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TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

BUO

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Opposition No. 91232127

Tidal Music AS

v.

The Rose Digital Entertainment LLC

Before Mermelstein, Masiello and Goodman,
Administrative Trademark Judges.

By the Board:

Background

The Rose Digital Entertainment LLC (“Applicant”) seeks to register the mark #TIDALTUESDAY, in standard character format, for the following services in International Class 35:

advertising, marketing and promotion services, namely, promoting the goods and services of others by providing customized exhibits; advertising and business services, namely, securing airtime on all forms of media communications stations, systems, networks, and services for the purpose of promoting the goods and services of others; advertising and marketing services provided by means of indirect methods of marketing communications, namely, social media, search engine marketing, inquiry marketing, internet marketing, mobile marketing, blogging and other forms of passive, sharable or viral communications channels; advertising services, namely, promoting and marketing the goods and services of others in the field of entertainment via print and electronic media;

on-line advertising and marketing services; providing advertising, marketing and promotional services, namely, development of advertising campaigns for social media; social media strategy and marketing consultancy focusing on helping clients create and extend their product and brand strategies by building virally engaging marketing solutions; the promotion of music videos, songs, and other forms of digital content through marketing campaigns on social media and websites.¹

Tidal Music AS (“Opposer”) filed a notice of opposition on the grounds of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), dilution under Section 43(c), 15 U.S.C. § 1125(c), and deceptiveness under Section 2(a), 15 U.S.C. § 1052(a). Opposer pleaded ownership of Registration No. 4830066 for the mark TIDAL, in standard characters, for computer software for use in the field of media and music, in International Class 9; retail store services in the field of media and music, and providing an online marketplace for the purchase and sale of music and media, in International Class 35; electronic transmission of downloadable music and media, online chat rooms, and bulletin boards, in International Class 38; and providing a website featuring temporary use of non-downloadable software that enables users to download music and media, application service provider services that provide software for use in connection with online music subscription services, and non-downloadable software for accessing music and media content, in International Class 42.² 1 TTABVUE 6-7, ¶ 9. Opposer attached a printout from the USPTO’s

¹ Application Serial No. 87062109 (“the ’109 application”), filed June 6, 2016 based on Applicant’s allegation of use of the mark in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a). Applicant alleges June 6, 2016, as the date of first use of the mark anywhere and its first use in commerce.

² The registration was issued October 13, 2015, from an application filed September 12, 2014.

Trademark Status and Document Retrieval database (“TSDR”), which shows the current status and title of Opposer’s pleaded registration as of the filing date of the notice of opposition. *See* Trademark Rule 2.122(d).

Opposer’s submission of this status and title copy of its registration record is sufficient to establish Opposer’s standing to bring this opposition. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Research in Motion Ltd. v. Defining Presence Mktg. Grp. Inc.*, 102 USPQ2d 1187, 1190 (TTAB 2012) (pleaded registrations of record); *Vital Pharms. Inc. v. Kronholm*, 99 USPQ2d 1708, 1712 (TTAB 2011) (standing established because pleaded registrations are of record on a motion for involuntary dismissal).

Applicant, in its answer, admitted such matters as Opposer’s ownership of the pleaded mark, 4 TTABVUE 2, ¶ 9, Opposer’s widespread use of the mark in connection with music streaming services since October of 2014, *id.*, ¶ 2-4, the fame of Opposer’s mark, *id.*, ¶¶ 8 and 13, and that Opposer’s mark became famous prior to Applicant’s alleged date of first use, *id.* at 3, ¶ 26. Applicant denied the remaining salient allegations of the notice of opposition and asserted the following “Defense”: “[w]e do not currently promote Tidal content, or any content, using the hashtag,” and “The Rose has never created or published content under #TidalTuesday, therefore registering the trademark has not caused any confusion with customers.” *Id.* at 5-6, ¶¶ 17 and 18.

Now before the Board is Opposer’s motion for summary judgment. 6 TTABVUE. Included with its motion for summary judgment, Opposer also moved to amend its

notice of opposition to add a claim that Applicant “had no *bona fide* use of the #TIDALTUESDAY mark in commerce on or in connection with the services identified in its use-based application, Serial No. 87/062,109 ... prior to the filing date of the Application.” *Id.* at 2. Opposer argues that “the Board should allow Opposer to amend the Notice of Opposition because Applicant made several admissions regarding Applicant not yet commencing use of the #TIDALTUESDAY mark in U.S. commerce, including making such admissions in Applicant’s Answer, in evidence that Opposer found online during the discovery period, and during the initial discovery conference with Opposer.” *Id.* at 6.

Should the Board allow Opposer’s proposed amendment, Opposer seeks summary judgment on the newly added claim, asserting, “the Application is void *ab initio* for lack of *bona fide* use of the #TIDALTUESDAY mark in United States commerce in connection with the identified services as of the filing date of Applicant’s use-based Application,” and “no genuine issue of material fact exists regarding Applicant’s non-use.” *Id.* at 7. The motion for summary judgment is fully briefed.

Motion to Amend

Applicant does not contest Opposer’s motion to amend. Nonetheless, the Board has reviewed the motion and the amended pleading. The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would be prejudicial to the rights of the adverse party or would violate settled law. *See* Fed. R. Civ. P. 15(a); *see also* Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 507.02 (June 2017), and cases cited

therein. Inasmuch as the information that forms the basis of Opposer's proposed claim was learned through Applicant's answer, statements made during the parties' discovery conference and Applicant's responses to discovery requests, all subsequent to the filing of the initial notice of opposition and reasonably contemporaneous to the filing of the present motion, the claim has been timely raised. Further, the Board does not find any specific prejudice that would result from amendment of Opposer's pleading. See *Metromedia Steakhouses Inc. v. Pondco II Inc.*, 28 USPQ2d 1205, 1206-07 (TTAB 1993); *Focus 21 Int'l Inc. v. Pola Kasei Kogyo KK*, 22 USPQ2d 1316, 1318 (TTAB 1992) (motion to amend filed prior to opening of petitioner's testimony period permitted). As Opposer points out, much if not all of the information needed for Applicant to defend the proposed additional claim is already in Applicant's custody or control. Additionally, the allegation of facts supporting the proposed added claim provides sufficient detail as to the basis thereof. *Conolty v. Conolty O'Connor NYC LLC*, 111 USPQ2d 1302, 1309 (TTAB 2014); *Great Seats, Ltd. v. Great Seats, Inc.*, 84 USPQ2d 1235, 1244 (TTAB 2007).

Accordingly, Opposer's motion for leave to file an amended notice of opposition adding a claim of nonuse is **GRANTED**; and the amended pleading is now Opposer's operative pleading. 6 TTABVUE 39-47. We now turn to Opposer's motion for summary judgment. For purposes of deciding the motion, we deem Applicant to have denied the allegations regarding the newly added ground.

Motion for Summary Judgment

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to material facts, thus allowing resolution as a matter of law. *See* Fed. R. Civ. P. 56(a). In deciding motions for summary judgment, the Board follows the well-established principles that all evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. The Board may not resolve disputes of material fact; it may only ascertain whether such disputes exist. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

The burden is on the party moving for summary judgment to demonstrate the absence of any genuine dispute of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(a). The burden of the non-movant to respond arises only if the summary judgment motion is properly supported. *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 160-61 (1970). If the evidence produced in support of the summary judgment motion does not meet this burden, "summary judgment must be denied even if no opposing evidentiary matter is presented." *Id.* (quoting Fed. R. Civ. P. 56 advisory committee notes to the 1963 amendments).

When a moving party's motion for summary judgment is supported by evidence sufficient to indicate that there is no genuine dispute as to any material fact and that the moving party is entitled to judgment, the burden shifts to the non-moving party

to demonstrate the existence of at least one genuine dispute as to a material fact that requires resolution at trial. The non-moving party may not rest on the mere allegations of its pleadings and assertions, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine dispute as to a material fact for trial. Factual assertions without evidentiary support are insufficient to defend against a motion for summary judgment. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1739 (TTAB 2001) (“applicant has produced no evidence, or raised any expectation that at trial it could produce evidence....”).

In support of its motion for summary judgment, Opposer submitted the declaration of Philippe Zylberg, who authenticated the following exhibits: (1) a copy of the application record of the '109 application;³ (2) a copy of the specimen submitted in connection with the subject application when it was filed on June 6, 2016;⁴ (3) a copy of the substitute specimen submitted in response to an Office Action citing the deficiency of the initial specimen;⁵ (4) a screenshot from Twitter showing no results returned from a search for the term “theroseapp;”⁶ and (5) screenshots from Twitter

³ 6 TTABVUE 19-31. The file of an application or registration that is the subject of a Board *inter partes* proceeding forms part of the record of the proceeding without any action by the parties, and reference may be made to the file by any party for any relevant and competent purpose. Trademark Rule 2.122(b)(1); *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626 (Fed. Cir. 2009). The Board discourages filing a copy of the subject application or subject registration because it is already of record. *See Venture Out Properties LLC v. Wynn Resorts Holdings LLC*, 81 USPQ2d 1887, 1889 n.8 (TTAB 2007) (applications automatically of record and need not be introduced again).

⁴ *Id.* at 33-34.

⁵ *Id.* at 36-37.

⁶ *Id.* at 61. It is unclear why Opposer has attached this evidence or the connection between

showing the posts of “King Juneya,”⁷ including references to #TIDALTUESDAY and TIDAL.⁸ Mr. Zylberg also attests, “[d]uring [the] initial discovery conference, Mr. Sims [Applicant’s principal and declaration signatory] stated that Applicant has not started using the #TIDALTUESDAY mark in United States commerce.” 6 TTABVue 16-17, ¶ 3. Mr. Zylberg further states:

I have confirmed that ... Applicant’s domain <tidaltuesday.com> ... has never driven sales or traffic to Tidal, has never displayed #TIDALTUESDAY, and has never been used in connection with an active website, let alone as a means to support rendering of the identified services under the #TIDALTUESDAY mark.

Id. at 17, ¶ 7.

A. Section 1(a) - Nonuse

Trademark Act Section 1(a) states, in pertinent part:

- (1) The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by ... filing in the Patent and Trademark Office an application....
- (2) The application shall include specification of ... the date of the applicant’s first use of the mark, the date of the applicant’s first use of the mark in commerce, the goods in connection with which the mark is used
- (3) The statement shall be verified by the applicant and specify that—

“The Rose App” and Applicant. Opposer presumably attributes ownership of this Twitter name to Applicant.

⁷ Opposer asserts in its reply brief that “King Juneya” is an alias for Mr. Robert Sims, Applicant’s principal. 10 TTABVue 7-8. In fact, in a Tweet posted to the Twitter page of King Juneya, reference is made to a connection with “the rose,” presumably referring to Applicant. 10 TTABVue 22. Additionally, throughout several posts, King Juneya refers to the law firm of Pryor Cashman, Opposer’s counsel. *See, e.g., Id.* at 30.

⁸ *Id.* at 65-74.

...

- (B) to the best of the verifier's knowledge and belief, the facts recited in the application are accurate;
- (C) the mark is in use in commerce....

In an application based on use in commerce under Section 1(a) of the Trademark Act, the applicant must use the mark in commerce on or in connection with all the goods and services listed in the application as of the application filing date. *See* Trademark Rule 2.34(a)(1)(i); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1044 (TTAB 2014). Where an applicant has not used the mark on any of the goods listed in its application as of the filing date of the application and the signing of the verified statement, the application is rendered void *ab initio*. *Id.* (citing *Gay Toys, Inc. v. McDonald's Corp.*, 585 F.2d 1067, 199 USPQ 722, 723 (CCPA 1978) (because applicant did not use the mark in commerce in association with the goods at the time it filed the application, its application was void)).

Opposer argues, “[t]he undisputed Record demonstrates that, as a matter of law, the transaction upon which the application is founded is not *bona fide* and summary judgment should be entered in Opposer’s favor.” 6 TTABVUE 10. Particularly, Opposer asserts, “[u]sing ‘#TidalTuesday’ on Twitter does not function as a source identifying trademark for any of the Class 35 services” *Id.* at 11. Opposer also points to the statements made in Applicant’s answer and during the parties’ discovery conference to support its conclusion that Applicant had not made use of the applied-for mark in commerce in connection with any of the services claimed in the

application. Additionally, Opposer cites several excerpts from the Twitter page of King Juneya a/k/a Robert Sims, stating that he had not begun using “the hashtag yet,” and that he would “start using [his] hashtag ... in May [2017].” *Id.* at 12 and 13.

Applicant contests,

The Rose has in fact established ‘*bona fide*’ use of the mark. We currently use #TidalTuesday in business. The use of Tidal to describe the goods we review and promote is an example of ‘Fair Use’, as there is no other way to describe, review, and report on the exclusive goods the opposer creates on social media.” 7 TTABVUE 2-3. Applicant asserts that “[w]ithin the industry described in this application, *Bona Fide* use is established when The Rose Digital Entertainment uses the Business pages/products to promote the Hashtag #TidalTuesday as a product coming soon.

Id. at 6. To this end, Applicant states, “The Rose Digital Entertainment has not started releasing original content under the #TidalTuesday mark,” but is “promoting the coming of the ‘#TidalTuesday’ product,” and “actively developing website and product presentations” *Id.* at 4. Finally, Applicant argues against consideration of the evidence supplied by Opposer from the Twitter page of King Juneya, contending, “@TheJuneya makes no reference to being owned by Robert Sims or The Rose Digital Entertainment.” *Id.* at 6. However, Applicant’s argument is belied by Opposer’s submission, with its reply brief, of the Instagram page of “KingJuneya,” which lists Robert Sims as the owner of the page and shows a picture of the same person pictured on the King Juneya Twitter page.⁹ 10 TTABVUE 7-8.

⁹ In viewing the evidence in a light most favorable to Applicant and drawing all justifiable inferences in its favor, we would have assumed (for the purposes of the pending motion) that King Juneya and Robert Sims are alter egos of Applicant, The Rose Digital Entertainment, such that use attributed to *any* of them would inure to Applicant’s benefit. There is, however,

In support of its response, Applicant provided: (1) a copy of its “Content Delivery Plan;”¹⁰ (2) screenshots of the Twitter and Facebook pages of Tidal Tuesday;¹¹ (3) screenshots of webpages displaying third-party usage of the term “tidaltuesday;”¹² (4) a copy of an unexecuted and undated “Website Development Agreement” from WeLive Branding, accompanied by an email from The WeLive Company dated April 26, 2017, indicating that they have received the “initial investment” from Mr. Sims for his project and the “requested content” has been uploaded;¹³ and (5) a screen capture from a mobile device showing the Twitter pages of “@TheRoseDEnt” and “@TidalTuesdays.”¹⁴

An applicant seeking registration of a mark under Section 1(a) must have used the mark in commerce on or in connection with the identified goods or services at the time of filing. Use of a mark in connection with services occurs “when it is [1] used or displayed in the sale or advertising of services and [2] the services are rendered in commerce” which can be regulated by Congress. Trademark Act § 45. *Lyons v. Am. Coll. of Veterinary Sports Med. & Rehab.*, 859 F.3d 1023, 123 USPQ2d 1024, 1027

no evidence of any such use.

¹⁰ 7 TTABVUE 8.

¹¹ *Id.* at 9. Applicant asserts that these social media pages are both “owned by The Rose Digital Entertainment.” Nonetheless, the Facebook page shows no activity and the Twitter page simply shows several posts of “#TIDALTUESDAY” with nothing more.

¹² *Id.* at 10. Despite Applicant’s assertion, the references to “tidaltuesday” in these webpages are not attributable to Applicant. Indeed, the stories refer to a submarine that ran aground in 1916 and stories from the Isle of Wight.

¹³ 7 TTABVUE 11-12. The evidence does not contain any mention of the mark #TIDALTUESDAY.

¹⁴ *Id.* at 13.

(Fed. Cir. 2017). No matter how earnest, the mere preparation to use a mark in the rendering of services is insufficient. *Aycock Eng'g Inc. v. Airflite Inc.*, 560 F.3d 1350, 90 USPQ2d 1301, 1308 (Fed. Cir. 2009).

By introducing evidence showing no dispute as to the fact that Applicant had not used the mark in commerce in connection with the services claimed in the '109 application, Opposer has satisfied its burden under the summary judgment standard. It was then incumbent upon Applicant to supply evidence sufficient to demonstrate that there is at least one genuine dispute of material fact to be determined at trial. However, Applicant has not submitted evidence raising a factual dispute. Instead, Applicant's evidence supports only a finding that the applied-for mark was not in use in commerce in connection with any of the identified services at the time the underlying application was filed. Although Applicant states, for instance, that "The Rose has in fact established 'bona fide' use of the mark," Applicant goes on to explain that in its opinion, "*Bona Fide* use is established when The Rose Digital Entertainment uses the Business pages/products to promote the Hashtag #TidalTuesday *as a product coming soon.*" (Emphasis added.) Applicant's understanding of "use" with respect to the Trademark Act is incorrect. As explained, under the Trademark Act, "use in commerce" requires that the identified services actually be rendered. Employment of a mark to promote a service not yet rendered is not use of a mark in commerce under the statute. In particular, the forward-looking nature of Applicant's statements, *e.g.* "planning," "developing," and "coming soon," demonstrates that Applicant has yet to use the mark in connection with any services

and is still planning and developing a strategy to use the mark. Indeed, Applicant's concessions made in its answer and the corresponding statements made in its response to the present motion for summary judgment do not show any dispute whether Applicant has used the mark in commerce in connection with any of the services listed in the application.

The mere mention of a term on the Internet, divorced from the advertisement *and* rendering of an identified service, does not constitute use of a trademark in commerce. As the Court of Appeals for the Federal Circuit found in *Couture v. Playdom, Inc.*, 778 F.3d 1379, 113 USPQ2d 2042 (Fed. Cir. 2015), for an application based on Section 1(a), use in commerce must be "as of the application filing date." *Id.* at 2043 (citing Trademark Rule 2.34(a)(1)(i)). In *Couture*, although the specimen in the underlying application was a website advertising the services, the Board found, and the Court agreed, that additional evidence showed that the services had not actually been rendered to any customer until well after the application filing date. *Id.* at 2044. "Without question, advertising or publicizing a service that the applicant intends to perform in the future will not support registration"; the advertising must instead "relate to an existing service which has already been offered to the public." *Aycock Eng'g Inc.*, 90 USPQ2d at 1308 (internal quotation marks and citations omitted).

Because we find on this record that no genuine disputes of material fact remain as to Opposer's standing, or its newly asserted claim of nonuse under Section 1(a), and that Opposer is entitled to judgment as a matter of law on that ground, Opposer's

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motion for summary judgment is **GRANTED**. Accordingly, judgment is entered against Applicant, the opposition is **SUSTAINED**, and registration is **REFUSED**.¹⁵

¹⁵ In light of the Board's decision sustaining the opposition on the ground of nonuse, the Board does not reach Opposer's likelihood of confusion, dilution or deceptiveness claims.