

Harry Potter And The Unregistrable Trademark: Beware The Pitfalls of
Trying to Trademark Your Book Title
by LaVar Oldham

Obtaining a trademark registration for the title of your new book may not be as simple as you think. The uninitiated may simply believe that their book title, particularly when that book title includes a trademark used for other goods and services, should be a registerable trademark to identify the source of the book. However, the issues are more complex than that.

As a rule, all or a portion of the title of a single book is not registerable as a trademark. This has been true since the 1958 case of *In re Cooper*, 254 F.2d 611, 615-16 (C.C.P.A. 1958). However, obtaining a trademark registration for the title of a series of books is allowed. Thus, in the titular example, 'Harry Potter' has been successfully registered as a trademark for books. The first registration I was able to find was after the second book in the series was published.

Note, however, that there are additional considerations with this example. First, marks that merely identify a character in a creative work, whether used in a series or in a single work, are not registerable. See *In re Scholastic Inc.*, 223 USPQ 431, 431 (TTAB 1984) (holding THE LITTLES, used in the title of each book in a series of children's books, does not function as a mark where it merely identifies the main characters in the books). However this can be overcome by providing evidence that the character name does not merely identify the character in the work. Thus, for example, putting the character name on the spine of the book, using alternative fonts for the character name, using the name on displays associated with the book, using the character name in conjunction with a UPC barcode on the book, etc., apart from the title itself, may be sufficient to show the character name does not merely identify a character in the book. Note that these and other strategies may be useful, even when the mark is not a character in the book, to show the use of the mark, as a mark, and not merely as part of the title of a book.

Second, it is important that the mark be used consistently to avoid the creation of multiple different commercial impressions. Thus, for example, books titled 'Harry Potter And The Unregistrable Trademark' and 'Harry Potter's Intellectual Property Advice' would likely not be considered to be a series for purposes of trademarking 'Harry Potter' as 'Harry Potter' and

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'Harry Potter's' may be considered to be two distinct commercial impressions.

Note that a revised edition may be sufficient to create a series. However, a hardback, and a paperback version of that hardback, do not constitute a series, even if the hardback includes a blooper or preview section.

Similar rules apply to movies and audio works. If you need help navigating the complexities of obtaining trademark protection for an aspect of your creative work, the trademark attorneys at Workman Nydegger have the expertise and experience to help you navigate the process.