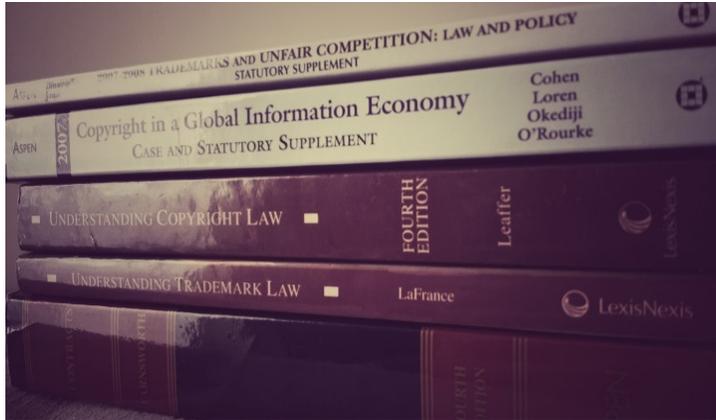


## Notes for Authors: Protecting Your Book Title

For authors seeking to acquire trademark protection of their literary titles, navigating the application and prosecution with the United States Patent & Trademark Office (USPTO) can be quite difficult. The essential purpose of a trademark is to serve as a source identifier for particular goods and/or services, giving notice to consumers that the goods and/or services are quality controlled by a specific supplier. The trademark must be unique, not immediately conveying the nature of the goods and services and for federal protection must meet the standard of arbitrary, fanciful or suggestive. Under existing trademark law, single literary titles are not eligible for federal trademark protection because the title of a literary work is inherently descriptive and cannot serve as a source identifier.<sup>1</sup> A trademark that describes the goods and/services it is associated with is not eligible for federal protection. For authors there are three likely ways to overcome this hurdle; 1) the title can acquire secondary meaning over time, 2) the title becomes the title of a series of books or 3) the title is associated with other goods and services produced as a single brand.



1 Trademark Protection for book titles can be difficult to acquire.

Under trademark law, a trademark is deemed to have acquired secondary meaning when the mark has come to develop and convey a different message in the minds of consumers than what it immediately states. One example of this is HOLIDAY INN which is known for more than identifying an inn for stays during the holidays. Developing this type of meaning can take a lot of time and marketing resources and would still be unlikely in the case of a book title.

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As a secondary option, the title of a series of books can serve as a trademark, identifying the source of a collection of various literary works. In these cases, the trademark is not deemed as descriptive because it points to the source of multiple works, e.g. the FOR DUMMIES series, instead of being the identifier of a single work. Alternatively, copyright law provides immediate

<sup>1</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.").

protection of the literary work as a whole. However for authors seeking to expand the brand of their book, trademark protection is best. Unfortunately, these authors will have to wait until a second book is published and this leaves the author's book title unprotected by trademark law until that time.

The third option for acquiring trademark protection for a book title is to apply for registration of the brand as it applies not only to the book but also other products and services of the author. For example, the author of a book about business services may also be producing newsletters, blogs, seminars, consulting services, etc. Keeping all of these products and services under one brand not only creates a valuable enterprise for the author but also allows for trademark protection of the book and suite of products and services because the trademark has secondary meaning beyond simply being a book title.

Every author's project will be unique and as such an attorney should be consulted to determine the best approach for acquiring protection.

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