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Sent: 8/27/2015 3:57:18 PM

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Subject: U.S. TRADEMARK APPLICATION NO. 85981686 - NO EXCUSES DIET - SBT0.T0200US - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85981686

MARK: NO EXCUSES DIET



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Jonathan Roche Fitness Ventures LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

SBTO.T0200US

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant, Jonathan Roche Fitness Ventures LLC, has appealed the examining attorney's¹ final refusal to register the proposed mark "NO EXCUSES DIET", in standard character form, under the Trademark Act of 1946 (as amended) (hereinafter "Trademark Act"), 15 U.S.C. § 1052(d). Registration was refused on the grounds that the mark fails to function as a trademark for applicant's books under Trademark Act Sections 1, 2, and 45.

FACTS

On July 25, 2012, the applicant filed the application at issue to register the mark, "NO EXCUSES DIET", in standard form, alleging intent to use the mark in commerce with a variety of goods in International Class 16.

After disclaiming the wording "DIET", the mark was approved for publication on November 21, 2012. The Notice of Allowance was mailed on March 12, 2013, and the applicant filed a combined Statement of Use and Request to Divide on March 12, 2014. The instant "child" application was created, limiting the identification of goods to "books in the field of food in health and wellness." The Statement of Use pertaining to these goods was then processed on April 25, 2014.

On April 26, 2014, the examining attorney issued an Office action refusing the specimen under Trademark Act Sections 1, 2, and 45 for failure to function as a trademark; specifically, because the proposed mark was used only as the title of a single creative work.

The applicant filed a response to the Office action on October 27, 2014. On October 29, 2014, the refusal was continued and made final.

On April 29, 2015, the applicant instituted this appeal.

¹ On July 8, 2015, this case was reassigned to the undersigned examining attorney to address the appeal.

ISSUE

The sole issue for consideration on appeal is whether the applicant's proposed mark, "NO EXCUSE DIET" for "books in the field of food in health and wellness" functions as a trademark under Trademark Act Sections 1, 2, and 45 as shown on the specimen of record.

ARGUMENT

I. APPLICANT'S MARK FAILS TO FUNCTION AS A TRADEMARK

The applied-for-mark, as used on the specimen of record, is used only as the title of a single creative work, namely, the title of a specific book; it does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate the source of applicant's goods. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; *see Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162-63, 64 USPQ2d 1375, 1378-79 (Fed. Cir. 2002); *In re Cooper*, 254 F.2d 611, 615-16, 117 USPQ 396, 399-400 (C.C.P.A. 1958); TMEP §§904.07(b), 1202.08.

Single creative works include works in which the featured content does not change significantly, whether that work is in printed, recorded, or electronic form. TMEP §1202.08(a); *see Mattel, Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140, 1143-44 (TTAB 2011) (holding that LAUGH & LEARN, with design, was merely the title of a single work, where the mark was used as the title of a pre-recorded VHS tape and DVD, the VHS tape and DVD contained the same featured program, and the DVD contained "minor enhancements" such as bloopers and previews).

The title of a single work, even an arbitrary title, is considered descriptive of the contents of the work itself “and is not associated in the public mind with the publisher, printer or bookseller;” whereas “[t]he name for a series, at least while it is still being published, has a trademark function in indicating that each [work] of the series comes from the same source as the others.” *In re Cooper*, 254 F. 2d 611, 615, 117 USPQ 396, 400 (C.C.P.A. 1958).

Applicant was provided the opportunity to respond to this refusal by submitting evidence that the applied-for mark is used to identify a series, rather than a single work. See TMEP §1202.08(c); see also Office Action, p. 1 (April 4, 2014); Final Office Action, p. 1 (October 29, 2014). The applicant elected not to submit any specimens beyond its original specimen showing the cover of its printed book. Specimens of Record, p. 1–6 (March 12, 2014). Thus, as displayed on the specimen, the mark is functioning as the title of a single work rather than indicating the source of applicant’s goods.

II. A PORTAL WEBPAGE AND ADDITIONAL INTERNET MATERIALS DO NOT CONSTITUTE A SERIES OF CREATIVE WORKS

A creative work is not considered a single work when it is either part of a series or includes content that changes with every issue, i.e. a monthly magazine. TMEP § 1202.08(b). A series may be indicated by labeling the works with phrases such as “‘volume 1,’ ‘part 1,’ or ‘book 1’”. *Id.* The key to determination of a series in this context is whether “changes in content are significant based on any evidence in the application or record.” *Id.*

On October 27, 2014, the applicant stated that the book was part of a series which included the following materials: a website “portal page” displaying a picture of the book cover and listing web links to various materials, a downloadable article entitled “15 Secrets for Better Health,” several checklists, and an audiobook version of the book. Response to Office Action, p. 1 (October 27, 2014). The audiobook page entered into the record contains links to audio files, but the audiobook files

themselves have not been entered into the record. *Id.* at 5. In any case, an audiobook, which presents the printed content of a book in an audio format, does not constitute a new work in a series. A series is not established when only the format of the work is changed, i.e., the same title used on a printed version of a book and a recorded version does not establish a series. *Mattel Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140, 1143 (TTAB 2011); TMEP § 1202.08(c).

As noted above, the applicant stated that the book shown in the specimen and these additional materials constitutes a series. A series is “[a] set of books, maps, periodicals, or other documents published in a common format or under a common title.” Oxford Dictionaries, © 2015 Oxford University Press, publishing as Oxford Dictionaries, search of “series”, http://www.oxforddictionaries.com/us/definition/american_english/series (August 5, 2015).² In other words, a series is simply a set of works that are all published under one format or use a common title. Therefore, additional material such as website portals, articles, and checklists that are in a different format than the original book, and also do not use a common title, do not constitute a series in conjunction with the applicant’s book.

A set of works with a common format may indicate a series, but the works at issue take completely different forms. The main work, as displayed on the specimen, is a published book, while the additional materials submitted by applicant are a webpage with a list of web links, an article, and a set of checklists. The book is in tangible, printed form, while the article is hosted online. The online portal page is a collection of links to other webpages referenced in the book. Finally, as discussed above, the audiobook is an audio file that is not read, but listened to, and constitutes a different format

² The examining attorney respectfully requests that the Trademark Trial and Appeal Board take judicial notice of the aforementioned dictionary definition of the term “series”. The Trademark Trial and Appeal Board can take judicial notice of online dictionaries available in printed format or online dictionaries that are readily available and capable of being verified, e.g. dictionaries that are available in specifically denoted editions via the Internet and CD-ROM. TBMP §§ 1208.04; 704.12.

that nonetheless does not establish a series. Each of these works is therefore presented in very different formats that do not create a series.

As discussed above, works using a common title may indicate a series. However, the additional materials do not use the NO EXCUSES DIET title. The portal page displays a picture of the NO EXCUSE DIET book cover, but does not contain a separate title for the page. Response to Office Action, p. 2 (October 27, 2014). Also, the portal page is hosted on the website www.noexcusesworkout.com, which contains different wording than the NO EXCUSES DIET title at issue. Applicant's Appeal Brief, p. 7 (June 29, 2015). The article entitled "15 Secrets to Better Health" contains a different title and does not use the phrasing NO EXCUSES DIET. Response to Office Action, p. 6 (October 27, 2014). Likewise, the checklists do not use the NO EXCUSES DIET phrasing anywhere on the page, nor does the page with links to the audiobook. *Id.* at 7–8.

Further, single "creative works that are serialized, i.e. the mark identifies the entire work but the work is issued in sections...are still considered single works." TMEP § 1202.08(a). Applicant continues to stress that the "book includes references to the interactivity [of the portal page] and points users to use the additional features, tools and materials available at the website." Applicant's Appeal Brief, p. 7 (June 29, 2015). However, these additional materials, including the portal page, the "15 Secrets for Better Health" article, and the checklists act as supplemental materials to be used in conjunction with the applicant's book. The book and the additional materials act as different sections of the applicant's work, and are expressly referred to in the applicant's book as materials to assist a reader of that particular published book.

In order to show use as a trademark, an applicant must submit evidence that a title is used on at least two different creative works. *In re Arnold*, 105 USPQ2d 1953, 1956 (TTAB 2013); TMEP §

1202.08(c). Therefore, without additional evidence showing more than one use of the mark with applicant's books, the mark fails to function as a trademark under Trademark Act Sections 1, 2, and 45.

III. THE ACCEPTABILITY OF THE SPECIMENS IS NOT AT ISSUE

The applicant has argued that its webpage specimen is acceptable as a display associated with the goods. *See Applicant's Appeal Brief*, p. 4–7 (June 29, 2015). However, the basis for the refusal is not the acceptability of the specimens. The original specimen was not refused as insufficient by the examining attorney, but rather refused because NO EXCUSES DIET was the title of a single work. As discussed above, there is no evidence that NO EXCUSES DIET is used as part of a series, and therefore fails to function as a trademark.

CONCLUSION

For the foregoing reasons, the examining attorney respectfully requests that the refusal to register applicant's mark, "No Excuse Diet" for "books in the field of food in health and wellness" in International Class 16, for failure to function as a trademark under Trademark Act Sections 1, 2, and 45 be affirmed.

Respectfully submitted,

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series

See definition in Oxford Advanced Learner's Dictionary

Top 1000 frequently used words
Syllabification: se-ries
Pronunciation: /sɪˈriːz/

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Definition of *series* in English:
noun (plural **same**)

- 1 A number of things, events, or people of a similar kind or related nature coming one after another.
'the explosion was the latest in a series of accidents'
'he gave a series of lectures on modern art'

MORE EXAMPLE SENTENCES

SYNONYMS

- 1 A set of books, maps, periodicals, or other documents published in a common format or under a common title.

EXAMPLE SENTENCES

Most popular in the US

- 1 valiant
- 2 unthaw
- 3 quiddity
- 4 numply
- 5 anchor baby

🔥 = trending



How do you pronounce scone?



Which Jane Austen heroine are you?

- 12 A set of games played between two teams, or among any number of individual competitors:
'a playoff series against Portland'
See also [World Series](#)
MORE EXAMPLE SENTENCES
- 13 A set of stamps, banknotes, or coins issued at a particular time or having a common design or theme.
EXAMPLE SENTENCES
- 14 A line of products, especially vehicles or machines, sharing features of design or assembly and marketed with a separate number from other lines:
[as noun + sing] 'a series III SWB Land Rover'
MORE EXAMPLE SENTENCES
- 2 A set of related television or radio programs, especially of a specified kind:
'a new drama series'
MORE EXAMPLE SENTENCES
SYNONYMS
- 3 *[as modifier]* Denoting electrical circuits or components arranged so that the current passes through each successively. The opposite of [parallel](#).
EXAMPLE SENTENCES
- 4 *Music* another term for [tone row](#).
EXAMPLE SENTENCES
- 5 *Geology* (in chronostratigraphy) a range of strata corresponding to an epoch in time, being a subdivision of a system and itself subdivided into stages:
'A series of strata corresponding to an epoch in time, being a subdivision of a system and itself subdivided into stages.'



Affect versus effect



Bacteria, bacteriae, bacterium? Sorting out the Ignoramuses from the cognoscenti (and other 'borrowed' plurals)

What is the origin of the word 'hazard'?

Video: what is the origin of the word 'hazard'?

TEST YOURSELF

What do these literary words mean?

1) effluent

- shining brightly
- spilling over

Next | Score: 0/0

[More about literary words](#)

'the Pliocene series'

MORE EXAMPLE SENTENCES

6 **Chemistry** A set of elements with common properties or of compounds related in composition or structure:
'the metals of the lanthanide series'
Compare with *period* (sense 5 of the noun).

MORE EXAMPLE SENTENCES

7 **Mathematics** A set of quantities constituting a progression or having the several values determined by a common relation.

EXAMPLE SENTENCES

8 **Phonetics** A group of speech sounds having at least one phonetic feature in common but distinguished in other respects.

Phrases

in series

1 (Of a set of *batteries* or electrical components) arranged so that the *current* passes through each successively.

EXAMPLE SENTENCES

Origin

Early 17th century: from Latin, literally 'row, chain', from *serere* 'join, connect'.

MORE

Words that rhyme with series

WORD OF THE DAY

retroject

Find out what it means

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in series
maxi-series
note-series
Test series
time series

Nearby words

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seriema
series
series spectrum
series-parallel

miniseries • Furies

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English (US)

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