed on October 22, 1996. Applicant filed its Statement of Use on April 8, 1997, and did not request an extension of time to file the Statement, should the Statement be found unacceptable.