

Semiannual Guide to Expert Witnesses

# Los Angeles Lawyer

A portrait of Jonathan L. Handel, a man with short dark hair, wearing a dark suit, a black shirt, and a patterned tie. He is looking directly at the camera with a neutral expression.

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**Workplace  
Surveillance**  
page 29

Los Angeles lawyer  
Jonathan L. Handel  
offers strategies  
for overcoming  
the prohibition  
against trademarking  
movie titles page 22

## Mark My Words

**PLUS**

**Interpreters in Litigation page 12**

**Off-Label Uses of Medical Devices page 18**

**Claims Trading in Bankruptcy page 34**

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by Jonathan L. Handel

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# MARK MY WORDS

While single-work titles may not be federally registered, other legal strategies are available to protect a movie title

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**TITLES ARE TROUBLESOME.** Case law and U.S. Trademark Office rules provide that while the title of a series of creative works—such as books or movies<sup>1</sup>—can be registered for trademark protection, the title of a single work cannot.<sup>2</sup> The distinctiveness of the title is irrelevant to the doctrine. Single-work titles<sup>3</sup> are deemed per se “inherently descriptive” or “inherently generic”<sup>4</sup> and thus incapable of the necessary distinctiveness for registration.

This judicial fiction applies regardless of how arbitrary or fanciful—that is, distinctive—the title might actually be.<sup>5</sup> Thus, under this doctrine, *Pulp Fiction* and *The 40-Year-Old Virgin*, as the titles of single movies, would not be registrable, whereas *Harry Potter*, as the title of a series of movies, would be. Even if a single-work title has acquired secondary meaning—essentially, significant recognition among the public<sup>6</sup>—it will not be eligible for registration.<sup>7</sup>

While the prohibition is not statutory,<sup>8</sup> it is seemingly absolute. The leading case, *In re Cooper*, although 50 years old,<sup>9</sup> has been con-

sistently followed by courts to this day with little explanation.<sup>10</sup> Moreover, the Trademark Office has stated flatly, “The title of a single creative work is not registrable on the Principal Register or the Supplemental Register.”<sup>11</sup> While some might cheer a legal doctrine that protects young wizards and leaves gun-toting mobsters and late bloomers to their own devices, the difference in treatment between single-work titles and series titles is peculiar and has been soundly criticized.<sup>12</sup>

Many of the criticisms are valid. Still, lawyers may not be aware that there are a variety of approaches to single-work title registration that circumvent—or, at least, circumnavigate—the accepted doc-

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trine. With one exception,<sup>13</sup> these approaches have not been previously discussed in the literature.

First, a practical question—why bother registering? It is not as though single-work titles altogether lack protection. For example, federal unfair competition law under Section 43(a) of the Lanham Act<sup>14</sup> provides protection for some single-work titles.<sup>15</sup> However, this route is difficult and unsatisfactory. The title owner must show that the title has achieved secondary meaning even if it is distinctive,<sup>16</sup> and this, in turn, is a question of fact with a high burden of proof.<sup>17</sup> Meeting the burden may require consumer surveys, proof of significant advertising expenditures, media coverage, and/or other evidence.<sup>18</sup> State unfair competition law may provide protection as well but is generally subject to the same difficulties.<sup>19</sup> Moreover, protection under California unfair competition law is even more limited than under federal law, because state case law does not permit enjoining use of an infringing title and instead requires only a disclaimer by the junior user.<sup>20</sup>

Under some circumstances, contract law may provide protection, but this is true only when there is privity.<sup>21</sup> The applicable contract can range from an agreement between two parties regarding a specific title to a multiparty agreement relating to the use of titles. The Title Registration Bureau of the Motion Picture Association of America (MPAA) is an example of the latter.<sup>22</sup> However, the Bureau only protects titles registered by members of the Bureau, which consists of the major studios and other companies that choose to sign up—and only protects the titles against use by other Bureau members.<sup>23</sup> Nonmembers are beyond the MPAA's reach.<sup>24</sup>

In contrast, federal trademark registration has none of the limitations of unfair competition or contract law or the MPAA system and, instead, has many benefits that those approaches do not. One key advantage is a set of evidentiary presumptions: Federal registration constitutes prima facie evidence of 1) the validity of the mark, 2) the registrant's ownership of the mark, and 3) the registrant's exclusive right to use the mark in commerce or in connection with the goods or services specified in the registration.<sup>25</sup> In addition, a registrant whose mark has been infringed may be able to obtain costs, treble damages, and attorney's fees; destruction of infringing goods; and prevention of importation of infringing goods.<sup>26</sup> These presumptions and potential remedies are powerful tools in any contest with a potential infringer and can not only help settle a dispute early but also reduce the likelihood of infringement altogether.

Even more powerful is a benefit available if a mark survives the first five years of its use in commerce. At that time, with the filing of a simple Trademark Office form, the mark becomes "incontestable."<sup>27</sup> This status means, among other things, that the registration becomes conclusive proof of the validity of the mark<sup>28</sup> and is thus a powerful deterrent to infringing use.

Federal registration also constitutes constructive notice of the registrant's claim of ownership of the mark.<sup>29</sup> Moreover, federal registrations and applications appear in commercially available trademark and title clearance reports that are customarily used in the entertainment industry. This provides an additional deterrent to would-be infringers and their errors and omissions (E&O) carriers.<sup>30</sup>

Yet another advantage of federal trademark law is the ability to apply for registration on an intent-to-use (ITU) basis.<sup>31</sup> While "actual use" applications are filed after the mark has been used in commerce, ITU applications are filed based on a bona fide intent to use the mark in commerce.<sup>32</sup> The application must first overcome substantive bars against registration, and once it does so and the registration is allowed, the registration will issue when the mark is used in commerce.<sup>33</sup> ITU applications in effect allow the applicant to reserve a name for a period of up to about four and one-half years because it can take up to 18 months to obtain a Notice of Allowance, and then the applicant generally is allowed up to three years to begin

using the mark in commerce.<sup>34</sup> The ability to reserve a mark in this fashion is a powerful commercial tool, since the title owner avoids spending money establishing a mark only to later discover that registration is not achievable.

## Federal Registration

Thus there are powerful reasons to seek federal registration of single-work titles—and, despite the contrary rule, this type of registration may be possible to obtain. The technique for doing so requires a review of the system by which goods and services are classified for purposes of trademark registration.

Trademarks—whether designating goods or services<sup>35</sup>—are registered in one or more International Classes according to the nature of the goods or services represented by the mark.<sup>36</sup> A close reading of the list of International Classes,<sup>37</sup> or a quick search of some existing registrations,<sup>38</sup> suggests an interesting question: Under what class should motion pictures be registered?

On the one hand, there is Class 41, which encompasses a number of services, including "entertainment." This seems simple enough and, indeed, a variety of movie series titles are registered in this class. Harry Potter, for example, is registered in Class 41 for "motion picture theatrical films," among other things.<sup>39</sup>

On the other hand, a movie today is more often watched on DVD than in a theater, and a DVD is a good, not a service. Further exploration of the list of International Classes reveals Class 9, a grab bag of goods ranging from viewfinders to vending machines, and even computer heat sinks—everything, it seems, but the kitchen sink (which is found in Class 11). Notably, Class 9 includes "recording discs," "apparatus for recording, transmission or reproduction of sound or images," and "cinematographic, [and] optical...apparatus."

These Class 9 descriptions seem broad enough to encompass DVDs, and indeed they do. Thus, Harry Potter is also registered in Class 9, for "digital versatile discs" (DVDs) and for "[m]otion picture films."<sup>40</sup> So, as a result of magic taught at the Hogwarts School of Trademark Law, Harry Potter identifies a single thing—a series of movies—as both a good and a service. Wizardry this may be, but it is clear that the Trademark Office approves, since the same duality is reflected in the office's compendium of recommended phraseologies for identification of goods and services.<sup>41</sup>

Interestingly, neither the forms in the Trademark Office's *U.S. Acceptable Identification of Goods and Services Manual* nor the Harry Potter registrations explicitly recite that the subject matter is a series of DVDs or films. Indeed, the Trademark Office's Examination Guide on the subject expressly provides that the identification of goods need not reflect their series nature.<sup>42</sup> Accordingly, one naturally wonders whether the Trademark Office has registered titles that are not series titles at all. The answer is yes. Although the Trademark Office has stated that it will not register titles of single creative works, it has done exactly that, on several occasions.

One example is *Reservoir Dogs*,<sup>43</sup> registered for "[p]re-recorded video-cassettes, video discs and DVDs featuring general entertainment," in Class 9. This registration is almost as interesting as the movie itself, because it is a trademark registration for the title of a single work—a movie without sequels, prequels, or spinoffs. The registration is relatively recent (2002) and the file shows only a single specimen of use in Class 9—a photo of a DVD box cover.

Nor is *Reservoir Dogs* a lone wolf. There are at least two other registered marks for single-work movie titles: *The Blair Witch Project* (2003)<sup>44</sup> in Class 9, and *Judge Dredd* (2005)<sup>45</sup> in Classes 9 and 41. In addition, a pending application in Class 9 for the single-work title *Enter the Matrix*<sup>46</sup> was approved for publication (and has been published), notwithstanding a statement of record by the applicant that the mark relates to a single motion picture.<sup>47</sup>

Registration of a single-work title does raise two questions. The



first is whether failure to disclose that the mark is the title of a single work constitutes fraud on the Trademark Office.<sup>48</sup> It appears not, because the failure to disclose facts that help show that registration is barred for descriptiveness is not fraud on the Trademark Office.<sup>49</sup> Indeed, the *Reservoir Dogs*, *Blair Witch*, and *Judge Dredd* registrations were obviously the result of applications filed notwithstanding the single-work title rule. This approach to registration is no doubt aggressive, as it amounts to a sotto voce challenge to a longstanding, if flawed, rule. However, the leading trademark treatise has approved taking an aggressive approach to a similar matter, stating that “[a]s a matter of strategy, an applicant should not in [a trademark application] concede that the [proposed mark] falls within any of the statutory bars of § 2(e) which require proof of secondary meaning under § 2(f).”<sup>50</sup>

Second, one may ask whether a single-work title registration would survive legal challenge. Perhaps it would not. If the above registrations are viewed as mistakes, then the fact that they achieved registration has no precedential value.<sup>51</sup> Nonetheless, even a vulnerable registration is likely to cause a prospective infringer to choose another title rather than incurring the expense and several-year delay that result from litigating.

In addition, if a title achieves registration and survives the first five years of its use in commerce, the owner can then file for incontestability. As a result, the mark may no longer be challenged because it is descriptive,<sup>52</sup> which is one basis on which the rule against registration of single-work titles is founded.<sup>53</sup> Thus, incontestability may insulate registration of a single-work title from challenge based on the rule against such registrations.

### Federal Intent-to-Use Application for a Series

If the above approach is refused by the Trademark Office, another way to approach federal registration is to extend the time for filing specimens of actual use. During the remaining time period, the title owner can release an actual sequel to the first movie,<sup>54</sup> thereby creating a series.<sup>55</sup>

As a practical matter, this technique provides some protection for the title even before the series has been created. The use of the single-work title by a third party is deterred during the pendency of the ITU application—even though the third-party use is not enjoined until the registration issues (if in fact it does).<sup>56</sup> In addition, even if a series ultimately is never created and the application expires, by that time secondary meaning may have been achieved, allowing protection under Section 43(a) of the Lanham Act.<sup>57</sup> Also, the expired application will continue to appear in trademark and title reports, providing notice not otherwise available under a Section 43(a) approach.

An ITU strategy may engender an objection that when the trademark application is filed, the studio might not have a bona fide intent to create a series because it may not know at that time whether it intends to release a sequel. However, the term “bona fide intent”

encompasses the possibility that the trademark applicant may conduct market research, product or service development, and promotional activities before deciding whether to release a product with the proposed mark.<sup>58</sup> Since the release of a movie often serves effectively as a market test to determine franchise potential, the objection seems without merit.

### State Registration

Yet another approach for protecting a single-work title is to bypass federal registration altogether. Although seldom discussed, each state has its own state trademark registration system.<sup>59</sup> The examination process is typically cursory, and registration is almost always achieved in a matter of weeks (and at a lower filing fee than federal registration).<sup>60</sup> One limitation, however, is that applications must be based on actual use, not intent to use.<sup>61</sup> Notably, none of the states appears to have rules against registration of single-work titles, although state courts may choose to impute federal substantive requirements when interpreting state trademark statutes.<sup>62</sup>

State registration provides few, if any, substantive legal bene-

fits, and state rights are limited by concerns regarding territoriality.<sup>63</sup> Nonetheless, state registrations show up in trademark and title reports and are therefore likely to have a deterrent effect.<sup>64</sup> Also, state registrations are more difficult for a challenger to cancel than federal registrations, because generally no administrative procedure exists for the cancellation of state trademarks. Instead, the opponent of the registration has to file a civil action.<sup>65</sup>

For these reasons, registration in key states—such as California, New York, and others of particular commercial or strategic value—is useful. Although state trademarks may be Lilliputian, a group of them can help tie down potential title poachers.

### Foreign Registration

It is also possible to protect single-work titles using foreign trademark registrations<sup>66</sup>—and this approach can even be used to protect the titles within the United States. Canada and the EU are the most significant jurisdictions to consider.

Registration in Canada offers interesting possibilities for those seeking to protect a motion picture title. On the one hand, Canada is obviously not bound by the U.S. doctrine against registration of single-work titles and indeed, no such prohibition exists in Canada.<sup>67</sup> On the other hand, in the U.S. film industry, English-speaking Canada is treated along with the United States as part of a unitary “domestic” territory for contractual and marketing purposes.<sup>68</sup> Thus, a registration in Canada, whether on a proposed use<sup>69</sup> or actual use basis, will have the practical effect of blocking a third party from using a confusingly similar title not just in Canada but also in the United States. It is unlikely that a studio will wish to market a movie under two separate titles within the single domestic territory.

Likewise, it is possible in the EU to register single-work titles for



trademark protection.<sup>70</sup> By registering for an EU-wide Community Trade Mark (CTM), one gains protection in much of Western Europe, including several foreign territories considered key in the international film distribution business.<sup>71</sup>

Although an EU registration does not preclude use of the title in the United States, it may have some deterrent effect, albeit less so than Canadian registration. This effect arises from the transnational nature of Internet-based film marketing. Movie Web sites—including a film’s “official” Web site, fan sites, and movie review sites—are available throughout the world. The inability to use a consistent English-language title across these online venues makes even a simple reference to the movie more difficult,<sup>72</sup> which is clearly a commercial disadvantage.

It may be possible to obtain U.S. registration, or its equivalent, by virtue of the foreign registration. This is accomplished using Lanham Act provisions that implement two of the major trademark treaties—the Paris Convention and the Madrid Protocol.<sup>73</sup> In both cases, however, there are two limitations to overcome. The first is that these provisions are intended primarily for the benefit of foreign registrants—that is, persons or entities that are nationals of or domiciled in a foreign country that is signatory to one of the treaties. However, there is a useful exception for U.S. entities that have a “real and effective industrial or commercial establishment” in the foreign country.<sup>74</sup> This “establishment” can include production facilities, business offices, or personnel.<sup>75</sup> Thus, distribution or film production offices should suffice.

The second limitation is that both provisions are subject to all the usual bars to registration.<sup>76</sup> This means that the supposedly absolute rule against registration of single-work titles would prevent use of the foreign registration for Paris or Madrid purposes. Nevertheless, the Trademark Office does not always scrupulously enforce this rule. Thus, not surprisingly, there is at least one example of an otherwise-barred mark achieving registration in this fashion: *Mamma Mia!*, the title of a musical based on songs of the 1970s pop group Abba.<sup>77</sup>

There is yet another, potentially helpful twist: The Lanham Act provision regarding the Paris Convention provides that if an internationally registered mark is not entitled to registration on the Principal Register, it can be registered on the Supplemental Register.<sup>78</sup> As applied to single-work titles, this provision suggests a partial end run around the single-work title rule, which bars registration on either register. Once registered on the Supplemental Register, the registered trademark symbol ® can be used in connection

with the mark, and the mark will show up in trademark and title searches—both with possible deterrent effect.<sup>79</sup>

In a mystery film, the culprit is sometimes hiding in plain sight. So, too, are solutions for those who seek to protect single-work titles. Parties seeking to protect a movie title should consider rounding up some less-than-usual suspects. Indeed, they can achieve their goal by using a variety of available trademark registration approaches, which can be used singly or in concert. Unless and until the law changes, the work-arounds suggested here—most of them previously unexplored—allow the creators of distinctive titles to attain practical protection. ■

<sup>1</sup> See Trademark Examination Guide 04-06: Registrability of Marks Used on Creative Works §IV.1 (Nov. 14, 2006), available at [www.uspto.gov/web/offices/tac/notices/examguide4-06.htm](http://www.uspto.gov/web/offices/tac/notices/examguide4-06.htm); TRADEMARK MANUAL OF EXAMINING PROCEDURE §1202.08 (4th ed. 2005), available at [tess2.uspto.gov/tmdb/tmep/](http://tess2.uspto.gov/tmdb/tmep/) (last visited July 21, 2007) (hereinafter TMPEP).

<sup>2</sup> See *In re Cooper*, 254 F. 2d 611 (C.C.P.A. 1958), cert. denied, 358 U.S. 840 (1958); *Herbko Int'l. Inc. v. Kappa Books, Inc.*, 308 F. 3d 1156 (Fed. Cir. 2002); TMPEP §§1202.08, 1301.02(d); 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§10:3, 4, 4.10, 6 (4th ed. 2004) (hereinafter MCCARTHY). Nor can titles of either sort be copyrighted. See 37 C.F.R. §202.1(a); 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §2.16 (2000).

<sup>3</sup> See James L. Vana, *Single Work Titles and Group, Artist or Author Names—Registrability Revisited*, 88 TRADEMARK REP. 250 (1998) (source for phrase “single-work title”).

<sup>4</sup> See *Cooper*, 254 F. 2d at 615 (“[H]owever arbitrary, novel or nondescriptive of contents the name of a book—its title—may be, it nevertheless describes the book.”); *Herbko*, 308 F. 3d at 1164 (stating that precedent treats single-work titles as “‘inherently descriptive’ at best and ‘inherently generic’ at worst”); 2 MCCARTHY §10:4 n.1.50 (Trademark Office views titles as “not just ‘descriptive,’ but ‘generic.’”).

<sup>5</sup> See *Cooper*, 254 F. 2d at 615.

<sup>6</sup> See 2 MCCARTHY §15:2.

<sup>7</sup> See 2 MCCARTHY §10:4.

<sup>8</sup> See Lanham Act (Trademark Act) §§2(a)-(e) (15 U.S.C. §§1052(a)-(e)) (listing grounds for refusal to register).

<sup>9</sup> See *Cooper*, 254 F. 2d 611.

<sup>10</sup> See, e.g., *Herbko Int'l Inc. v. Kappa Books, Inc.*, 308 F. 3d 1156 (Fed. Cir. 2002); Vana, *supra* note 3, at 253; 2 MCCARTHY §10:4 nn.6-6.50.

<sup>11</sup> TMPEP §1202.08 (citing *Herbko*, 308 F. 3d 1156, and *Cooper*, 254 F. 2d 611).

<sup>12</sup> See, e.g., 2 MCCARTHY §§10:3, 4, 4.10; Vana, *supra* note 3, at 252-56.

<sup>13</sup> See text, *infra*.

<sup>14</sup> See Lanham Act §43(a) (15 U.S.C. §1125(a)).

<sup>15</sup> See *Herbko*, 308 F. 3d at 1162 n.2; 2 MCCARTHY §§10:1-10:3.

<sup>16</sup> See 2 MCCARTHY §§10:1-10:3.

<sup>17</sup> See 2 MCCARTHY §§10:10-10:13, 15:21.

<sup>18</sup> See 2 MCCARTHY §§10:13, 15:21.

<sup>19</sup> See 2 MCCARTHY §§10:1 n.1, 10:35 nn.11-12.

<sup>20</sup> See 2 MCCARTHY §10:35 nn.11-12.

<sup>21</sup> See Victor S. Netterville & Barry L. Hirsch, *Piracy and Privilege in Literary Titles*, 32 S. CAL. L. REV. 101, 115, 146-47 (1959).

<sup>22</sup> See generally Memorandum of the Title Committee

of the Motion Picture Association of America, Inc. (May 1, 2007) (on file with author); Edward Robert McCarthy, *Comment: How Important Is a Title? An Examination of the Private Law Created by the Motion Picture Association of America*, 56 U. MIAMI L. REV. 1071 (July 2002).

<sup>23</sup> See *id.*

<sup>24</sup> See *id.*

<sup>25</sup> See Lanham Act §7(b) (15 U.S.C. §1057(b)), §33(a) (15 U.S.C. §1115(a)).

<sup>26</sup> See Lanham Act §§35(a) & (b), 36, 42 (15 U.S.C. §§1117(a) & (b), 1118, 1124).

<sup>27</sup> See 6 MCCARTHY §32:140.

<sup>28</sup> See Lanham Act §33(b) (15 U.S.C. §1115(b)).

<sup>29</sup> See Lanham Act §22 (15 U.S.C. §1072).

<sup>30</sup> Producers are customarily required by financiers and distributors to carry E&O insurance. See, e.g., 2 DONALD C. FARBBER, ENTERTAINMENT INDUSTRY CONTRACTS (2002), Form 15-1 (Production-Financing-Distribution Agreement), §5 & cmt. 15; Form 17-1 (Acquisition and Distribution Agreement), §8 & cmt. 8.

<sup>31</sup> See Lanham Act §1(b)(1) (15 U.S.C. §1051(b)(1)); TMPEP §1101.

<sup>32</sup> See *id.*

<sup>33</sup> See Lanham Act §§1(c) & (d)(1) (15 U.S.C. §§1051(c) & (d)(1)); TMPEP §1103.

<sup>34</sup> See Lanham Act §§1(d)(1) & (2) (15 U.S.C. §§1051(d)(1) & (2)); TMPEP §1108.02(f).

<sup>35</sup> The word “trademark” is ambiguous. Sometimes the word “mark” is used instead to embrace both trademarks (for goods) and service marks (for services). Cf. 1 MCCARTHY §4:19.

<sup>36</sup> See 5 U.S.C. §1112; 37 C.F.R. §2.85.

<sup>37</sup> See 37 C.F.R. §6.1.

<sup>38</sup> See the Trademark Office registration database, available at [www.uspto.gov](http://www.uspto.gov).

<sup>39</sup> Reg. nos. 2568097 (word mark), 2574410 (design mark).

<sup>40</sup> Reg. nos. 2525908 (word mark), 2526111 (design mark).

<sup>41</sup> See U.S. ACCEPTABLE IDENTIFICATION OF GOODS AND SERVICES MANUAL, available at [tess2.uspto.gov/netahtml/tidm.html](http://tess2.uspto.gov/netahtml/tidm.html) (last visited Feb. 27, 2008) (hereinafter MANUAL); TMPEP §1402.04.

<sup>42</sup> See Trademark Examination Guide 04-06, *supra* note 1, at §IV.5.

<sup>43</sup> Reg. no. 2640668.

<sup>44</sup> Reg. no. 2800585.

<sup>45</sup> Reg. no. 3007341.

<sup>46</sup> Serial no. 78135234.

<sup>47</sup> See Response to First Office Action (May 2, 2003), at 5.

<sup>48</sup> Cf. Lanham Act §38 (15 U.S.C. §1120).

<sup>49</sup> See 6 MCCARTHY §31:69 n.5; *Bart Schwartz Int'l Textiles, Ltd. v. Federal Trade Comm'n*, 289 F. 2d 665, 669 (C.C.P.A. 1961).

<sup>50</sup> See 3 MCCARTHY §19:11.

<sup>51</sup> See *In re Nett Designs Inc.*, 236 F. 3d 1339, 1342 (Fed. Cir. 2001); *In re The Signal Cos., Inc.*, 228 U.S.P.Q. 956, 1986 TTAB LEXIS 167, at \*9 n.9 (T.T.A.B. 1986).

<sup>52</sup> See *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189 (1985); see also 2 MCCARTHY §13:36; *John R. Thompson Co. v. Holloway*, 366 F. 2d 108, 113 (5th Cir. 1966).

<sup>53</sup> See text, *supra*, at note 2. However, some cases alternately suggest that titles may be generic. See *id.* If this interpretation is adopted, then incontestability will not shield a single-work title registration from challenge, because a challenge based on the generic nature of a mark is an exception to incontestability. See Lanham Act §15(4) (15 U.S.C. §1065(4)); 6 MCCARTHY §12:60 nn.6-8, 32:149 nn.13-14.

<sup>54</sup> See David J. Kera & Theodore H. Davis, Jr., ANNUAL REVIEW: A. UNITED STATES: THE FIFTY-SIXTH YEAR OF ADMINISTRATION OF THE LANHAM TRADEMARK ACT OF

1946, 94 TRADEMARK REP. 1, 28 (Jan.-Feb. 2004).

<sup>55</sup> See *Herbko Int'l. Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1163 (Fed. Cir. 2002).

<sup>56</sup> See 3 MCCARTHY §§19:26, 19:30 n.2.

<sup>57</sup> See text, *supra*, at notes 13-16.

<sup>58</sup> See TMEP §1101; 37 C.F.R. §2.89(d) (Trademark Rules of Practice); 3 MCCARTHY §19:14 n.12.

<sup>59</sup> See 3 MCCARTHY §22; INTERNATIONAL TRADEMARK ASSOCIATION, STATE TRADEMARK AND UNFAIR COMPETITION LAW (2006).

<sup>60</sup> See JAMES E. HAWES & AMANDA DWIGHT, 2 TRADEMARK REGISTRATION PRACTICE §22:1 (2d ed. 2007); 5 GILSON §36.01.

<sup>61</sup> See 3 MCCARTHY §22:1 n.9, 22:10.

<sup>62</sup> Cf. 3 MCCARTHY §22:7 (appropriate for court to rely on Lanham Act case law in interpreting state trademark statutes); Andrew L. Goldstein, *Dilution Law: At a Crossroad? Bringing the Model State Trademark Bill into the 90s and Beyond*, 83 TRADEMARK REP. 226, 234 (1993) (same) (citing cases). Such imputed requirements could include the rule against single-work title registration, although there appear to be no cases on point.

<sup>63</sup> See 3 MCCARTHY §§22:1, 22:2.

<sup>64</sup> See 3 MCCARTHY §22:1; 5 GILSON §36.01.

<sup>65</sup> See HAWES & DWIGHT, *supra* note 60, at §22:2.

<sup>66</sup> Also, copyright (and quasi-copyright) protection for titles is available in some foreign jurisdictions. See PAUL EDWARD GELLER & MELVILLE B. NIMMER, INTERNATIONAL COPYRIGHT LAW AND PRACTICE §2[4][a] in each national chapter (2007). This contrasts with the U.S. rule. See *supra* note 2.

<sup>67</sup> See e-mail from Canadian Intellectual Property Office (Sept. 6, 2007) (on file with author) (“[T]he title of a single work can be trade-marked.”); Leslie Alan Glick, *Protection of Literary and Artistic Titles*, 55 CORNELL L. REV. 449, 453-54 (1970).

<sup>68</sup> See, e.g., FARBER, *supra* note 30, at Form 17-1 (Acquisition and Distribution Agreement), cmt. 2 (“United States...territory...normally includes... English-language versions in Canada.”).

<sup>69</sup> “Proposed use” is the Canadian equivalent of the U.S. intent-to-use system. See Canada Trade-Mark Law §30(e).

<sup>70</sup> See e-mail from Natascha Semjevski, OHIM (EU trademark office) (July 17, 2007) (on file with author) (“[T]he title of a single book or single motion picture is registrable as a CTM.”). This type of registration is also possible in each of a number of European states. See Glick, *supra* note 67, at 454-69.

<sup>71</sup> The UK, Germany, France, Italy, and Spain. Cf. 2 FARBER, *supra* note 30, at ¶17.01 (listing Korea but not Spain).

<sup>72</sup> See, e.g., Wikipedia: Naming conventions (films) §3.1, available at [en.wikipedia.org/wiki/Wikipedia:Naming\\_conventions\\_\(films\)](http://en.wikipedia.org/wiki/Wikipedia:Naming_conventions_(films)) (last visited Sept. 2, 2007) (style guide for Wikipedia articles on movies).

<sup>73</sup> See Lanham Act §§44(e), 66(a) (15 U.S.C. §§1126(e), 1141f(a)).

<sup>74</sup> See TMEP §1902.02(j) (discussing Lanham Act §66(a)); 3 MCCARTHY §19:31.40. The language in Lanham Act §44(e) is similar but substitutes “bona fide” for “real.” See Lanham Act §44(c) (15 U.S.C. §1126(c)); TMEP §1002.04; 5 MCCARTHY §§29:10 n.10, 29:18.

<sup>75</sup> See TMEP §1002.04.

<sup>76</sup> See Lanham Act §§44(e), 68(a)(1) (15 U.S.C. §§1126, 1141h(1)); TMEP §1007, 1904.02(a); 5 MCCARTHY §§29:9.50, 29:10, 29:13 nn. 6-7 (discussing Lanham Act §44(e)); 3 MCCARTHY §§19:31.20 *et seq.* (discussing Lanham Act §66(a)).

<sup>77</sup> Reg. no. 3000555.

<sup>78</sup> See Lanham Act §44(e) (15 U.S.C. §1126); 5 MCCARTHY 29:11 n.1.

<sup>79</sup> See HAWES & DWIGHT, *supra* note 60, at v. 1, §§2:3, 12:4; 2 MCCARTHY §19:37(3).