

#TidalTuesday #UseInCommerce #RegistrationFail

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by Jake Holt



A recent decision by the Trademark Trial and Appeal Board in *Tidal Music AS v. The Rose Digital Entertainment LLC* (Opp. No. 91232127) confirms the importance of ensuring proper use of a service mark before filing an allegation of use. The key take-away from the decision is that when filing an application based on use in commerce for services, it is not sufficient to advertise or promote the future offering of the service – the service must actually be rendered before use in commerce can be alleged in the application.

The Rose is a tech startup with a business model built around curating digital entertainment content organized by days of the week, e.g., #MusicVideoMonday and #StandupSaturday. The plan for Tuesday was #TidalTuesday, in which content from the

Tidal music streaming service would be promoted. The Rose filed a use-based application for the mark #TidalTuesday on June 6, 2016, claiming first use in commerce on the same day. The application covered a variety of advertising, marketing, and promotional services in Class 35.

Tidal was apparently not a fan of the idea and opposed the application on the ground of likelihood of confusion with its prior TIDAL registration. In a hurry to argue that there could be no confusion, The Rose asserted in its answer that “[w]e do not currently promote Tidal content, or any content, using the hashtag” and that it “has never created or published content under #TidalTuesday, therefore registering the trademark has not caused any confusion with customers.” #Oops. Though the *pro se* applicant later made admirable arguments regarding nominative fair use, this inadvertent admission that the mark had not been used in commerce would prove fatal.

Tidal moved for summary judgment, adding a claim that the application was void *ab initio* because The Rose had not made *bona fide* use its mark in connection with the subject use-based application. #Lawyered. The Rose argued that such use occurred when it registered the domain name tidaltuesday.com and used the mark on its website and social media accounts for “promoting the coming of the ‘#TidalTuesday’ product.”

The TTAB sided with Tidal, finding that such use does not meet the requirements of the Trademark Act, which states that a service mark is used in commerce “when it is used or displayed in the sale or advertising of services and the services are rendered in commerce ...” 15 U.S.C. § 1127 (emphasis added). As the Board explained, “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.”

Because The Rose had not used the mark in commerce within the meaning of the statute as of the date of filing, Tidal’s motion for summary judgment was granted and the #TidalTuesday application was refused registration.

The law is clear that promotional use of a mark for a service the applicant intends to offer later is not sufficient to support a use-based application for registration. The *Tidal Music* decision is a good reminder of that foundational rule. We also note the decision was issued on a Friday (September 8, 2017) and think the Board really missed its chance to make a great joke about #FailFriday.