

<p>This Opinion is Not a Precedent of the TTAB</p>
--

Mailed: September 24, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Meredith Madsen

Serial No. 87054308

Barry L. Haley of Malin Haley DiMaggio & Bowen, P.A.,
for Meredith Madsen.

Odessa Bibbins, Trademark Examining Attorney, Law Office 118,
Michael W. Baird, Managing Attorney.

Before Heasley, Dunn and Hudis,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

Meredith Madsen (“Applicant”) seeks registration on the Principal Register of the
mark PREDICTIVE ENTREPRENEUR (in standard characters) for

Education services in the nature of courses at the university level; Education services, namely, providing tutorial sessions in the field of business and entrepreneurship; Education services, namely, providing tutoring in the field of business and entrepreneurship; Business education and training services, namely, developing customized leadership and executive development programs, providing executive coaching services, and providing business education programs to employees and executives; Continuing education services, namely, providing live and on-line continuing professional education seminars in the field of business and entrepreneurship; Leadership development training in the field of business and entrepreneurship

in International Class 41.¹

The Examining Attorney refused registration under Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§ 1051-1053, 1127, on the ground that Applicant's mark PREDICTIVE ENTREPRENEUR, as shown in Applicant's specimen of use, is used only as the title of a single creative work, namely, the title of a specific live presentation, an educational course. Therefore, contends the Examining Attorney, PREDICTIVE ENTREPRENEUR 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.

After the Examining Attorney made the refusal final, Applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. We **reverse** the refusal to register.

I. Procedural History

Applicant filed her intent-to-use application to register the PREDICTIVE ENTREPRENEUR mark for the listed educational services on May 31, 2016. In an Examiner's Amendment issued on September 18, 2016, the Examining Attorney added the disclaimer upon authorization from Applicant's counsel to: "No claim is made to the exclusive right to use 'Entrepreneur' apart from the mark as shown."

¹ Application Serial No. 87054308 filed on May 31, 2016, under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), based upon Applicant's allegation of a bona fide intention to use the mark in commerce.

The PREDICTIVE ENTREPRENEUR application was published for potential opposition on November 8, 2016, and thereafter the Office issued a Notice of Allowance on July 4, 2017. Applicant filed her Statement of Use pursuant to Trademark Act Section 1(d), 15 U.S.C. § 1051(d), on January 3, 2018, claiming a date of first use and first use in commerce of the mark of August 23, 2016. With her Statement of Use, Applicant submitted a specimen of use described as a “course flyer,” appearing as follows:



FAU faculty, staff and alumni \$75
Community members \$99

If you are a student interested in taking this course for credit or if you want more information email adamscenter@fau.edu

Special Topics Series in:

ENTREPRENEURSHIP

fau.fau.edu/SpecialTopicsSeries

THE PREDICTIVE ENTREPRENEUR

August 23 - September 20, 2016, *Tuesday nights 6:30 - 9:20 pm*

Beyond the bootstrap: How to see around corners and take your business from survive to thrive! According to the Small Business Administration about 50% of businesses fail during the first year of business. Some of these failures come from unforeseen and unpredictable events, but what if these failures were predictable? What if you could prepare for them? This course focuses on real world perspectives concerning common and uncommon pitfalls that many businesses face, including faulty planning, unrealistic expectations, and lack of agility to the market. We explore student business ideas, existing business plans and startups to uncover hidden pitfalls and build the tools needed to succeed.

Course Instructor Bio:



Meredith Madsen is the CEO and owner of Madsen Advertising, a multiple Addy Award-Winning Creative & Marketing Agency and Glitter Tots, a company specializing in products for children and tweens sold in nearly 1,000 stores and 15 countries world-wide. Meredith also has over 20 years of leadership experience working for some of the world's largest brands. Meredith holds an MBA in International Business and a Bachelors of fine arts. She is a certified Project Management Professional and Six Sigma Green Belt. She was a professional photographer represented by Getty Images and has been published in many leading magazines worldwide. Meredith has a unique combination of creative and strategic skills enabling her to bring dynamic, fresh solutions to the challenges faced by her clients spanning multiple industries. She offers these valuable lessons to students of this course.

DISRUPTIVE TECHNOLOGY

September 27 - November 1, 2016, *Tuesday nights 6:30-9:20 pm*

Disruptive Technologies define generations, transform history and (can) change the world. We are all familiar with the steam engine, the telephone, the computer and the Internet. However, beneath those are thousands of smaller disruptive technologies that have disrupted the status quo. Also, millions of products and ideas have failed. Why do some succeed? Why do many more fail? This course will focus on the defining technologies and more importantly, the differentiating factors that divide success and failure including intellectual property rights; regulatory clearances; capitalization; public perception; privacy rights and more.

Course Instructor Bio:



Scott R. Silverman is a dynamic CEO that has successfully led 5 public companies over the last 20 years. He is a leader in technology, healthcare, and is recognized as the world's foremost expert in implantable Radio Frequency Identification technologies (RFID). His managerial expertise is broad including operations, P&L management, budget, legal, investor relations, public relations, capital markets and personnel motivation. Mr. Silverman founded and served as Chairman and CEO of Veriteq Corporation- a leader in RFID technology for medical devices. Veriteq went public in 2013 and was recently sold to a leading breast implant manufacturer. VeriChip completed its initial public offering on the Nasdaq in 2007 raising more than \$30 million. Verichip was sold to Stanley Works in 2008 for in excess of \$50 million.

Mr. Silverman attended the University of Pennsylvania (B.A., 1985) and Villanova University School of Law (J.D., 1989). He practiced law for 6 years before beginning his business career. Mr. Silverman began his career as an attorney specializing in commercial litigation and communications law at the law firm of Cooper Periskie in Atlantic City, New Jersey, and Philadelphia, Pennsylvania. Mr. Silverman is involved in various philanthropic and community endeavors. He is on the Board of Trustees for the Pinecrest School in Fort Lauderdale, FL. He also serves on the Board of the Federal Enforcement Homeland Security Foundation and has received many awards and honors, including, but not limited to the 2004 Abacus Award of the AeA as Executive of the Year and the 2004 ID Spotlight Award of the ID World International Congress.

HOW TO ESTABLISH FOREIGN BUSINESS

November 8 - December 6, 2016, *Tuesday nights 6:30-9:20 pm*

This course will provide the ABC's of exporting, international trade, multi-national business and foreign marketing. Students will learn about worldwide sales, shipping, product modification, joint venture partners, and manufacturing overseas. Upon completing this course, you will fully understand the process to enter into Foreign Business.

Course Instructor Bio:



Hank Samuel has accrued a quarter century of experience in the development of global channels of distribution. Hank has a broad knowledge of transnational sales and merchandising having structured and implemented marketing programs that have resulted in strong profitable share positions. He has lectured at the American Management Association on exporting and he is also an adjunct at the University of California, Davis and USC Los Angeles. Hank was awarded the Presidential "E" for export for excellence in Trade Development Columnist in the "New York Journal of Commerce on International Trade". Hank has published books on International Banking and Finance, Exporting Procedure, and International Logistics. Hank has a Bachelor's of Science in Economics

from Universidad Mexico City; a Masters of Business from University of Chicago; and he studied International Law at Northwestern University.

FAU faculty, staff and alumni \$75

Community members \$99

If you are a student interested in taking this course for credit or if you want more information email adamscenter@fau.edu

Sign up for courses at fauf.fau.edu/SpecialTopicsSeries

If accommodation(s) for a disability is required contact adamscenter@fau.edu or call 561-297-3654 a minimum of five (5) working days in advance of the date of the event.

In the first Office Action of February 5, 2018, refusing registration, the Examining Attorney stated: "the applied-for ... mark, PREDICTIVE ENTREPRENEUR, as used

on the specimen of record, is used only as the title of a single creative work, namely, the title of a specific live presentation, **a course**; it 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."² In support of the refusal, in addition to Applicant's specimen, the Examining Attorney made of record the following online press release³ from Florida Atlantic University, where Applicant is a course instructor:

Florida Trend • Business Florida • Media Kit

8:42:18 PM 2/5/2018

FREE FLORIDA TREND ENEWSLETTERS

FREE GIFT WITH SUBSCRIPTION

Florida Small Business

BUSINESS BASICS BEYOND BASICS dba FLORIDA TRY IT RESOURCES

February 5, 2018

Recommend 4

7

Share

Email

Print

NEWS RELEASE

FAU offers courses in entrepreneurship -- open to the public -- this fall

| 8/5/2016

FAU's Adams Center Offers Special Series of Courses in Entrepreneurship Open to the Public this Fall.

BOCA RATON, Fla. – Florida Atlantic University's Adams Center for Entrepreneurship will host a special topic series of courses this fall in entrepreneurship, open to FAU students, faculty, staff and alumni, as well as the public.

The courses will take place on Tuesdays from 6:30 to 9:20 p.m.

The first course, "The Predictive Entrepreneur," will be from Aug. 23 to Sept. 20. This course focuses on real-world perspectives concerning common and uncommon pitfalls that many businesses face, including faulty planning, unrealistic expectations and lack of agility to the market. Students explore business ideas, existing business plans and startups to uncover hidden pitfalls and build the tools needed to succeed. The course instructor is Meredith Madsen, CEO and owner of Madsen Advertising, a multiple Addy Award-winning creative and marketing agency, and Glitter Tots, a company specializing in products for children and tweens sold in nearly 1,000 stores and 15 countries worldwide.

The series continues with "Disruptive Technology," which runs from Sept. 27 to Nov. 1. This course will focus on the defining technologies and more importantly, the differentiating factors that divide success and failure including intellectual property rights, regulatory clearances, capitalization, public perception, privacy rights and more. The instructor is Scott R. Silverman, a dynamic CEO who has successfully led five public companies over the last 20 years. A leader in technology and healthcare, Silverman is recognized as the world's foremost expert in implantable Radio Frequency Identification technologies (RFID).

The series concludes with "How To Establish Foreign Business," which runs Nov. 8 to Dec. 6. This course will provide the ABCs of exporting, international trade, multi-national business and foreign marketing. Students will learn about worldwide sales, shipping, product modification, joint venture partners, and manufacturing overseas.

Join Jeb Bush, Jr. and Friends for the 18th Annual Celebration of Reading Benefitting the Barbara Bush Foundation for Family Literacy Friday, February 16, 2018 The Hyatt Regency Coconut Point Resort & Spa, Bonita Springs Sponsorships available now at barbarabush.org

TRY IT - Free Downloads

Do I Have What It Takes?

Entrepreneurial Assessment

Industry Assessment

Market Analysis: Customers

Market Analysis: Competitors

Compare Your Business to Others in Florida

Securing a Loan Checklist

Financial Analysis: Start-Up Expenses

Financial Analysis: Ongoing Expenses

1994 Established 15,000+ Students 40,000+ Alumni 2,000+ Employees Strong reach. Healthy outcomes.


² Office Action of February 5, 2018 at TSDR 2. Page references to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval ("TSDR") system – to the downloadable .pdf versions of the documents. References to the briefs on appeal refer to the Board's TTABVUE docket system. Before the TTABVUE designation is the docket number; coming after this designation are the page references, if applicable.

³ *Id.* at TSDR 4-6.

Upon completing this course, students will fully understand the process to enter into foreign business. The course instructor, Hank Samuel, has accrued a quarter century of experience in the development of global channels of distribution. Samuel has a broad knowledge of transnational sales and merchandising, having structured and implemented marketing programs that have resulted in strong profitable share positions.

Cost of each course is \$99 for members of the community, and \$75 for FAU faculty, staff and alumni. FAU students interested in taking any of the courses for credit can email adamscenter@fau.edu for more information. Members of the community, as well as FAU faculty, staff and alumni can register online at <https://fauf.fau.edu/SpecialTopicsSeries>.

Tags: Florida Small Business



► LEARN MORE

SUCCESS STORIES

Linda Daniel Lights Up a New Career

Shifting Focus: Pharma to "Farming"

Linda Toffolon Risks All to Relocate


Veteran Finds Collaboration a Key to Success

Disaster Planning: A Tale of Three Companies


Applied and Approved

Michelle Pellito Pairs Song and Social Media

Scoring in Global Markets



\$489.99



\$489.99

Also on FloridaTrend.com

- » Florida's Best Companies to Work For
- » Florida Economic Yearbook
- » 350 Biggest Companies in Florida
- » TopRank Florida lists for download
- » Special offer: Subscribe - get a FREE gift!

Market Update

DOW	24,345.75	-1,175.21
NASDAQ	6,967.53	-273.42
S&P 500	2,648.94	-113.19

Enter a stock symbol ►

- » Stocks of Florida's Top Public Companies

Florida Business News

- » SpaceX's new monster rocket ready for first test flight from Florida
SpaceX's hot new monster rocket makes its launch debut this week, blasting off from the same pad that hoisted men to the moon a half-century ago.
- » Boost in tourism is a gain for The Villages
With or without tourism marketing, The Villages remains an attraction for out-of-state visitors.
- » Florida regulator report shows assignment of benefits abuse worsening statewide
The epidemic of assignment of benefits abuse that has been plaguing Florida for several years is only getting worse.
- » South Florida group mentors youths on how to become successful in business
T.E.E.S. (Teens Exercising Extraordinary Success) is preparing South Florida youths to be the entrepreneurs and leaders of tomorrow.
- » **Small Business Advice**
Steps to starting a business in Florida
A well-constructed business plan will address all of the necessary steps you must take in the formation of a new business.

When making this online press release a part of the record, the Examining Attorney was required to provide complete information as to the date the evidence was published or accessed from the Internet, **and** its source (e.g., the complete URL address of the website). Because the Examining Attorney did not do so, this material normally would not have been considered. *In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018). However, Applicant failed to object to this evidence. We thus consider

this online press release for whatever probative value it may have. *See In re Mueller Sports Medicine, Inc.*, 126 USPQ2d 1584, 1587 (TTAB 2018).

In her August 6, 2018 response to the first Office Action, Applicant states:

Applicant has provided at least seven different lectures covering different subject matter in each lecture using the mark for educational services. The different course content for seven different lectures indicates that the mark is used for educational services and is a series, not a single work.⁴

Applicant followed up her response on August 16, 2018 by filing a Declaration under oath stating:

2. I make this declaration in support of the above-referenced application in the belief that my educational services listed in the application were not for a single work.

3. As Applicant, I provided at least seven different lectures for the educational services recited in this application with different subject matter for each lecture relating to the mark Predictive Entrepreneur. [T]he different course content indicates that the educational services provided by applicant is a series.⁵

In the final Office Action of October 8, 2018, the Examining Attorney maintained the refusal, but neither added more to the record nor inquired further as to the nature of the services offered in connection with the mark.

II. Applicable Law

Trademark Act Section 2, 15 U.S.C. § 1052, provides that “[n]o trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless” the

⁴ Response of August 6, 2018 at TSDR 4.

⁵ Applicant’s Declaration filed by way of Post-Publication Amendment of August 16, 2018 at TSDR 4.

refusal is based on an applicable statutory ground. Trademark Act Section 3, 15 U.S.C. § 1053, states that “[s]ubject to the provisions relating to the registration of trademarks, so far as they are applicable, service marks shall be registrable, in the same manner and with the same effect as are trademarks” Further, “[t]he Patent and Trademark Office (PTO) bears the burden of establishing that a proposed mark is [unregistrable].” *Cf. In re Cordua Rests., Inc.*, 823 F.3d 594, 600, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016); *see also In re Arnold*, 105 USPQ2d 1953, 1956 (TTAB 2013) (Reversing refusal on grounds that proposed mark was the title of a single work: “Because the record does not clearly indicate that the content of the two [specimens] is the same, we give the applicant the benefit of the doubt that they contain different content.”).

The title of a single creative work, such as a book, is not considered a trademark, and is therefore unregistrable. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§ 1051, 1052, and 1127; *In re Cooper*, 254 F.2d 611, 117 USPQ 396, 400 (CCPA 1958). “The policy for this 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.” *Mattel, Inc. v. Brainy Baby Co., LLC*, 101 USPQ2d 1140, 1144 (TTAB 2011).

The Federal Circuit Court of Appeals has confirmed, “this court’s case law prohibits proprietary rights for single book titles.” *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002), and the Board has followed suit. *E.g., In re Arnold*, 105 USPQ2d at 1954 (“It is well settled that the title

of a single creative work is not considered a trademark and is, therefore, unregistrable...."); *Mattel, Inc. v. Brainy Baby Co., LLC*, 101 USPQ2d at 1144 ("The case law is clear that parties cannot gain trademark rights in titles of [individual] works...."); *In re Hal Leonard Publ'g Corp.*, 15 USPQ2d 1574 (TTAB 1990) (INSTANT KEYBOARD unregistrable as the title of single book featuring musical keyboard instruction).

In *In re Posthuma*, 45 USPQ2d 2011, 2014 (TTAB 1998), we affirmed the Office's extension of the "title of a single work" refusal from applying only to books to applying to a live theatrical production, and thus the refusal to register the mark PHANTASM for a live theater production. After reviewing relevant precedent upholding the denial of registration for single book titles, we said:

The materials of record all identify PHANTASM as the name of the live theater production, and the purchasing public likely would perceive it as the title of the play, as opposed to perceiving it as a service mark identifying source or origin. In this connection, **we believe that the title of a play is perceived in the same manner as is the title of a book which, as [we] discussed ..., is unregistrable.**

* * *

We recognize that the nature of live theater dictates that changes will occur from time to time in a stage production. Nonetheless, ..., the essential story of the play remains, by and large, intact. **Whatever the changes made to this live theater production, it still remains a single work, thus, these often subtle changes do not transform the show into a "series" of shows, thereby turning the unregistrable title into a registrable service mark.**

* * *

To allow registration of **play titles** and not **book titles** would lead to the anomalous result of registering ... titles ... for a single theatrical production, but not allowing registration when these same titles are used as book titles. **[W]e see no reason why they should be treated differently by the Office.** (Emphasis added).

Id. 45 USPQ2d at 2013-14.

III. Analysis

Relying on *Posthuma* and Applicant's specimen of use, the course flyer, the Examining Attorney asserts the educational course that Applicant is offering in connection with the Florida Atlantic University School of Business under the mark PREDICTIVE ENTREPRENEUR is but one course in a series of other courses (*e.g.*, DISRUPTIVE TECHNOLOGY and HOW TO ESTABLISH FOREIGN BUSINESS), on the broader topic of entrepreneurship, and will be perceived as the title of a single work.⁶

We disagree with the Examining Attorney's premise that Applicant's educational services comprise a single creative work. Single creative works include works in which the content does not change, whether that work is in printed, recorded, or electronic form. A theatrical performance is a single creative work because the content of the play, musical, opera, or similar production does not significantly change from one performance to another. *In re Posthuma*, 45 USPQ2d at 2014; TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) §1202.08(a) (2019).

Educational services such as university courses are different from scripted theatrical performances. In fact, the TMEP specifies that "[l]ive performances by musical bands, television and radio series, **and educational seminars** are presumed to change with each presentation and, therefore, are not single creative works." TMEP § 1202.08(b) (emphasis added).

⁶ Examining Attorney's Brief, 6 TTABVUE 4.

In this case, Applicant avers that she has “provided at least seven different lectures for the educational services recited in this application with different subject matter for each lecture relating to the mark Predictive Entrepreneur.”⁷ This averment is unchallenged. In sum, we find that the Examining Attorney did not meet her burden regarding the refusal to register on the ground that the mark is used only as the title of a single creative work.

IV. Decision

The refusal to register Applicant’s mark PREDICTIVE ENTREPRENEUR pursuant to Trademark Act Sections 1, 2, 3, and 45, is **reversed**.

⁷ Applicant’s Declaration filed by way of Post-Publication Amendment of August 16, 2018 at TSDR 4.