

This Opinion is not a  
Precedent of the TTAB

Mailed: September 10, 2019

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

*In re Rothman*

Serial No. 85945757

Scott J. Major of Millen, White, Zelano & Branigan, P.C.,  
for Judith Rothman

Amy E. Thomas, Trademark Examining Attorney, Law Office 110,  
Chris A.F. Pedersen, Managing Attorney.

Before Mermelstein, Heasley and English,  
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Judith Rothman (“Applicant”) seeks registration on the Principal Register of the proposed mark THE NEUROTIC PARENT’S GUIDE (in standard characters, with GUIDE disclaimed) for “Publications, namely, books on the subjects of colleges and college admissions” in International Class 16.<sup>1</sup>

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<sup>1</sup> Application Serial No. 85945757 was filed on May 29, 2013, based on Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

The Trademark Examining Attorney has refused registration of Applicant's proposed mark under Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051-1052, 1127, on the ground that it fails to function as a trademark, as it is merely the title of a single creative work.

### I. Procedural History

Applicant originally sought registration of the proposed mark THE NEUROTIC PARENT for "Publications, including books on the subjects of colleges and college admissions." In her first Office Action, the Examining Attorney advised Applicant that upon consideration of an allegation of use, registration might be refused on the ground that the applied-for mark, as used on the specimen of record, is the title of a single creative work, namely, the title of a book, and as such would not function as a trademark to indicate the source of Applicant's goods and distinguish them from others'. She further advised Applicant, however, that the name for a series of creative works may function as a registrable trademark, indicating that each work in the series comes from the same source as the others.<sup>2</sup>

In response, Applicant's counsel stated that Applicant:

has used the mark and title THE NEUROTIC PARENT in connection with a blog (see attachment) published online since March 2008. In this regard, the Applicant owns U.S. Reg. No. 4096671 for the same mark for blogging services. Since March 2008, there have been hundreds of new entries posted for the blog.<sup>3</sup>

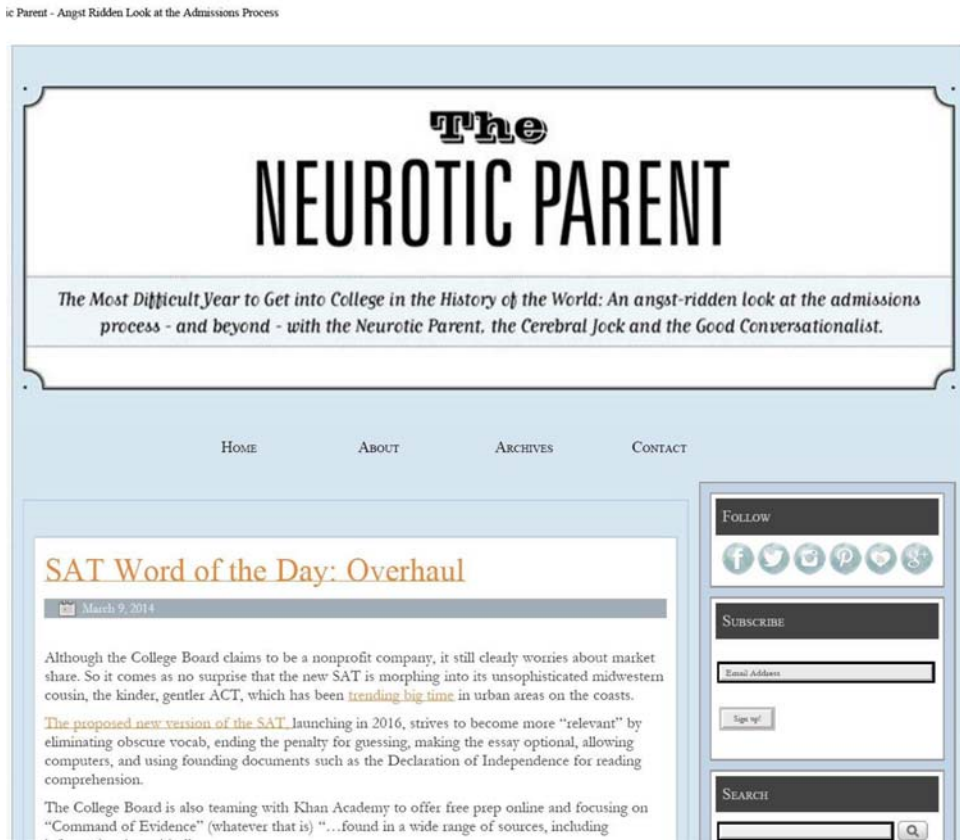
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Page references to the application record are to the downloadable .pdf version of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs, motions and orders on appeal are to the Board's TTABVUE docket system.

<sup>2</sup> Sept. 16, 2014 Office Action at 2.

<sup>3</sup> March 12, 2014 Response to Office Action at 1.

Applicant’s Principal Register registration for THE NEUROTIC PARENT is for “An online journal, namely, a blog featuring information on colleges and college admissions.”<sup>4</sup> Applicant submitted five entries from her blog. For example:



<sup>4</sup> Reg. No. 4096671, issued on Feb. 7, 2012, Section 8 and 15 declarations accepted and acknowledged.

informational graphics

Here is a graphic used on the SAT site to illustrate that the new exam will have “problems grounded in a real-world context,” with “passages...paired with informational graphics.” If spiky Europe is an indication of what is to come, these new graphics should be a blast to interpret.



Sadly, this could be too little too late. These changes will cause even more kids to gravitate to the tried and true ACT, which rarely changes, and will not leaving the SAT tutors scrambling to update their flashcards.

The Neurotic Parent Institute has just released findings of a study showing that if the SAT really wants to re-engage test-takers, it will have to alter its exam by truly making it more relevant in the following ways:

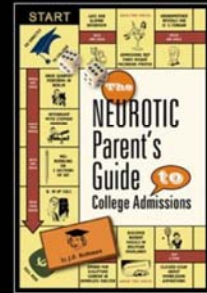
- Change the start time to 1pm, the hour that most teenagers wake up
- Offer free Red Bull and Frappuccinos – granola bars are so 20th century
- Grant extended time for anyone with anxiety caused by parental helicoptering, overscheduling or Instagram inferiority issues
- Allow unlimited texting and Googling during the exam – essential research skills for college students
- Incorporate advanced hashtag usage into the #grammarandpunctuation section.
- Bring back the iconic analogies, the only fun part of the exam – These were deemed culturally biased because of the notorious [regatta oarsman](#) comparison, but most college hopefuls now know all about crew, thanks to the [Winklevosses](#).
- Employ angel investors as proctors – If you can pitch them a good idea, you get to skip college altogether and go straight to running your own start-up.

So sharpen your #2s, ninth graders. Here's to relevance in test taking.

ABOUT



## All About the Book!



ALSO ON

## Report from Readers: College Tour '14 and Beyond

February 20, 2014

Q: What's the latest buzz from the college tours?

A: (from SFD – Smart, funny dad, a reader on the road) **“During a tour of a top Midwestern University we passed the undergrad business building. The guide remarked that a Personal Finance Class was very popular among Seniors – ‘because it helps you plan your retirement.’”**

The reader's FB friends could not see what was so terrible about planning for retirement while still a teen. SFD's response to his friends: “I see college as a time to forge identity, dream, try on values and attitudes and there seems to be so little of that now. It's all bottom line and branding. I guess what I have more trouble with is that this was highlighted on the tour as a ploy to hook in parents....I guess I also think that there's plenty of time to think about retirement once you've started to actually work full time.”

The pressure is on. Now it's not enough to angst about that (prestigious) first job before even starting college, but also *retirement*. Yikes.

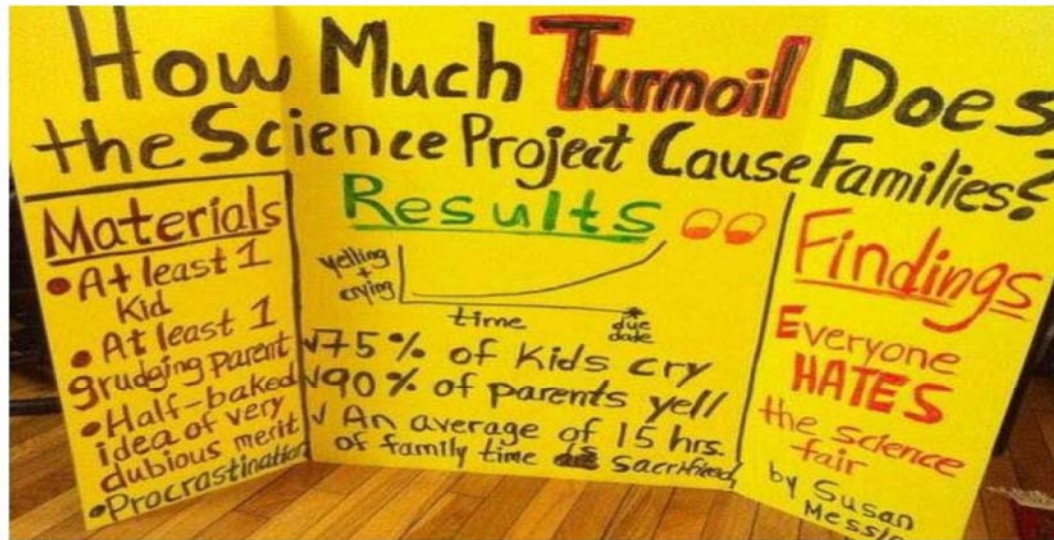
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Q: What is the hot school this year?

A: (according to a financial aid expert) U of Virginia. Their mission is to expand their out-of-state contingency, but that expansion has so far yielded mostly rejections.

Q: Any memes you care to share? Maybe one that shows why growing up is not such a bad thing, why all this college insanity is still better than middle school:

A:



Q: What's the next must-have product for helicopter parents?

A: The teen version of this near-implant baby monitor:

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“Accordingly,” Applicant submitted, “a refusal on the ground that the mark identifies the title of a single creative work cannot be sustained.”<sup>6</sup> Applicant also amended her identification of goods to “Publications, namely, publications on the subjects of colleges and college admissions.”

The Examining Attorney issued a final Office Action stating that Applicant was required to amend the identification of goods to specify the type of publication that would bear the applied-for mark. She also repeated her advice that the title of a single

<sup>5</sup> TheNeuroticParent.com, 3/12/2014, March 12, 2014 Response to Office Action at 5-11.

<sup>6</sup> March 12, 2014 Response to Office Action at 1.

book or similar publication would not function as a trademark, stating that “[t]he 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. An applicant must submit evidence that the title is used on at least two different creative works. ... **A series is not established when only the format of the work is changed...**”<sup>7</sup>

In response, Applicant amended her identification of goods to its present form, “Publications, namely, books on the subjects of colleges and college admissions,” and requested reconsideration of the final Office Action.<sup>8</sup> With that amendment, her Application to register THE NEUROTIC PARENT was published in the Official Gazette. It encountered no opposition, and a Notice of Allowance issued. After requesting and obtaining five extensions of time, Applicant filed a Statement of Use supported by the following specimen:



<sup>7</sup> April 1, 2014 Office Action at 2.

<sup>8</sup> April 3, 2014 Response to Office Action/Request for Reconsideration.

<sup>9</sup> Statement of Use and Specimen, July 31, 2017.

The Examining Attorney then refused registration on two grounds. First, she noted, the mark in the drawing did not match the mark depicted on the specimen of use: “Specifically, the specimen displays the mark as THE NEUROTIC PARENT’S GUIDE; however, the drawing displays the mark as THE NEUROTIC PARENT.”<sup>10</sup> Second, she maintained, “the applied-for mark, as used on the specimen of record, is used only as the title of a single creative work, namely, the title of a specific book....” “There is no evidence in the application record that applicant’s book is part of a series of works.... Therefore, consumers would view the applied-for mark as the title of a single work, rather than as a trademark to indicate the source of applicant’s goods and to distinguish applicant’s goods from others.”<sup>11</sup>

In response to the first ground for refusal, Applicant amended the proposed mark to THE NEUROTIC PARENT’S GUIDE to conform to the specimen, and submitted that the amendment was not material.<sup>12</sup> In response to the second ground for refusal, Applicant’s counsel maintained:

Regarding the title of a single work refusal, the Applicant has used the mark THE NEUROTIC PARENT in connection with a successful blog on the college admissions process since 2008, and is the owner of US Reg. No. 4096671 for the mark for such services. A blog is a creative work in a different medium. Accordingly, the mark is not used merely as the title of a single creative work.<sup>13</sup>

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<sup>10</sup> Aug. 25, 2017 Office Action at 2.

<sup>11</sup> *Id.*

<sup>12</sup> Feb. 26, 2018 Response to Office Action at 2.

<sup>13</sup> *Id.*

In view of the amendment to THE NEUROTIC PARENT'S GUIDE, the Examining Attorney withdrew her refusal based on the proposed mark not matching its depiction in the specimen of use, although she required a disclaimer of GUIDE as merely descriptive of the goods.<sup>14</sup>

However, the Examining Attorney maintained her refusal based on the proposed mark being the title of a single creative work, namely, the title of a book. The Examining Attorney noted that "The applicant argued that THE NEUROTIC PARENT has been used in connection with a successful blog regarding the college admissions process. The applicant notes a blog is a creative work in a different medium."<sup>15</sup> She cited the TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) for the proposition that "**[a] series is not established when only the format of the work is changed, that is, the same title used on a printed version of a book and a recorded version does not establish a series.**" TMPEP § 1202.08(c). She concluded that "Applicant may overcome this refusal by submitting evidence that the applied-for mark is used to identify a series of creative works. Note the series of creative works must be in the same medium."<sup>16</sup>

In response to this Office Action, Applicant disclaimed GUIDE, but emphasized that:

Since March 2008, there have been hundreds of new entries posted for the blog. Each such entry, as well as the blog in its entirety, constitutes a creative work. The Applicant's book is yet another work, offered under a

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<sup>14</sup> March 20, 2018 Office Action at 2.

<sup>15</sup> *Id.* at 2-3.

<sup>16</sup> *Id.* at 3.



slightly different (but not materially so) mark and title, in this ongoing series. The book relates to the blog but also includes additional creative content; as such, it is not merely the same work transferred to another medium.<sup>17</sup>

The Examining Attorney asserts that the series of works “must be in the same medium”. The Applicant respectfully submits that there is no support for this assertion. The focus should be on whether there is variation in the content, not on the medium/media in which the content is offered.<sup>18</sup>

In the alternative, Applicant submitted that her book title would be recognized as a mark by virtue of her longstanding use of essentially the same mark in connection with her blog. In this regard, she analogized to a “secondary source” claim, where a proposed mark used in a decorative or ornamental manner on a product also serves a source-indicating function for that product through its non-ornamental, trademark use with other goods or services.<sup>19</sup>

The Examining Attorney accepted the disclaimer of GUIDE, but made final the refusal that the proposed mark THE NEUROTIC PARENT’S GUIDE was the title of a single creative work, which would fail to function as a trademark. “Single creative works include works in which the featured content does not change significantly, whether that work is in printed, recorded, or electronic form,” she stated.<sup>20</sup> She acknowledged that “A book with a second or subsequent edition in which the content changes significantly is not regarded as a single creative work,” but was not persuaded by Applicant’s argument that the creative works could be in different

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<sup>17</sup> March 29, 2018 Response to Office Action at 1.

<sup>18</sup> *Id.*

<sup>19</sup> *Id.*

<sup>20</sup> April 17, 2018 Office Action at 2.

media.<sup>21</sup> Finally, the Examining Attorney stated, “To the extent Applicant is raising a ‘secondary source’ argument or positing that the single book THE NEUROTIC PARENT’S GUIDE has acquired distinctiveness for its identified goods based on [a] blog, neither princip[le] applies here,” as the title of a single creative work simply fails to function as a source indicator, and is not registrable on either the Principal or Supplemental Register.<sup>22</sup>

When the refusal was made final, Applicant appealed and requested reconsideration.<sup>23</sup> After the Examining Attorney denied the request for reconsideration,<sup>24</sup> the appeal was resumed. The appeal is fully briefed.

## II. Analysis

### A. Applicable Law

The title of a single creative work, such as a book, is not considered a trademark, and is therefore unregistrable. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§ 1051, 1052, and 1127. *In re Cooper*, 254 F.2d 611, 117 USPQ 396, 400 (CCPA 1958). Although *Cooper* is often cited as the seminal decision on this point, it states that the principle has “long been settled,” *id.* at 398, and hearkens back to still older cases enunciating this principle. *See, e.g., In re Page Co.*, 47 App. D.C. 195 (D.C. Cir. 1917); *see also Black v. Ehrich*, 44 F. 793, 794 (C.C.S.D.N.Y. 1891) (ENCYCLOPEDIA BRITANNICA name not protected by trademark; “Neither the author nor proprietor of

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<sup>21</sup> *Id.*

<sup>22</sup> *Id.*

<sup>23</sup> 4 TTABVUE.

<sup>24</sup> 5 TTABVUE.

a literary work has any property in its name.”). In the six decades following *Cooper*, that principle has remained unchanged. The Federal Circuit Court of Appeals has confirmed, “this court’s case law prohibits proprietary rights for single book titles.” *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002). And the Board has followed suit. *E.g.*, *In re Arnold*, 105 USPQ2d 1953, 1954 (TTAB 2013) (“It is well settled that the title of a single creative work is not considered a trademark and is, therefore, unregistrable....”); *Mattel, Inc. v. Brainy Baby Co., LLC*, 101 USPQ2d 1140, 1144 (TTAB 2011) (“The case law is clear that parties cannot gain trademark rights in titles of [individual] works....”); *In re Hal Leonard Publ’g Corp.*, 15 USPQ2d 1574 (TTAB 1990) (INSTANT KEYBOARD unregistrable as the title of single book featuring musical keyboard instruction). *See generally* TMEP § 1202.08 (Oct. 2018) (“The title of a single creative work is not registrable on either the Principal or Supplemental Register.”).

The *Cooper* Court explained the rationale for this refusal by analogizing the name of a book to the name of a generic category of goods:

The purchaser of a book is not asking for a “kind” or “make” of book. He is pointing out which one of millions of distinct titles he wants, designating the book by its name. It is just as though one walked into a grocery and said “I want some kind of food” and in response to the question “What kind of food?” said, “A can of chicken noodle soup.”

*Cooper*, 117 USPQ at 400.

Although this analogy appears to involve polar opposites—on the one hand, the proper name of a particular good (the title of a book), and on the other hand, the generic name of a category of goods (a kind of food) they have one thing in common:

neither is registrable because neither functions as a trademark. Generic terms are “the common descriptive name of a class of goods or services.” *Royal Crown Co., Inc. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1045 (Fed. Cir. 2018). An applicant cannot register a generic term as his trademark, even if he created the product and gave it its generic name, because that is the only name by which it is known to the public, and that is the name his competitors may use to identify their goods. *See In re Pennington Seed, Inc.*, 466 F.3d 1053, 80 USPQ2d 1758 (Fed. Cir. 2006) (holding that applicant who developed and named new grass seed varietal could not register that name because it was generic) (citing with approval *Dixie Rose Nursery v. Coe*, 131 F.2d 446, 55 USPQ 315, 316-17 (D.C. Cir. 1942) (generic name given to a patented variety of rose could not be registered as a trademark because “It would tend to prolong appellant’s monopoly, beyond the life of appellant’s patent, by making it difficult for a newcomer to break into the field.”)).

Similarly, as the *Cooper* Court explained, even though an author/applicant creates the title of his literary work, that is the only name by which the literary work is known to the public. “How else would you describe it — what else would you call it?” *Cooper*, 117 USPQ at 400:

There is a compelling reason why the name or title of a book of the literary sort cannot be a trademark. The protection accorded the property right in a trademark is not limited in time and endures for as long as the trademark is used. A book, once published, is protected against copying only if it is the subject of a valid copyright registration and then only until the registration expires, so eventually all books fall into the public domain. The right to copy which the law contemplates includes the right to call the copy by the only name it has and the title cannot be withheld on any theory of trademark right therein. As was aptly said in *In re Page Company*, 47 App.

D.C. 195, when copyright in a protected work expires, “the use of the descriptive name becomes publici juris.”

The Federal Circuit reaffirmed *Cooper’s* reasoning, declaring that “this court’s precedent has treated all single works, such as single book titles, as ‘inherently descriptive’ at best and ‘inherently generic’ at worst.” *Herbko v. Kappa Books*, 64 USPQ2d at 1379:

Even where a title bears little or no relation to the book contents, however, another reason forecloses trademark rights in the title to a single book, at least beyond expiration of the book’s copyright. That reason results from the interplay between copyright and trademark law. Specifically, while trademarks endure as long as the mark is used, copyrights eventually expire. Upon expiration of the copyright, others have the right to reproduce the literary work and to use the title to identify the work. ... For example, once the copyright to *Gone with the Wind* expires, a variety of publishers may wish to market copies of the work. A trademark in the title to this single book would compromise the policy of unrestricted use after expiration of the copyright because a book with a trademarked title, of course, could be published only under a different title. *Gone with the Wind* would perhaps become *That Book About Scarlett O’Hara and Rhett Butler* or *My Life with Tara*, 1864. The policy against proprietary rights in the titles to single books therefore finds additional support in the interface with copyright law.

*Id.* (citing 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 10:4; and J.L. Vana, *Single Work Titles and Group Artist or Author Names: Registrability Revisited*, 88 Trademark Rep. 250 (1998)).

The Board has consistently followed these principles. *E.g.*, *In re Innovative Cos., LLC*, 88 USPQ2d 1095, 1100 (TTAB 2008) (quoting *Herbko*); *Mattel v. Brainy Baby*, 101 USPQ2d at 1144 (“The policy for this is clear. Because a trademark can endure for as long as the trademark is used, at the point that copyright protection ends and

others have the right to use the underlying work, they must also have the right to call it by its name.”); *see generally* TMEP § 1202.08.

Even though the title of a single work is unregistrable, the name for a **series** of works is registrable because it functions as a trademark. “The name for a series, at least while it is still being published, has a trademark function in indicating that each book of the series comes from the same source as the others.” *Cooper*, 117 USPQ at 400, *quoted in In re Scholastic Inc.*, 23 USPQ2d 1774, 1776-77 (TTAB 1992) (*Scholastic II*) (holding that “THE MAGIC SCHOOL BUS, as used on books, would be recognized as a trademark identifying a series of children’s books emanating from applicant.”); Brooke J. Egan, Lanham Act Protection for Artistic Expression: Literary Titles and the Pursuit of Secondary Meaning, 75 Tul. L. Rev. 1777, 1791–92 (2001) (“The Magic School Bus’ had acquired meaning to the consuming public as a source of children’s books and not as an individual book title; thus, [the Board] awarded trademark status to ‘The Magic School Bus.’”). That is why titles of popular series such as ENCYCLOPEDIA BROWN,<sup>25</sup> HARDY BOYS ADVENTURES,<sup>26</sup> and NANCY DREW<sup>27</sup> are registrable. Applicant relies on this “series” exception, and on acquired distinctiveness.

#### B. Arguments of Applicant and the Examining Attorney

Applicant argues that she has established a series, first through her online blog

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<sup>25</sup> Reg. No. 4623713.

<sup>26</sup> Reg. No. 4530214.

<sup>27</sup> Reg. No. 1125972.

entitled THE NEUROTIC PARENT, and second through her book titled THE NEUROTIC PARENT'S GUIDE. Applicant argues:

The shift in medium – that is, from electronic to print – did not sever the connection between the blog and the book; the book joined the many blog entries as part of a series of works on the same general topics.

Moreover, the TMEP provides that a “title of a single work” refusal may be overcome with the submission of “evidence that the title is used on at least two different **creative works**.” TMEP Section 1202.08(c) (emphasis supplied). There is no requirement specified in this subsection that the works at issue be in the same medium.

In this regard, the Applicant asks the Board to take judicial notice of the definition of “work” from the online version of the Merriam-Webster’s Dictionary as “[s]omething produced by the exercise of creative talent or expenditure of creative effort: artistic production” (definition at Exhibit A). Significantly, this definition does specify or require a particular medium.<sup>28</sup>

In the alternative, Applicant argues, “although it should not be necessary to rely upon a claim of acquired distinctiveness in this instance, the Applicant is willing to accept registration on the Principal Register under Section 2(f) based upon its use of the mark in commerce for books for more than five years.”<sup>29</sup> Applicant asserts that “the title is recognized as a mark by virtue of the longstanding use of essentially the same mark in connection with a blog and the Applicant’s ownership of Reg. No. 4096671 [for THE NEUROTIC PARENT].”<sup>30</sup> She alludes to a nonprecedential Board decision, *In re King Prods., Inc.*, 2014 WL 7172033 (TTAB 2014), which, following the language in *Cooper*, based the refusal to register the title of a single creative work on

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<sup>28</sup> Applicant’s brief, 9 TTABVUE 3, 10, citing Merriam-Webster.com 2/13/2019.

<sup>29</sup> Applicant’s brief, 9 TTABVUE 4.

<sup>30</sup> Applicant’s reply brief, 12 TTABVUE 5.

Section 2(e)(1), which left open the possibility that the refusal could be overcome by a showing of acquired distinctiveness under Section 2(f), even though the applicant in that case failed to prove acquired distinctiveness.<sup>31</sup> She also repeats her analogy to a “secondary source” claim. *See* TMEP § 1202.03(c) (“To show that a proposed mark that is used on the goods in a decorative or ornamental manner also serves a source-indicating function, the applicant may submit evidence that the proposed mark would be recognized as a mark through its use with goods or services other than those being refused as ornamental. To show secondary source, the applicant may show: (1) ownership of a U.S. registration on the Principal Register of the same mark for other goods or services based on use in commerce under § 1 of the Trademark Act....”).

The Examining Attorney responds that Applicant has not established a series:

the proposed mark THE NEUROTIC PARENT’S GUIDE acts to identify a single printed book. Indeed, the applicant has admitted this fact in its appeal brief by stating “The Applicant has not yet published a second book under the mark.”<sup>32</sup>

The applicant’s argument that the printed book of the proposed mark is a part of a series of creative works in which the other work is comprised of an online blog is not persuasive. There is no evidence of record that the applicant’s printed book would be associated as a source identifier along with another creative work that is not a book and is only available on the Internet. The applicant provided no evidence that potential purchasers of printed books would even be aware there was an online blog. Additionally, there is no evidence of record that the single book references the online blog in any way or that it is marketed as part of a series which includes the online blog.<sup>33</sup>

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<sup>31</sup> Applicant’s brief, 9 TTABVUE 4-5.

<sup>32</sup> Examining Attorney’s brief, 11 TTABVUE 3-4.

<sup>33</sup> Examining Attorney’s brief, 11 TTABVUE 4.



With respect to whether the works must be in the same medium, the Examining Attorney points to the USPTO web page tutorial providing in pertinent part that **“Evidence of a series includes copies of at least two different book covers....”**<sup>34</sup> For example, in *In re Polar Music Int’l AB*, 714 F.2d 1567, 221 USPQ 315 (Fed. Cir. 1983), the Examining Attorney notes, the Federal Circuit found that because the musical group ABBA’s name “had been used numerous times on different records and has therefore come to represent an assurance of quality to the public, the name may be registered as a trademark since it functions as one.” *Id.* at 318. “This is not the case with the instant application,” the Examining Attorney contends:

The applicant’s mark has not been used numerous times on different books. There is no evidence of record that the single book and the online blog function as “one.” Rather, the proposed mark THE NEUROTIC PARENT’S GUIDE is used once, as the title of a single printed book. The proposed mark has not been shown to represent an assurance of quality of different creative works to the public. Based on the evidentiary record, the applicant’s single printed book does not function as a trademark by showing that the book of the purported series comes from the same source as the online blog.<sup>35</sup>

Furthermore, the Examining Attorney observes, “A series is not established when only the format of the work is changed, that is, the same title used on a printed version of a book and a recorded version does not establish a series.” (citing *Mattel v. Brainy Baby*, 101 USPQ2d at 1143 (finding that a program recorded on both a VHS tape and a DVD were the same creative work, and that the addition of minor

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<sup>34</sup> Examining Attorney’s brief, 11 TTABVUE 5 (emphasis added by Examining Attorney).

<sup>35</sup> Examining Attorney’s brief, 11 TTABVUE 4.

enhancements in the DVD did not transform this single work into a series)).<sup>36</sup> “The applicant merely made a conclusory statement that ‘the book includes some past blog entries in whole or in part,’ and it ‘features additional creative content that had not previously been published.’”<sup>37</sup>

As for Applicant’s claim of acquired distinctiveness, the Examining Attorney responds that Section 2(f) does not apply to the title of a single creative work. The applied-for mark was not refused based on being merely descriptive or ornamental; it simply fails to function as a trademark. The Board decision on which Applicant relies, *In re King Productions*, is nonprecedential, she points out, whereas Federal Circuit precedent, *Herbko v. Kappa Books*, 64 USPQ2d at 1378, establishes that a single title is not registrable on either the Principal or Supplemental Register, so it cannot acquire distinctiveness.<sup>38</sup>

### C. Discussion

We find Applicant’s acquired distinctiveness argument unavailing under prevailing precedent. Although *Cooper* stated that titles of creative works are descriptive under Section 2(e)(1), which implies that they could acquire distinctiveness under Section 2(f), that is not the case. As the Federal Circuit

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<sup>36</sup> Examining Attorney’s brief, 11 TTABVUE 3.

<sup>37</sup> Examining Attorney’s brief, 11 TTABVUE 4.

<sup>38</sup> Examining Attorney’s brief, 11 TTABVUE 2, 5-6. Concerning Applicant’s “secondary source” argument, the Examining Attorney states inter alia that the proposed mark was not refused for being ornamental. *Id.* at 5. As Applicant points out, though, this argument was an analogy, illustrating her point that the book title contains content that could be perceived as source-indicating. Applicant’s reply brief, 12 TTABVUE 5. Our discussion of acquired distinctiveness comprehends this analogy.

observed in *Herbko*, *Cooper* treated titles of single works as the ultimate in descriptiveness, “as ‘inherently descriptive’ at best and ‘inherently generic’ at worst.” *Herbko v. Kappa Books*, 64 USPQ2d at 1379. Consequently, they fail to function as source identifiers:

This court’s precedent also clearly holds that the title of a single book cannot serve as a source identifier. *In re Cooper*, 254 F.2d 611, 117 USPQ 396, 399-400 (CCPA 1958) (titles of single books cannot be registered as a trademark); *see also* Trademark Manual of Examining Procedure § 1202.08 (3rd ed. June 2002) (“The title of a single creative work is not registrable on the Principal Register or the Supplemental Register.”).

...

In sum, this court’s case law prohibits proprietary rights for single book titles.

*Herbko v. Kappa Books*, 64 USPQ2d at 1378, 1380 (citations revised).

The title of a single work is thus unregistrable even if an applicant submits proof of acquired distinctiveness. 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 10:4 (5th ed. June 2019 update) (“The Patent and Trademark Office reads the 1958 *Cooper* decision as meaning that the title of a single work is not just “descriptive,” but “generic,” and not protectable or registerable even upon proof of acquisition of secondary meaning.”). “The use of the same mark on other non-creative matter ... does not overcome the refusal. ... 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.” TMEP § 1202.08.<sup>39</sup>

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<sup>39</sup> Titles of single works are, however, protectable in court under Section 43(a) of the Trademark Act upon a showing of secondary meaning. *Cooper*, 117 USPQ at 401; *Herbko v. Kappa Books*, 64 USPQ2d at 1378 n.2; GILSON ON TRADEMARKS § 2.03 (2019) (“Titles of single creative works have long been protectable under Section 43(a) if the titles had secondary

If, on the other hand, a title **has** been used on a series of creative works, then additional evidence of distinctiveness may help show that the reading public would recognize the series title as a trademark. *See Scholastic II*, 23 USPQ2d at 1777, 1779 (use of series title on tags and stickers, and in advertisements corroborates its commercial impression as a trademark). But the sine qua non of registrability is use of the mark on a series of works.

Although Applicant’s blog and book appear in different media, their passage from the screen to the printed page does not prevent them from being perceived together as a series. As Applicant has requested, we take judicial notice that a “work” is “[s]omething produced by the exercise of creative talent or expenditure of creative effort: artistic production.”<sup>40</sup> Works are not limited to one medium, and there is no requirement that creative works appear in the same medium to form a series. The Examining Attorney relies upon a USPTO web page tutorial on series titles that provides in pertinent part that “Evidence of a series includes copies of at least two

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meaning.”). *See, e.g., Estate of Jenkins v. Paramount Pictures Corp.*, 90 F. Supp. 2d 706, 54 USPQ2d 1484, 1488 (E.D. Va. 2000) (“[T]he title of a single expressive work may receive trademark protection only upon a showing that the title is not generic, and that it has acquired secondary meaning.”). This dichotomy between what is protectable and what is registrable has received some criticism, 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 10:4.10, but it affords authors a remedy in court for unfair competition, while maintaining a relatively “bright line” rule for registrability.

<sup>40</sup> Merriam-Webster.com 2/13/2019. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed form or regular fixed editions. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *M/S R.M. Dhariwal (HUF) 100% EOU v. Zarda King Ltd. and Global Tech. & Trade Marks Ltd.*, 2019 USPQ2d 14909, \*1 n. 2 (TTAB 2019).

different book covers....”<sup>41</sup> But that is an illustrative example, not an exhaustive list. Similarly, in *Polar Music*, on which the Examining Attorney also relies, the Federal Circuit found trademark usage of the name of the musical group ABBA, noting that “Every ‘ABBA’ **album** and **single** and **tape** has the word ‘ABBA’ on it in addition to its title.” *In re Polar Music*, 221 USPQ at 318 (emphasis added). As Applicant observes, the Court impliedly acknowledged that a series of creative works may extend into different media.<sup>42</sup>

The issue is not whether the creative works appear in the same medium; it is whether they would tend to be associated with a single source in the mind of the relevant public. *See Cooper*, 117 USPQ at 400; *Herbko v. Kappa Books*, 64 USPQ2d at 1378. In this case, the relevant reading public would be adults with children nearing college age. As noted, Applicant began her blog under the title THE NEUROTIC PARENT in 2008. Applicant owns a Principal Register registration, issued seven years ago, for THE NEUROTIC PARENT for “an online journal, namely, a blog featuring information on colleges and college admissions.”<sup>43</sup> The presumption under Trademark Act Section 7(b) is that she owns the mark and provides the identified services under the mark to all potential classes of ordinary consumers of such services. 15 U.S.C. §1057(b). *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1357 (Fed. Cir. 2000). Applicant has provided

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<sup>41</sup> Examining Attorney’s brief, 11 TTABVUE 5 (emphasis added by Examining Attorney).

<sup>42</sup> Applicant’s reply brief, 12 TTABVUE 3.

<sup>43</sup> Reg. No. 4096671, issued Feb. 7, 2012.

representative samples of entries from the blog THE NEUROTIC PARENT. The blog advertises her book, entitled THE NEUROTIC PARENT’S GUIDE:

Here is a graphic used on the SAT site to illustrate that the new exam will have “problems grounded in a real-world context,” with “passages...paired with informational graphics.” If spiky Europe is an indication of what is to come, these new graphics should be a blast to interpret.




Sadly, this could be too little too late. These changes will cause even more kids to gravitate to the tried and true ACT, which rarely changes, and will not leaving the SAT tutors scrambling to update their flashcards.

The Neurotic Parent Institute has just released findings of a study showing that if the SAT really wants to re-engage test-takers, it will have to alter its exam by truly making it more relevant in the following ways:

- Change the start time to 1pm, the hour that most teenagers wake up
- Offer free Red Bull and Frappuccinos – granola bars are so 20th century
- Grant extended time for anyone with anxiety caused by parental helicoptering, overscheduling or Instagram inferiority issues
- Allow unlimited texting and Googling during the exam – essential research skills for college students
- Incorporate advanced hashtag usage into the #grammarandpunctuation section.
- Bring back the iconic analogies, the only fun part of the exam – These were deemed culturally biased because of the notorious [regatta oarsman](#) comparison, but most college hopefuls now know all about crew, thanks to the [Winklevosses](#).
- Employ angel investors as proctors – If you can pitch them a good idea, you get to skip college altogether and go straight to running your own start-up.

So sharpen your #2s, ninth graders. Here’s to relevance in test taking.



ABOUT

All About the Book!

START

THE NEUROTIC Parent's Guide TO College Admissions

The book addresses the same general subject, colleges and college admissions, and could be available in print, via an e-reader, or by other means online. The substance of the works, not their form or medium, would permit the relevant public to perceive them together as a series.

The problem lies with the **titles** and **contents** of the blog and book. With respect to titles, we note that in *Scholastic II*, the series of book titles appeared essentially this way:

THE MAGIC SCHOOL BUS  
AT THE WATERWORKS

THE MAGIC SCHOOL BUS  
INSIDE THE EARTH

THE MAGIC SCHOOL BUS  
LOST IN THE SOLAR SYSTEM

THE MAGIC SCHOOL BUS  
INSIDE THE HUMAN BODY

The Board found that:

[T]he words THE MAGIC SCHOOL BUS are prominently displayed on the Books' covers, and are in a larger, bolder style of type and different color from the remainder of each title. Moreover, the words appear on a separate line above the remainder of each title. When presented in this fashion, we believe that THE MAGIC SCHOOL BUS makes a commercial impression separate and apart from, for example, the complete title THE MAGIC SCHOOL BUS AT THE WATERWORKS.

*Scholastic II*, 23 USPQ2d at 1777.

Consequently, the Board concluded, “notwithstanding the fact that it appears as a portion of titles of specific books in a series, the designation THE MAGIC SCHOOL BUS, as used on books, would be recognized as a trademark identifying a series of children’s books emanating from applicant.” *Id.*, cited in *Mattel v. Brainy Baby*, 101 USPQ2d at 1142 (“[I]f a term has been used to identify the source of a series of creative works, it functions as a trademark, and the fact that it may also be included in the title of each work does not destroy its source-originating function.”). The common characteristic in the series was a registrable trademark. See TMEP § 1202.08(d).

In this case, however, the subject Application does not seek to register the common characteristic in the titles; it seeks to register the title of the book: THE NEUROTIC PARENT’S GUIDE. The book title, as shown in Applicant’s specimen of use, does not prominently display the words THE NEUROTIC PARENT in a way that would make

a commercial impression separate and apart from THE NEUROTIC PARENT'S GUIDE. That is the opposite of the holding in the THE MAGIC SCHOOL BUS case.

The other problem presented in this case is discerning the **contents** of Applicant's blog and book from the evidentiary record. In the THE MAGIC SCHOOL BUS case, the series of children's educational books had variations in each book: an eccentric teacher, Ms. Frizzle, takes her pupils on field trips aboard a yellow bus that transports them, for example, to a cloud or to the center of the earth, where they learn firsthand about various scientific facts. *Scholastic II*, 23 USPQ2d at 1775. Those variations in content are important in establishing a series. If the content were the same, albeit in different formats, the work would be considered a single creative work, not a series. *See Mattel v. Brainy Baby*, 101 USPQ2d at 1144 (LAUGH & LEARN and design considered a title of a single creative work, despite being used on a program offered in both VHS and DVD formats, and therefore petition to cancel registration granted). TMEP § 1202.08(c).

In this case, the blog and book appear to have a common theme—advising parents about colleges and college admissions—but we are left to guess about their differences, if any. Applicant has provided representative entries from her blog,<sup>44</sup> but none of the content from her book. Applicant's counsel asserts that “This was not merely a transfer to another medium of material that previously had been electronically published in the blog. Rather, while the book includes some past blog entries in whole or in part, it also features additional creative content that had not

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<sup>44</sup> TheNeuroticParent.com, 3/12/2014, March 12, 2014 Response to Office Action at 5-11.



previously been published, all again relating to information on colleges and college admissions,”<sup>45</sup> and that “[t]he book includes some material from the blog but also a considerable amount of previously unpublished material.”<sup>46</sup> As the Examining Attorney correctly observes, though, this is asserted, not proven.<sup>47</sup> “Attorney argument is no substitute for evidence.” *Enzo Biochem Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005), *quoted in Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed Cir. 2018); *see In re Simulations Pub’ns, Inc.*, 521 F.2d 797, 187 USPQ 147, 148 (CCPA 1975) (where appellant argued that the magazines at issue dealt with unrelated subject matter, the court held that “[s]tatements in a brief cannot take the place of evidence.”). In the absence of record evidence differentiating the contents of the two works, we are unable to conclude that they constitute a series.

### III. Conclusion

While it is possible for titles of creative works in different media to form a series, the evidence of record in this case does not show that the applied-for mark is the title of the claimed series, or that the content of the creative works differs sufficiently to create a series.

**Decision:** The refusal to register Applicant’s mark THE NEUROTIC PARENT’S GUIDE is affirmed.

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<sup>45</sup> Applicant’s brief, 9 TTABVUE 2-3.

<sup>46</sup> Applicant’s reply brief, 12 TTABVUE 2.

<sup>47</sup> Examining Attorney’s brief, 11 TTABVUE 4.