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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of:

Hartman International, LLC

for

THE COLOR CODE

Application No. 77/320,125
Filed April 27, 2009

BRIEF FOR APPELLANT

International Class 16

Trademark Examining Attorney
RENEE SERVANCE

Law Office 111

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I. Table of Authorities

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II. Description of the Record

Applicant Hartman International, LLC filed a Section 1(a) trademark application on November 2, 2007 seeking to register “The Color Code” in connection with the following services in International Class 016:

books, printed summaries and reviews of books, printed informational articles, printed instructional articles, printed instructional materials, printed forms and newsletters in the fields of personality, personality profiles, personality traits, character traits, communication, communication improvement, personal relationships, professional relationships, employee relationships, employee management, diversity, team work, business interaction, leadership, human behavior, caring, sharing, compassion, integrity, creativity, honesty, loyalty, values, motives, motivation, positive affirmations, passion for life, success in life, enjoyment of life, stress reduction, conflict reduction, skills, skills development, productivity, sales, effectiveness, and personal improvement.

Applicant submitted an image of the cover of the book “The Color Code” as a specimen along with the application.

On February 15, 2008, a non-final office action was sent to Applicant refusing registration based on the specimen of record being a single creative work under 15 U.S.C. §§1501-1052 and 1127, and TMEP § 1208.08. The Applicant was also invited to modify the goods description to include the modifiers *interpersonal* before *skills* and *skills development*, and *personal* before *effectiveness*.

Applicant submitted a response to the office action through TEAS on March 11, 2008, which amended the description as suggested by the Examiner. The response also included additional specimens of newsletters associated with the book, which include “The Color Code” in the title of the newsletter and throughout the text of the newsletter in bold type, and also references Color Code International, a group associated with “The Color Code.”

A second non-final action was sent to applicants on March 31, 2008 maintaining the

single creative work refusal, and additionally refusing based on an alleged failure to establish a series of books or other creative works because the newsletter for adherents to the principals in “The Color Code” includes the modifier “Connection” after “The Color Code”. The Examiner also indicated since the title of the newsletter is “The Color Code Connection” that it does not match with the requested mark “The Color Code.”

Applicant responded through TEAS to the second non-final action on September 30, 2008. Applicant argued that the portion of the title “The Color Code” from the newsletter is a separate and distinct element separated from “Connection” with a solid line and alone on its own line of text. Applicant further argued that the newsletter indicates the source as being the same as “The Color Code” due to the use of “The Color Code” in bold, capital letters throughout the newsletters.

A final refusal was sent to Applicant on October 27, 2008. The Examiner maintained the previous reasons for refusal and further argued and indicated that “**Newsletters are Not Creative Works**” (emphasis in original). Applicant filed a notice of appeal on April 27, 2009.

III. Argument

Applicant is entitled to registration of the mark “The Color Code” because Applicant has established that the mark has been used in commerce on different related works, including the book “The Color Code” and associated newsletters “The Color Code Connection.” Even if the book is considered alone, and therefore not registerable as a single creative work, the serial newsletter “The Color Code Connection” establishes the required use of “The Color Code” for registration.

Newsletters are Creative Works

The first issue that must be addressed in the Examiner's astonishing assertion, without any legal support, that "**Newsletters are Not Creative Works**" (emphasis in original).

Newsletters are creative works and may include titles or names that may be registered as trademarks as reflected by the acceptable goods description of, for example, "Newsletters in the field of {indicate subject matter}" listed under class 016 in the Trademark ID Manual.

Additionally, TMEP § 1202.08(b) indicates what is *not excluded* from trademark protection under the single creative work rule, including "magazines, newsletters, brochures, comic books, comic strips, or printed classroom materials." Thus, newsletters are not *single* creative works subject to the exception, but are serial creative works that may be used as goods subject to trademark protection.

The Book and Newsletters Are Part of a Series of Creative Works

The Examining Attorney refused registration of "The Color Code" as the title of a single book. TMEP §1202.08(a) et seq. "The name of a series of books or other creative works may be registrable if it serves to identify and distinguish the source of the goods." TMEP §1202.08(c). In order to establish a series for trademark protection of a mark "[A]n applicant must submit evidence that the title is used on at least two different creative works." Id. The mark "The Color Code" is used on both the book and on each of the newsletters submitted. The book and each newsletter are different creative works or related material, as each includes different material and articles, and as such, the common mark "The Color Code" is registerable. *See In re Scholastic Inc.*, 23 USPQ2d 1774 (TTAB 1992); TMEP §1202.08(c).

“The Color Code” is Separate and Distinct From “Connection” in the Newsletter

The Examining Attorney continued and maintained the refusal of the mark even after submission of two specimens by Applicant showing use of the mark in a series of newsletters titled “The Color Code Connection.” Applicant submits that, in addition to being part of different creative works with respect to the book, “The Color Code” as used in the newsletters is sufficient to warrant registration of the mark. Applicant maintains that the portion of the title, “The Color Code,” as used on the specimens, is a separate and distinct element indicating that the source of the newsletter originates with the same source as the book. Alternatively, the title of the two newsletters at least indicates a series of creative works registerable under TMEP §1202.08(c).

“The name of a series of books or other creative works may be registerable if it serves to identify and distinguish the source of the goods.” TMEP §1202.08(c); *See also In re Cooper*, 254 F.2d 611, 117 U.S.P.Q. 396 (C.C.P.A. 1958), cert. denied, 358 U.S. 840, 119 U.S.P.Q. 501 (1958). To make it evident that the “The Color Code” is being promoted as a mark, text within the body of the newsletter reading “The Color Code” or “Color Code” is bolded, indicating the source of the series of newsletters is the same as the original book. “The Color Code,” as it is used in the specimens, is used as a trademark to identify the source of the series of newsletters, as opposed to a “series title [that] merely identifies the contents of the book.” *See In re Scholastic Inc.*, 23 USPQ2d 1774 (TTAB 1992). Therefore, “The Color Code,” is registerable because it functions to identify and distinguish the source of Applicant’s book and newsletters.

Furthermore, when a mark is used as a portion of a title, it is registerable upon a showing that “(1) [i]t creates a separate commercial impression apart from the complete title; (2) [i]t is

used on series of works; and (3) [i]t is promoted or recognized as a mark for the series.” See TMEP §1202.08(d). In considering whether a portion of a title creates a separate commercial impression, a key consideration is whether it appears on a separate line above the remainder of the title. See *In re Scholastic Inc.*, 23 USPQ2d 1774 (TTAB 1992); See TMEP §1202.08(d)(i).

The authors of the book, THE COLOR CODE, desiring to continue their work, chose to publish a series of newsletters as the vehicle to provide further educational materials on personal improvement. The portion of the title of the newsletters, “The Color Code,” is placed above the remainder of the title to indicate that the source of the newsletter originates with the same source as the book, as well as other newsletter publications in the same series. Moreover, to further indicate that “The Color Code” is used to create a distinct commercial impression, a line is drawn between the mark and the remainder of the title, “Connection,” as seen in the specimens provided.

Additionally, the newsletters were published by Color Code International, a group dedicated to promoting the principals in the book “The Color Code.” The first article in column 1 of Volume 1, No. 1 issue of the newsletter was written by the author of “The Color Code,” tying the book to the newsletter and indicating common origin.

VI. Summary

Applicant is entitled to registration of the mark “The Color Code” because Applicant has established that the mark has been used in commerce on different related works, including the book “The Color Code” and associated newsletters “The Color Code Connection.” Newsletters are goods that may be subject to trademark protection. Even if the book is considered alone, and

therefore not registerable as a single creative work, the serial newsletter “The Color Code Connection” establishes the required use of “The Color Code” for registration.

Thus, for at least these reasons, Applicant respectfully requests that the Trademark Trial and Appeal Board allow registration of the mark “The Color Code.”

Dated this 26th day of June, 2009.

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