



Case Study: Mattel V. Brainy Baby

Law360, New York (March 19, 2012, 12:53 PM ET) -- In a recent precedential decision, the U.S. Trademark Trial and Appeal Board reaffirmed that the title of a creative work may not be registered on the Principal Register unless that title is used on at least two of the applicant's works (a series). However, the TTAB went further in this new decision and held that VHS and DVD versions of the same creative work are properly considered a single work and not a series, even if the DVD includes additional content and features that the TTAB considers "minor enhancements." [Mattel Inc. v. The Brainy Baby Co.](#), Cancellation No. 92052047, 101 U.S.P.Q.2d 1140, (TTAB Dec. 30, 2011).

The TTAB defended its "single work" rule by explaining that whereas "[t]he title of a single creative work is, of necessity, descriptive of the work and does not function as a trademark," in contrast, the name of 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."

The DVD-only content and features that the TTAB deemed insufficient to create a second work in this case were (1) a seven-minute "Behind the Scenes" segment that included information on the making of respondent's (Brainy Baby's) video; (2) outtakes and bloopers that the TTAB characterized as less than two minutes long; (3) a "Sneak Peeks" section promoting respondent's other videos (none of which included the trademark in question); (4) a scene selection menu enabling viewers to begin DVD playback at various points of the program; (5) a nine-panel storyboard that did not change in content, and according to the TTAB was viewable for less than two minutes; (6) a "Contact Us" screen that included respondent's contact information; and (7) a "DVD-ROM Activities" page instructing viewers to put the DVD into a computer to display a design similar to the DVD cover.

According to the TTAB, these DVD-only features did not create a second work distinct from the VHS version because the DVD and VHS versions both included the same "featured program," namely, 45 minutes of basic learning concepts designed for toddlers (respondent's trademark in question was "Laugh & Learn"). The TTAB held that

[t]he featured program on both the VHS tape and the DVD are the same creative work, and the addition of the minor enhancements in the DVD does not transform this single work into a series, any more than the variations in a live performance that occur from night to night transform the title of a single production into a series. ... Consumers will understand that the DVD version, even with the enhancements, is merely the same work as appears on the VHS tape, both of which have the title LAUGH & LEARN, rather than regarding the DVD as another item in a series bearing the mark LAUGH & LEARN.

To support this conclusion, the TTAB also relied on the fact that respondent's "Laugh & Learn" program is promoted in respondent's catalogs as a single work that is available in both VHS and DVD formats.

For these reasons, the TTAB granted petitioner's summary judgment motion and petition for cancellation, holding that respondent's mark was not in use as a trademark as a matter of law when respondent filed its application, because the applied-for "Laugh & Learn" mark was being used only as the title of a single creative work and not as a trademark for a series at the time of filing.

Although this decision concerned DVDs and VHS tapes, other creative work formats are also impacted, particularly those formats that commonly include unique or specialized content. For example, CDs often include bonus features that are not included on other formats of the same creative work, in order to entice consumers to buy tangible CDs instead of digital downloads.

As a result of this decision, it will be more difficult for a trademark applicant who distributes a particular creative work in several formats, some of which have unique content, to demonstrate the "use in a series" that is necessary for registering the title. However, although the specialized DVD content in this particular case was insufficient to create a distinct second work, the TTAB did not hold that unique content in a particular format could never suffice to create a second work and thus a series. More, however, will need to be shown than was demonstrated here.

Furthermore, the TTAB's focus on the application filing date as determinative for whether a series existed was a result of the challenged registration being based on a "use" application. This decision does not change the fact that an applicant may still file an intent-to-use application before the creative work title is used in a series, and provided that the trademark is used in a series before the statement of use filing deadline and the statement of use is timely filed, that mark will still be registrable. Accordingly, even after this decision, the ability of content owners to file intent-to-use applications for creative work titles remains an important tool that should not be disregarded.

The TTAB's decision can be found [here](#).

--By Adam D. Siegartel, [Proskauer Rose LLP](#)

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