

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: July 27, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Learning Annex Holdings, LLC
v.
True Power International, Ltd.

Opposition No. 91168283
to application Serial No. 78492400
filed on September 30, 2004

Andrew Hyams of Kerstein, Coren & Lichtenstein for Learning Annex Holdings, LLC.

Richard H. Zaitlen of Pillsbury Winthrop Shaw Pittman LLP
for True Power International, Ltd.

Before Quinn, Rogers, and Kuhlke, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, True Power International, Ltd., seeks
registration of the mark SECRETS OF THE MILLIONAIRE MIND in
standard characters for goods and services identified in the
application as:

sound recorded tapes and compact discs, video
recorded tapes, dvds, and electronic book
publications concerning self-improvement and
wealth accumulation; cd-roms and computer software
in the field of self-improvement and wealth
accumulation, in International Class 9;

printed matter related to self-improvement and wealth accumulation, namely notebooks, envelopes, writing paper, note pads, calendars, tablets, bumper stickers, memo boards, cards, journals, diaries and address books; syndicated columns dealing with self-improvement and wealth accumulation, in International Class 16; and

education services namely, one-on-one mentoring and personal coaching services in the fields of self-improvement and wealth accumulation; education services namely, conducting workshops and seminars via live audio and video streaming over the internet in the fields of self-improvement and wealth accumulation, in International Class 41.¹

Opposer, Learning Annex Holdings, LLC, opposed registration of applicant's mark on the grounds that, as used in connection with applicant's goods and services, applicant's proposed mark is merely descriptive and has not acquired secondary meaning. Specifically, opposer alleges that "[t]he phrases SECRETS OF THE MILLIONAIRE MIND, 'Millionaire Mind,' 'Millionaire Mindset' and 'Mind of the Millionaire' are used as common names for self-improvement and wealth accumulation products made by many companies ... the phrase SECRETS OF THE MILLIONAIRE MIND conveys an immediate idea of the ingredients, qualities and characteristics of the Applicant's goods and services, and the phrase is thus merely descriptive ... Applicant's use of the mark SECRETS OF THE MILLIONAIRE MIND has not been

¹ Application Serial No. 78492400, filed September 30, 2004, alleging a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b).

exclusive ... [c]onsumers do not associate the mark SECRETS OF THE MILLIONAIRE MIND with a single source, and thus the mark has no secondary meaning." Notice of Opposition ¶¶8, 11-13.²

In addition, in its brief opposer asserts as a further basis for opposition that "as was revealed in discovery, the Applicant is improperly seeking to trademark a book title." Br. p. 2. Because the application is based on an allegation of a bona fide intention to use the mark in commerce, to the extent a claim could be based on this assertion, it would be that applicant does not have a bona fide intention to use the mark in commerce to support registration because its intent is only to use it as the title of a single work. Such a claim was not asserted in the pleading, nor did opposer seek to amend the pleading to assert such a claim. However, applicant briefed this issue on its merits. In view thereof, we consider the pleadings amended by implied consent to include this as a claim.

Applicant, in its answer, denied the essential allegations of the notice of opposition.

THE RECORD

By operation of Trademark Rule 2.122 the record includes the pleadings and the file of the subject

² In the Notice of Opposition, opposer also alleged that the proposed mark is generic; however, in its brief opposer waived this claim. See Br. p. 2.

application. In addition, in support of its case-in-chief, opposer submitted a notice of reliance on a third-party registration for the mark MILLIONAIRE'S MINDSET, dictionary definitions and a printed publication.³ In support of its defense, applicant submitted the testimony depositions (with exhibits) of Michelle Burr, applicant's consultant, and Maraia Hoffman, applicant's client. Opposer, in rebuttal, submitted the testimony deposition (with exhibits) of Sara Bushard, legal secretary for opposer's counsel, and a notice of reliance on a third-party application for the mark SECRETS OF THE MILLIONAIRE MIND and a printed publication.

STANDING

To establish standing, opposer must show a real interest in the proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). Generally, where a claim of mere descriptiveness is asserted, it is sufficient for the plaintiff to establish that it is a competitor. *Plyboo America, Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633 (TTAB 1999) and *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502 (TTAB 1985). Opposer, in the notice of opposition, alleged:

3. Since 1980, Learning Annex Holdings, LLC (Opposer or LAH), through its predecessors-in-interest, has been engaged in the sale of goods or educational services related to self-improvement

³ Exhibit Nos. 3-15 and 17-23 were stricken from the notice of reliance by Board order on February 20, 2009 and they have not been considered.

and wealth accumulation. As to all of the goods and service International Classifications in which Applicant is seeking to register the mark, Opposer is either a competitor, or those classifications constitute a normal expansion of Opposer's business.

4. Opposer's courses have had such titles as "How to Develop a Millionaire Mind," "Develop a Millionaire's Mind," "How to Become a Mental Millionaire," "Discover the Seven Secrets to Becoming a Millionaire," and "Amazing Secrets of Self-Made Millionaires."

Applicant denied these allegations, leaving opposer to its proof. There is nothing in the record to establish these allegations. Opposer introduced no direct evidence, testimonial or otherwise, to establish that it is "engaged in the sale of goods or educational services related to self-improvement and wealth accumulation" or in any other business for that matter. No Nonsense, 226 USPQ at 505. Therefore, opposer has not established its standing. However, for completeness we also address opposer's claims that the proposed mark is merely descriptive and that it is intended to be used as the title of a single work.

MERE DESCRIPTIVENESS

Opposer argues that "The Applicant's mark SECRETS OF THE MILLIONAIRE MIND states to consumers that the Applicant provides the mental 'secrets' of people who have accumulated a million dollars or more. Simply stated, the applicant's mark tells consumers merely that the applicant is the source or provider of mental

secrets of wealth accumulation." Br. p. 4. Opposer relies on the dictionary definitions of the individual words "secret," "millionaire" and "mind" to support its position that:⁴

...consumers will presume that Applicant's goods and services will do exactly what the dictionary definitions state: the goods and services will provide secrets about how to have more than a million dollars- in other words, "wealth accumulation." Or as Applicant phrases it in its publicity: "Think Rich to Get Rich." Since the Applicant's identification of goods and services contains information regarding wealth accumulation, the wording "secrets of the millionaire mind" is merely descriptive... SECRETS OF THE MILLIONAIRE MIND describes exactly what the applicant provides in its educational goods and services: the secrets of wealthy people. Applicant's mark is not partially descriptive; it is entirely descriptive.

Br. p. 6.

In response, applicant argues that "opposer has failed to meet the required minimum legal standard to support a finding of mere descriptiveness and, therefore, the opposition should be denied." Br. p.

10. Further, applicant argues that opposer's "piecemeal analysis of Applicant's Mark by its individual components is an improper attempt by Opposer

⁴ "Secret - something kept hidden or unexplained," "millionaire - a person whose wealth is estimated at a million or more (as of dollars or pounds)," and "mind - the element or complex of elements in an individual that feels, perceives, thinks, wills and especially reasons." First Notice of Reliance, Exh. No. 1 (excerpt from Merriam-Webster Online Dictionary).

to circumvent the anti-dissection rule." Br. p. 11.

In addition, applicant argues that:

...a consumer must engage in mature thought or follow a multistage reasoning process to determine any specific attributes of Applicant's goods and services: first, a consumer must connect the terms 'secrets' (generally defined as 'something hidden or unexplained') and 'mind' to knowledge, experience or information, and then must connect 'millionaire' to wealth accumulation and self-improvement. After making these respective connections, the consumer is then forced to make some sense out of the various meanings conveyed by the combination of these terms. For example, SECRETS OF THE MILLIONAIRE MIND could be interpreted in multiple ways to mean a study of how millionaires think, or a scientific examination of a millionaire's brain, or tips on wealth accumulation. However, all of these interpretations require a multi-stage reasoning process. As such, this need to resort to imagination renders Applicant's Mark suggestive, at a minimum, of Applicant's goods and services.

Br. pp. 12-13.

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered

merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use or intended use. *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002) ("The question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods and services are will understand the mark to convey information about them.") That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Finally, a slogan, phrase or any other combination of words may act as a trademark so long as the slogan or combination is used in such a way as to identify and distinguish the user's goods or

services from those of others. A slogan or phrase may be merely descriptive and, thus, unregistrable on the Principal Register in the absence of acquired distinctiveness, if it directly refers to a characteristic of the goods or services with which it is used. The mere descriptiveness analysis is the same for a slogan as it is with any other proposed mark. See *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (CCPA 1960). See generally J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, §7:22 (4th ed. updated 2009).

Opposer must prove its claim of mere descriptiveness by a preponderance of the evidence. This record does not meet that burden. In this case, simply piecing together the separate dictionary definitions of the individual words is not sufficient to establish that this phrase in its entirety is merely descriptive. The meaning and significance of the component words and the composite phrase, when considered in conjunction with the identified goods and services, are not so immediately and directly informative as to be merely descriptive. The phrase SECRETS OF THE MILLIONAIRE MIND may be suggestive of the subject matter of the goods and services but there is something of an atmospheric quality to the phrase

SECRETS OF THE MILLIONAIRE MIND that diminishes the immediacy of any information it imparts as to the goods and services. We add that there is no evidence in the record to support opposer's allegations that the particular phrase or similar phrases are commonly used by third parties in the relevant industry.⁵

In view of our determination based on this record that the phrase SECRETS OF THE MILLIONAIRE MIND is not merely descriptive, we do not reach applicant's alternative defense that, even if merely descriptive, the phrase has acquired distinctiveness as a source indicator for its goods and services.⁶

TITLE OF A SINGLE WORK

Opposer also argues that "Applicant is seeking, through the 'backdoor,' to trademark the name of its best-selling book Secrets of the Millionaire Mind, authored by T. Harv

⁵ The third-party application is not evidence of third-party use.

⁶ Applications based on intent to use may include a claim of acquired distinctiveness under Section 2(f) of the Trademark Act when applicant establishes "through the appropriate submission, the acquired distinctiveness of the same mark in connection with specified other goods and/or services in connection with which the mark is in use in commerce. All of the rules and legal precedent pertaining to such a showing in a use-based application are equally applicable in this context...[and] through submission of relevant evidence rather than mere conjecture, a sufficient relationship between the goods or services in connection with which the mark has acquired distinctiveness and the goods or services recited in the intent-to-use application to warrant the conclusion that the previously created distinctiveness will transfer to the goods or services in the application upon use." In re Rogers, 53 USPQ2d 1741, 1744 (TTAB 1999).

Eker... [and t]he title of a single book cannot be registered even if secondary meaning can be shown...[and] Applicant's case is a Herculean effort to elevate a mere book title into something more." Br. p. 7. Opposer analyzes applicant's evidence of acquired distinctiveness as only showing use of the phrase SECRETS OF THE MILLIONAIRE MIND as the title of a single book.

Applicant responds by stating that "a title of a book series can be trademarked...[and] Applicant's Application was filed on an intent-to-use basis, meaning Applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. As such, Applicant is not foreclosed from developing another book in the SECRETS OF THE MILLIONAIRE MIND series, or other goods and services as listed in its Application...[and] Opposer ignores the fact that there are other uses of Applicant's Mark, such as the CDs and DVDs, the SECRETS OF THE MILLIONAIRE MIND seminar, and the Wisdom cards." Br. pp. 18-19.

The title of a single creative work is not registrable on either the Principal or Supplemental Register unless the title has been used on a series of creative works. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); TMEP §1202.08 (5th ed. 2007). Books, sound recordings, DVDs and audio CDs are usually

single creative works. TMEP §1202.08(a). Finally, "[t]he issue of whether a proposed mark is the title of a single creative work is tied to use of the mark, as evidenced by the specimen. Therefore, generally, no refusal will be issued in an intent-to-use application under §1(b) of the Trademark Act, 15 U.S.C. §1051(b), until the applicant has submitted a specimen with an allegation of use under §1(c) or §1(d) of the Act, 15 U.S.C. §1051(c) or (d)." TMEP §1202.08(f).

To the extent opposer advances this argument to attack the sufficiency of applicant's evidence of acquired distinctiveness, as noted above we do not reach the issue of acquired distinctiveness. To the extent opposer is asserting that the proposed mark is unregistrable as the title of a single work, this claim would arguably be applicable only for the goods in International Class 9. As applicant has argued, this application is based on intention to use the mark in commerce and this record does not establish that applicant will not use this proposed mark in connection with its International Class 9 goods on a series of creative works.

Decision: The opposition, both on the claim of mere descriptiveness and on the claim that the mark is the title of a single work, is dismissed.