

This Opinion is Not a
Precedent of the TTAB

Mailed: April 15, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re Jonathan Roche Fitness Ventures LLC
—

Serial No. 85981686
—

Peter B. Scull of Hamilton, DeSanctis & Cha, LLP for
Jonathan Roche Fitness Ventures LLC

Jessica Hilliard, Trademark Examining Attorney, Law Office 120,
Michael W. Baird, Managing Attorney.
—

Before Kuhlke, Kuczma and Adlin,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Jonathan Roche Fitness Ventures LLC (“Applicant”) seeks registration on the Principal Register for the term NO EXCUSES DIET (in standard characters, with DIET disclaimed), for “Books in the field of food in health and wellness.”¹ After

¹ Application Serial No. 85981686, filed July 25, 2012, based on an intent to use the mark in commerce under Section 1(b) of the Trademark Act. This is the “child” application of application Serial No. 85686747, in which Applicant seeks registration of the mark for “Printed pamphlets, brochures, manuals, booklets, leaflets, flyers, informational sheets and newsletters, adhesive backed stickers, and kits comprising one or more of the foregoing materials in the field of food in health and wellness.” The record contains no information about the parent application or its current status.

Serial No. 85981686

Applicant filed its Statement of Use, the Examining Attorney refused registration under Sections 1, 2 and 45 of the Act on the ground that the term does not function as a mark because it is merely the title of a single book rather than a series of books. After the refusal became final, Applicant appealed, and Applicant and the Examining Attorney filed briefs.

The Record

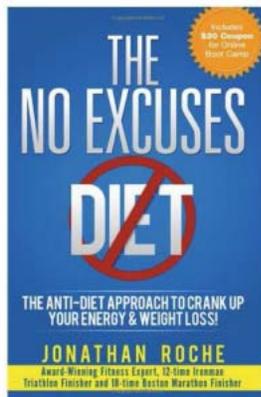
The specimen submitted with Applicant's Statement of Use is a printout from "amazon.com," a portion of which is reproduced below²:



² Page 6 of specimen filed by Applicant on March 12, 2014.

After the Examining Attorney refused registration on the ground that the specimen shows the mark used only in the title of a single creative work, Applicant submitted additional materials, some bearing the proposed mark and some not, including the following page from its website³:

 (<http://noexcusesworkouts.com>)



Jonathan here: Welcome to the special page I set up for you as a reader of The No Excuses Diet: The Anti-Diet Approach to Crank up your Energy Fitness and Weight Loss!

(<http://www.noexcusesworkout.com/oldsite/wp-content/uploads/2014/01/Screen-Shot-2014-01-14-at-9.48.42-PM.png>)

This page contains all the tools, articles, etc. that I reference in the book:

1) Fifteen Secrets to Better Health -> [Click here to view \(http://www.noexcusesworkout.com/oldsite/wp-content/uploads/2011/06/15secrets.pdf\)](http://www.noexcusesworkout.com/oldsite/wp-content/uploads/2011/06/15secrets.pdf)

2) Sample Interval & No Excuses Workouts:

Please be sure to have your doctor's OK to exercise prior to trying these Sample Workouts.

• **Interval Workouts (Suggested for Mondays, Wednesdays and Fridays):**

[Click here to view \(http://youtu.be/d3o-nlrQdv0\)](http://youtu.be/d3o-nlrQdv0) a 30-minute Boxing Interval Workout Video (for all exercise levels)

[Click here to download \(http://www.noexcusesworkout.com/oldsite/wp-content/uploads/2011/06/sample-interval.pdf\)](http://www.noexcusesworkout.com/oldsite/wp-content/uploads/2011/06/sample-interval.pdf) a 25-minute Interval Workout (the written version)

• **No Excuses Strength Training Workouts (Suggested for Tuesdays, Thursdays and Saturdays):**

[Click here to view \(http://www.youtube.com/watch?v=xCuTtmA-eLs\)](http://www.youtube.com/watch?v=xCuTtmA-eLs) a sample 6-minute No Excuses Strength Training Workout Video

[Click here to download \(http://www.noexcusesworkout.com/oldsite/wp-content/uploads/2011/06/sample-strength.pdf\)](http://www.noexcusesworkout.com/oldsite/wp-content/uploads/2011/06/sample-strength.pdf) a 6-minute No Excuses Workout (the written version of the above workout)

[Click here to view \(http://youtu.be/CHTUXuc6QvA\)](http://youtu.be/CHTUXuc6QvA) a 32-minute No Excuses (with cardio mixed in) Video (for all exercise levels)

³ October 27, 2014 Response to Office Action, pp. 4-5.

Applicant also submitted a copy of what it refers to as “a “downloadable” article⁴ that is “referenced” in its THE NO EXCUSES DIET THE ANTI-DIET APPROACH TO CRANK UP YOUR ENERGY & WEIGHT LOSS! book:

15 Secrets to Better Health

Attitude & Focus

- 1) **Concentrate on your health as opposed to losing weight.** If you have kids, concentrate on your kids and how you losing weight will help improve the energy you bring to your relationship with them.
- 2) **Hold yourself accountable and don't make excuses.** We are all extremely busy, but you can fit movement into your schedule. You deserve to take some personal time each day to invest in yourself and your health.
- 3) **When you exercise, be proud of yourself.** Know how much it positively affects your energy and health.
- 4) **Stay positive.** Life is too short to beat yourself up over weight you have gained or workouts you have missed. Staying positive helps all areas of your life!
- 5) **Have fun.** If your workouts are not fun you are not going to keep doing them. So, if you dread going to a gym, don't go. Instead, go for a walk, play with your kids in the yard, etc. If you can turn the dreaded exercise word into a fun activity, then your chances of being successful go up dramatically.
- 6) **Throw the rear view mirror out the window.** Concentrate on today and tomorrow. You can't change the past and beating yourself up is only going to drag you in the wrong direction. Today is a New Day!

Exercise & Movement

- 7) **Do Interval Workouts 3 days per week.** Intervals help you Burn 30% More Calories per Workout and can help Leave Your Metabolism Elevated for up to 12 hours after each workout. You can access a free sample workout by going to: <http://www.NoExcusesWorkouts.com/Sample-Workouts/>
- 8) **Do the 6-minute No Excuses Workout 3 days per week.** You can do this quick and highly effective strength training workout right in your living room; no equipment is required. You can access the Free sample workout by going to: <http://www.NoExcusesWorkouts.com/Sample-Workouts/>
- 9) **Turn random acts into fitness.** Take the stairs at work, park in the furthest spot at the store or work, play with your kids instead of sitting on the sideline, walk in place while brushing your teeth, etc. Be creative and you can turn activities you already do into opportunities to improve your health.

Nutrition

- 10) **Always eat breakfast & never skip meals.** Have breakfast within 1 hour of waking up to kick-start your metabolism. Skipping meals causes your metabolism to slow down and sends the signal to your body to store your next meal as fat in order to avoid starving.
- 11) **Drink 64 ounces of water per day** plus one additional ounce per minute of workout time. You should be going to the bathroom at least once every hour to hour and a half.
- 12) **Eat something every 2 to 3 hours.** Eat healthy snacks midmorning and mid-afternoon to help keep your metabolism buzzing and to help you avoid over-eating at lunch or dinner.
- 13) **Control your Portions.** Avoid seconds and eat until you are no longer hungry versus until you are full.
- 14) **Only have dessert once per week.** This could save you 300 calories per day on the six non-dessert days (1,800 calories per week). Since you have to have burned 3,500 more calories than you consume to lose 1 pound, this new habit could lead to losing an additional pound every two weeks or 26 pounds in one year!
- 15) **Limit yourself to one soda per day (ideally zero per day).** The excess sugar is not good for your health and can cause major ups and downs as far as your energy level.

Information provided by Jonathan Roche, Founder & CEO, Breakthrough Health & Wellness Solutions, Inc.
To maximize every minute of your limited exercise time check out the No Excuses Workout System
<http://www.NoExcusesWorkouts.com/Products/>

⁴ October 27, 2014 Response to Office Action, p. 8.

Finally, Applicant introduced what it refers to as “user usable checklists for multi-day progress tracking”⁵ which do not bear the NO EXCUSES DIET mark:

Win Today Check List

Use this check list to keep you on track each day.

Action Item	Completed? (Enter 0 or 1)						
	Mon.	Tue.	Wed.	Thu.	Fri.	Sat.	Sun.
Had breakfast within 1 hour of waking							
Had a healthy mid-morning snack							
Drank plenty of water (all day long)							
Nailed my scheduled workout							
Did Random Acts of Fitness throughout the day							
Had a healthy mid-afternoon snack							
Controlled my portions at lunch and dinner							
Only had dessert if this was my 1 dessert night							
Went to bed at a set time to line me up for 7 hours							
Total Score							

Win Today Score for the week (Max = 63):

Action Item	Completed? (Enter 0 or 1)						
	Mon.	Tue.	Wed.	Thu.	Fri.	Sat.	Sun.
Had breakfast within 1 hour of waking							
Had a healthy mid-morning snack							
Drank plenty of water (all day long)							
Nailed my scheduled workout							
Did Random Acts of Fitness throughout the day							
Had a healthy mid-afternoon snack							
Controlled my portions at lunch and dinner							
Only had dessert if this was my 1 dessert night							
Went to bed at a set time to line me up for 7 hours							
Total Score							

Win Today Score for the week (Max = 63):

Action Item	Completed? (Enter 0 or 1)						
	Mon.	Tue.	Wed.	Thu.	Fri.	Sat.	Sun.
Had breakfast within 1 hour of waking							
Had a healthy mid-morning snack							
Drank plenty of water (all day long)							
Nailed my scheduled workout							
Did Random Acts of Fitness throughout the day							
Had a healthy mid-afternoon snack							
Controlled my portions at lunch and dinner							
Only had dessert if this was my 1 dessert night							
Went to bed at a set time to line me up for 7 hours							
Total Score							

Win Today Score for the week (Max = 63):

⁵ October 27, 2014 Response to Office Action, pp. 9-10.

Arguments

The issue involved in this appeal is whether Applicant's proposed mark NO EXCUSES DIET for "books in the field of food in health and wellness" functions as a trademark under Trademark Act Sections 1, 2 and 45 as shown on the specimen and supporting evidence of record.

The Examining Attorney argues that the additional materials Applicant submitted do not establish that NO EXCUSES DIET is used for a series:

... a series is simply a set of works that are all published under one format or use a common title. Therefore, additional material such as website portals, articles, and checklists that are in a different format that (sic) the original book, and also do not use a common title, do not constitute a series in conjunction with the applicant's book.

A set of works with a common format may indicate a series, but the works at issue take completely different forms. The main work, as displayed on the specimen, is a published book, while the additional materials submitted by applicant are a webpage with a list of web links, an article, and a set of checklists. The book is in tangible, printed form, while the article is hosted online. The online portal page is a collection of links to other webpages referenced in the book.... Each of these works is therefore presented in very different formats that do not create a series.⁶

Furthermore, the Examining Attorney points out that the webpage stating "This page contains all the tools, articles, etc. that I reference in the book" is accessible at "noexcusesworkout.com" which is not the term in question, and that the term in question only appears on this page in the picture of, and the author's reference to, the

⁶ Examining Attorney's Appeal Brief at 6-7.

NO EXCUSES DIET book. As for the remaining materials Applicant submitted, they do not bear the term NO EXCUSES DIET at all, and because all of Applicant's supplemental materials are intended to be used "in conjunction with the applicant's book," they are merely "different sections" of Applicant's creative work.⁷

Applicant argues that in addition to serving as the title of the book depicted in the specimen, NO EXCUSES DIET is "also simultaneously acting as a mark on a portal to numerous – i.e., a series – of other works accessible through this singular portal labeled with the mark in question."⁸ More specifically, "[t]he book includes references to" the "*noexcusesworkout.com*" website, including to the page reproduced above which includes a depiction of the book bearing the title NO EXCUSES DIET⁹ and states "This page contains all the tools, articles, etc. that I reference in the book."¹⁰ According to Applicant, "[c]onsumers are made aware of the purveyors of, the source and origin of, the plurality of materials at issue."¹¹

Analysis

We begin by recognizing that a single book's title, even if "arbitrary, novel or non-descriptive" of the book's contents, "nevertheless *describes* the book," and "is not

⁷ Examining Attorney's Appeal Brief at 6.

⁸ Applicant's Appeal Brief at 4.

⁹ Although the applied-for mark is NO EXCUSES DIET, the name shown in large letters on the cover of the book is THE NO EXCUSES DIET.

¹⁰ Applicant's Appeal Brief at 7.

¹¹ Applicant's Reply Brief at 2.

associated in the public mind with the publisher, printer or bookseller.” *In re Cooper*, 254 F.2d 611, 117 USPQ 396, 400 (CCPA 1958). Accordingly, when a title is “no more than the name of a [single] book,” it “is not a trademark under the statute Section 2.” *Id.* See also *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) (“This court’s precedent also clearly holds that the title of a single book cannot serve as a source identifier.”).

However, where a title is more than simply the name of a single book,¹² such as when it identifies a series of works, it performs a trademark function and may be registered. *In re Cooper*, 117 USPQ at 400 (“The name for a series, at least while it is still being published, 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.”); *Mattel Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140, 1142 (TTAB 2011) (“if a term has been used to identify the source of a series of creative works, it functions as a trademark, and the fact that it may also be included in the title of each work does not destroy its source-originating function”).

¹² The Board has recognized that in certain cases book titles may function as trademarks. *In re Scholastic, Inc.*, 23 USPQ2d 1774, 1779 (TTAB 1992) (“even if THE MAGIC SCHOOL BUS were the complete title of one of the books in the series, or identified a character in the books, these factors would be insufficient to overcome the evidence in this case that THE MAGIC SCHOOL BUS also functions as a trademark.”); see also, *In re First Draft Inc.*, 76 USPQ2d 1183, 1189 (TTAB 2005) (considering analogous question of trademark protection for an author’s name, and holding that “the Board’s primary concern must be whether a designation would be perceived as a mark” rather than the policy bases for generally denying registration for author’s names).

The Examining Attorney took note of the definition of “series” based on the Oxford Dictionary’s definition of “series” as “[a] set of books, maps, periodicals, or other documents published in a common format or under a common title”¹³ to argue that NO EXCUSES DIET is used only as the title of a single book rather than a series of works, but also noted that Applicant could overcome the refusal by submitting evidence that the applied-for mark is used to identify a series of creative works.¹⁴

Even considering broader definitions of “series,” including: “a set of books, articles, etc., that involve the same group of characters or the same subject” and “a number of things or events of the same class coming one after another in spatial or temporal succession,”¹⁵ the result would be the same. The point is not whether a term is used as a “common title,” or whether it is used for multiple works in the same “format,” but rather, whether it is “associated in the public mind with the publisher, printer or bookseller.” *In re Cooper*, 117 USPQ at 400; *see also, Herbko*, 64 USPQ2d at 1378 (“Thus, the publication of a single book cannot create, as a matter of law, an association between the book’s title (the alleged mark) and the source of the book (the publisher). ... That association requires more than publication of a single book.”).

¹³ We grant the Examining Attorney’s request that the Board take judicial notice of the definition she provided in the Examining Attorney’s Appeal Brief, at p. 5.

¹⁴ April 26, 2014 Office Action.

¹⁵ Merriam-Webster.com (<http://www.merriam-webster.com/dictionary/series>). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

We look to the specimen and the evidence submitted with Applicant's Response to the Final Office Action,¹⁶ with respect to the goods identified in the Application, to ascertain the manner in which the term NO EXCUSES DIET is used and the commercial impact created to determine what function the term performs. Upon doing so, it is clear that the proposed mark NO EXCUSES DIET¹⁷ only identifies the title of a single "book in the field of food in health and wellness." Therefore, NO EXCUSES DIET does not function as a trademark for "books" based on the evidence showing its use as the title of a single book.

This is very different from the situation presented in *In re Scholastic Inc.* where the evidence was such that the commercial impression that the mark made on the public, as shown by the applicant's book covers, was that of a trademark. There, THE MAGIC SCHOOL BUS was held to function as a mark given its prominent display on the books' covers; multiple reviewers and consumers referring to the series as "the Magic School Bus books" or "the Magic School Bus series;" and applicant's use of THE MAGIC SCHOOL BUS *per se*, apart from any book title. The designation THE MAGIC SCHOOL BUS was more than just a portion of the title of each book in the series -- it functioned as a trademark for the series itself. *In re Scholastic Inc.*, 23 USPQ2d 1774, 1779 (TTAB 1992).

¹⁶ Applicant's Response to Final Office Action submitted October 27, 2014.

¹⁷ While the full title listed on the cover of the book depicted in the specimen is "The No Excuses Diet: The Anti-Diet Approach to Crank Up Your Energy and Weight Loss!", [The] NO EXCUSES DIET forms a separate commercial impression due to the increased font size in which it is shown, versus the reduced font size and spacing utilized for "The Anti-Diet Approach to Crack Up Your Energy & Weight Loss!".

The additional evidence submitted by Applicant essentially advertises materials in its book, including workouts, articles and other items available via Applicant's noexcusesworkout.com website or on YouTube, that are available for downloading on the same webpage that offers its book for sale.¹⁸ Such use does not constitute use of NO EXCUSES DIET as a trademark for books. However, it may indicate that Applicant's proposed mark could function as a service mark for related services such as providing information, news and/or commentary in the field of food in health and wellness.

Conclusion

Given the description of goods in this case, *i.e.* books in the field of food in health and wellness, we affirm the refusal to register. The facts of this case are reminiscent of the affirmance of the refusal to register NATIONAL for garden books, based on a specimen bearing the title NATIONAL GARDEN BOOK, because the title was only used for a single book. *In re National Council Books, Inc.*, 121 USPQ 198 (TTAB 1959). In that case, albeit in *dicta*, we noted: "It may be that applicant publishes a series of books identified as 'NATIONAL' (e.g., 'NATIONAL COOK BOOK,' 'NATIONAL FLOWER ARRANGING BOOK,' etc.), in which event the word may function as a trademark. The record, however, does not disclose such a situation." 121

¹⁸ We note that the materials submitted in Applicant's October 27, 2014 Response to the Office Action did not include copies of what was contained on the links identified in its submissions.

USPQ at 199. Neither does the record presented in this case indicate the term NO EXCUSES DIET functions as a trademark for books.

Decision: The refusal to register is affirmed.

Opinion by Adlin, Administrative Trademark Judge, dissenting:

Because I believe that the Examining Attorney and the majority have an unduly narrow conception of “books,” “titles” and “series” given the record in this case, and because I would find that THE NO EXCUSES DIET is associated in the public mind with the book’s source, I respectfully dissent.

At the outset, with respect to the dictionary definition upon which the majority and the Examining Attorney rely, there are other, broader definitions of a “series,” including: “a set of books, articles, etc., that involve the same group of characters or the same subject” and “a number of things or events of the same class coming one after another in spatial or temporal succession.”¹⁹ Thus, it is not at all clear that only works in the same format or with the same title as the original qualify for “series” status.

More importantly, requiring that a proposed mark be used without any variation whatsoever as the title of multiple works in a series, or that each work in the series

¹⁹ Merriam-Webster.com (<http://www.merriam-webster.com/dictionary/series>). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

be in the same format, exalts form over substance. The point is not whether a term is used as a “common title,” or whether it is used for multiple works in the same “format,” but rather, as the majority concedes, whether it is “associated in the public mind with the publisher, printer or bookseller.” *In re Cooper*, 117 USPQ at 400; *see also, Herbko*, 64 USPQ2d at 1378 (“Thus, the publication of a single book cannot create, as a matter of law, an association between the book’s title (the alleged mark) and the source of the book (the publisher). ... That association requires more than publication of a single book.”). In fact, in *Herbko*, the Court did *not* indicate that the *only* way to establish trademark rights would be to use the term as the title of multiple works, or to use it in connection with multiple works in the same format. To the contrary, the Court left open the possibility that other types of evidence could establish trademark rights in a title. *Herbko*, 64 USPQ2d at 1379 (“Because sales of a single book title are insufficient to create proprietary rights and because Kappa provided no other evidence of *association creating activities* (e.g., use of mark as trade name), the Board erred in holding Kappa established priority to the mark.”).

As the majority also concedes, in *In re Scholastic, Inc.*, 23 USPQ2d at 1774, we found that THE MAGIC SCHOOL BUS functioned as a mark, focusing on: the prominent display of the mark THE MAGIC SCHOOL BUS on the books’ covers; multiple reviewers and consumers referring to the series as “the Magic School Bus books” or “the Magic School Bus series;”²⁰ and Applicant’s use of THE MAGIC

²⁰ In this case, one of the consumer reviews appearing in the specimen of use states: “I am a huge fan of Jonathan Roche and am glad I purchased the book but it is only good in addition to his website.”

SCHOOL BUS per se, apart from any book title. This evidence “bearing on the recognition of THE MAGIC SCHOOL BUS as a trademark” was so persuasive in establishing that THE MAGIC SCHOOL BUS functioned as a mark that the result would not have been different “even if THE MAGIC SCHOOL BUS were the complete title of one of the books in the series, or identified a character in the books.” *Id.* at 1779.

In this case, while Applicant apparently offers only one book the title of which includes THE NO EXCUSES DIET, that book is not Applicant’s only use of the mark (or closely related marks) for products and services related to nutrition, health and wellness. In fact, the mark is also used on ancillary products and services, including the webpage referenced in the book which is accessible at “noexcusesworkout.com,” which is “set up for you as a reader of” the book, and includes links to: “Sample Interval & No Excuses Workouts;” “No Excuses Strength Training Workouts;” and “32-minute No Excuses (with cardio mixed in) Video.” This webpage includes depictions of and references to the mark THE NO EXCUSES DIET. Thus, THE NO EXCUSES DIET is not used only as the title of a single book; it is also used in connection with ancillary materials referenced in the book. In combination, the book and this associated “special page” which contains a variety of links, form a system or process to “crank up your energy fitness and weight loss.” The connection between the book and the “special page” is apparent because each directly refers to the other, they are explicitly intended to be used in concert and both display THE NO EXCUSES DIET. Together, the book and “special page” fall within the definitions of

“series” as “a set of books, articles, etc., that involve the same group of characters or the same subject;” and “a number of things or events of the same class coming one after another in spatial or temporal succession.” In fact, the book and “special page” even seem to fall within the Oxford Dictionary definition of “series” upon which the majority and Examining Attorney rely, as they are “documents published in a common format” (to the extent that literary works are a “format”), and they have the same title (to the extent that the heading of the “special page” constitutes its “title”).

Furthermore, while Applicant seeks registration of THE NO EXCUSES DIET, the record as a whole demonstrates that this is but one form of Applicant’s mark NO EXCUSES. For example, the book depicted in the specimen references the “downloadable” material which bears the heading “15 Secrets to Better Health,” which includes sections on “Attitude & Focus,” “Exercise & Movement” and “Nutrition,” and which at the bottom of the page states “To maximize every minute of your limited exercise time check out the No Excuses Workout System <http://www.NoExcusesWorkouts.com/Products/>.”²¹ Moreover, the record reveals that in addition to the terms THE NO EXCUSES DIET, NO EXCUSES WORKOUT and NO EXCUSES WORKOUT SYSTEM, and the domain name “noexcusesworkouts.com,” Applicant uses the mark NO EXCUSES in the following forms:

NO EXCUSES STRENGTH TRAINING WORKOUTS

²¹ The book also refers its readers to the “user usable checklists” entitled “Win Today Check List” and “Win Tomorrow Check List.”

NO EXCUSES STRENGTH TRAINING WORKOUT
VIDEO

32-MINUTE NO EXCUSES (with cardio mixed in)
VIDEO

The term NO EXCUSES WORKOUT SYSTEM highlights that what Applicant is providing through the book and “special page,” as well as the other ancillary products, is a “system” of healthy living, which includes methods of exercising, eating and “focusing.” Furthermore, the involved application itself supports a finding that NO EXCUSES is in fact Applicant’s primary mark, as Applicant disclaimed the generic term “diet” apart from the mark as shown. In other words, while Applicant uses THE NO EXCUSES DIET in a “series” comprised of its book and the “special page” referenced therein, the “series” of NO EXCUSES products becomes more apparent and extensive when we consider that Applicant’s root mark is simply NO EXCUSES, forms of which include not only THE NO EXCUSES DIET but also Applicant’s NO EXCUSES WORKOUT, NO EXCUSES STRENGTH TRAINING, NO EXCUSES WORKOUT SYSTEM, etc.

In fact, while I agree with the majority that this case calls to mind *In re National Council Books*, I disagree that that case weighs in favor of affirming the refusal to register. In that case, albeit in dicta, we stated: “It may be that applicant publishes a series of books identified as ‘NATIONAL’ (e.g., ‘NATIONAL COOK BOOK,’ ‘NATIONAL FLOWER ARRANGING BOOK,’ etc.), in which event the word may function as a trademark. The record, however, does not disclose such a situation.” This case presents “such a situation,” or is at least analogous thereto, in that NO

EXCUSES is used in connection with multiple works, and more specifically literary works, including the book depicted in the specimen, the “special page” and the “15 Secrets to Better Health” material.

There is nothing magical about traditional published books as opposed to other types of literary works, or for that matter other types of non-literary creative works. This is especially true in the Internet era, as it is no longer always clear whether a literary work is an “article,” “book,” “e-book,” “portal,” “worksheet,” “webpage,” “posting” or something else. The focus should instead be on substance: whether the term is used for more than simply a single work, and if it is whether it is used in such a way that it would be perceived as a mark or source identifier, or, as stated in *Herbko*, whether the applicant is engaged in “association creating activities.” *Herbko*, 64 USPQ2d at 1379.

This approach is consistent with the *Brainy Baby* case, in which the problem was not that the works in question were in two different formats, VHS tape and DVD, but instead that each format contained essentially the same work. *Mattel Inc. v. Brainy Baby*, 101 USPQ2d at 1143 (“We have reviewed these submissions and could not identify any differences in the content of the featured program in the VHS tape and the DVD.”). Indeed, in *Brainy Baby* we held that “in order to obtain or maintain a registration, there must be clear evidence that the mark identifies a series of different works,” *id.* at 1144, not that the mark must identify a series of works in the same exact format. In this case, the Examining Attorney does not contend nor does the record reveal that the book in the specimen and the ancillary materials are the same

work; the evidence makes clear that they are not. That the ancillary materials are in a different format than the book (at least under the traditional and in my estimation no longer valid view of what constitutes a “book”) is essentially irrelevant to the ultimate question of whether THE NO EXCUSES DIET would be perceived as a mark. The “special page,” as well as the other evidence of record, establish that THE NO EXCUSES DIET functions as a mark.

In short, the majority’s focus on Applicant’s identification of goods, “books in the field of food in health and wellness,” is misplaced. There is no dispute that Applicant is offering books in the field of food in health and wellness, and the only question is whether THE NO EXCUSES DIET functions as a mark for those books. The record as a whole demonstrates that it does, because the title THE NO EXCUSES DIET does not merely identify the particular book in question. To the contrary, Applicant is engaged in a number of “association creating activities” under the marks NO EXCUSES and THE NO EXCUSES DIET, and as a result of Applicant’s activities, those marks identify a set of literary and other works on the same subject, specifically nutrition, health and wellness.
