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Paper No. 9
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sheila Atchley

Serial No. 75/408,739

James C. Nemmers, Esq. for applicant.

John Alumit, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney).

Before Simms, Walters and Holtzman, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Sheila Atchley has filed a trademark application to register the mark shown below for "pre-recorded audio tapes for relaxation and sleep inducement."[1]

[1] Serial No. 75/408,739, in International Class 9, filed December 19, 1997, based on use in commerce, alleging first use and first use in commerce as of October 11, 1997.

The Trademark Examining Attorney has finally refused registration under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. 1051, 1052 and 1127, on the ground that applicant's proposed mark, as used on the specimens of record, does not function as a trademark; rather, it merely identifies the title of a single audio work.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

The determination in this case is based solely upon the record before us. The court, in *In re Bose Corp*., 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976), stated that "[b]efore there can be registration, there must be a trademark, and unless words have been so used they cannot qualify." (*citation omitted.*) Noting that "the classic function of a trademark is to point out distinctively the origin of the goods to which it is attached," the court stated further (*citations and footnote omitted*):

> An important function of specimens in a trademark application is, manifestly, to enable the PTO to verify the statements made in the application regarding trademark use. In this regard, the manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used *as a trademark* with respect to the goods named in the application.

Id. at 215-216.

The specimen, and only evidence of use of the mark herein, consists of the jacket liner of an audio tape cassette. The proposed mark appears on the jacket liner, as shown below:

The Examining Attorney contends that the mark is not registrable because it appears on the specimens as the title of a single audio work; and that, as with the title of a single literary work, the title of a single audio tape cassette is merely descriptive of the specific audio work contained on the tape cassette.

Applicant concedes that SWEET DREAMS is the title of a single audio work, but contends that the mark herein includes a design element and, as such, is not merely a title. Applicant argues, further, that SWEET DREAMS is not the title of a single work because she intends to produce a series of audio tapes and use the mark herein as the title for that series.

Although this case involves the title of a single audio tape, it is directly analogous to cases involving the registrability of the title of a single literary work. In the seminal case on the registrability of titles of books as trademarks, *In re Cooper*, 254 F.2d 611, 117 USPQ 396, 398 (CCPA 1958),[2] the court found the title of a book to be unregistrable as a trademark for books because, essentially, titles of books are considered to be nothing more than the name by which the book may be identified in much the same way that other items of merchandise are identified. The court opined (*supra* at 400):

> [H]owever arbitrary, novel or non-descriptive *of contents* the name of a book – its title – may be, it nevertheless *describes* the book. Appellant has nowhere attempted to answer the question, How else would you describe it – What else would you call it? If the name or title of a book were not available as a description of it, an effort to denote the book would sound like the playing of the game "Twenty Questions."

However, the court reiterated the general principle that whether certain subject matter is a trademark in connection with books must be determined on the specific facts pertaining to the manner of use thereof (*supra* at 398):

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[2] *See also*, *In re Scholastic Inc.*, 223 USPQ 431 (TTAB 1984) *(Scholastic I); Paramount Pictures Corp. v. Romulan Invasions*, 7 USPQ2d 1897, 1899 (TTAB 1988); *In re Hal Leonard Publishing Corp.*, 15 USPQ2d 1574 (TTAB 1990); *In re Scholastic Inc.*, 23 USPQ2d 1774 (TTAB 1992) *(Scholastic II)*; and *In re Phil Postuma and Cordell Langeland,* 45 USPQ2d 2011 (TTAB 1998).

> No one has asserted that a word may not be *used* as a trademark for books or that there cannot *be* trademarks for books, in the form of a word or otherwise, or that trademarks for books cannot be registered under the Lanham Act. Appellant appears to assume that [its alleged mark] has been used *as a trademark* for books in asking that it be registered, but that is what we have to decide. Nothing we say should be taken as implying that no trademark for books can be registered; but before there can be registration there must be a trademark and a trademark exists only where there has been trademark use.

(emphasis in original.)

Cooper and the cases following it have consistently reaffirmed the principle that subject matter that is merely the title of a single work is not used as a trademark.

While subject matter used to identify a series of works may be a registrable trademark, such use is not the case herein.[3] Applicant contends that she has a bona fide intention to use the alleged mark on a series of audio tapes, but she admits that she has not done so yet. However, applicant chose to file this application based on

[3] The Board, in *In re Scholastic Inc*., 23 USPQ2d 1774 (TTAB 1992) *(Scholastic II),* found THE MAGIC SCHOOL BUS, which formed part of the title of each book in a series of children's books, to be a registrable trademark in connection with "a series of non-fiction picture books for children." In that case, there was substantial evidence showing the prominent and distinctive display of the phrase THE MAGIC SCHOOL BUS on book covers in the series; as well as evidence of reviews in widely circulated publications referring to "the Magic School Bus series" and similar terminology; substantial promotional materials for "THE MAGIC SCHOOL BUS" series; and recognition by the public of the phrase as a mark. While this case is inapposite to the extent that it pertains to the use of a phrase to identify a *series* of books, which is not the case herein, it demonstrates the nature and scope of an evidentiary showing which may establish trademark use of a phrase in connection with books.

use of the alleged mark on her single audio work, rather than based upon a bona fide intention to use the alleged mark on a series of audio works. As indicated above, we are constrained to consider the record as it appears before us. Thus, we must consider the issue of registrability based on applicant's admitted use of the alleged mark on only a single audio work.

Applicant also argues that her alleged mark contains a design element and, as such, is not simply the title of a single work. Even if a design would permit trademark registration of what is otherwise a single title of an audio work, which we do not decide herein, the design in this case is so minimal as to be of little significance in the overall impression created by the title as it appears on the specimen. The script in which the wording appears is fairly ordinary and the drawing of the sheep near the initial "S" in SWEET DREAMS is so small as to be unrecognizable except upon careful inspection, particularly in the actual size shown on the specimen.

Finally, applicant argues that the specimens show "Sweet Dreams" to be the owner of the copyright in the graphics and text on the specimen and, although not mentioned by applicant, the content of the audio tape. Whatever rights applicant may claim or, in fact, have under

copyright law in connection with her audio tape are of no relevance to whether the alleged mark is registrable as a trademark. We also note that applicant has placed a "TM" adjacent to her alleged mark on the specimen. However, applicant's intention that this material be considered a trademark does not make it so. See *In re Frederick Warne & Co., Inc.*, 218 USPQ 345 (TTAB 1983). It remains, on the record before us, the title of a single audio work.

In conclusion, for the reasons stated we find that applicant's alleged mark is not registrable because it is the title of a single audio work.

Decision: The refusal to register is affirmed.