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INTELLECTUAL PROPERTY

The author outlines the various options under trademark law for protecting the titles of creative works.

A Different Kind of Title Insurance: How to Protect Titles of Creative Works

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When is a name just a name . . . and when is it more than just a name? This appears to be the fundamental question when attempting to protect the title of a creative work.

The Copyright Conundrum

Although creative works, such as books, movies, television shows, artwork, music, lyrics, and sound recordings, are protected via copyright,¹ “titles, names, short phrases, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering, or coloring; mere listings of ingredients or contents” are not protectable by copyright.²

¹ Copyright Act of 1976, 17 U.S.C. § 102(a) (2006).

² U.S. COPYRIGHT OFFICE, *Copyright Basics (Circular 1)*, at 3 (2012), available at <http://www.copyright.gov/circs/circ01.pdf>;

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Copyright protection extends only to “original works of authorship,”³ and protection of certain subject matter is specifically excluded in Section 102(b) of the Copyright Act,⁴ which states, “In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”⁵

Titles, names, and other short phrases are viewed as ideas or concepts and do not contain the minimum amount of authorship in the form of original literary, musical, pictorial, or graphic expression to meet the requirements for copyright protection. Although each copyright applicant is required to include a title (and may also include previous or alternative titles) on the application to identify the work being filed (even if the title is “Untitled”), and although works appear alphabetically in the indexes and catalogs of the Copyright Office, “the presence of a title in the Office’s registration records does not mean that the title itself is copyrighted or subject to copyright protection.”⁶ Therefore, numerous works may have the same or similar titles, even though the authors and the works are entirely different.

However, titles of creative works *may* be protectable under trademark law and principles of unfair competition.

The Trademark Trophy

The term “trademark” includes:

U.S. COPYRIGHT OFFICE, *Copyright Protection Not Available for Names, Titles, or Short Phrases (Circular 34)*, at 1 (2012), available at <http://www.copyright.gov/circs/circ34.pdf>.

³ 17 U.S.C. § 102(a).

⁴ 17 U.S.C. § 102(b).

⁵ *Id.*

⁶ *Circular 34*, at 1.

[A]ny word, name, symbol, or device, or any combination thereof—

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.⁷

A mark may consist of “any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, device, any matter that as a whole is not functional, or any combination of any of the foregoing, but such mark must be capable of distinguishing the applicant’s goods or services.”⁸

For practical purposes, the same rules apply to service marks as apply to trademarks,⁹ the main difference being that service marks technically identify services (International Classes 35-45), whereas trademarks identify goods (International Classes 1-34). References to trademarks in this article also apply to service marks.

Trademark rights may be used to prevent others from using a confusingly similar mark for identical, similar or related goods and services, but not to prevent others from making the same goods or from selling the same goods or services under a clearly different mark.

Common Law Marks

Federal registration is not required to establish rights in a trademark. Common law rights in a mark can be established based on actual use of the mark in commerce. However, common law trademark rights are limited.

Trademark rights are based on (1) priority (who used the mark first); (2) territory (the geographic area where the mark has been used); and (3) use (whether goods or services are actually provided under the mark). In other words, the first individual or entity to use a mark in commerce in connection with specific goods or services typically has priority over an individual or entity who attempts to use the same or confusingly similar mark in connection with identical, similar, or related goods and services, at least in the geographic area(s) where the first user actually used the mark.

For example, a band has been providing live performances in Illinois, Missouri, and Texas, under the name “Army of Sound” since 2011. That band can likely prevent another band that starts using the same or confusingly similar mark in 2012 for live musical performances from using that mark, at least in Illinois, Missouri, and Texas and any other geographic area where Army of Sound performed prior to the other band.

State Registration

State trademark registration is also available, but actual use of the mark in commerce in the state in which registration is sought must have occurred in order to register the mark with the applicable Secretary of

State’s Office, and the trademark rights are still limited to the particular state(s) in which the mark is registered.

Federal Registration

There are many benefits to federal trademark registration on the Principal Register¹⁰ with the Patent and Trademark Office, such as:

- constructive public notice nationwide of the trademark owner’s claim in the mark and evidence of ownership of the trademark, including listing in the PTO’s online database;
- the exclusive right to use the mark on or in connection with the goods or services set forth in the registration throughout the United States (although a third party using the mark in connection with identical, similar, or related goods or services prior to your registration may have the right to continue using the mark in limited geographic areas);
- the right to use the federal registration symbol ®;
- the ability to bring an action concerning the mark in federal court;
- the use of the U.S. registration as a basis to obtain registration in foreign countries;
- the ability to record the U.S. registration with the U.S. Customs and Border Protection Service to prevent importation of infringing foreign goods; and
- incontestable status after five years of registration (which limits third parties’ rights to contest the mark).

Federal Registration Based on Intent to Use

Although trademark rights are typically established through actual use of a mark in commerce, a federal application can be filed to essentially “reserve” a mark that has not yet been used in commerce but for which the owner has a bona fide intent to use the mark.¹¹

Although a registration will not issue for a mark filed based on intent to use until actual use of the mark has occurred, once the intent to use application is approved by the PTO and allowed for registration, the applicant has six months from the date the application is allowed to file (1) an Allegation of Use, or (2) a Request for an Extension of Time to File an Allegation of Use to obtain an additional six months to begin use of the mark or file an additional extension. The applicant may file up to five six-month extensions, effectively providing up to 36 months of protection from the date the application is allowed before use is required.

Now that we have a general understanding of how trademark rights are established, let us return our focus to how we can protect the title of a creative work.

One Is the Loneliest Number: Single Creative Works

Typically, trademark protection will be granted to a mark so long as it is not merely descriptive of or the ge-

⁷ Trademark (Lanham) Act of 1946, 15 U.S.C. § 1127 (2006).

⁸ 15 U.S.C. § 1091.

⁹ 15 U.S.C. § 1053.

¹⁰ There are fewer benefits to registration on the Supplemental Register. See 15 U.S.C. §§ 1091-1096.

¹¹ 15 U.S.C. § 1051(b).

neric name for the goods and/or services on or in connection with which it is used. Marks that are deemed merely descriptive may be registered on the Supplemental Register, and registration on the Principal Register may be sought upon a showing that the mark has become distinctive of the applicant's goods or services in commerce, namely, that the mark has "acquired distinctiveness" or "secondary meaning."¹²

Proof of substantially exclusive and continuous use of a mark in commerce for the five years before the date on which the claim of distinctiveness is made may be accepted in appropriate cases as prima facie evidence that the mark has acquired distinctiveness as used with the applicant's goods or services, although the PTO may require additional evidence of distinctiveness depending on the nature of the mark in relation to the specified goods or services.¹³

Just as the Copyright Office views the title of a work as merely a descriptive identifier of or generic name for the work, the title (or a portion of a title) of a *single* creative work is not registrable on either the Principal or Supplemental Register because the title of a single creative work cannot serve as a source identifier.¹⁴ Titles of single creative works have traditionally been viewed essentially as the descriptor or proper name for the work being referenced.¹⁵ "The theory apparently is that any such work is single and unique, not in competition with any other work and its title is not inherently distinctive. . . . The courts view each literary work as a specific, separate and unique commercial item and not as one product among many competing products. . . . 'Trademark use' means that the word is used to identify and distinguish the goods of one seller, and not merely to describe its qualities or as the name of the product itself."¹⁶

The rationale behind this is that, because the duration of copyright protection for the creative work is limited and eventually expires, any trademark rights in the title of the creative work expire upon expiration of the copyright, at which point others have the right to reproduce the creative work and use the title to identify the work.¹⁷ If the title of the single creative work were to be registered to one party, but used by a third party copy-

ing the expired work, the mark could be misleading as to the source of the copied goods or services.¹⁸

"Single creative works include works in which the content does not change, whether that work is in printed, recorded, or electronic form,"¹⁹ such as a book, a television episode, a film or DVD, a theatrical performance (such as a play, musical, or opera), a phonograph record or CD, or a downloadable song or ringtone.²⁰ Creative works that are serialized (e.g., where the work is issued in sections or chapters) are also considered single creative works.²¹

Interestingly, computer software, computer games, coloring books, puzzle books, and activity books are not treated as single creative works, and trademark protection is available even if only one work will be sold in connection with the mark.²²

The anomaly is that, even though titles of most single creative works are not registrable, courts have given trademark protection to the title of a single creative work at common law and under Section 43(a) of the Lanham Act,²³ but only upon a showing of secondary meaning, even if the title is inherently distinctive and not merely descriptive of the contents of the work.²⁴ As McCarthy states, "[t]his lack of congruence between registration and court enforcement impairs the ability of the federal register to reflect the reality of the marketplace."²⁵

Additional evidence of secondary meaning or acquired distinctiveness may include specific dollar sales under the mark, advertising figures (or indicating the types of media through which the goods and services have been advertised (e.g., national television) and how frequently the advertisements have appeared), samples of advertising, consumer or dealer statements of recognition of the mark as a source identifier, affidavits, and any other evidence that establishes the distinctiveness of the mark as an indicator of source.²⁶

If additional evidence is submitted, the following factors are generally considered when determining acquired distinctiveness: (1) length and exclusivity of use of the mark in the United States by applicant; (2) the type, expense, and amount of advertising of the mark in the United States; and (3) applicant's efforts in the United States to associate the mark with the source of

¹² Trademark Manual of Examining Procedure (TMPEP) §§ 1212 *et seq.* (8th ed. Oct. 2011).

¹³ 15 U.S.C. § 1052(f); TMPEP § 1212.05.

¹⁴ See *Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 1162, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) (64 PTCJ 440, 9/20/02) ("the title of a single book cannot serve as a source identifier"); *In re Cooper*, 254 F.2d 611, 615-16, 117 USPQ396, 400 (C.C.P.A. 1958), *cert. denied*, 358 U.S. 840, 119 USPQ 501 (1958) ("A book title . . . identifies a specific literary work . . . and is not associated in the public mind with the publisher, printer or bookseller. . . ."); *In re Posthuma*, 45 USPQ2d 2011 (T.T.A.B. 1998) (holding the title of a live theater production unregistrable); *In re Hal Leonard Publishing Corp.*, 15 USPQ2d 1574 (T.T.A.B. 1990) (holding "Instant Keyboard," as used on music instruction books, unregistrable as the title of a single work); *In re Appleby*, 159 USPQ 126 (T.T.A.B. 1968) (holding the title of single phonograph record, as distinguished from a series, does not function as mark); TMPEP § 1202.08.

¹⁵ 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 10.3 (4th ed. 2009).

¹⁶ *Id.*

¹⁷ See 2 MCCARTHY, *supra* note 15, § 10:4.10, citing *Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002).

¹⁸ See 2 MCCARTHY, *supra* note 15, § 10:4.10.

¹⁹ TMPEP §§ 1202.08(a), 1301.02(d).

²⁰ TMPEP § 1202.08(a).

²¹ *Id.*

²² TMPEP § 1202.08(b).

²³ 15 U.S.C. § 1125.

²⁴ See, e.g., *Herbko*, 64 USPQ2d at 1379 n.2 ("While titles of single works are not registerable, they may be protected under section 43(a) of the Lanham Act upon a showing of secondary meaning."); *Orion Pictures Co. v. Dell Publishing Co.*, 471 F. Supp. 392, 395, 202 USPQ 819 (S.D.N.Y. 1979) ("[W]e have applied a more stringent rule to literary titles, . . . in requiring the trademark proprietor to demonstrate secondary meaning notwithstanding the suggestive nature of the title."); TMPEP § 1202.08(d)(iii).

²⁵ 2 MCCARTHY, *supra* note 15, § 10:4.10.

²⁶ See 37 C.F.R. § 2.41(a); *In re Ideal Industries Inc.*, 508 F.2d 1336, 184 USPQ 487 (C.C.P.A. 1975); *In re Instant Transactions Corp.*, 201 USPQ 957 (T.T.A.B. 1979); TMPEP §§ 1212.06 *et seq.*

the goods and/or services, such as unsolicited media coverage and consumer studies.²⁷

A showing of acquired distinctiveness need not consider all these factors, and no single factor is determinative.²⁸

It Takes (at Least) Two to Tango: Series of Creative Works

While the title of a *single* creative work is generally not registrable as a trademark, if the title has been used in connection with a *series* of creative works (e.g., a series of books, the second edition of a book with significant changes, a periodically issued magazine, newspaper, or comic strip, a continuing radio program or a television or movie series²⁹), it may constitute a mark for a series of audio or audio/visual works in Class 9, a series of publications in International Class 16, or either entertainment services or educational services in International Class 41.³⁰

Generally, if the creative work is a type of work in which the content changes with each issue, volume, episode, or performance (including a series of live performances by a musical artist or a series of educational seminars), the work is not considered a single creative work, and, therefore, the title of the series can be protected as a trademark.

Although the title of a series of creative works may be protectable under trademark law, general trademark principles still apply to the mark at issue. If the title is descriptive of the contents of the work, the title will likely only be registrable on the Supplemental Register without evidence of acquired distinctiveness (demonstrating that the title in question is associated with a single source in the minds of a significant number of people).

However, proof of acquired distinctiveness is not required for titles that are inherently distinctive (marks which are suggestive, arbitrary, or fanciful as applied to the goods or services) and not merely descriptive of the contents of the work. Truly generic titles—comprised of works that the relevant purchasing public understands primarily as the common or class name for the goods or services—are never protectable as trademarks.³¹

Because an applicant must submit evidence that the title is used on at least two different creative works in

order to obtain a trademark registration for the title, an intent-to-use application may be filed if the title owner intends to create a series in the near future. One of the main reasons to file an intent-to-use application for the title of a series of creative works is to reserve the mark's priority date and prevent others from obtaining rights in the mark for similar goods or services while the product or service is being developed.

Filing an application for a mark that has not yet been used also allows for evaluation of the mark by the PTO and potentially provides the applicant time to change the title in case any obstacles to registration arise. In the event that a single creative work has already been developed and a second work using the same title is in the works, filing an intent-to-use application for the title at this point can allow the potentially lengthy trademark approval process (typically six to 12 months for a relatively issue-free application) to play out in the PTO while the second work is completed.

Once the application has been allowed and the second work in the series is complete, an Allegation of Use can be filed and the registration will proceed to issue.

A Fine (and Acceptable) Specimen: Evidence of a Series

In order to prove to the PTO that the title is being used on multiple creative works, specimens showing use of the title in connection with the goods or services must be submitted to the PTO. For example, to show use of a title in connection with a series of books, scanned or digitally photographed images of a least two books using the same title should be submitted along with the dates of first use of the mark.

Specimens that show use of a mark in connection with television programs or a movie series may be in the nature of a screenshot or digital photograph of the video or film frame when the mark is used in the program.³²

However, the record must show that “the matter sought to be registered is more than the title of one presentation, performance, or recording,”³³ or written work. In other words, the works must be two different works with different content (or contain significant changes from the original edition as opposed to corrections of typographical errors or minor changes³⁴).

A series is not established if the second work is merely (1) a translation of the original work; (2) the original work in a different format (e.g., a printed and recorded version of the same book); or (3) the use of the title on the original work and on collateral materials such as posters, mugs, bags, or t-shirts.³⁵ Additionally, a specimen showing use of a mark in advertising will not be acceptable to show actual use in commerce on goods (International Classes 1-34), but it is acceptable to show actual use in commerce in connection with services (International Classes 35-45).

In Whole or in Part: Protecting Partial Titles

A portion of a title of any single creative work is registrable only if (1) it creates a separate commercial impression apart from the complete title (meaning that the

²⁷ See *In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005).

²⁸ *In re Steelbuilding.com*, 415 F.3d at 1300, 75 USPQ2d at 1424; see TMEP §§ 1212 *et seq.*

²⁹ TMEP §§ 1202.08(a), 1301.02(d).

³⁰ For more information on international trademark classification, see *Nice Agreement Tenth Edition—General Remarks, Class Headings and Explanatory Notes*, available at <http://www.uspto.gov/trademarks/notices/international.jsp>, the *International Classification of Goods and Services for the Purposes of the Registration of Marks* (10th ed. 2011), published by the World Intellectual Property Organization, available at <http://www.wipo.int/classifications/en/index.html>, and the *U.S. Acceptable Identification of Goods and Services Manual (ID Manual)*, available at <http://tess2.uspto.gov/netathtml/tidm.html>.

³¹ TMEP § 1209.01(c); see also 2 McCarthy, *supra* note 15, § 10:9 (“Consumer Electronics Monthly” held to be generic for a class of magazines describing electronic equipment for consumers; “Video Buyers Guide” generic for a class of magazines; “Nutrition Bulletin” generic for an internet site providing dietary and nutritional information).

³² TMEP § 1301.02(d).

³³ *Id.*

³⁴ TMEP § 1202.08(b).

³⁵ TMEP § 1202.08(c).

mark is used as a separable element as indicated by the size, type font, color, and any separation between the mark and the rest of the title³⁶); (2) it is used on a series of works; and (3) it is promoted or recognized as a mark for the series.³⁷ For example, the mark “The Little Engine” used in connection with a series of books, such as “The Little Engine That Went to the Fair,” and “The Little Engine Goes to School,” would be registrable if “The Little Engine” was displayed prominently on the books and the applicant or others promoted “The Little Engine” as a book series title. “The mere use of the same words in more than one book title is insufficient to establish the words as a mark for a series. The applicant must show that the public perceives the portion sought to be registered as a mark for the series.”³⁸ This can be demonstrated by submitting more than one book cover or CD cover with the mark used in all the titles.³⁹

An Apparent Apparition: Phantom Marks

Although partial titles may be registrable as a trademark, registration will not be granted to marks with a changeable or “phantom” element, such as “Chicken Soup for the ___ Soul,” where the blank line represents a word, geographic location, alphanumeric designation, date or year, model number, or other component that is subject to change.⁴⁰ The changeable or “phantom” element may also be represented by using dots, dashes or other designation, such as “XXXX.” Such applications will be refused on the ground that the application seeks registration of more than one mark,⁴¹ as a trademark application must be limited to only one mark.⁴²

Because trademark registration serves as constructive notice to the public of the registrant’s ownership of the mark,⁴³ to make such constructive notice meaningful, the mark as registered must accurately reflect the mark that is used in commerce so that a search of the

³⁶ TMEP § 1202.08(d)(i); see also *In re Scholastic Inc.*, 23 USPQ2d 1774, 1777 (T.T.A.B. 1992) (“[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”).

³⁷ TMEP § 1202.08(d).

³⁸ TMEP § 1202.08(d)(iii); see also *In re Scholastic Inc.*, 23 USPQ2d at 1777 (T.T.A.B. 1992) (holding “The Magic School Bus” used as a portion of the book titles in “The Magic School Bus at the Waterworks” and “The Magic School Bus Inside the Earth,” functions as a mark for a series, because the record contained evidence of repeated use of the designation displayed prominently on book covers, as well as evidence that applicant promoted “The Magic School Bus” as a series title, that others used the designation in book reviews to refer to a series of books, and that purchasers recognized the designation as indicating the source of a series of books).

³⁹ TMEP § 1202.08(d)(ii).

⁴⁰ TMEP § 1214.

⁴¹ See *In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999); *In re Primo Water Corp.*, 87 USPQ2d 1376 (T.T.A.B. 2008); *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theatres Inc.*, 56 USPQ2d 1538 (T.T.A.B. 2000); TMEP § 1214.01.

⁴² TMEP § 807.01.

⁴³ 15 U.S.C. § 1072.

register for similar marks will locate the registration. Although the PTO granted registration to several such registrations, such as “- - -for Dummies,”⁴⁴ Federal courts have since held that “phantom marks” with missing elements “encompass too many combinations and permutations to make a thorough and effective search possible” and, therefore, registration of these marks does not provide adequate notice to competitors and the public.⁴⁵ Therefore, each such mark now requires a separate application.

Letter to the Editor: Titles of Columns or Sections of Publications

A mark that identifies a column, section, or supplement of a printed publication is normally not registrable on the Principal Register unless (1) it is sold, syndicated, or offered for syndication separate and apart from the larger publication in which it appears,⁴⁶ or (2) it has acquired distinctiveness and separate recognition (as evidenced by promotion, long use, advertising expenditures, and breadth of distribution or sales figures).⁴⁷ The evidence must establish that the column or section title is used to distinguish the work from the columns or sections of other publishers’ publications, not merely from other columns or sections of applicant’s publication.⁴⁸ Otherwise, the mark may be registered on the Supplemental Register.⁴⁹

If a mark identifies a non-syndicated removable or pull-out section, distinctiveness can likely be established with a lesser degree of evidence.⁵⁰ Supplemental Registration for any mark is only available for marks that have actually been used in commerce.⁵¹ However, a mark that identifies a column or section of online publications (which are considered to be services as opposed to goods) can be registered on the Principal Register without a showing of acquired distinctiveness because it can be accessed directly and exist independent of any single publication.⁵²

Epilogue

Although the principles of protection for titles of creative works do not always adhere to traditional intellectual property doctrines, protection does exist in many instances. As with any intangible asset, protecting rights in titles of creative works is often as important as protecting rights in the underlying creative works and can prove to be invaluable additions to any intellectual property estate.

⁴⁴ See, e.g., - - - FOR DUMMIES, Registration No. 1887907.

⁴⁵ *In re International Flavors & Fragrances Inc.*, 183 F.3d at 1367-68, 51 USPQ2d at 1517-18.

⁴⁶ *In re Broadcasting Publications Inc.*, 135 USPQ 374 (T.T.A.B. 1962); *Ex parte Meredith Publishing*, 109 USPQ 426 (Comm’r Pats. 1956); TMEP § 1202.07(a) *et seq.*

⁴⁷ TMEP § 1202.07(a)(ii).

⁴⁸ *Metro Publishing v. San Jose Mercury News*, 987 F.2d 637, 25 USPQ2d 2049 (9th Cir. 1993); *In re Broadcasting Publications Inc.*

⁴⁹ TMEP § 1202.07(a)(ii).

⁵⁰ *Id.*

⁵¹ 15 U.S.C. § 1091; TMEP § 1102.03.

⁵² See *Ludden v. Metro Weekly*, 8 F. Supp. 2d 7, 14, 47 USPQ2d 1087, 1093 (D.D.C. 1998); TMEP § 1202.07(b).