

THIS OPINION IS NOT A  
PRECEDENT OF THE  
TTAB

Mailed:  
26 March 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

In re Cashflow Technologies, Inc.

---

Serial No. 78965495

---

David E. Rogers of Squire, Sanders & Dempsey L.L.P. for  
Cashflow Technologies, Inc.

Linda Lavache, Trademark Examining Attorney, Law Office 106  
(Mary I. Sparrow, Managing Attorney).

---

Before Grendel, Drost, and Mermelstein, Administrative  
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 31, 2006, Cashflow Technologies, Inc.  
(applicant) applied to register the mark CHOOSE TO BE RICH  
(in standard character form) on the Principal Register for  
goods ultimately identified as "Audio tapes featuring  
financial educational information in the field of financial  
education; video tapes and pre-recorded CDs and DVDs  
featuring financial educational information; downloadable

electronic publications, namely, pamphlets, brochures, newsletters, and books regarding financial education" in Class 9. Serial No. 78965495.<sup>1</sup> The application contains an allegation of a date of first use anywhere and in commerce of June 30, 2001 for the Class 9 goods.

The examining attorney has refused to register applicant's mark for the goods in Class 9 on two grounds. First, the examining attorney refused registration on the ground that the mark is a title of a single creative work and unregistrable under Sections 1, 2, and 45 of the Trademark Act. 15 U.S.C. §§ 1051, 1052, and 1127. The examining attorney also refused registration on the ground that applicant failed to provide a specimen depicting a mark that is a substantially exact representation of the mark in the drawing. 37 CFR § 2.51.

Title of a Single Creative Work

We will first consider whether applicant's mark is the title of single creative work. The Federal Circuit has held that "[t]his court's precedent also clearly holds that the title of a single book cannot serve as a source

---

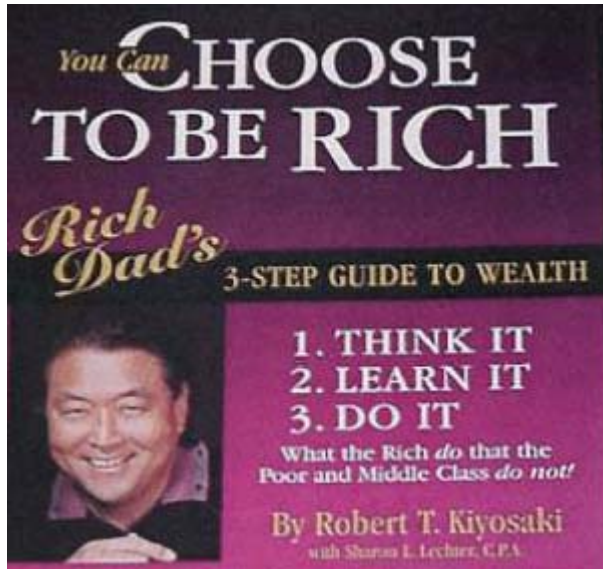
<sup>1</sup> The application also contains services in Classes 35, 36, and 41, but there are no refusals directed toward these classes. Therefore, regardless of the outcome of this appeal, the application will be forwarded to publication. The classes for services are based on applicant's allegation of a bona fide intent to use the mark in commerce.

identifier." *Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002). See also *In re Cooper*, 254 F.2d 611, 117 USPQ 396, 400 (CCPA 1958) ("As TEENY-BIG is no more than the name of a book, its only name, it is not a trademark under the statute Section 2"); TMEP § 1202.08 (5<sup>th</sup> ed. rev. September 2007) ("The title, or a portion of a title, of a single creative work must be refused registration under §§ 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127, unless the title has been used on a series of creative works. The title of a single creative work is not registrable on either the Principal or Supplemental Register").

In addition to books, the names of other creative works are similarly prohibited from registration on the Principal or Supplemental Registers. TMEP § 1202.08(a) ("Materials such as books, sound recordings, downloadable songs, downloadable ring tones, videocassettes, DVDs, audio CDs and films are usually single creative works"). See also *In re Innovative Companies LLC*, 88 USPQ2d 1095, 1102 (TTAB 2008) ("The FREEDOM STONE [building] cornerstone is similarly a single creative work, although as we pointed out there will be only one such cornerstone in existence"); *In re Posthuma*, 45 USPQ2d 2011, 2014 (TTAB 1998) ("We

conclude that PHANTASM, as the title of a single live theater production, is unregistrable because it does not function as a service mark"); *In re Appleby*, 159 USPQ 126, 126-27 (TTAB 1968) (Using the mark on a phonograph album in English and Spanish and a transcribed copy of the recorded materials still a title of a single work).

Therefore, the title of a single creative work does not function as a trademark. However, applicant argues that the "content on each of the respective tapes is clearly different (e.g., like different books rather than different chapters of the same book) and therefore, is acceptable to show use of the mark on a series of creative works." Brief at 2. The examining attorney responds by arguing that "the record includes evidence indicating that the item shown in the 08/31/2006 specimen is promoted as a single creative work whose title is YOU CAN CHOOSE TO BE RICH." Brief at unnumbered p. 9. The evidence shows that applicant is selling several cassette tapes as a single work.



Another specimen submitted with the application seems to show six tapes in a cassette notebook with some printed materials.



Applicant also submitted another specimen with its brief, which it says is "a clear version" of the photos it claimed to have submitted earlier, does not show that applicant is selling individual tapes.<sup>2</sup> Applicant's Brief at 2. As the examining attorney suggests, it seems to be a close up of the tapes shown in the binder in the original specimen. Brief at unnumbered p. 8 n.3.

Furthermore, the examining attorney has submitted evidence that shows that "You Can Choose to Be Rich: Rich Dad's 3-step Guide to Wealth (Rich Dad Book Series)" is identified as an "Audiobook." Denial of Request for Reconsideration, [www.amazon.com](http://www.amazon.com) attachment. In addition, the examining attorney submitted a printout that identifies numerous books that are available on tape and the number of tapes for each book:

Travels with Charley: In Search of America  
(Unabridged, 6 Cassettes, 8 Hrs.)

Pride and Prejudice (4 Cassettes)

Christmas Carol (Unabridged, 2 Cassettes, 3 hrs.)

The Adventures of Tom Sawyer (Unabridged, 6 cassettes,  
9 hrs.)

The Odyssey (Fagles translation) (Booklet & 9  
Cassettes)

---

<sup>2</sup> The examining attorney discusses this photograph and does not specific object to its submission on appeal. Therefore, we will consider this photograph.

**Ser. No. 78965495**

My Antonio (Unabridged, 7 cassettes, 585 minutes)

Ethan Frome (Unabridged, 3 Cassettes)

The Good Earth (Unabridged, 8 cassettes, 11 hours)

This evidence indicates that what appear to be titles of single works are often sold in cassette form with multiple cassettes for practical reasons.

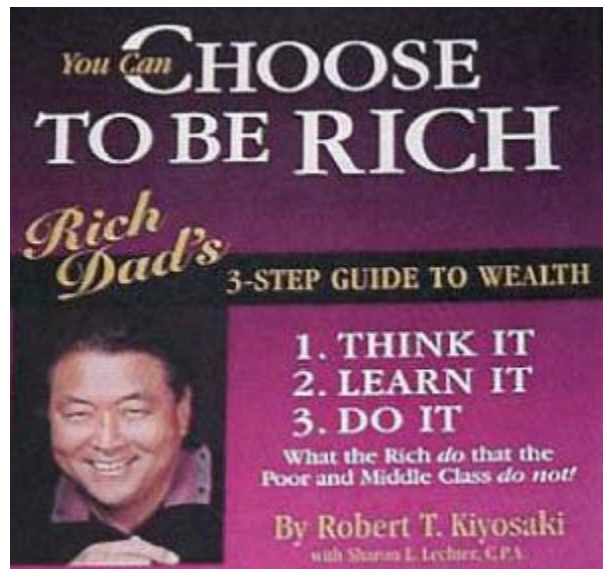
In this case, applicant has chosen to market its Class 9 goods as a single work. The fact that an applicant may have enough material to make more than one book, CD, or album is not determinative. An exceptionally long, detailed book on the American Civil War would not be a series simply because it required more than one CD to transform the printed work into electronic form. Similarly, the puzzles in *Herbko* or the album in *Appleby* could likely have been broken up into at least two smaller books or records. Here, applicant apparently could have sold its cassettes individually but it did not. Applicant instead sells its YOU CAN CHOOSE TO BE RICH cassettes as a single work as if the cassettes were chapters of a book. There is no evidence that indicates that there is a series of cassette tapes sold individually under applicant's mark. Indeed, applicant describes its materials as a "3-Step Guide to Wealth." This further suggests that applicant has

a single work that provides a step-by-step guide to wealth, and not a series of separately sold cassettes.

Therefore, we affirm the refusal to register on the ground that the mark is a title of a single creative work.

Substantially Exact Representation of the Mark

We next look at the examining attorney's requirement that applicant submit specimens that are a substantially exact representation of the mark in the drawing. "A drawing depicts the mark sought to be registered." 37 CFR § 2.52. In this case, applicant's drawing identifies the mark for which registration is sought as CHOOSE TO BE RICH. The specimen shows the mark with the words "YOU CAN" intersecting the "C" in Choose.



Other specimens clearly show the mark used as part of the sentence "You Can Choose to Be Rich." The examining attorney argues (Brief at 11):



The mark depicted in the specimen, YOU CAN CHOOSE TO BE RICH, includes additional non-generic wording that changes the commercial impression of the mark. Specifically, the applied-for mark shown in the drawing, CHOOSE TO BE RICH, is a command, whereas YOU CAN CHOOSE TO BE RICH is a statement that conveys the idea that the reader has the ability to be rich.

Applicant asserts that because the words CHOOSE TO BE RICH are shown in a different size and font than the YOU CAN wording on the cover of the packaging, the mark depicted on the specimen creates a separate commercial impression. While the words YOU CAN do appear in a different font and size than the remainder of the title, they also bisect the letter 'C' in Choose. Because the words YOU CAN are physically intertwined with the remainder of the title, consumers are likely to view the title of the goods as YOU CAN CHOOSE TO BE RICH, and not likely to perceive the applied-for mark, CHOOSE TO BE RICH, as being separate from the complete title.

In response, applicant maintains (Brief at 3) that the words CHOOSE TO BE RICH "creates a separate commercial impression ... since it is clearly more prominent and in different font than the small words 'You Can.'"

USPTO rules (37 CFR § 2.51(a)) require:

In an application under section 1(a) of the Act, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.

The TMEP § 807.12(d) (5<sup>th</sup> ed. rev. September 2007) (citations omitted) sets out the standard for determining whether an applicant is permitted to register less than the entire mark shown on the specimen.

In an application under §1 of the Trademark Act, the mark on the drawing must be a complete mark, as

evidenced by the specimen. When the representation on a drawing does not constitute a complete mark, it is sometimes referred to as "mutilation." This term indicates that essential and integral subject matter is missing from the drawing. An incomplete mark may not be registered.

However, in a §1 application, an applicant has some latitude in selecting the mark it wants to register. The mere fact that two or more elements form a composite mark does not necessarily mean that those elements are inseparable for registration purposes. An applicant may apply to register any element of a composite mark if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen.

The determinative factor is whether or not the subject matter in question makes a separate and distinct commercial impression apart from the other element(s).

The question of whether a mark is a mutilation "boils down to a judgment as to whether that designation for which registration is sought comprises a separate and distinct 'trademark' in and of itself." *Institut National des Appellations D'Origine v. Vintners International Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992). The Federal Circuit held, when an applicant sought to register the medicine dropper and droplet from the design below, that the mark was a mutilation. *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828, 1830 (Fed. Cir. 1988).



The "'eye-dropper intersects with the handle of the watering can and the drop of water [sic] is shown going into the watering can.' The three elements of the background -- the dropper, the droplet, and the watering can -- are interrelated elements of a single unified design. We agree with the Board that these elements constitute 'a unitary mark which creates a single commercial impression and that to try to separate out the eyedropper portion of the mark results in an impermissible mutilation.'" *Id.*

In another case, the board held that even the omission of a degree symbol can result in the mark in the drawing not being a substantially exact representation of the mark shown on the specimen. *In re Yale Sportswear Corp.*, 88 USPQ2d 1121, 1123 (TTAB 2008) ("Upper 90" not a

substantially exact representation of the mark "Upper 90°" on the specimen).

In this case, the words, "You can" are intertwined with the letter "C" in CHOOSE TO BE RICH. Indeed, the letter "C" in "Can" forms part of the letter "C" in Choose. The word "You" precedes the word "Can" and "Choose" as it would in an English sentence.



These features support the argument that the mark would be viewed as YOU CAN CHOOSE TO BE RICH. We add that the evidence shows that this phrase is used in advertising for the goods. See [www.amazon.com](http://www.amazon.com) (You Can Choose to Be Rich: Rich Dad's 3-step Guide to Wealth) and [www.richdad.com](http://www.richdad.com) ("Think It" "Learn It" "Do It" - You Can Choose to Be Rich - CD/DVD).

In another recent case, the board concluded that the mark "irestmymcase" failed to function as a mark when the specimen showed the mark as "restmymcase."

Applicant's drawing page unambiguously displays her applied-for mark as irestmymcase. Both the original specimen filed with the application and "restmymcase" as it appears as applicant's user name on her Internet message board fail to display that designation, if for no other reason than they fail to include all of the letters comprising applicant's proposed mark. In addition, "I Rest My Case" as it appears on applicant's message board, while containing all of the letters comprising applicant's proposed mark,

disagrees with irestmymcase as it appears on applicant's drawing page. Thus, we find that such uses fail to show use of irestmymcase as a mark or otherwise.

See also *In re Larios S.A.*, 35 USPQ2d 1214, 1217 (TTAB 1995) ("[W]hen the respective marks are considered in their entireties, the mark 'GRAN VINO MALAGA LARIOS' and design shown on the initial drawing is not a substantially exact representation of the mark 'VINO DE MALAGA LARIOS' and design illustrated in the foreign registration").<sup>3</sup>

Here, the meaning of the two sentences CHOOSE TO BE RICH and YOU CAN CHOOSE TO BE RICH are not necessarily the same. The first can be view as a command while the second is more of an encouragement or "a statement that conveys the idea that the reader has the ability to be rich." Examining Attorney's Brief at 11. We conclude that the mark sought to be registered does not create a separate and distinct commercial impression from the other material on the specimen. Therefore, applicant's mark is not a substantially exact representation of the mark shown on the specimen.

Decision: The refusals to register on the grounds that the term CHOOSE TO BE RICH is a title of a single

---

<sup>3</sup> The board subsequently held that the "amendment of the drawing is permissible inasmuch as the mark 'VINO DE MALAGA LARIOS' and design is not a material alteration of the mark 'GRAN VINO MALAGA LARIOS' and design." *Larios*, 35 USPQ2d at 1218.

**Ser. No. 78965495**

creative work and that the mark on the specimen is not a substantially exact representation of the mark in the drawing are affirmed as to the goods in Class 9. The application will proceed to publication as to the services in Classes 35, 36, and 41.