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

Proceeding	77367804
Applicant	Open Window Foundation
Applied for Mark	OPERATION WORSHIP
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Submission	Appeal Brief
Attachments	OPERATION WORSHIP Applicant's Brief on Appeal.pdf ( 14 pages )(1362558 bytes ) OPERATION WORSHIIP Request For Judicial Notice.pdf ( 8 pages )(581106 bytes )
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Date	03/01/2010

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

In re application of:

Open Window Foundation

Application Ser. No. 77/367,804

For: **OPERATION WORSHIP**

TM Attorney: Georgia Ann Carty Ellis

Law Office: 117

**APPLICANT'S BRIEF ON APPEAL**

Commissioner for Trademarks  
P. O. Box 1451  
Alexandria, Virginia 22313-1451

**I. INTRODUCTION**

Appellant-Applicant Open Window Foundation ("Applicant") hereby files this Appeal Brief in response to the Examining Attorney's Final Refusal dated December 3, 2009. Applicant appeals the Examining Attorney's refusal to accept the statement of use in Class 16 on the grounds of use as a portion of a title of a single creative work. For the reasons set forth below,

Applicant respectfully requests that the Trademark Trial and Appeal Board (“the Board”) reverse the Examining Attorney’s decision and allow the application to proceed to registration.

## **II. APPLICANT’S TRADEMARK**

The refusal to register in Class 16 must be reversed for three reasons. First, applying the Court’s definition of a “book title” as announced in *In re Cooper*, the mark OPERATION WORSHIP does not form part of the title of the work identified in Applicant’s specimen. The title of the work is *Holy Bible*. Second, because *In re Cooper* notes that the rule prohibiting registration of a portion of a single creative work’s title applies to new works, and not new copies of old works, Applicant’s applied-for mark is not subject to the rote application of the rule. Third, the Examining Attorney’s request that Applicant “satisfy the statutory requirements” by proving that OPERATION WORSHIP identifies a series of creative works is inapplicable, because the OPERATION WORSHIP mark does not constitute part of the title of the work, and therefore is not subject to the requirements of TMEP §§ 1202.08(d) *et seq.*

### **A. OPERATION WORSHIP DOES NOT CONSTITUTE PART OF A BOOK TITLE**

The Court’s definition of a “book title” in the seminal case *In re Cooper*, 254 F.2d 611, 117 U.S.P.Q.396 (C.C.P.A. 1958), confirms that OPERATION WORSHIP constitutes neither the entire title nor part of the title of Applicant’s goods. *In re Cooper* remains the authoritative decision addressing the registrability of marks used in connection with creative works. *See, e.g., In re Posthuma*, 45 U.S.P.Q.2d 2011, 2012 (T.T.A.B. 1998) (beginning its analysis of the applied-for mark’s registrability with “the seminal case in this area . . . *In re Cooper*”). The Court in *In re Cooper* explained the rationale that underlies the general prohibition against registering titles of single creative works as trademarks. *Id.* at 400 (noting that “[t]here is a

compelling reason why the name or title of a book of the literary sort cannot be a trademark”). The opinion states that “[a] book title . . . identifies a specific literary work, of whatever kind it may be, and is not associated in the public mind with the publisher, printer or bookseller—the ‘manufacturer or merchant’ referred to in the Trademark Act.” *Id.* Applying this language to the immediate facts makes clear that OPERATION WORSHIP does not qualify as a book title or a part thereof.

*In re Cooper* provides a carefully-constructed definition, advising that a book title “is not associated in the public mind with the publisher, printer or bookseller.” *Id.* This is accurate—classic, familiar titles such as *The Symposium*, *Pride and Prejudice*, and *Beowulf* do not indicate the source—that is, the publisher, printer or bookseller—of the underlying work. Titles identify “a specific literary work, of whatever kind it may be.” *Id.* *In re Cooper*’s definition is even more useful in isolating the “book title” when one contemplates the myriad editions, iterations, or reconstructions of those works available today: Consumers, for instance, would not perceive that “The *Penguin Classics* edition of *Beowulf*” constitutes the title of that particular work.<sup>1</sup> Rather, the title of the book in the public mind is simply *Beowulf*. Because *Penguin Classics* contrasts sharply with the well-known title, it instead “is associated in the public mind with the publisher, printer or bookseller,” and thus by definition is not part of the title of the book. Indeed, the public mind would perceive *Penguin Classics* as source identifier, allowing it to function as a trademark. These terms indicate to the purchaser *whose copy* of *Beowulf* she is about to buy—a

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<sup>1</sup> See “Applicant’s Request to Take Judicial Notice in Connection With Brief On Appeal,” ¶ 1 and Exhibit 1 attached thereto. (hereinafter “Req. for Notice”)

copy published by Penguin Classics—insofar as they are associated with the “‘manufacturer or merchant’ referred to in the Trademark Act.” *Id.* at 400.

Similarly, *Dover Thrift Editions* is not part of the title of *Beowulf*, despite the fact that Dover Publications publishes a volume that displays those terms together on its front cover.<sup>2</sup> *Beowulf* is not associated in the public mind with the publisher, printer or bookseller; it is the title of the book. *Dover Thrift Editions*, on the other hand, is certainly associated with Dover Publications, and pursuant to the holding in *In re Cooper*, the source-identifying terms must be excluded from the book title. The same analysis can be applied to the *Barnes & Noble Classics* copy of *Beowulf*.<sup>3</sup> The public mind would not perceive the bookseller’s mark as part of the title of the book.

Applying this rationale to the OPERATION WORSHIP copies of the *Holy Bible* produces the same results: OPERATION WORSHIP is the bookseller, and exhibits attached to Applicant’s Response to the Patent and Trademark Office (“PTO”) dated January 9, 2008, show Applicant’s goods promoted and displayed in connection with the OPERATION WORSHIP mark. Attached as Appendix 1, pg. 3. Given the mark’s placement on the promotional display unaccompanied by the *Holy Bible* title, and its contextual placement on the book cover, sentient purchasers and prospective purchasers will understand that OPERATION WORSHIP is involved in printing, publishing, or selling the book. The mark, therefore, will be “associated in the public mind with the . . . bookseller,” and cannot be part of the title of the book, according to the Court’s holding in *In re Cooper*. Indeed, the consuming public would not perceive the title of

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<sup>2</sup> See Req. for Notice, ¶ 1 and Exhibit 2 attached thereto.

<sup>3</sup> See Req. for Notice, ¶ 1 and Exhibit 3 attached thereto.

the work as *OPERATION WORSHIP Holy Bible*. The *Holy Bible* is an ancient text; its title is universally familiar, immutable, and will be recognized as such despite the supplementary, source-identifying text found on the front cover of Applicant's specimen.<sup>4</sup>

Applicant's additional, non-literary uses for the OPERATION WORSHIP bolster the mark's role as a source-identifier, and decrease the likelihood that the purchasing public will perceive OPERATION WORSHIP solely as part of the title of Applicant's copies of the *Holy Bible*. Applicant makes such non-literary, non-titular uses of its OPERATION WORSHIP service mark in connection with its U.S. Registration in International Class 41 (Serial No. 77/367,804) for charitable services, religious instruction services, educational and entertainment services, and motivational and educational speakers. In light of this array of alternate uses, the public will associate OPERATION WORSHIP with a source or origin of goods and services, rather than part of a title of a single work.

Finally, regarding the physical layout of Applicant's specimen, the Board's treatment of the applied-for mark's font and placement in *In re Scholastic* confirms Applicant's classification of OPERATION WORSHIP as a source identifier separate from the title of the underlying work. 23 U.S.P.Q.2d 1774 (T.T.A.B. 1992). In *In re Scholastic*, the Board found that because "the words THE MAGIC SCHOOL BUS are prominently displayed on the books' covers . . . in a larger, bolder style of type and different color from the remainder of each title," and because THE MAGIC SCHOOL BUS "appear[s] on a separate line above the remainder of each title," the terms create "a separate commercial impression separate and apart from" the book's title. *Id.*

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<sup>4</sup> If, on the other hand, the title of Applicant's underlying goods were new and somewhat obscure, we might proceed with less certainty regarding the public's ability to distinguish

Footnote continued on next page

at 1777. Similarly, in the immediate case OPERATION WORSHIP appears in a different font, on “a separate line above the remainder of [the] title,” and is scaled considerably smaller than *Holy Bible*, the title of the book. *Id.* Because of these stylistic distinctions, OPERATION WORSHIP creates a separate commercial impression as printed on the cover of Applicant’s goods.

Based on the foregoing discussion, Applicant’s OPERATION WORSHIP mark should not be considered part of the title of Applicant’s goods. Because the definition of a “book title” from *In re Cooper* necessarily excludes the OPERATION WORSHIP mark, reversal of the Examining Attorney’s refusal of registration conforms to the well-established case law cited herein.

**B. THE RULE PROHIBITING REGISTRATION OF A PORTION OF A SINGLE CREATIVE WORK’S TITLE APPLIES TO NEW WORKS, NOT TO NEW COPIES OF OLD WORKS**

*In re Cooper* expressly acknowledges a distinction between “new copies of old books” and “new books.” *Id.* at 399. Copies of *new* books are necessarily “unique” and their titles serve to identify a particular literary work. Because those works will eventually fall into the public domain, their titles must be available for use by all to describe the literary content. On the other hand, “new copies of old books are constantly manufactured – ‘Hamlet,’ the ‘Holy Bible,’ ‘Webster’s Dictionary’ and J.K. Lasser’s ‘Your Income Tax.’” *Id.* Whatever the rule of *In re Cooper* and its progeny, the subject is plainly the titles of new books and the need for the titles to remain in the public domain.

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between the text comprising its title, and the text identifying its source.

Indeed, the Court in *In re Cooper* explicitly distinguishes *new copies of the Holy Bible* from the case of new titles for new works. *See Id.* The Examining Attorney confirms in the Final Refusal that various “new copies” of the *Holy Bible* feature registrable source-identifying text or marks: Both the registered marks DURAWORD (Registration No. 3,251,868) and TRUGLO (Registration No. 3,131,254) are owned by publishing companies, and are used to identify “each respective registrant’s reconstruction/interpretation of the bible.”

Registration of trademarks used on “new copies of old books” is appropriate because a consumer has an interest in ascertaining the source of the *Holy Bible* she is purchasing. On the shelf or on the internet, names such as TRUGLO and OPERATION WORSHIP—like *Penguin Classics* and *Dover Thrift Editions*—answer the conjectural question asked by the Court in *In re Cooper*: “If there were two publishers of [the work titled] ‘Pollyanna,’ how could the title possibly indicate origin or distinguish the goods of one from the goods of the other?” *Id.* Accordingly, the use of OPERATION WORSHIP together with the work’s title *The Holy Bible* does not implicate any requirement that *In re Cooper* and its progeny may impose with regard to the title of a new work. Simply put, the public would not perceive *Dover Thrift Editions Beowulf* or *TRUGLO Holy Bible* as some new *title* applied to those ubiquitous texts bearing millennia-old, immutable names. And consumers will not assume that Applicant’s goods fall under a new, full title of *OPERATION WORSHIP Holy Bible*.

### **C. THE RULE REQUIRING PROOF OF A SERIES OF CREATIVE WORKS DOES NOT APPLY**

In maintaining the refusal to register in Class 16, the Examining Attorney insists that Applicant submit “[e]vidence of a series include[ing] copies of at least two different book covers



or packaging for recorded works” in order to “satisfy the statutory requirements.”<sup>5</sup> The Examining Attorney asserts that such evidence is a statutory requirement for registration of a title or portion of a title, and cites well-known and unquestioned cases wherein the alleged mark appears *in the title of the book*. *In re Scholastic, Inc.*, at 1775-76 (TTAB 1992) (mark THE MAGIC SCHOOL BUS appears “as part of each book's title”); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156 (Fed. Cir. 2002) (mark CROSSWORD COMPANION appeared as the title of the works); *In re Cooper*, 117 USPQ 396, 397-98 (CCPA 1958) (“the title of the book is TEENY-BIG and the book has no other name, title, subtitle or any other designation except its generic name ‘book.’”). These cases are distinguished and remain inapplicable because, as discussed above, Applicant’s OPERATION WORSHIP mark does not constitute any portion of the title of the work. The case law does not justify expansion of the general rule against registering titles of single, creative works to encompass uses that are not reasonably perceived by consumers as part of the name of a book—particularly for well established, immutable, ancient works.

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<sup>5</sup> The Examining Attorney advises Applicant “that multiple copies of the same specimen do not constitute plurality of use.” Applicant’s specimen, however, depicts four separate works, each bearing a unique color scheme, pattern, and text label corresponding to the four major branches of the United States Armed Forces—*i.e.* the Navy, Marines, Army, and Air Force. Applicant respectfully asserts that the four works depicted in its specimen *do* constitute plurality of use, insofar as they are neither freely substitutable nor interchangeable. While the Examining Attorney may not see an appreciable difference in these works, it is likely that both (A) active members of the Armed Forces, and (B) those sending OPERATION WORSHIP *Holy Bibles* to soldiers overseas would consider the OPERATION WORSHIP *Holy Bible* for Marines to be a separate and distinct product from the OPERATION WORSHIP *Holy Bible* for the Air Force. To declare these works “multiple copies of the same specimen” is roughly comparable to giving a blue onesie to the new parent of a baby girl and insisting that the color makes no difference and bears no particular significance.

The Examining Attorney also requests that Applicant submit multiple creative works because its identification claims that OPERATION WORSHIP will be used for “religious books.” The Examining Attorney distinguishes “religious books” from “bibles,” stating that a specimen showing a single bible would satisfy the latter category, but not the former, because “religious books is a broad class of printed goods.” The Examining Attorney, however, has never objected to Applicant’s identification on grounds of indefiniteness. Moreover, the breadth of applicant’s identification cannot dictate the number of specimens Applicant must submit—Applicant need only submit one. *See* TMEP § 904.01 (noting that “[o]ne specimen for each class is required”). Applicant has submitted a specimen depicting four separate bibles, which would suffice to show use for a “bibles” identification, and certainly satisfies the broader, encompassing “religious books” category. *See* Appendix 1, pg. 4.

### III. CONCLUSION

Given these facts, Applicant’s mark is entitled to registration. Applicant respectfully requests that the Board reverse the Examining Attorney’s rejection and allow the application to proceed to publication.

Respectfully submitted,

TOWNSEND and TOWNSEND and CREW LLP

Dated: March 1, 2010

By: 

Marc M. Gorelnik  
*Attorneys for Applicant*  
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62403350 v2

## **APPENDIX 1**

**TRADEMARK**

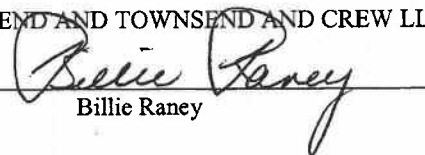
Attorney Docket No. 000020-011000US

Date of Deposit: April 15, 2009

I hereby certify that this correspondence is being deposited with the United States Postal Service as "First Class Mail" in an envelope addressed to: Commissioner for Trademarks, P. O. Box 1451, Alexandria, VA 22313-1451.

TOWNSEND AND TOWNSEND AND CREW LLP

By:

  
Billie Raney

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

In re Application of:

Open Window Foundation

Serial No. 77/367,804

Filed: January 9, 2008

Mark: **OPERATION WORSHIP**

Trademark Attorney:  
Ramona Ortiga Palmer

Law Office No. 117

**RESPONSE**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Commissioner:

This communication is responsive to the Office Action dated February 4, 2009. The Office Action has been reviewed in depth, and this Amendment is intended to place the Application into condition for publication and formal allowance.

Registration has been refused in Class 16. Applicant respectfully believes that the Examining Attorney misapprehends the specimen of record. The Examining Attorney states that the mark is used as the title of a single work. However, the mark is not used as a title. Instead,



**04-17-2009**

the title of the work is prominently shown as "HOLY BIBLE." Applicant does not seek to register the title of the work. Therefore, the objection to the specimen is misplaced.

The mark OPERATION WORSHIP appears on the specimen, to be sure, but to indicate source rather than the title of the work. The attached materials show various versions of the work (cover artwork) and a display associated with the goods. In each case, the title of the work is readily distinguishable from the source of the goods. Accordingly, Applicant respectfully requests that the refusal to register in Class 16 be withdrawn and the application be advanced to registration.

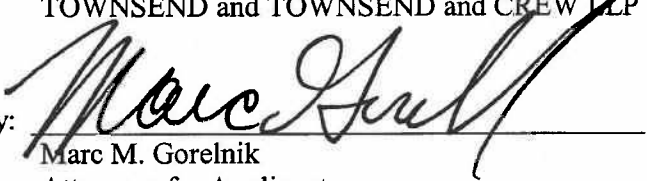
**CONCLUSION**

Applicant believes that this application as now presented is fully in condition for passage to publication and formal allowance and requests prompt action to that end. Should the Examining Attorney believe that a telephone conference would expedite the prosecution of this application, she is invited to call the undersigned at (415) 576-0200.

Respectfully submitted,

TOWNSEND and TOWNSEND and CREW LLP

By:

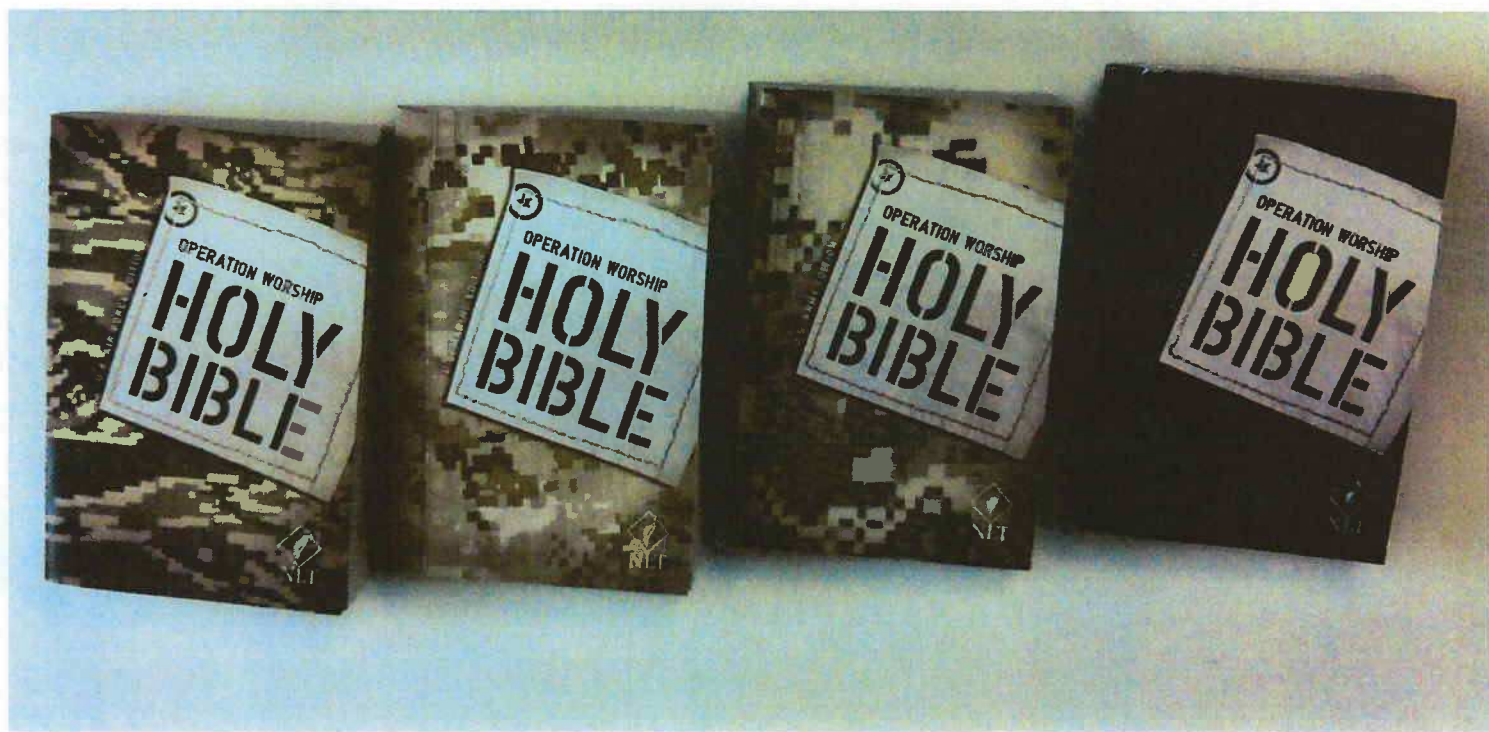
  
Marc M. Gorelnik  
Attorneys for Applicant

Dated: April 15, 2009

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

In re application of:

Open Window Foundation

Application Ser. No. 77/367,804

For: **OPERATION WORSHIP**

TM Attorney: Georgia Ann Carty Ellis

Law Office: 117

**APPLICANT'S REQUEST TO  
TAKE JUDICIAL NOTICE IN  
CONNECTION WITH BRIEF ON  
APPEAL**

Commissioner for Trademarks  
P. O. Box 1451  
Alexandria, Virginia 22313-1451

Appellant-Applicant Open Window Foundation, by and through its attorneys, hereby requests that the Board take judicial notice, pursuant to TBMP § 704.12(a), 37 CFR § 2.122(a), and Federal Rule of Evidence 201, of the following fact:

1. Different publishers, printers, and booksellers produce copies of classic, ancient texts such as *Beowulf*, and distinguish their copies from those of others by including one or more source-identifying marks on the “new copies” of the old work. These source-identifying marks alert the consumer as to the source of the copy of *Beowulf* that she



is purchasing. Examples of new copies of *Beowulf* featuring source-identifying marks are attached hereto as Exhibits 1, 2, and 3. The source-identifying mark in Exhibit 3 is located in the lower left corner.

Respectfully submitted,

TOWNSEND and TOWNSEND and CREW LLP

Dated: March 1, 2010

By: 

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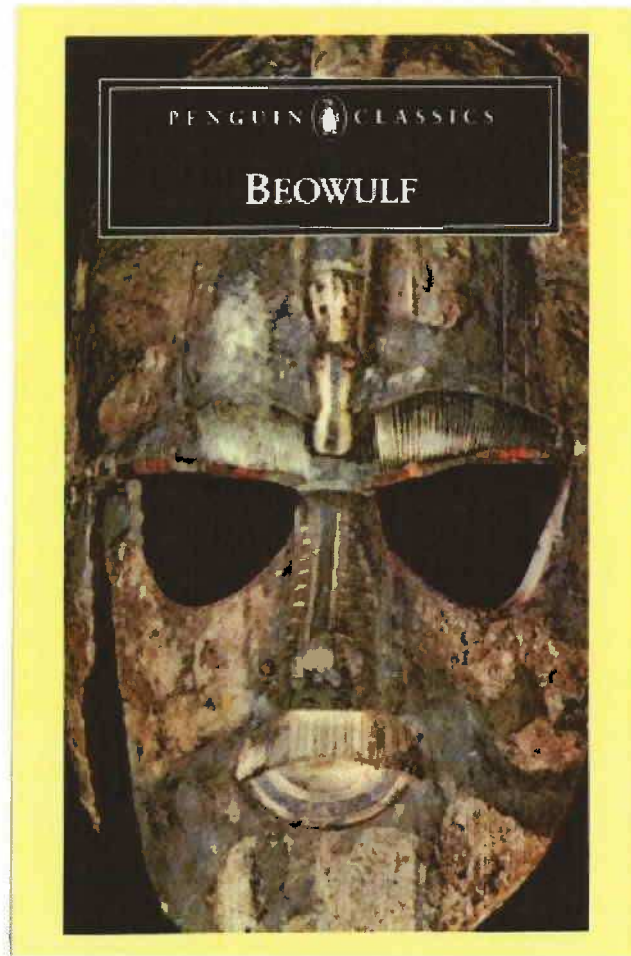
62481338 v1

## **EXHIBIT 1**

amazon.com

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**Beowulf: A Prose Translation (Penguin Classics)**



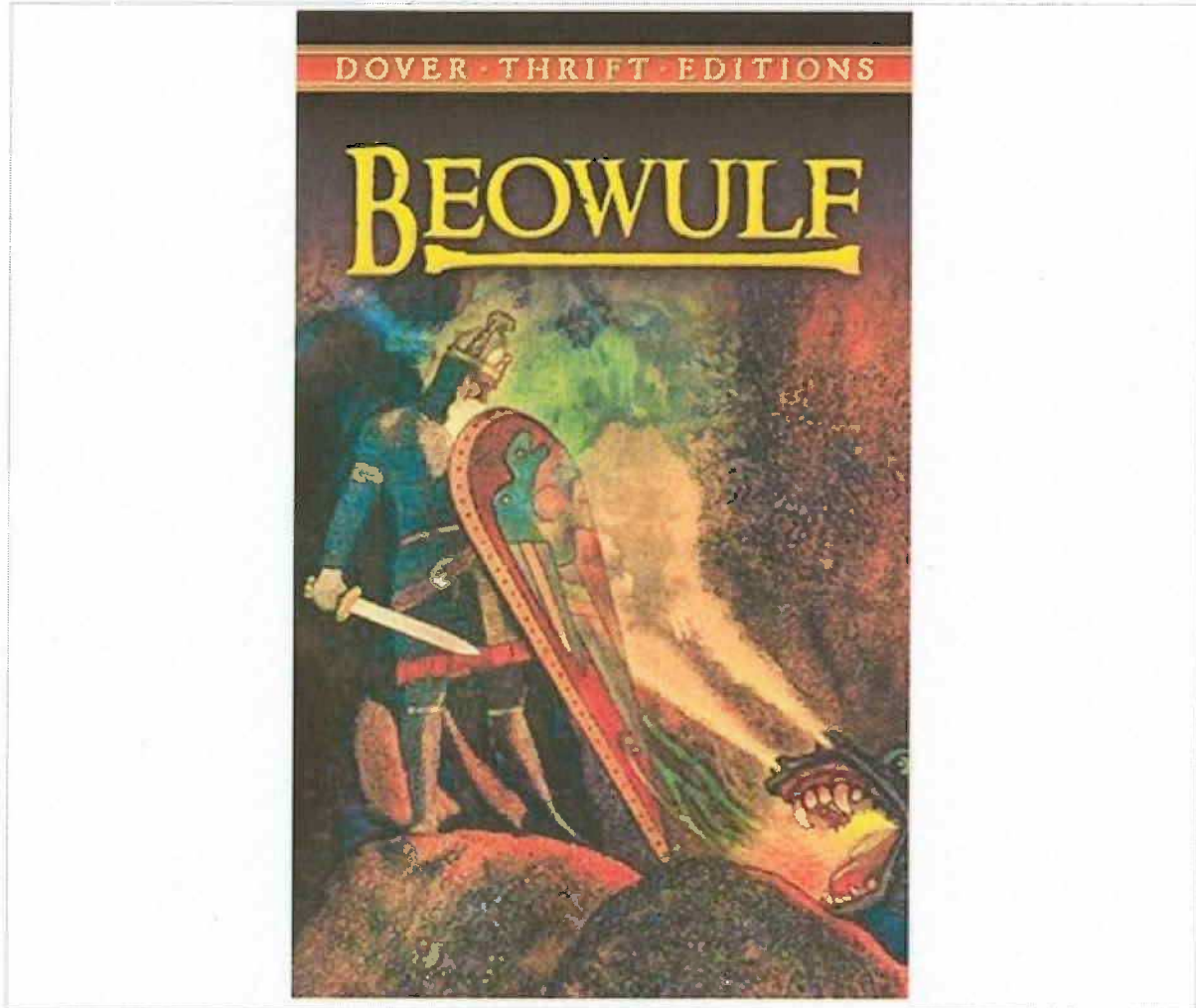
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## **EXHIBIT 2**

amazon.com

Close window

Beowulf (Dover Thrift Editions)



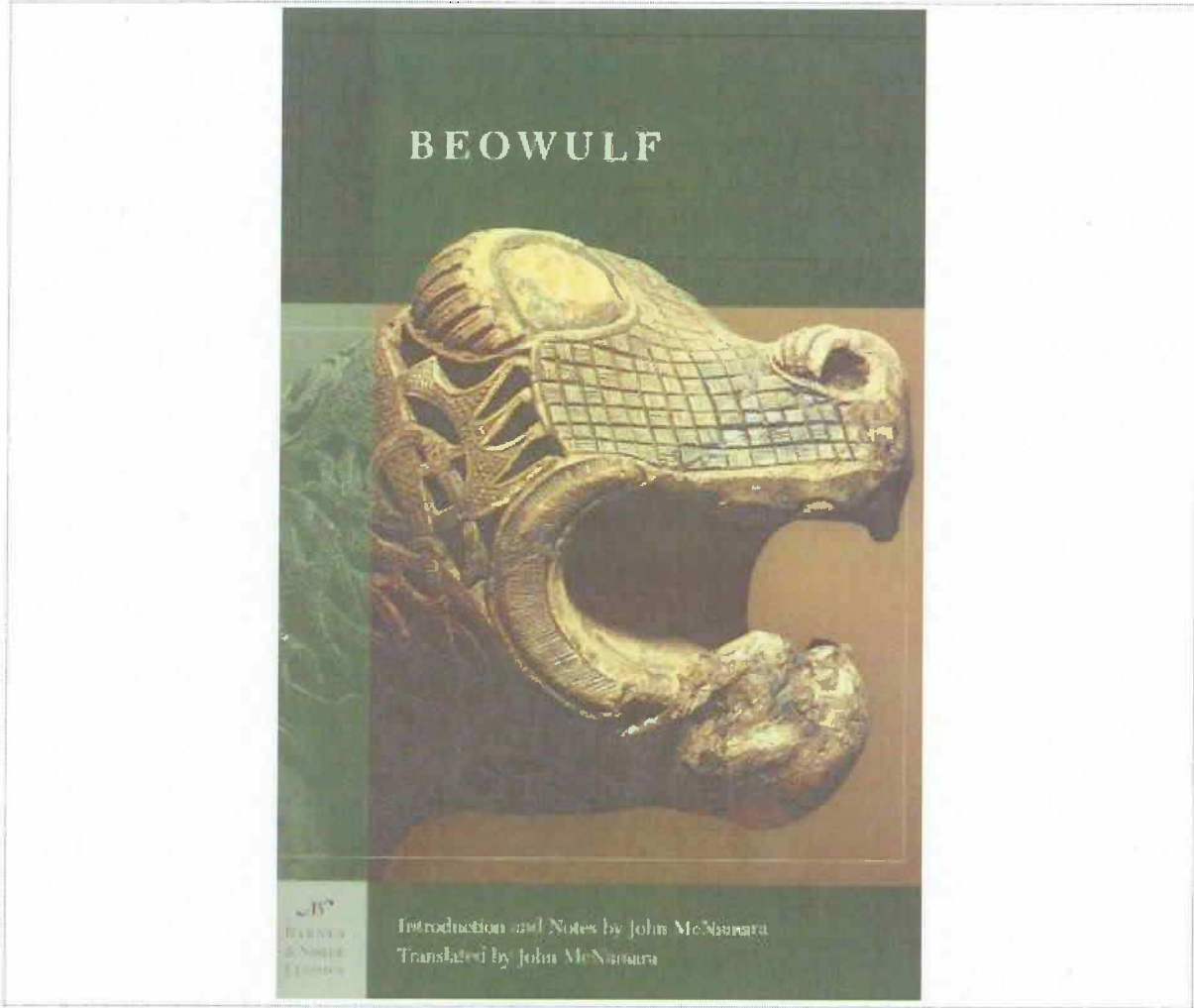
[Close Window](#)

## **EXHIBIT 3**

amazon.com

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Beowulf (Barnes & Noble Classics)



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