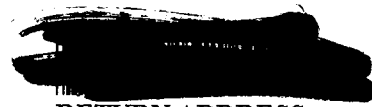


**UNITED STATES PATENT AND TRADEMARK OFFICE**

SERIAL NO: 76/420605

APPLICANT: First Draft, Inc.



CORRESPONDENT ADDRESS:  
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RETURN ADDRESS:  
Commissioner for Trademarks  
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Alexandria, VA 22313-1451

MARK: FERN MICHAELS

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

Serial Number 76/420605

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT:	FIRST DRAFT, INC.	BEFORE THE
Trademark:	FERN MICHAELS	TRADEMARK TRIAL
Serial No.:	76420605	AND
Attorney:	Oliver R. Chernin	APPEAL BOARD
Address:	McLaughlin & Stern, LLP 260 Madison Avenue New York, NY 10016	ON APPEAL

The Office has reassigned this application to the undersigned trademark examining attorney.

**EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant has appealed the examining attorney's final refusal to register the proposed trademark under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127.

**I. FACTS**

The applicant applied to register the mark FERN MICHAELS for a series of fictional books. The examining attorney refused registration on that basis that the proposed mark does not function as a trademark. The applicant argued against the refusal. Registration was finally refused. This appeal timely filed, follows the Examining Attorney's final refusal to register and the denial of the applicant's Motion for Reconsideration.

## II. ARGUMENT

### **A. THE APPLICANT'S PROPOSED MARK DOES NOT FUNCTION AS A TRADEMARK**

Subject matter used solely as an author's name, even on multiple books, does not function as a trademark. See *In re Chicago Reader Inc.*, 12 USPQ2d 1079 (TTAB 1989) (CECIL ADAMS, as used on the specimens, merely identifies the author and is not used as a trademark). A nom de plume or pseudonym of a writer is not generally regarded as a trademark for the writing. *Norcross v. Richardson* 68 USPQ 371 (Com'r. Pat. 1946), *aff'd*. 78 USPQ 122 (DC 1948).

To determine whether a term is being used as a trademark, the examining attorney must consider the specimen of record, together with any other evidence submitted with the application. *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213 (C.C.P.A. 1976); *In re Restonic Corp.*, 189 USPQ 248 (TTAB 1975). Not all words, designs, symbols or slogans used in the sale or advertising of goods or services function as trademarks, regardless of the applicant's intent. A term does not function as a trademark unless it is used in a manner, which clearly projects to purchasers a single source of the goods or services. *In re Morganroth*, 208 USPQ 284 (TTAB 1980). TMEP §§1202 *et seq.* The mark is FERN MICHAELS for a series of fictional books. As specimens, the applicant has submitted several book covers. On each cover, the name FERN MICHAELS merely identifies the author and is not used as a trademark.

It is indisputable that not all words, designs, symbols or slogans used in the sale or advertising of goods or services function as trademarks, regardless of the applicant's intent. A term does not function as a trademark unless it is used in a manner, which clearly projects to purchasers a single source of the goods or services. *In re Morganroth*, 208 USPQ 284 (TTAB 1980). TMEP §§1202 *et seq.* In this case, while the mark undoubtedly appears on the books, it merely serves to identify and name the author of the book and does not project a single source of the goods.

The Trademark Trial and Appeal Board has noted that "not everything that a party adopts and uses with the intent that it function as a trademark necessarily achieves this goal or is legally capable of doing so and not everything that is recognized or associated with a party is necessarily a registrable trademark." As the Court of Customs and Patent Appeals observed in *In re Standard Oil Co.*, 275 F.2d 945, 94 USPQ 227, 229 (C.C.P.A. 1960):

The Trademark Act is not an act to register words but to register trademarks. Before there can be registrability, there must be a trademark (or a service mark) and, unless words have been so used, they cannot qualify for registration. Words are not registrable *merely* because they do not happen to be descriptive of the goods or services with which they are associated.

The purpose of a trademark is to identify and distinguish goods and to indicate the source of the goods. In the instant case, the name FERN MICHAELS as used on the books merely identifies the author of the books, not the source of the books.

Further, to determine whether a term is being used as a trademark, the examining attorney must consider the specimen of record, together with any other evidence submitted with the application. *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213 (C.C.P.A. 1976); *In re Restonic Corp.*, 189 USPQ 248 (TTAB 1975). In *In re Chicago Reader, Inc.* 12 USPQ2d 1079 (TTAB 1983), the Board found that the name CECIL ADAMS did not show use as a trademark, but rather as a byline used *to identify the author* (emphasis added.) Similarly, the name FERN MICHAELS as used on the series of books submitted by the applicant does not show use as a trademark but rather to identify the author of the books. On one of the book covers, the wording "acclaim for the novels of New York Times best-selling author FERN MICHAELS" and "New York Times best-selling author FERN MICHAELS" appears which clearly

identifies FERN MICHAELS as the author of the books. Moreover, the inside jacket of the books contain a short biography and picture of the author, FERN MICHAELS. Additionally, the name FERN MICHAELS appears above the title of the book or on the spine of the book, which is the typical place the author's name is placed on a book so that consumers will be made aware of who wrote the book. Therefore, consumers will view FERN MICHAELS as merely the name of the author of the books, not a trademark for the books.

**B. THE MARK DOES NOT SERVE A DUAL FUNCTION**

Subject matter used solely as an author's name, even on multiple books, does not function as a trademark. *See In re Chicago Reader Inc.*, 12 USPQ2d 1079 (TTAB 1989) (CECIL ADAMS, as used on the specimens, merely identifies the author and is not used as a trademark). The applicant has stated that the mark serves a dual function in that it identifies the author but it also identifies the products placed into the stream of commerce. However, as stated above, as used on the submitted specimens, the name FERN MICHAELS is merely the author's name and does not function as a trademark for the books.

**C. REGISTRATION OF AUTHOR'S NAMES IS DETERMINED ON A CASE-BY-CASE BASIS**

In an application under §1 of the Act, the examining attorney must determine whether the subject matter for which registration is sought is used as a trademark by reviewing all evidence (e.g., the specimens of use and any promotional material) of record in the application. *See In re Safariland Hunting Corp.*, 24 USPQ2d 1380 (TTAB 1992) (examining attorney should look primarily to specimens to determine whether a designation would be perceived as a source indicator, but may also consider other evidence, if there is other evidence of record).

The TARR print-outs and file wrappers submitted by the applicant show current registrations for seven marks composed of a name and used on a series of books. Prior decisions and actions of other trademark examining attorneys in registering different marks are without evidentiary value and are not binding upon the Office. Each case is decided on its own facts, and each mark stands on its own merits. *AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re International Taste, Inc.*, 53 USPQ2d 1604 (TTAB 2000); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984); *In re Consolidated Foods Corp.*, 200 USPQ 477 (TTAB 1978); *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977).

Even so, it is worth noting that several of the registrations presented in support of the applicant's argument show use of the mark that is considerably different from the use in the instant application. For instance, Registration No. 2,609,471 for the mark SYDNEY OMARR'S, shows the mark used as the portion of the title of several books. Registration No. 2,698,054 for the mark DR. SUESS and Registration No. 2,231,032 for the mark AGATHA CHRISTI, show use of the mark in advertising and promotional material in addition to the books. Registration No. 2,630,156 features a word mark combined with a design, which is used on the spine of the books.

The examining attorney maintains that in the instant application the proposed mark merely functions as the name of the author of the books. Generally, subject matter used solely as an author's name, even on multiple books, does not function as a trademark. *See In re Chicago Reader Inc.*, 12 USPQ2d 1079 (TTAB 1989) (CECIL ADAMS as used on the specimens merely identifies the author and is not used as a trademark); *Cf. In re Wood*, 217 USPQ 1345 (TTAB 1983) (artist's pseudonym YSABELLA, affixed to an original work of art, functioned as a trademark). TMEP §1202.09.

**III. CONCLUSION**

For the foregoing reasons, the applicant's mark fails to function as a trademark and the refusal to register under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127 should be

affirmed.

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