

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Atlas Media Corp.

Serial No. 76655719

Myron Amer, Esq. for Atlas Media Corp.

Barney L. Charlon, Trademark Examining Attorney, Law Office
104 (Chris Doninger, Managing Attorney).

Before Seeherman, Walters and Bergsman, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Applicant, Atlas Media Corp., seeks registration on
the Principal Register of the mark EVERYBODY I EVER SLEPT
WITH, in standard character form, for "providing on-going
television programs in the field of romance," in
International Class 41.¹

¹ Serial No. 76655719, filed February 27, 2006. The application
was filed on the basis of intent-to-use under Trademark Act
Section 1(b), 15 U.S.C. §1051(b). A statement of use with
specimen was filed on May 21, 2007, alleging first use and use in
commerce as of June 15, 2005.

At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark on the ground that the proposed mark is used only as the title of a single work, and therefore does not function as a service mark to identify and distinguish applicant's services from those of others and to indicate the source of applicant's services, under Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051-1053, 1127.

The appeal is fully briefed. After careful consideration of the evidence and arguments of record, we reverse the refusal to register.

In this case, it is useful to review the actions taken by applicant and the examining attorney during the examination of the statement of use. After publication of the mark herein for opposition and issuance of a notice of allowance, applicant submitted a statement of use. The specimen submitted with the statement of use is a piece of paper with the mark in yellow letters on a red background carrier. The examining attorney informed applicant that this specimen is unacceptable as evidence of use of the mark in connection with the identified services. (Office Action, 9/5/2007.)

Applicant submitted a substitute specimen consisting of a photograph of the cover of a DVD showing the mark

superimposed over the photographic DVD cover art; and the declaration of applicant's president, Bruce David Klein, who states, inter alia, that "the specimen is the cover of a DVD applicant is circulating in connection with [the identified services.]" (Response, 2/28/2008.)

The examining attorney responded that the substitute specimen is unacceptable because the DVD is "goods" and a service mark specimen of use must show use of the mark in connection with the sale or advertising of applicant's services. (Office Action, 4/8/2008.)

Applicant replied that the DVD is used in connection with the advertising of its services; and submitted the declaration of Liz Morrison, who states that "the DVD ... is a promotional communication to obtain advertisers of the television program..."; that "the content of the DVD has images of selected reference-identified EVERYBODY I EVER SLEPT WITH ongoing television exemplary broadcasts"; and that "the use of the promotional DVD is a practice customary in the trade." (Responses, 4/17/2008 and 6/6/2008.)

At this point, the examining attorney accepted the substitute specimen but refused registration on the ground that the mark is the title of a single work. In this regard, the examining attorney states:

[A]pplicant's substitute specimen ... consists of a single DVD bearing the title of applicant's television program, EVERYBODY I EVER SLEPT WITH. This specimen, in that it merely constitutes the title of a single work, fails to function as a source identifier for applicant's series of television programs or to distinguish the mark from the individual titles of applicant's programs.
(Office Action, 5/15/2008.)

We begin our analysis by noting that the only issue before us in this appeal is whether the specimen shows that the mark is used only as the title of a single work, not as the title of a series.

As the examining attorney correctly states:

[T]he title of a continuing series of presentations, including a television or movie "series," may constitute a mark for either entertainment services or educational services. TMEP §1301.02(d). However, the title of a single creative work, that is, the title of one episode or event presented as one program, does not function as a service mark. *In re Posthuma*, 45 USPQ2d 2011 (TTAB 1998).
(Office Action, 5/15/2008)

In this case, it is clear from both the recitation of services, i.e., "providing *on-going* television programs in the field of romance" (emphasis added), and Ms. Morrison's statement that "the DVD ... is a promotional communication to obtain advertisers of the television program..." and that "the content of the DVD has images of selected reference-

identified EVERYBODY I EVER SLEPT WITH ongoing television exemplary broadcasts," that applicant uses the mark EVERYBODY I EVER SLEPT WITH to identify a series of television broadcasts. In other words, it is *not* the title of only a single work or episode.

It appears that the examining attorney has confused the use of the mark on the promotional DVD, which is a single work and an acceptable specimen, with a mark being the title of a single work, which it is not because it identifies an ongoing television series. Accordingly, the refusal is not well taken.

Decision: The refusal to register is reversed. The application will be forwarded for issuance of the registration in due course.