

# SINGLE LITERARY TITLES AND FEDERAL TRADEMARK PROTECTION: THE ANOMALY BETWEEN THE USPTO AND CASE LAW PRECEDENTS

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## INTRODUCTION

Why do courts grant trademark protection to single literary titles<sup>1</sup> having acquired secondary meaning, yet owners of single literary titles cannot federally register that title on either the Principal or Supplemental Register? Although viewed by some as nothing more than artistic expression, books are nevertheless sold in the commercial marketplace like any other commodity and make “the danger of consumer deception a legitimate concern that warrants some government protection.”<sup>2</sup> Yet, the United States Patent and Trademark Office (“PTO”) continually refuses to federally register single literary titles on the Principal or Supplemental Register,<sup>3</sup> even though courts grant protection to single literary titles upon a showing of secondary meaning.<sup>4</sup> As McCarthy points out, “[t]his lack of congruence between registration and court enforcement impairs the ability of the federal register to reflect the reality of the marketplace.”<sup>5</sup> If single

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<sup>1</sup> As used in this Note, the term “literary title” means an artistic expression used exclusively for the title of a book.

<sup>2</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 997 (2d Cir. 1989).

<sup>3</sup> *Practitioner’s Trademark Manual of Examining Procedure* § 1202.08 (James Hawes & Amanda Dwight eds., 3d ed., West 2004) [hereinafter TMEP] (“The title of a single creative work is not registrable on the Principal Register or the Supplemental Register.”).

<sup>4</sup> See *Twin Peaks Prods., Inc. v. Pubs. Intl., Ltd.*, 996 F.2d 1366, 1379 n. 4 (2d Cir. 1993) (applying a more stringent rule to literary titles and requiring trademark proprietors to demonstrate secondary meaning notwithstanding any suggestive nature of the title).

<sup>5</sup> J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* vol. 2, § 10:4 (4th ed., West 2004).

literary titles are as incapable of functioning as trademarks as mandated by the PTO, courts should similarly find that single literary titles are, and forever will be, incapable of functioning as trademarks notwithstanding any showing of secondary meaning. Conversely, the PTO should at least grant single literary titles registration upon the Supplemental Register, and avail titles the opportunity of acquiring secondary meaning and growing into federally protected marks.

Claiming that single literary titles are merely descriptive, the PTO precludes them from gaining federal registration.<sup>6</sup> Unlike single literary titles, however, other merely descriptive marks are registrable on the Supplemental Register and entitled to protection as federally registered trademarks under the Lanham Act.<sup>7</sup> Fortunately, § 43(a) of the Lanham Act allows owners to protect unregistered trademarks from being used by junior users in such a way that creates a likelihood of confusion as to source, affiliation, sponsorship or connection upon a showing of secondary meaning.<sup>8</sup> But, unlike owners of federally registered marks who only have to prove a likelihood of confusion between their mark and an infringing mark, proprietors of single literary titles bear the additional burden of proving single titles have acquired secondary meaning and function as trademarks.<sup>9</sup> Proprietors do, however, have the ability to federally register a literary title if it is timely used as the title for a series of works.<sup>10</sup>

This Note will analyze why single literary titles are prohibited from being federally registered and address the discrepancy between the PTO and case law precedent within the context of maximizing a trademark owner's competitive advantage as well as preserving the public's right not to be

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<sup>6</sup> See *Herbko Intl., Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162 (Fed. Cir. 2002) (“the title of a single book cannot serve as a source identifier”); *In re Cooper*, 254 F.2d 611, 615-16 (C.C.P.A. 1958) (“a book title . . . identifies a specific literary work . . . and is not associated in the public mind with the publisher, printer or bookseller”).

<sup>7</sup> TMEP, *supra* n. 3, at § 1209.01 (“Merely descriptive marks may be registrable on the Supplemental Register.”).

<sup>8</sup> See *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 (5th Cir. 1999) (all single book titles are viewed as descriptive of the contents and require proof of secondary meaning).

<sup>9</sup> See *Heirs of Est. of Jenkins v. Paramount Pictures Corp.*, 90 F. Supp. 2d 706, 710 (E.D. Va. 2000) (“titles of expressive works are treated differently from other trademarks, in that titles, even if suggestive, arbitrary or fanciful, nonetheless require secondary meaning to receive trademark protection, while other suggestive, arbitrary and fanciful marks do not”).

<sup>10</sup> *In re Cooper*, 254 F.2d at 615 (“The name for a series . . . has a trademark function in indicating that each book of the series comes from the same source as the others. The name of the series is not descriptive of any one book and each book has its individual name or title.”).

confused by competing goods in the marketplace. Part I will provide an overview of the history of trademarks and the requirements for federal trademark registration and protection under the Lanham Act. Part II will review current precedent. Part III will address the juxtaposition of trademark and copyright issues associated with literary publishings and the policy arguments that support the PTO's current preclusion of granting single literary titles federal registration. Part IV will discuss why single literary titles should be registrable on the Supplemental Register at the very least, and that perpetuating the inconsistency between the PTO and case law precedent inhibits competitiveness in the marketplace and breeds consumer confusion.

## I. BACKGROUND

### A. *History of Trademark Registration and the Lanham Act*

The first federal act<sup>11</sup> providing for trademark registration was passed by Congress in 1870, and did not specify whether marks had to be used in interstate or foreign commerce. In 1879, however, the Supreme Court held the Act unconstitutional because Congresses power to regulate trademarks was limited to the Commerce Clause.<sup>12</sup> Interpreting the U.S. Constitution, article I, section 8, clause 8,<sup>13</sup> the Court held that Congress only had the power to regulate patents and copyrights and was precluded from regulating trademarks.<sup>14</sup> The Court found that trademarks are “simply founded on priority of appropriation,” and have no relation to invention and discovery or original writings.<sup>15</sup> Nevertheless, the Trademark Act of 1905 more narrowly granted registration to technical common-law trademarks.<sup>16</sup> As applied, the Act of 1905 protected arbitrary or fanciful marks, but prevented descriptive marks from being registered.<sup>17</sup>

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<sup>11</sup> *An Act to Revise, Consolidate and Amend the Statutes Relating to Patents and Copyrights*, Act of July 8, 1870, 16 Stat. at L 198 §§ 77-84; see McCarthy, *supra* n. 5, at § 5:3 n. 1.

<sup>12</sup> See *U.S. v. Steffens*, 100 U.S. 82, 99 (1879) [hereinafter *Trademark Cases*].

<sup>13</sup> “[T]o promote the progress of science and the useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.” U.S. Const. art I, § 8, cl. 8.

<sup>14</sup> *Trademark Cases*, 100 U.S. at 93-4.

<sup>15</sup> *Id.* at 94.

<sup>16</sup> Act of Feb. 20, 1905; 15 U.S.C. §§ 81 et seq. (2000); see McCarthy, *supra* n. 5, at § 5:3 n. 9.

<sup>17</sup> See e.g. *Stand. Paint Co. v. Trinidad Asphalt Mfg. Co.*, 220 U.S. 446, 454-55 (1911).

Despite a series of amendments,<sup>18</sup> however, the Trademark Act of 1905 continued to inadequately address the realities of Twentieth Century commerce and brand names.<sup>19</sup>

Following Congress' rigorous efforts to secure a trademark statute, President Truman signed the Lanham<sup>20</sup> Trademark Act on July 5, 1946, which took effect one year later on July 5, 1947.<sup>21</sup> "The purpose . . . [of the] [T]rademark [Act] . . . is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get."<sup>22</sup>

### **B. Trademarks**

"[B]efore there can be registration there must be a trademark and a trademark exists only where there has been trademark use."<sup>23</sup> Section 45 of the Lanham Act defines a "trademark" as:

any word, name, symbol, or device, or 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 principle register established by [the Lanham Act],

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.<sup>24</sup>

Accordingly, trademarks serve the following four functions: 1) to identify and distinguish the seller's goods; 2) to signify that all goods bearing the mark come from the same source; 3) to signify all goods bearing the mark

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<sup>18</sup> *E.g.* Act of May 4, 1906; Mar. 2, 1907; Feb. 19, 1909; Feb. 18, 1911; Jan. 8, 1913; Mar. 19, 1920; Jun. 7, 1924; Mar. 4, 1925; Mar. 2, 1929, Apr. 11, 1930; Jun. 10, 1938. *See* McCarthy, *supra* n. 5, at § 5:3 n. 15.

<sup>19</sup> McCarthy, *supra* n. 5, at § 5:3.

<sup>20</sup> Congressman Fritz Garland Lanham, the democratic representative and lawyer from Fort Worth Texas, gave his name to the 1946 Trademark Act. Congressman Lanham served for 28 years, from 1919 to 1947, when he retired from public office. *See id.* at § 5.4.

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

<sup>22</sup> Sen. Rpt. 1333 (May 14, 1946) (reprinted in 1946 U.S.C.C.A.N. 1274) (Legislative history accompanying the Lanham Act).

<sup>23</sup> *In re Cooper*, 254 F.2d at 613.

<sup>24</sup> 15 U.S.C. § 1127 (2004).

are of equal quality; and 4) to be used to advertise and sell the good.<sup>25</sup> Trademarks are also an objective symbol of the goodwill associated with the owner's brand and product.<sup>26</sup> Thus, trademark owners only have a property right in their mark "insofar as is necessary to prevent consumer confusion as to who produced the goods and to facilitate differentiation of the trademark owner's goods."<sup>27</sup>

Moreover, the trademark must perform the job of identification; it must identify a source and distinguish it from other sources.<sup>28</sup> If the mark fails to do this, it is not protectable as a trademark.<sup>29</sup> The "salient question is whether [the] designation, as used, will be recognized in and of itself as an indication of origin for [the] particular product, that is, does [the] component create [a] commercial impression separate and apart from [the] other material appearing on [the] label?"<sup>30</sup>

### C. *Registered and Unregistered Trademarks*

In order for trademarks to be federally registered on the Principal or Supplemental Register, the mark must: 1) be capable of being categorized as either a trademark, service mark, collective mark, or certification mark; 2) be used to distinguish goods or services; 3) not be confusingly similar to any other registered mark; and 4) be distinctive.<sup>31</sup> Distinctiveness is based on a judicially adopted classification system, and a determination of whether the mark is generic, descriptive, suggestive, arbitrary, or fanciful.<sup>32</sup> Generic terms refer to the genus of which the product is a species; descriptive marks describe the product or its qualities, ingredients, or characteristics; suggestive marks require "imagination, thought and perception" to determine what the

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<sup>25</sup> *Springfield Fire & Marine Ins. Co. v. Founders' Fire & Marine Ins. Co.*, 115 F. Supp. 787, 792 (D. Cal. 1953).

<sup>26</sup> McCarthy, *supra* n. 5, at § 3:2; *see generally Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403 (1916).

<sup>27</sup> *Intl. Order of Job's Daughters v. Lindenburg & Co.*, 633 F.2d 912, 919 (9th Cir. 1980).

<sup>28</sup> *Rock and Roll Hall of Fame and Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 753 (6th Cir. 1998) (plaintiff must prove they used their mark as a trademark).

<sup>29</sup> McCarthy, *supra* n. 5, at § 3:3.

<sup>30</sup> *Proctor & Gamble Co. v. Keystone Automotive Warehouse, Inc.*, 191 U.S.P.Q. 468, 469 (T.T.A.B. 1976).

<sup>31</sup> *Trademark Protec. & Prac.* vol. 1, § 3.04[3] (Jerome Gilson & Jeffrey M. Samuels eds., Matthew Bender & Co., Inc. 1998).

<sup>32</sup> *Abercrombie & Fitch Co. v. Hunting World*, 537 F.2d 4, 9 (2d Cir. 1976).

product is; arbitrary marks are ordinary words used in uncommon ways; and fanciful marks are words invented solely for their use as trademarks.<sup>33</sup>

A mark's classification of distinctiveness is directly connected to its degree of protection.<sup>34</sup> Under § 21 of the Lanham Act, generic marks are precluded from trademark protection and registration on either the Principal or Supplemental Register, because the goods they are attached to are not "distinguish[able] from the goods of others."<sup>35</sup> "[N]o matter how much money and effort the user of a generic [mark] has poured into promoting the sale of its merchandise . . . , it cannot deprive competing manufacturers of the product . . . to call an article by [the] name [it is known by]."<sup>36</sup> Similarly, § 2(e)(1) of the Lanham Act prevents the registration of a mark that, "when used on or in connection with the goods of the applicant is merely descriptive . . . of them."<sup>37</sup> Section 2(f) of the Lanham Act, however, provides applicants of descriptive marks the ability to register their marks on the Principal Register upon a showing that the mark "has become distinctive of the applicant's goods in commerce."<sup>38</sup> Proof of substantially exclusive and continuous use of the mark for five years prior to applying for registration is considered prima facie evidence that the mark has become distinctive and acquired secondary meaning.<sup>39</sup>

Suggestive, arbitrary and fanciful marks are entitled to registration upon the Principal Register without such a showing because they are inherently distinctive.<sup>40</sup> Accordingly, Registration on the Principle Register creates a rebuttable presumption that a mark is fanciful, arbitrary or suggestive, thus constituting prima facie evidence of the strength of the mark and availing the mark of full protection under the Lanham Act.<sup>41</sup> Conversely, marks that are not registrable on the Principal Register but capable of distinguishing an applicant's goods or services are registrable on the Supplemental Register on the premise that they were not denied registration

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<sup>33</sup> *Id.* at 9-11.

<sup>34</sup> *Id.* at 9.

<sup>35</sup> 15 U.S.C. § 1052.

<sup>36</sup> *Abercrombie & Fitch*, 537 F.2d at 9.

<sup>37</sup> 15 U.S.C. § 1052(e).

<sup>38</sup> *Id.* at § 1052(f).

<sup>39</sup> *Abercrombie & Fitch*, 537 F.2d at 10.

<sup>40</sup> *Id.* at 11; see *Bristol-Meyers Squibb Co. v. McNeil, P.P.C.*, 973 F.2d 1033, 1039 (2d Cir. 1992).

<sup>41</sup> *Abercrombie & Fitch*, 537 F.2d at 11.

on the Principal Register under § 2 (a)-(d) and (e)(3).<sup>42</sup> Thus, marks that are merely descriptive under § 2(e)(1) and denied registration on the Principal Register are not precluded from registering on the Supplemental Register so long as they are “capable of distinguishing the applicant’s goods or services.”<sup>43</sup> Upon acquiring distinctiveness,<sup>44</sup> an applicant can then amend the registration on the Supplemental Register to the Principal Register.<sup>45</sup>

#### ***D. Lanham Act Protection for Registered and Unregistered Trademarks***

Owners of federally registered trademarks can invoke Lanham Act protection for infringement under § 32 or unfair competition under § 43(a), while owners of unregistered marks can only invoke protection under § 43(a) upon a showing that their mark has acquired distinctiveness.<sup>46</sup> The Federal Circuit explained that marks that are not inherently distinctive can be registered upon “an adequate evidentiary showing that [the mark] had acquired a secondary meaning ‘sufficient to identify an applicant’s goods.’”<sup>47</sup>

Section 43(a) of the Lanham Act proscribes an action for “false designation of origin, or any false description or representation” in relation to goods or services.<sup>48</sup> It is also the only provision in the Lanham Act that protects unregistered marks.<sup>49</sup> Owners claiming protection under § 43(a) bear the burden of proving that in addition to the ordinary common meaning

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<sup>42</sup> 15 U.S.C. § 1091(a) (“Nothing in this section shall prevent the registration on the supplemental register of a mark, capable of distinguishing the applicant’s goods or services and not registrable on the principal register under this [Act].”).

<sup>43</sup> *Id.*

<sup>44</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992) (“The general rule regarding distinctiveness is clear: an identifying mark is distinctive and capable of being protected if it either (1) is inherently distinctive or (2) has acquired distinctiveness through secondary meaning.”).

<sup>45</sup> TMEP, *supra* n. 3, at § 816.03.

<sup>46</sup> *Id.* at § 1212.06 (“In considering a claim of acquired distinctiveness, the issue is whether acquired distinctiveness of the mark in relation to the goods or services has in fact been established in the minds of the purchasing public, not whether the mark is capable of becoming distinctive.”).

<sup>47</sup> *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1124 (Fed. Cir. 1985) (quoting *In re Hehr Mfg. Co.*, 279 F.2d 526, 528 (C.C.P.A. 1960)).

<sup>48</sup> 15 U.S.C. § 1125(a).

<sup>49</sup> *Simon & Schuster, Inc. v. Dove Audio, Inc.*, 936 F. Supp. 156, 160 (S.D.N.Y. 1996).

of the words, the mark has acquired a secondary meaning in its particular market.<sup>50</sup>

A mark acquires secondary meaning when “it [is] shown that the *primary* significance of the term in the minds of the consuming public is not the product but the producer.” Thus, the crux of the doctrine of secondary meaning “is that the mark comes to identify not only the goods but the source of those goods,” even though the relevant consuming public might not know the name of the producer.<sup>51</sup>

The six elements used to determine whether a mark has acquired secondary meaning are: 1) advertising expenditures; 2) consumer studies linking the mark to a source; 3) unsolicited media coverage of the product; 4) sales success; 5) attempts to plagiarize the mark; and 6) the length and exclusivity of the mark’s use.<sup>52</sup> However, no single factor is dispositive and every element need not be proved.<sup>53</sup>

A claim of Federal Trademark Infringement under § 32 of the Lanham Act and Unfair Competition under § 43(a) of the Lanham Act, are measured by essentially the same standard—a likelihood of consumer confusion.<sup>54</sup> Owners of federally registered marks are protected under § 32 upon a showing that the defendant’s mark is confusingly similar to their inherently distinctive mark.<sup>55</sup> Similarly, owners of unregistered marks are protected under § 43(a) upon a showing that the defendant’s competing mark will cause confusion as to the origin or sponsorship of the good or service.<sup>56</sup>

First articulated by the Second Circuit as a test, courts balance a set of variable factors and determine whether or not the alleged infringing use is likely to cause consumer confusion.<sup>57</sup> No single factor is dispositive, and the weight allotted to each factor depends on the specific scenario before the court.<sup>58</sup> Furthermore, the list of factors is not exhaustive and the analysis is

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<sup>50</sup> *Id.*

<sup>51</sup> *Centaur Communs., Ltd. v. A/S/M Communs., Inc.*, 830 F.2d 1217, 1221 (2d Cir. 1987) (citing *20th Cent. Wear, Inc. v. Sanmark-Stardust Inc.*, 815 F.2d 8, 10 (2d Cir. 1987) quoting *Ralston Purina Co. v. Thomas J. Lipton, Inc.*, 341 F. Supp. 129, 133 (S.D.N.Y. 1972) (emphasis in original)).

<sup>52</sup> *Id.* at 1222.

<sup>53</sup> *Id.*

<sup>54</sup> *A & H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 210 (3d Cir. 2000).

<sup>55</sup> 15 U.S.C. § 1114.

<sup>56</sup> *See Taco Cabana Intl. v. Two Pesos, Inc.*, 932 F.2d 1113, 1117-118 (5th Cir. 1991), *aff’d*, 505 U.S. 763 (1992).

<sup>57</sup> *See e.g. Polaroid Corp. v. Polarad Elects. Corp.*, 287 F.2d 492 (2d Cir. 1961).

<sup>58</sup> *A & H Sportswear, Inc.*, 237 F.3d at 234.



not a “mechanical process.”<sup>59</sup> The original *Polaroid* factors include: 1) the strength of the mark; 2) the similarity between the marks; 3) the similarity of the products; 4) the probability that the first owner will bridge the gap; 5) actual confusion; 6) the good faith of the junior user in adopting its mark; 7) the quality of the junior user’s product; and 8) the consumer’s level of sophistication.<sup>60</sup>

## II. CASE LAW PRECEDENT

### A. *Unprotected Single Literary Titles*

#### i. *In re Cooper*

As the Court of Customs and Patent Appeals stated, “[n]othing we say should be taken as implying that no trademark for books can be registered.”<sup>61</sup> Despite their good intentions, however, their holding in *Cooper* to affirm the PTO’s denial of registration for a book title has done just that—established precedent that books’ titles are incapable of functioning as trademarks. Citing § 2(e) of the Lanham Act, the Court held petitioner’s book title TEENY-BIG was unregistrable because it did not function as a trademark and was merely the name of the applicant’s book.<sup>62</sup>

On September 18, 1953, the petitioner sought to register TEENY-BIG as the trademark for his children’s book that told the tale of an elf with magical powers.<sup>63</sup> Denying trademark registration, the PTO found TEENY-BIG was merely the title of the book and that proprietors have no property rights in the name of a literary work that must be used to describe or identify the book.<sup>64</sup> Reviewing the PTO’s decision, the Court agreed that TEENY-BIG, although arbitrary, was descriptive because it functioned as the name of

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<sup>59</sup> *Estée Lauder Inc. v. The Gap, Inc.*, 108 F.3d 1503, 1510 (2d Cir. 1997) (citing *Arrow Fastener Co. v. Stanley Works*, 59 F.3d 384, 391 (2d. Cir. 1995)).

<sup>60</sup> *See Polaroid Corp.*, 287 F.2d 492.

<sup>61</sup> *In re Cooper*, 254 F.2d at 613.

<sup>62</sup> *Id.* at 613-14.

<sup>63</sup> *Id.* at 612.

<sup>64</sup> *Id.* at 612-13 (“[t]he name which is the only name by which an article of merchandise may be identified—whether a book or any other—is not a trademark and is therefore not registrable”).

the good, and because it was incapable of distinguishing the good of one person from the goods of another.<sup>65</sup>

The petitioner claimed the PTO examiner erred in its finding that a title of a book cannot function as a mark because there is no other way of asking for the book.<sup>66</sup> Comparing a request for the book TEENY-BIG to a request for SUNKIST oranges, the petitioner argued single titles are capable of functioning as trademarks to differentiate among the millions of books, just as brand names such as SUNKIST differentiate between the various brands of oranges.<sup>67</sup> Dismissing that argument, the Court held the petitioner's analogy was erroneous.<sup>68</sup> The Court reasoned that a request for one book out of millions is more like a request for one type of food rather than a request for a specific brand of one particular type of food.<sup>69</sup> In the Court's opinion, the more accurate analogy would involve someone asking for food, and in response to the question "What kind of food?" saying, "A can of chicken noodle soup."<sup>70</sup> The Court went on to say that titles of single literary works, no matter how arbitrary, novel or nondescriptive of a book's contents the title may be, still describe the book.<sup>71</sup> "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.'"<sup>72</sup>

The Court also addressed the petitioner's argument that granting registration to the name of a series of books is inconsistent with the PTO's decision denying registration of single literary titles.<sup>73</sup> Finding no inconsistency, the Court held the name of a series functions as a trademark because it indicates that each book in a series comes from the same source as

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<sup>65</sup> *Id.* at 615. ("While this policy is of long standing, it makes little sense. It is like saying that 'Coca-Cola' is not registrable if used only for a single type of beverage, or 'McDonalds' is not registrable if used only for hamburgers. Certainly use of a mark on a single copy of a book . . . may not be sufficient use in commerce to warrant registration. But to assert that the first [book] of a popular [author], a [book] that may have sold millions of copies, does not make the name of the [book] registrable is absurd."); TMEP, *supra* n. 3, at § 1202.08.

<sup>66</sup> *In re Cooper*, 254 F.2d at 614.

<sup>67</sup> *Id.*

<sup>68</sup> *Id.* at 614-15.

<sup>69</sup> *Id.*

<sup>70</sup> *Id.* at 615.

<sup>71</sup> *Id.*

<sup>72</sup> *Id.*

<sup>73</sup> *Id.*

the others.<sup>74</sup> “The name of the series is not descriptive of any one book and each book has [an] individual name or title.”<sup>75</sup> The Court reasoned that although the public may associate the name of a series with the general contents of each book, the series name is not the name or title of anything contained in the book but indicative that the series of books comes from the same source.<sup>76</sup> Single literary work titles, on the other hand, “especially one that is coined or arbitrary, identifies a specific literary work . . . and is not associated in the public mind with the publisher, printer, or bookseller. . . . If a title is associated with anything, it is with the author for it is he who has produced the literary work which is the real subject of purchase.”<sup>77</sup>

Dissenting, Justice Worley emphatically disagreed with the Court’s departure from prior precedent that supported the opposite conclusion.<sup>78</sup> Despite the issues in the cases being different, the court in *Whitman Publishing Co.*, held “trade-mark ownership in a mark applied to books depends upon exactly the same considerations as those by which the question of ownership is determined with respect to marks applied to any other merchandise.”<sup>79</sup> Reciting § 2(d) of the Lanham Act, the dissent found that an arbitrary title of a single literary work satisfies the Act’s requirement that the mark facilitate the capability that the petitioner’s goods can be distinguished from the goods of others.<sup>80</sup> The dissent also noted the incongruity of acknowledging that TEENY-BIG is arbitrary on one hand and descriptive on the other.<sup>81</sup>

As Justice Worley explained, the Court’s standard for denying registration of a single literary title on the basis that it would be impossible to identify a specific book without referring to it by name was also flawed.<sup>82</sup> If that were the case, consumers would never be able to request any good or commodity without referring to it by name.<sup>83</sup> Justice Worley argued that, under the majority’s reasoning, once SUNKIST became registered for

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<sup>74</sup> *Id.*

<sup>75</sup> *Id.*

<sup>76</sup> *Id.*

<sup>77</sup> *Id.*

<sup>78</sup> *Id.* at 617 (quoting *Whitman Publ. Co. v. McLouglin Bros., Inc.*, 97 F.2d 608, 611 (C.C.P.A. 1917) (“I can perceive no reason why a trade-mark may not properly be applied to a book.”).

<sup>79</sup> *Id.* (quoting *Whitman Publ. Co.*, 97 F.2d at 611).

<sup>80</sup> *Id.* at 618.

<sup>81</sup> *Id.*

<sup>82</sup> *Id.*

<sup>83</sup> *Id.*

oranges the mark would be “unavailable” for use in commerce and consumers would have to request SUNKIST oranges without using the mark SUNKIST—resulting in the quagmire of “Twenty Questions” alluded to in their opinion.<sup>84</sup> Moreover, as one commentator noted:

a registered trademark is not ‘unavailable’ to purchasers; indeed the purpose of the mark is to allow customers to call for the goods by name. . . . The only ‘unavailability’ resulting from the trademark registration is that which prevents a competitor from using the mark to identify itself as the source of the same or related goods or services.<sup>85</sup>

**ii. *Herbko Intl., Inc. v. Kappa Books, Inc.***

Upholding its predecessor’s decision in *Cooper*, the Court of Appeals for the Federal Circuit reiterated the principle that titles of single literary works are incapable of functioning as trademarks because they do not create an association between the book’s title and the source of the book.<sup>86</sup> The dispute in *Herbko International* concerned whether the publication of a single literary work created a proprietary right for purposes of trademark priority when the work was timely developed into a series.

In 1993, Kappa Books published the first in a series of crossword puzzle books under the name CROSSWORD COMPANION.<sup>87</sup> One year later, Herbko filed an application to register CROSSWORD COMPANION for its handheld device comprising scrollable rolls of crossword puzzles and claimed a first use date of September 1994.<sup>88</sup> In 1995, Kappa Books published its second CROSSWORD COMPANION book.<sup>89</sup>

In 1996, Kappa Books learned of Herbko’s use of CROSSWORD COMPANION as a registered trademark in connection with the sale of its hand held crossword device.<sup>90</sup> Claiming first use of the mark and likelihood of confusion, Kappa filed for cancellation of Herbko’s mark in 1997.<sup>91</sup> Reviewing Kappa’s petition, the TTAB found Kappa’s first use of CROSSWORD COMPANION in 1993 created an analogous use that was perfected when it published a second CROSSWORD COMPANION book in

<sup>84</sup> See *id.* at 615.

<sup>85</sup> James L. Vana, *Single Work Titles and Group, Artist or Author Names—Registrability Revisited*, 88 TMR 250, 255 (May-June 1998).

<sup>86</sup> *Herbko Intl.*, 308 F.3d at 1162-63.

<sup>87</sup> *Id.* at 1160.

<sup>88</sup> *Id.*

<sup>89</sup> *Id.*

<sup>90</sup> *Id.*

<sup>91</sup> *Id.*

1995.<sup>92</sup> The Board reasoned that proprietary rights in the title of a book series date back to the beginning of the series if the second volume in the series is published within a reasonable time.<sup>93</sup> Reversing the Board's decision, however, the Federal Circuit found perfection of analogous use requires not only timely publication of a series, but an association between the mark and the goods it represents as well.<sup>94</sup>

Citing *Cooper*, the Court held that single literary work titles cannot serve as source identifiers.<sup>95</sup> Accordingly, the Court held the title of a series will not be granted protection even when the second volume in the series has been timely published if there is no association with the series title in the public mind.<sup>96</sup> Despite the volume of sales resulting from Kappa's first book in 1993, the Court found those sales related only to the first volume and were insufficient to establish the needed public association between the books' title and publisher.<sup>97</sup> Revisiting the *In re Cooper* Court's discussion of the function of single literary titles as trademarks, the Court reiterated that single book titles are "inherently descriptive" at best and "inherently generic" at worst because they do nothing more than describe the book's contents.<sup>98</sup>

As one commentator observed:

The decision highlights the disparity in the protection accorded to single literary works. On one hand, the [PTO] will not register single titles even with proof of secondary meaning. On the other, courts have held titles may be protected under § 43(a) of the Lanham Act on a showing of secondary meaning.

[I]t [is] unfair that the owner of a famous literary work may be able to prevent use of a confusingly similar title but may not be able to prevent registration of the same mark.<sup>99</sup>

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<sup>92</sup> *Id.* at 1162.

<sup>93</sup> *Id.*

<sup>94</sup> *Id.*

<sup>95</sup> *Id.*

<sup>96</sup> *Id.* at 1163.

<sup>97</sup> *Id.*; see *In re Cooper*, 254 F.2d at 614-15 (holding the public may associate a single book title with, at most, an author or a subject, but not with the source of the book, *i.e.*, the publisher or printer).

<sup>98</sup> *Herbko Intl.*, 308 F.3d at 1164 (quoting *In re Cooper*, 254 F.2d at 614-15).

<sup>99</sup> Jennifer Elgin, *Use of Single Literary Title Does Not Create Proprietary Rights*, *Federal Circuit Holds*, 8 No. 12 *Intell. Prop. Strategist* 6 (Sept. 2002).

### B. *Single Literary Titles Possessing Secondary Meaning*

“Secondary meaning in a literary title occurs when the title is sufficiently well known that consumers associate it with a particular author’s work.”<sup>100</sup> In 1996, the United States District Court for the Southern District of New York held that the owner of a single literary title may prevent the use of the same title or a confusingly similar title by other authors when the book has acquired secondary meaning.<sup>101</sup> Simon & Schuster (the publisher) and Bennett (the author) accused Dove of trademark infringement and unfair competition and claimed protection under § 43(a) of the Lanham Act.<sup>102</sup>

In 1993, Simon & Schuster published Bennett’s book entitled *The Book of Virtues*.<sup>103</sup> The book experienced phenomenal success and as of August 9, 1995—the date of the complaint—had been on *The New York Times* bestseller’s list for 86 consecutive weeks, and sold more than 2.2 million hardcover copies.<sup>104</sup> Simultaneously, Simon & Schuster and Bennett intended to capitalize on the success of *The Book of Virtues* and developing other publications and products utilizing that name and mark, such as *The Children’s Book of Virtues* and *The Moral Compass*, to be sold as a companion book to *The Book of Virtues*.<sup>105</sup>

Simon & Schuster later published an audiobook version of *The Book of Virtues*.<sup>106</sup> Shortly thereafter, however, Dove published and sold an audiobook entitled *The Children’s Audiobook of Virtues* as the first in a line of “Dove Kids” audiobooks.<sup>107</sup> Upon learning of Dove’s audiobook through an advertisement in *Publisher’s Weekly* in February 1995, Simon & Schuster immediately requested that Dove cease and desist all infringing conduct and change the title of its audiobook.<sup>108</sup> Claiming relief under § 43(a) of the Lanham Act, Simon & Schuster and Bennett alleged Dove intentionally copied their renowned mark in an attempt to trade upon and capitalize on their goodwill and that the title of Dove’s audio book was likely to cause confusion between the competing works.<sup>109</sup>

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<sup>100</sup> *Simon & Schuster*, 936 F. Supp. at 163.

<sup>101</sup> *Id.* (citing *Grimaldi*, 875 F.2d at 998).

<sup>102</sup> *Id.* at 158.

<sup>103</sup> *Id.*

<sup>104</sup> *Id.*

<sup>105</sup> *Id.* at 158-59.

<sup>106</sup> *Id.* at 159.

<sup>107</sup> *Id.*

<sup>108</sup> *Id.*

<sup>109</sup> *Id.* at 159-60.

The Court found that since *The Book of Virtues* was not a registered mark, and Simon & Schuster were claiming protection under §43(a), Simon & Schuster bore the burden of showing the mark was at the very least descriptive and that secondary meaning had been adequately acquired.<sup>110</sup> Ultimately, the Court held the mark was descriptive and that it had acquired secondary meaning because consumers associated *The Book of Virtues* with its author—Bennett.<sup>111</sup>

### C. *Protection for Titles of Series*

In contrast, series of literary works are capable of functioning as trademarks and are afforded full trademark protection without the additional hurdle of showing secondary meaning.<sup>112</sup> As stated in *Cooper*, “[t]he name for a series . . . has a trademark function in indicating that each book of the series comes from the same source as others.”<sup>113</sup> In 1992, the TTAB held the literary title of a series could function as a trademark.<sup>114</sup> *In re Scholastic* concerned whether THE MAGIC SCHOOL BUS could be used as the mark for a series of childrens books about a science teacher and the magic yellow school bus that transported students to their adventurous field trip destinations.<sup>115</sup> Scholastic introduced evidence that the title was used on a series of books and that consumers referred to the series of books as “THE MAGIC SCHOOL BUS” series and not by the title of the individual books.<sup>116</sup> Particularly persuaded by the dominant display of the mark THE MAGIC SCHOOL BUS on the cover, the TTAB found the use of THE MAGIC SCHOOL BUS in each book’s title created a distinct commercial impression from the entire title of each book.<sup>117</sup> Accordingly, the TTAB granted THE MAGIC SCHOOL BUS trademark status because consumers associated the

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<sup>110</sup> *Id.* at 160.

<sup>111</sup> *Id.* at 163.

<sup>112</sup> Elgin, *supra* n. 99.

<sup>113</sup> *In re Cooper*, 254 F.2d at 615.

<sup>114</sup> *In re Scholastic*, 23 U.S.P.Q.2d 1774, 1779 (T.T.A.B. 1992).

<sup>115</sup> *Id.* at 1775.

<sup>116</sup> *Id.* Titles of the series include, “The Magic School Bus Inside the Earth,” “The Magic School Bus Inside the Human Body,” “The Magic School Bus Lost in the Solar System,” and “The Magic School Bus at Waterworks.”

<sup>117</sup> *Id.* at 1776. (comparing “The Magic School Bus” to “The Magic School Bus at Waterworks”).

title of each book with a series of books produced by one source, rather than associating the title of the book with one particular book.<sup>118</sup>

### III. COPYRIGHT CONCERNS

First articulated in *Cooper* and then reiterated in *Herbko International*, both courts couch their policy decision denying single literary titles trademark protection in copyright law.<sup>119</sup> While the property right in a trademark is potentially unlimited and endures as long as the trademark is in use, the property right in a valid copyright registration eventually expires availing the work to the public domain.<sup>120</sup> Furthermore, “[a] copyright on a literary work does not carry with it the exclusive right to use of the title on any other work.”<sup>121</sup> The Court of Customs and Patent Appeals found it impossible to reconcile this juxtaposition between trademark and copyright law because the right to copy a work that has entered the public domain includes the right to call the work by its name.<sup>122</sup> “When copyright in a protected work expires, ‘the use of the descriptive name becomes public juris.’”<sup>123</sup> Similarly, the Federal Circuit in *Herbko International* stated:

[a] trademark in the title to [a] 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*.<sup>124</sup>

As Justice Worley’s dissent in *Cooper* contends, the Court was overly influenced by the copyright statute and the fear that granting a single literary work trademark protection for its title would provide permanent protection to the contents of the book.<sup>125</sup> As Justice Worley observed, granting a single literary title trademark protection would not give that one book any greater degree of protection over its contents than a series of books afforded trademark protection for its title.<sup>126</sup>

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<sup>118</sup> *Id.* at 1779.

<sup>119</sup> *Herbko Intl.*, 308 F.3d at 1164; *In re Cooper*, 254 F.2d at 616.

<sup>120</sup> *In re Cooper*, 254 F.2d at 616.

<sup>121</sup> McCarthy, *supra* n. 5, at § 10:34.

<sup>122</sup> *In re Cooper*, 254 F.2d at 616.

<sup>123</sup> *Id.* (quoting *In re Page Co.*, 47 App.D.C. 195, 196 (D.C. Cir. 1917)).

<sup>124</sup> *Herbko Intl.*, 308 F.3d at 1164.

<sup>125</sup> *In re Cooper*, 254 F.2d at 619.

<sup>126</sup> *Id.*



Surprisingly, the copyright concern is miraculously moot upon a title requiring secondary meaning or becoming a series. Analogizing to another literary medium for guidance, trademark registration for titles of periodicals covers only the title, and not the contents. The contents of the periodical pass into the public domain upon copyright expiration, yet the protected title under which the contents were published remains with the publisher. Similarly, registering single literary work titles would not give publishers any greater protection over the contents of their works than publishers of series or literary works that have acquired secondary meaning. Granting single literary titles registration would actually ensure that copyrighted works entering the public domain continued to be printed under the same title rather than requiring publishers of public works to change the title as suggested by the Federal Circuit in *Herbko International*. Therefore, continuing to deny registration for single literary titles actually promotes the likelihood that other authors will re-cycle or intentionally use the titles of copyrighted works entering the public domain, undermining the intended purposes of trademark protection—prevention of consumer confusion and owner protection from unfair competition.

#### IV. ANALYSIS

##### A. *The Anomaly*

As this Note introduces, the PTO bars single literary titles registration upon the Principal and Supplemental Register because they are only descriptive and incapable of functioning as trademarks.<sup>127</sup> Not only do single literary titles merely describe the contents of books or one of the book's characters, but consumers do not associate the title of a single literary work with its source.<sup>128</sup> Enforcing the standard established by the PTO, the Court of Customs and Patent Appeals went a step further in *Cooper* when it found the meaning of a single literary title was not only descriptive, but generic, and not protectable even upon a showing of acquired distinctiveness.<sup>129</sup> Most recently, the Federal Circuit in *Herbko International* claimed to follow the precedent established in *Cooper* when it reiterated that

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<sup>127</sup> McCarthy, *supra* n. 5, at § 10:4.

<sup>128</sup> *Id.*

<sup>129</sup> *In re Cooper*, 254 F.2d at 614-15.

a single literary title does not serve to identify the source of the book,<sup>130</sup> but, instead, contributed to the inconsistency between the PTO and case law.

While holdings such as *Herbko International* purport to follow precedent established by *Cooper* and remain congruent with PTO precedent, the anomaly is perpetuated when courts grant single literary titles protection under § 43(a) of the Lanham Act because titles have acquired distinctiveness.<sup>131</sup> Barring single literary titles from registration on both the Principal Register and the Supplemental Register, the PTO has in essence mandated that single literary titles can never acquire secondary meaning and are incapable of functioning as trademarks. If, as *Herbko International* and other courts have held,<sup>132</sup> titles are capable of acquiring secondary meaning, then literary titles should be registrable upon the Supplemental Register and provided the opportunity of acquiring distinctiveness. Thereafter, applicants could amend their Supplemental Registration to the Principal Register. Such action would bring the PTO's treatment of single literary titles into conformity with that afforded other descriptive marks initially denied registration on the Principal Register under § 2(e), and bring the PTO into conformity with the single title/secondary meaning precedent carved out by case law. As noted by McCarthy:

Why [did] such a distinction . . . [arise]? Most cases now merely recite the requirement of a secondary meaning for titles of single works without stopping to consider why this should be the law. In some of the older cases, the reason given was that titles, such as book titles, are per se the descriptive indication of the literary work itself, and the only name by which the public describes the work.<sup>133</sup>

As the TMEP observes, this reasoning makes little sense.<sup>134</sup> “It is like saying that ‘Coca-Cola’ is not registrable if used only for a single type of beverage, or ‘McDonalds’ is not registrable if used only for hamburgers.”<sup>135</sup> Moreover, single literary titles are supposedly not capable of functioning as trademarks

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<sup>130</sup> *Herbko Intl.*, 308 F.3d at 1161-62 n. 2 (“While titles of single works are not registrable, they may be protected under § 43(a) of the Lanham Act upon a showing of secondary meaning.”).

<sup>131</sup> See *Simon & Schuster*, 936 F. Supp. at 163 (consumers associating the book's title with the author sufficient to show title had acquired secondary meaning and distinctiveness for protection under § 43(a) of the Lanham Act).

<sup>132</sup> See e.g. *EMI Catalogue Partn. v. Hill, Holliday, Connors, Cosmopolos, Inc.*, 228 F.3d 56, 63 (2d Cir. 2000), *amended*, 2000 U.S. App. Lexis 30761 (2d Cir. 2000); *Sugar Busters LLC*, 177 F.3d at 269 (all single book titles are viewed as descriptive of the contents and require proof of secondary meaning).

<sup>133</sup> McCarthy, *supra* n. 5, at § 10:3.

<sup>134</sup> TMEP, *supra* n. 3, at § 1202.08.

<sup>135</sup> *Id.*

because a single title cannot function as a source identifier. Yet, three years prior to the *Cooper* decision, the Second Circuit stated that it doesn't matter whether or not customers know exactly who the source of a product is.<sup>136</sup> Thus, the PTO's continued insistence that single literary titles are not within the scope of trademarks—because consumers do not associate a single title with its source—is a desperate attempt to cling to the outdated view that trademarks can never indicate an anonymous source. Conversely, the modern view accepts that “the ‘source’ identified by a trademark need not be known by name to the buyer.”<sup>137</sup> Indeed, the buyer does not need to know, or even care about, who made the product or distributed it.<sup>138</sup>

*Cooper* and *Herbko International* held the public may associate a single book with, at most, an author or a subject, but not with the source of the book—the publisher.<sup>139</sup> Contrary to that reasoning, however, both courts stated the title of a literary series is entitled to protection—and registrable—when consumers associate the title with the same author as the others.<sup>140</sup> Contributing to the Federal Circuit's incompatible reasoning, the Southern District of New York held a single literary title had acquired distinctiveness *because consumers associated the book with its author*.<sup>141</sup> Hence, not only are the practices of the PTO anomalous to case law, but case law is inconsistent among the various federal jurisdictions.

### **B. Ramifications**

Denying single literary titles registration on the Principal and Supplemental Register significantly impacts an owner's protection under the Lanham Act. Owners of federally registered marks are able to bring an action for infringement of their mark under § 32 of the Lanham Act, and have the rebuttable presumption that their mark is distinctive. Owners of unregistered single literary titles, on the other hand, can only seek protection under § 43(a) of the Lanham Act and bear the burden of showing their unregistered title has acquired distinctiveness which is extremely costly. As alluded to by J. Elgin, preventing owners from registering single literary titles increases the possibility of other literary works possessing the same

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<sup>136</sup> See *Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches, Inc.*, 221 F.2d 464, 466 (2d Cir. 1955).

<sup>137</sup> McCarthy, *supra* n. 5, at § 3:9.

<sup>138</sup> *Id.*

<sup>139</sup> *Herbko Intl.*, 308 F.3d at 1163; *In re Cooper*, 254 F.2d at 614-15.

<sup>140</sup> *Id.*

<sup>141</sup> *Simon & Schuster*, 936 F. Supp. at 163 (emphasis added).

title or the mark being used by a competitor on another product.<sup>142</sup> While owners are able to bring an action under § 43(a) of the Lanham Act for unfair competition against a confusingly similar title, owners can do nothing to prevent registration of the same mark.<sup>143</sup> Not only is this contrary to the purpose of protecting owners from infringing uses of their mark, but it undoubtedly breeds consumer confusion.

## V. CONCLUSION

Either single literary titles should be incapable of acquiring distinctiveness per se, or the PTO should allow owners of merely descriptive single literary titles registration on the Supplemental Register until such time that they acquire distinctiveness. As dictated by case law, single literary titles are capable of acquiring distinctiveness through secondary meaning. Moreover, titles do not need to be indicative of a book's source (the publisher) to acquire distinctiveness; an association between the book's title and its author is sufficient.<sup>144</sup>

Despite the PTO's belief that books do not constitute a protectable class of goods and are nothing more than artistic expression, they are commodities sold in the marketplace. As such, owners of single literary titles should be able to protect themselves from unfair competition and be afforded the same federal protection mechanisms as all other classes of goods. Similarly, consumers have a right to be protected from being confused between different books bearing the same title.<sup>145</sup> While granting single literary titles registration on the Supplemental Register may not yield any greater federal protection immediately, it would at least prevent use of the same or similar title. In this manner, the federal register would more accurately reflect the marketplace because consumers would be less likely to encounter books from different sources bearing the same title. Rectifying the anomaly would also cease any perpetuation of inconsistent case law among jurisdictions and ultimately provide protection for both consumers and single literary title owners.

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<sup>142</sup> Elgin, *supra* n. 99.

<sup>143</sup> *Id.*

<sup>144</sup> *Simon & Schuster*, 936 F. Supp. at 163.

<sup>145</sup> A visit to your local library might surprise you how many books share the same title. Reference librarians at the Concord, NH, Public Library regularly help patrons who are unfamiliar with the author, or publisher, of a book find the "actual" book they are searching for. Reserving books for patrons over the telephone only exacerbates the problem.