

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: September 26, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Skeeziks, LLC

Serial No. 78435362

Robert L. Powley of Powley & Gibson, P.C. for Skeeziks,
LLC.

Natalie Polzer, Trademark Examining Attorney, Law Office
108 (Andrew Lawrence, Managing Attorney).

Before Drost, Kuhlke and Cataldo, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Skeeziks, LLC, applicant, has filed an application to register as a trademark on the Principal Register the mark TICK, TICK...BOOM! in standard characters for "musical sound recordings; prerecorded audio and video cassettes, tapes and discs featuring performances of a musical play" in International Class 9; "printed publications, namely, songbooks; lyrics and music printed in sheet or book form; posters; greeting cards; and post cards" in International Class 16; "housewares, namely, mugs and glassware" in

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International Class 21; "clothing, namely, shirts and hats" in International Class 25; and "entertainment services in the nature of a theatrical performance of a musical play" in International Class 41.¹

The examining attorney finally refused registration under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, 1127, on the ground that applicant's designation TICK, TICK...BOOM!, as used on the specimens of record, does not function as a trademark for the goods and services in International Classes 9, 16, and 41, because it is the title of a single work, and for the goods in International Classes 21 and 25, because it is mere ornamentation.

Applicant appealed these refusals and filed a request for reconsideration. In response to the request for reconsideration, the examining attorney withdrew the refusals as to all of the goods in International Classes 21 and 25 and as to the "posters, greeting cards and post cards" in International Class 16. On March 4, 2008, the Board resumed the appeal and briefs were filed.

¹ Application Serial No. 78435362, filed June 15, 2004, alleging June, 2001 as the date of first use and first use in commerce for the goods in International Classes 9, 16, 21, and 25, and January, 1990 for the services in International Class 41.

In view of the examining attorney's decision on reconsideration, this appeal only pertains to the refusal based on the assertion that the proposed designation is the title of a single work as applied to the goods and services listed in International Classes 9 and 41 and the "printed publications, namely songbooks, lyric and music printed in sheet or book form" listed in International Class 16. Thus, regardless of the outcome regarding the specified goods and services at issue in this appeal, applicant's mark may be published for opposition for at least the remaining goods in the application. 37 C.F.R. §2.65(a).

It is well-established that a title of a single work is not registrable. In re Cooper, 254 F.2d 611 117 USPQ 396, 400 (CCPA 1958), cert. denied, 358 U.S. 840 (1958); In re Scholastic Inc., 223 USPQ 431 (TTAB 1984). This concept is equally applicable to musical recordings, printed publications and live theatrical productions. See In re Posthuma, 45 USPQ2d 2011 (TTAB 1998) and cases cited therein.

Applicant does not dispute this, rather applicant argues that its designation "is not the title of a single work and that the mark identifies a series of distinct creative works and therefore, properly serves as a trademark for applicant's goods and services." Br. p. 3.

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In support of its position that TICK, TICK...BOOM! is used on a series of creative works, applicant submitted copies of two copyright registrations. Applicant states that it has submitted the "copyright registrations in two substantial distinct plays with Applicant's mark as the title, not to demonstrate that it owns a valid trademark, but to show that there are two distinct creative works that have Applicant's mark as the title." Br. p. 6. Applicant argues that "since copyright law is applicable to the determination of whether works are both creative and distinctive, Applicant submits that its copyright registrations are probative and substantially demonstrate that Applicant has used its mark as the title of at least two distinct creative works." Br. pp. 6-7.

As stated by applicant, the "test for whether the title of a work may be registrable is whether the title has been used on a series of creative works." Copyright registrations are not evidence of use of the term in commerce, as defined by Section 45 of the Trademark Act. 15, U.S.C. §1127. Thus, there is nothing in the record to establish that applicant has used the designation TICK, TICK...BOOM! on a series for the goods and services at issue in this appeal. In that regard we note that, while Copyright Registration No. PA-1-295-639 (the derivative

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work) lists a creation date and publication date, Copyright Registration No. PAu-2-157-266 (the previous registration) only lists a creation date.

Finally, we are not convinced that the determination under copyright law that a work registered as a derivative work is the equivalent of a series for purposes of trademark registration. As the examining attorney stated, while the copyright registrations serve to "show the historical artistic progression of the one play TICK, TICK ...BOOM!" they do not demonstrate a series of different creative works. Br. p. 9. The claim in the first registration is for "a musical play" whereas the claim in the second registration is limited to "remaining music, song lyrics, script and dialog."

The examining attorney compared the evolution of the play as shown by the original copyright and the copyright based on a derivative work to the evolution of a theatrical production which was expressly rejected as evidence of a series of theatrical shows in *In re Posthuma*, supra. As stated by the examining attorney:

While the applicant's new material represented an original work of authorship sufficient to secure a second copyright registration in connection with the play Tick, Tick...Boom!, it does not demonstrate use of the title of the play on a series of distinct theatrical productions. Rather, the applicant's copyright registrations

point to the fact that the applicant's play has undergone adaptations as part of the creative process but remains a single musical play entitled Tick, Tick...Boom!" Br. p. 11.

Based on this record, we agree with the examining attorney that the second registration does not evince a series of plays but rather merely indicates "that some additional material was added to the original play as part of the overall creative process" of the one work and "[c]ontrary to the applicant's assertions that multiple copyrights show evidence of a series, the submitted copies of two copyright registrations merely show that the play entitled Tick, Tick,...Boom! was adapted in 2001." Br. p. 10.

Moreover, the definition of a derivative work under the Copyright Act supports the examining attorney's position that a derivative work is not a series for purposes of establishing source identifying significance in a proposed mark. A derivative work is defined as:

A work based upon one or more preexisting works, such as a translation, musical arrangement... abridgment...or any other for in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications, which, as a whole, represent an original work of authorship, is a "derivative work."

Copyright Act, 17 U.S.C. §101.

Citing to Section 1202.08(c) of the Trademark Manual of Examining Procedure, the examining attorney correctly notes that a "series is not established when only the format of the work is changed and use of the title on unabridged and abridged versions of the same work does not establish a series." Br. p. 10.

In view of the above, based upon consideration of all the evidence in the record, we find that applicant has failed to establish that the title TICK, TICK...BOOM! has been used on a series of creative works.

Decision: The refusal to register on the grounds that the proposed mark is the title of a single work is affirmed as to all of the goods and services in International Classes 9 and 41 and as to the goods identified as "printed publications, namely songbooks, lyric and music printed in sheet or book form" in International Class 16 and the application will proceed to publication as to the remaining goods.