

**THIS OPINION IS
NOT A
PRECEDENT OF
THE TTAB**

Mailed: July 27, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Alphacritters, Inc.

Serial No. 76573434

Daniel T. Earle of Shlesinger, Arkwright & Garvey LLP for
Alphacritters, Inc.

Janice L. McMorrow¹, Trademark Examining Attorney, Law
Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Hairston, Mermelstein and Wellington, Administrative
Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Alphacritters, Inc., applicant, filed an application
to register CRITTERS FOR COMPANY (in standard characters)
as a trademark on the Principal Register for "children's
books" in International Class 16, based on Section 1(b)
(intent-to-use).²

¹ Application was reassigned to the identified examining
attorney.

² Application Serial No. 76573434 filed on February 2, 2004.

The application was published for opposition and, no opposition having been filed, a Notice of Allowance subsequently issued. Applicant was granted three extensions of time to file a statement of use, and then filed its statement of use with specimens.

The examining attorney finally refused registration under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, 1127, on the ground that applicant's proposed mark, as used on the specimens of record, does not function as a trademark for the identified goods because it is the title of a single work.

Applicant concurrently filed an appeal of the refusal and a request for reconsideration thereof. In response to the request for reconsideration, the examining attorney maintained the refusal. The Board resumed the appeal and briefs were filed.

It is well settled, as recognized both by applicant and the Examining Attorney, that titles of single works are not registrable as trademarks. *In re Cooper*, 254 F.2d 611 117 USPQ 396, 400 (CCPA 1958), *cert. denied*, 358 U.S. 840 (1958); *Herbko Int'l Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 1984); *In re Scholastic Inc.*, 223 USPQ 431 (TTAB 1984). The rationale for such an absolute refusal can be explained by the language in *Cooper*

where the court analogized a book purchaser's decision to that of someone seeking to buy a can of soup:

The purchaser of a book is not asking for a "kind" or "make" of book. He is pointing out which one of millions of distinct titles he wants, designating the book by its name. It is just as though one walked into a grocery and said "I want some kind of food" and in response to the question "What kind of food?" said, "A can of chicken noodle soup."

In re Cooper, 254 F.2d at 614-615.

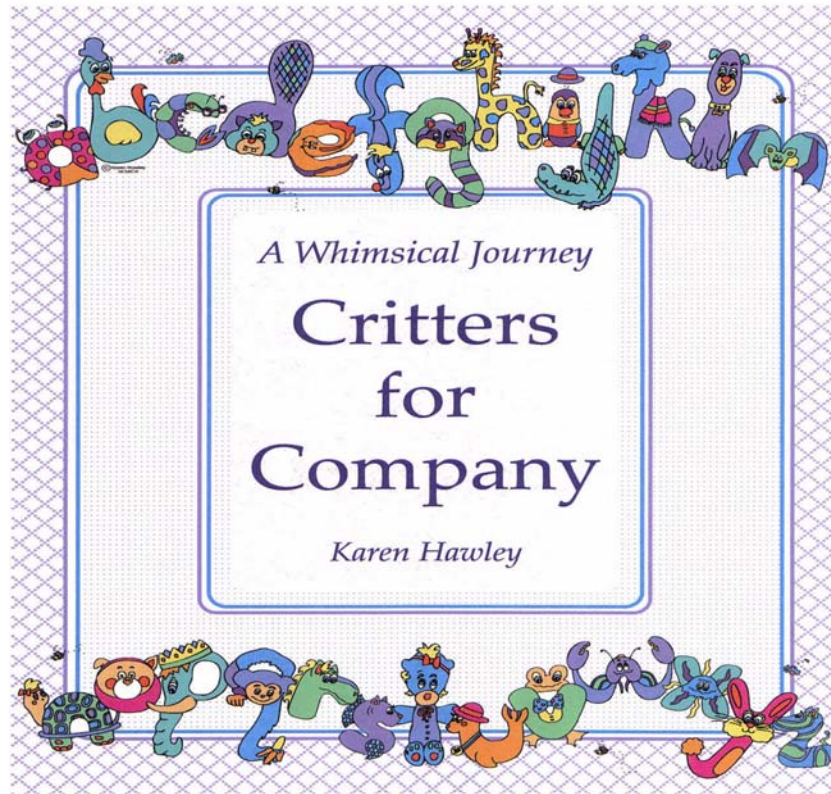
Should the proposed mark be used as a name for a series of books that remain in publication, however, it serves a trademark function because it is "indicating that each book of the series comes from the same source as the others." *Id.* at 615. That is,

The name of the series is not descriptive of any one book and each book has its individual name or title. A series name is comparable to the title of a periodical publication such as a magazine or newspaper.

Id.

The "title of a single work" refusal has been extended to musical recordings, printed publications and live theatrical productions. See *In re Posthuma*, 45 USPQ2d 2011 (TTAB 1998), and cases cited therein.

The proposed mark, as it appears in the specimen, is as follows:



"prominently displayed on the cover of the book in an effort to identify the source of applicant's goods, and expand the use of applicant's mark." Brief, p. 9.

In further support of registration of its proposed mark, applicant notes specifically that the court in *Cooper* stated that, "no one has asserted that a word may not be used as a trademark for books or that they cannot be trademarks for books, in the form of a word or otherwise, or that trademarks for books cannot be registered under the Lanham Act." *In re Cooper*, 254 F.2d at 613. And that the court continued:

Nothing we say should be taken as implying that no trademark for books can be registered; but before there can be registration there must be a trademark and a trademark exists only where there has been trademark use.

Id.

Based on *Cooper* and other case law, including Board precedent, applicant asserts that the "ultimate question is whether the designation sought to be registered is a trademark or is the title of the work." Brief, p. 8. And, in this regard, applicant argues that it has "created an entire business around the mark [CRITTERS FOR COMPANY]." Brief, p. 8. In particular, applicant points to two registrations that it owns, and made of record, for the same mark for various types of other goods, e.g., clothing,

bedding, and stationery.³ With its request for reconsideration, applicant attached printouts from its website that, according to applicant, "demonstrate[] that applicant uses the mark, CRITTERS FOR COMPANY, to identify the source of various goods. Included in the goods offered by applicant is a series of books."⁴ Applicant concludes that the record demonstrates that it uses the proposed mark on, or in connection with, various goods and services, including children's books, and "it is not the title of any particular work, but rather, functions as a trademark." Id. at 10.

Essentially, applicant has raised two issues. First, whether the proposed mark, as used, is the title of a single work. Second, assuming the proposed mark is being used as the title of a single work, can evidence of its use on unrelated goods support registration of the proposed mark on books or otherwise obviate the refusal to register.

³ Registration No. 2845744 (issued May 25, 2004) covering: Stationery, namely, printed invitations, greeting cards, note cards and paper banners in International Class 16; Bedding and linens, namely, youth bed sheets, crib bed sheets, pillowcases, comforters, shams, dust ruffles, crib bumper pads and cloth banners in International Class 24; and Wallpaper and wall hangings in International Class 27.

Registration No. 2909811 (issued December 14, 2004) covering: Children's and infant's clothing, namely, pajamas, t-shirts, hats, caps, jackets and bibs in International Class 25.

⁴ Request for Reconsideration, dated December 19, 2008.

In addressing the first issue, we note that it is not disputed that applicant does not use its proposed mark in connection with a series of books. Rather, applicant states that it intends to create such a series, but, as a result of the death of the author of the first book, its efforts in this regard have been delayed and applicant is currently only using the proposed mark in connection with a single book. Thus, the only question in addressing the first issue is really whether the proposed mark is the title of the book. Based on the specimen of use, we conclude that CRITTERS FOR COMPANY would be perceived by consumers as the title of the book. The proposed mark appears in larger letters directly above the author's name. The second page of applicant's specimen providing "A little background..." indicates that even applicant, itself, uses the proposed mark as the title of the book ("Friend and customers everywhere have asked for a venue featuring the entire 'critters' alphabet collection and to that end, work on Critters for Company ® -- the book - began!") Moreover, we agree with the examining attorney that the other phrase, A WHIMSICAL JOURNEY, is "merely serving as a secondary or explanatory title." Brief, (unnumbered) p. 4. Even if we were to accept applicant's argument that the secondary phrase creates a different commercial impression and is

actually a title of the book, we see no reason why the same book may not have more than one title. In other words, CRITTERS FOR COMPANY would still be the title of a single work.

We turn now to the second issue raised by applicant and, in doing so, recognize that applicant is essentially arguing that its proposed mark, CRITTERS FOR COMPANY, is being used as a mark in connection with other goods and that secondary meaning may be attributed to applicant's mark when it is used on its book, albeit as a title. In this regard, we note that applicant's evidence, including its registrations, demonstrate that applicant has rights in the same mark in connection with various goods other than books. Applicant's argument, however, is unavailing. Our primary reviewing court has made it clear that although titles of single works may be protected under Section 43(a) of the Lanham Act ("False designations of origin; false description or representation")⁵, the Patent and Trademark Office's policy of barring all titles of single works is in accordance with the *Cooper* decision. Specifically, the Court of Appeals for the Federal in *Herbko* cites to *Cooper* approvingly for the proposition that "titles of single

⁵ Section 43(a) is associated with civil actions and not Board proceedings.

books cannot be registered as a trademark" and acknowledges the section in the "Trademark Manual of Examining Procedure" that provides "[t]he title of a single work is not registrable on the Principal Register or the Supplemental Register." *Herbko Int'l Inc.*, 308 F.3d at 1163.⁶ In a footnote, the court clarified that, "[w]hile titles of single works are not registrable, they may be protected under section 43(a) of the Lanham Act upon a showing of secondary meaning." *Id.* (citations omitted). With such precedent, even if we were to find that applicant demonstrated that its proposed mark CRITTERS FOR COMPANY has acquired secondary meaning as a result of its use of the term as a mark on other various goods,⁷ such a finding cannot overcome the refusal should we find, as we have here, that the proposed mark serves as the title of a single book.

In conclusion, inasmuch as we find that the proposed mark is the title of a single book, we affirm the examining attorney's refusal to register the proposed mark on that ground.

⁶ The current section which has not changed in substance, is Trademark Manual of Examining Procedure (TMEP) § 1202.08 (5th ed. rev. September, 2007).

⁷ For sake of clarity, we make no such finding regarding whether secondary meaning has been established because, as explained, any such finding would be pointless.

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Decision: The refusal to register is affirmed.