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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Doidge

Serial No. 77801845

Scott J. Major of Millen, White, Zelano & Branigan, PC for Norman Doidge, M.D.

Alyssa Paladino Steel, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).

Before Quinn, Taylor, and Hightower, Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

On August 11, 2009, applicant applied pursuant to Trademark Act Section 1(b), 15 U.S.C. § 1051(b), to register the mark THE BRAIN THAT CHANGES ITSELF for goods and services ultimately designated in four classes. The mark was published on August 31, 2010, and a notice of allowance issued on October 26, 2010. After filing a statement of use with accompanying specimens on April 26, 2011, applicant divided his goods and services in International Classes 9, 41, and 42 into child application Serial No. 77983200, which has matured into Registration No. 4165017 and is not before us on appeal.

The case before us concerns the parent application to register THE BRAIN THAT CHANGES ITSELF for "printed materials, namely, books and instructional materials on the subjects of the human brain, brain science and neuroplasticity" in International Class 16. The examining attorney has refused registration of this application on the ground that THE BRAIN THAT CHANGES ITSELF does not function as a trademark because it is used on the specimen of record only as the title of a single creative work, namely, a book title. Applicant timely appealed, and his request for reconsideration as to the Class 16 goods was denied. Applicant and the examining attorney each filed an appeal brief.

Evidence

Applicant has submitted the following evidence in support of registration for his Class 16 goods:

- Applicant's Class 16 specimen, a printout from the Amazon.com website offering a book authored by applicant titled "The Brain That Changes Itself" and subtitled "Stories of Personal Triumph from the Frontiers of Brain Science"; and

- Photocopies of two DVDs titled "The Brain That Changes Itself." Applicant states that these DVDs contain two different versions – one 70 minutes in duration, the other 44 minutes – of a documentary film relating to his book that has appeared on television and "is currently available on DVD." Applicant's Brief, at 1. The following statement appears on the front of both DVDs: "THE BRAIN THAT CHANGES ITSELF is produced by 90th Parallel Productions Ltd. in association with the Canadian Broadcasting Corporation and ARTE France with the participation of the Canadian Television Fund created by the Government of Canada and the Canadian Cable Industry, the Government of Canada-Canadian Film or Video Tax Credit Program, and the Ontario Media Development Corporation Tax Credit Program."

In his brief, applicant states that he has used his mark "in connection with Applicant's website featuring additional copyright materials." The evidence of record pertaining to applicant's website consists of two specimens of use submitted for applicant's Class 42 services ("Providing a website with scientific information on the subjects of the human brain, brain science and neuroplasticity"). The first appears to be the home page of applicant's website, www.normandoidge.com, titled the "official website" of "Norman Doidge, MD | The Brain That Changes Itself." (The examining attorney also provided a different version of this page.) The second specimen is a 10-page printout from the "Frequently Asked Questions" section of the site. The first page of this printout states, under the title "FAQS AND LINKS":

> With *The Brain That Changes Itself*™ available in over 90 countries, we can no longer reply [sic] individual emails about neuroplastic techniques. So, we have prepared the following answers, based on past email inquiries and questions from his lectures. We periodically update this page, as new neuroplastic developments occur. If you saw Dr. Doidge on television, or heard him on radio, and have a question, keep in mind the answer to your question might well be in the book.

The site next references "Questions Arising from the book, The Brain That Changes Itself." It goes on to summarize "some of the disorders covered in the book" and then addresses several "Frequently Asked Questions."

Applicant also states in his brief that he has used his mark as "the title for revised versions and translations of the book" and "as the title and mark for printed instructional materials distributed in connection with [applicant's] seminar and lectures." Applicant's Brief, at 1. However, there is no record evidence relating to the revised versions of applicant's book or his printed instructional materials.

Analysis

It is well-established that a title of a single work is not considered a trademark and is therefore unregistrable on the Principal Register under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§ 1051, 1052, and 1127. *See In re Cooper*, 254 F.2d 611, 117 USPQ 396, 400 (CCPA), *cert. denied*, 358 U.S. 840 (1958). The title of a single creative work is, of necessity, descriptive of the work and does not function as a trademark. *See In re Scholastic Inc.*, 223 USPQ 431, 431 (TTAB 1984).

In order to function as a trademark by designating source, a mark must have been used to identify a series of different creative works. *See In re Scholastic Inc.*, 23 USPQ2d 1774, 1776 (TTAB 1992); Trademark Manual of Examining Procedure ("TMEP") § 1202.08 (October 2012). The policy underlying this approach is clear. Because a trademark can endure for as long as the trademark is used, at the point that copyright protection ends and others have the right to use the underlying work, they must also have the right to call it by its name. *See Cooper,* 117 USPQ at 400.

In the decades since *Cooper*, the Board and our primary reviewing court have both followed this policy and affirmed refusals to register titles of single creative works. *See, e.g.*, *Herbko Int'l Inc. v. Kappa Books Inc.,* 308 F. 3d 1156, 64 USPQ2d 1375, 1379-80 (Fed. Cir. 2002) (finding that petitioner did not have proprietary rights in CROSSWORD COMPANION for a series of crossword puzzle books at the time respondent filed its involved application because petitioner did not publish its second volume of such books until after respondent's first use); *Mattel, Inc. v. The Brainy Baby Co.*, 101 USPQ2d 1140, 1143-44 (TTAB 2011) (holding that use of

LAUGH & LEARN and design for a program of elementary learning concepts geared toward toddlers, offered in both VHS and DVD formats, constituted a single creative work); *In re Posthuma*, 45 USPQ2d 2011, 2014 (TTAB 1998) (finding PHANTASM unregistrable as the title of a theater production, notwithstanding the variations stemming from live performance of that production).

Applicant argues that THE BRAIN THAT CHANGES ITSELF cannot be deemed merely the title of a single creative work, that is, applicant's book of that title. First, applicant argues that the same mark has been used as the title for revised versions and translations of his book. Applicant, however, has submitted no evidence regarding the substance or extent of those revisions. As explained in TMEP § 1202.08(b):

> A book with a second or subsequent edition in which the content changes significantly is not regarded as a single creative work. For example, a statement on the jacket cover that a cookbook is a "new and revised" version would indicate that it includes significant revisions. However, a new edition issued to correct typographical errors or that makes only minor changes is not considered to be a new work.

In his response to Office action dated November 2, 2011, applicant stated that his book has been translated into more than 15 languages, some of which include a different foreword than that for the English version, but provided no further detail.

We need not, and do not, take a position today as to whether a different book foreword could ever be a content revision significant enough to constitute a new creative work. We find only that applicant has provided no evidence that his book "The Brain That Changes Itself" has undergone significant change.

Applicant next contends that he has used the mark in connection with his website "featuring additional copyrighted materials." Applicant's Brief, at 1. The printouts from applicant's eponymous website, however, use THE BRAIN THAT CHANGES ITSELF to reference and promote his book. The printouts from the "FAQS" section of the site were accepted as a specimen of use of the mark for applicant's Class 42 services, but applicant cites no authority for the proposition that his website constitutes a separate creative work for purposes of our Class 16 analysis. On the facts before us, we view the website content of record as collateral to applicant's book. *See* TMEP § 1202.08(c) ("use of the title on . . . collateral goods such as posters, mugs, bags, or t-shirts does not establish a series").

As previously noted, although applicant states that he has used his mark in association with printed instructional materials, there is no record evidence relating to those uses.

Finally, applicant asserts use of the mark in connection with a documentary film relating to the book. Applicant provides no evidence, however, regarding the source of the documentary film; where it has appeared on television; and where it is available on DVD. The DVD photocopies submitted by applicant do not identify him as their source, but suggest that the documentary was a work of Canadian journalism. There is nothing in the record to indicate that this documentary film has been shown on television or distributed on DVD in the United States. Nor is there any record evidence that applicant is the source of this documentary rather than his book simply serving as its subject.

There is no record evidence establishing that applicant has used THE BRAIN THAT CHANGES ITSELF as a mark for any goods in Class 16. Rather, the evidence shows only that applicant has used the term as the title of a single book, which cannot serve a source-identifying trademark function.

Conclusion

Decision: The refusal of registration is affirmed.