

23 U.S.P.Q.2d 1774 (Trademark Tr. & App. Bd.), 1992 WL 215313

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

IN RE SCHOLASTIC, INC.

Serial No. 73/794,140

June 4, 1992

*1 [Mary A. Donovan](#) of Nims, Howes, Collison, Hansen & Lackert for applicant.

[Henry Zak](#), Trademark Senior Attorney

Law Office 5

([Mary I. Sparrow](#), Managing Attorney)

Before Rooney, [Seeherman](#) and [Quinn](#)

Members

Opinion by [Quinn](#)

Member

An application has been filed by Scholastic, Inc. to register the mark THE MAGIC SCHOOL BUS for “a series of non-fiction picture books for children.”¹

The Trademark Examining Attorney has refused registration on the ground that the designation THE MAGIC SCHOOL BUS, as used on the specimens, does not function as a trademark since the designation comprises a portion of the complete title of each book in a series of books. The Examining Attorney cites Sections 1, 2 and 45 of the Act as the statutory bases for refusal.

Applicant's Use Of THE MAGIC SCHOOL BUS

Applicant is a publisher of books, including a series of children's books authored by Joanna Cole and illustrated by Bruce Degen. This series of books is intended to be educational and is directed to children aged six through nine. To date, four books have been published in the series, with nine more under contract. Over one million copies of the books, including both hardcover and softcover editions, have been sold, and applicant has spent in excess of \$100,000 on promotional efforts. The books are sold through applicant's catalogs to teachers, schools and students, and also to the general public, namely parents and children, through book stores and other retail book channels.

The story line of the series of books in question revolves around the fantasy of science field trips conducted by a school teacher, Ms. Frizzle. Ms. Frizzle is known as a “strange” teacher who has frizzy hair and wears unusual dresses and shoes. In teaching science to her class Ms. Frizzle takes her pupils on field trips. The children board a yellow school bus driven by Ms. Frizzle. The field trips soon turn into a fantastic adventure where the children are transported, for example, to a cloud or to the center of the earth. The children learn first hand about various scientific facts, such as how rain makes its way from clouds to become drinking water or the types of rock found below the earth's surface. In the author's words, she is able to combine “science and humor”, passing along scientific information to her readers. The evidence of record includes covers from the hardback editions of applicant's four books--the title of each book is reproduced below as it appears on the book's front cover.

TABULAR OR GRAPHIC MATERIAL SET FORTH AT THIS POINT IS NOT DISPLAYABLE

Applicant argues that the designation THE MAGIC SCHOOL BUS is not the title of any single book in its series, but rather functions as a trademark for the entire series. Applicant points to the prominent manner in which THE MAGIC SCHOOL BUS is displayed as part of each book's title appearing on the cover of the book as shown by the specimens of record. Applicant also relies on declarations, book reviews and promotional efforts to show that the relevant purchasing public recognizes the designation THE MAGIC SCHOOL BUS as identifying a series of books originating with applicant.

*2 On the other hand, the Examining Attorney contends that case law prohibits registration of a portion of a complete title of a single book in a series. The Examining Attorney states that book publishers, including applicant, consistently identify series of books in a separate, distinguishable manner from titles of individual books in the series; the designation THE MAGIC SCHOOL BUS appears, the Examining Attorney contends, only as part of specific book titles.

Registrability of Series Titles

The seminal case in this area of the law was issued almost thirty-five years ago. In the case of In re [Cooper](#), 254 F.2d 611, 117 USPQ 396 (CCPA 1958), the U.S. Court of Customs and Patent Appeals affirmed this Office's refusal to register TEENY-BIG as a trademark for a single children's book. The Court essentially held that the title of a single book, even an "arbitrary" title, is merely descriptive. Each literary title is regarded as a designation used to describe the literary work itself, rather than a trademark used to identify and distinguish the literary work of one source from that of another. The Court viewed the issue as hinging on the manner in which the title is used. The Court stated as follows:

No one has asserted that a word may not be *used* as a trademark for books or that there cannot *be* trademarks for books, in the form of a word or otherwise, or that trademarks for books cannot be registered under the Lanham Act ... Nothing we say should be taken as implying that no trademark for books can be registered; but before there can be registration there must be a trademark and a trademark exists only where there has been trademark use. (emphasis in original)

Id. at 398. The Court went on to address the applicant's argument that there is an inconsistency in registering as a trademark the name for a series of books and in not registering the title of a single book:

We see no inconsistency. 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 book and each book has its individual name or title. A series name is comparable to the title of a periodical publication such as a magazine or newspaper. While it may be indicative either specifically or by association in the public mind, of the general nature of the contents of the publication, it is not the name or title of anything contained in it. A book title, on the other hand especially one which is coined or arbitrary, identifies a specific literary work, of whatever kind it may be, and is not associated in the public mind with the publisher, printer or bookseller--the "manufacturer or merchant" referred to in the Trademark Act (Sec. 45, definition of trademark). If a title is associated with anything, it is with the author for it is he who has produced the literary work which is the real subject of purchase.

*3 *Id.* at 400.

Soon after the Cooper decision the Board had an opportunity to consider the registrability of the designation NATIONAL for garden books. In the case of In re [National Council Books, Inc.](#), 121 USPQ 198 (TTAB 1959), the Board affirmed the refusal to register, relying on the rationale set out in Cooper. The Board noted that the title page of the book bore the title "NATIONAL GARDEN BOOK." The Board stated [t]hat name ["NATIONAL GARDEN BOOK"], like any book title, may serve to differentiate the publication designated thereby from other books having different titles, but this cannot obviate the fact that "NATIONAL", as used by applicant in association with "GARDEN BOOK", is nothing more than a portion of the title of its book, and it therefore does not function as a trademark.

Id. at 199. Of even greater significance to the specific issue presently before us are the Board's further comments:

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.

Id.

Almost fifteen years later the Board considered an appeal from the refusal to register THE LITTLES for a series of educationally oriented children's books. [In re Scholastic Inc., 223 USPQ 431 \(TTAB 1984\)](#). Registration was refused on the ground that the matter sought to be registered was used as the title or a portion of the title of each book in a series of books and, as such, did not function as a trademark. The Board, in affirming the refusal, noted that the series concerned a fictional family called the "Littles" and that each book involved a particular activity of that family. Inasmuch as use of THE LITTLES in the title of each book named the main characters of the book (i.e., identified the reading material found between the book's covers), the Board found that THE LITTLES did not function as a trademark. Since THE LITTLES was used only as a portion of the title of each of the specific books of the series, the Board viewed THE LITTLES "only as the identity of the characters in the title of each book and not as a trademark for a series of books." *Id.* In that case the Board discounted the applicant's reliance on *National Council Books*, supra. The Board stated as follows:

As to the case of [In re National Council Books, Inc., 121 USPQ 198 \(TTAB 1959\)](#) cited by applicant, we see nothing inconsistent with our position. The statement made therein is merely dicta, as argued by the Examining Attorney. Even if it were not, it could be distinguished. The Board there merely said that it may be that applicant publishes a series of books identified as NATIONAL (i.e., NATIONAL GARDEN BOOK, NATIONAL COOK BOOK, NATIONAL FLOWER ARRANGING BOOK) in which event the word NATIONAL may function as a trademark. Use of the word, may, is significant, indicating that the Board reserves judgment until it is shown how the term might be presented to the public thereon.

*4 *Id.* at 431-432.

Registrability Of THE MAGIC SCHOOL BUS As A Series Title

In the instant case we find that, notwithstanding the fact that it appears as a portion of titles of specific books in a series, the designation THE MAGIC SCHOOL BUS, as used on books, would be recognized as a trademark identifying a series of children's books emanating from applicant. See generally: [1 J.T. McCarthy, Trademarks and Unfair Competition, § 10:3 \(2d ed. 1984\)](#).

We initially note that the words THE MAGIC SCHOOL BUS are prominently displayed on the books' covers, and are in a larger, bolder style of type and different color from the remainder of each title. Moreover, the words appear on a separate line above the remainder of each title. When presented in this fashion, we believe that THE MAGIC SCHOOL BUS makes a commercial impression separate and apart from, for example, the complete title THE MAGIC SCHOOL BUS AT THE WATERWORKS.

The record includes the declaration of Richard Krinsley, applicant's executive vice president. Exhibits to the declaration include several reviews of books in this series published by applicant which appeared in such widely circulated publications as *The New York Times*, *The Washington Post* and *The Los Angeles Times*, and in trade publications such as *Publishers' Weekly* and *School Library Journal*. The reviewers consistently refer to this series of children's books as

“the Magic School Bus books”, “the Magic School Bus series”, or “the series of Magic School Bus books.” Some of the reviewers refer to the book titles as “Inside the Earth”, “Inside the Human Body”, “Lost in the Solar System” and “At the Waterworks”, separate and apart from THE MAGIC SCHOOL BUS. Also submitted with Mr. Krinsley's declaration are promotional materials distributed by applicant which feature the designation THE MAGIC SCHOOL BUS per se, apart from any book title. In connection with promoting its series of books, applicant provides kit materials to schools, bookstores and the like which are interested in hosting a “Magic School Bus Party.” Items such as name tags or stickers, reproduced below,

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are included in the kit. Applicant's advertisements for its books show such statements as “Don't miss the first three Magic School Bus books” and “We've launched another Magic School Bus Book.” The Examining Attorney is correct in stating that the above exhibits do not show technical trademark use of THE MAGIC SCHOOL BUS for books. However, this evidence shows that the designation THE MAGIC SCHOOL BUS, as actually used by applicant on book covers, does function as a trademark and would be recognized as a trademark, separate and apart from also comprising a portion of specific book titles.

Mr. Krinsley asserts that the designation THE MAGIC SCHOOL BUS is recognized in the book trade and by the consuming public as a trademark for a particular series of books emanating from applicant. In this regard, applicant has made of record numerous letters from book store proprietors wherein they state that the designation THE MAGIC SCHOOL BUS on a book cover is recognized in the trade as indicating a book series published by applicant which serves to distinguish this series of books from the books of other children's books publishers. The letters include one from a merchandise manager of children's books for (allegedly) the largest book store chain (Waldenbooks®) in the United States. In addition to the trade's recognition of THE MAGIC SCHOOL BUS as a trademark for a series of books, Ms. Holland states that many parents and children ask store personnel for “*The Magic School Bus* books or The Magic School Bus series rather than for a particular title in the series....” She also states that customers have asked questions such as “When is the next *Magic School Bus* book coming out?” or “What is the next *Magic School Bus* book about?”

*5 Applicant likewise has submitted letters from administrators of three different public school systems wherein they state that teachers and students refer to applicant's books as “The Magic School Bus series.”

All of the above lead to the conclusion, at least in our minds, that the designation THE MAGIC SCHOOL BUS, as shown on book covers, functions as a trademark and not just as a portion of a book title. Where the designation THE MAGIC SCHOOL BUS has been used in each title of each book of the series and also has come to represent a source to purchasers, the designation may be registered as a trademark since it functions as one. Cf. [In re Polar Music International AB](#), 714 F.2d 1567, 221 USPQ 315 (Fed.Cir.1983). Notwithstanding its appearance in the books' titles, THE MAGIC SCHOOL BUS is recognized by purchasers who, when they see the term, know what they are getting--that is, another book in this particular series of children's books emanating from applicant.²

The evidence submitted by the Examining Attorney does not persuade us to reach a contrary result. That book catalogs allegedly do not show the designation THE MAGIC SCHOOL BUS as identifying a series of books (unlike, for example, THE BABY-SITTERS CLUB) or that THE MAGIC SCHOOL BUS is grammatically connected to the remainder of each book's title is not dispositive.³

The Examining Attorney, in urging affirmance of the refusal, places substantial reliance on the case of *In re Scholastic, Inc.*, *supra*, and, to a lesser degree, on *National Council Books, Inc.*, *supra*. The present case is factually distinguishable from those two cases. In *National Council Books* there was no evidence, unlike in the present case, that the applicant published a series of books. From what we can tell by reading *Scholastic*, which involved the same applicant as the one involved in this appeal, the designation THE LITTLES was not as prominently displayed in the books' titles as is THE MAGIC SCHOOL BUS, such prominent use giving THE MAGIC SCHOOL BUS a commercial impression

separate and apart from the titles. Moreover, except for a single instance, the record in *Scholastic* apparently was devoid of evidence, unlike the record now before us, showing that the matter sought to be registered was promoted as a series title. The panel in *Scholastic* also looked to the facts that THE LITTLES was the complete title of one of the books in the series and that the designation identified the characters in the books. Here, those facts are not present. We hasten to add, however, that those factors are not important to us in this case given the other factors bearing on the recognition of THE MAGIC SCHOOL BUS as a trademark. That is to say, 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.

*6 Although *National Council Books* and *Scholastic* stand for the proposition that a portion of a book title, just as the title itself, cannot function as a trademark, those cases left open the possibility that this matter might also be used in a manner such that it would be perceived as a trademark for a series of books. See: *National Council Books*, *supra* ["It may be that applicant publishes a series of books identified as 'NATIONAL' ... in which event the word may function as a trademark."]. As noted above, the panel in *Scholastic*, *supra*, in reviewing the decision in *National Council Books*, stated that use of the word "may" in that decision was significant, "indicating that the Board reserves judgment until it is shown how the term might be presented to the public." We thus believe that the Examining Attorney has too narrowly read these two cases as standing for the proposition that there is an absolute bar against registration of words which may comprise a portion of titles in a series of books when those words appear only as a portion of titles. In the present case the specimens of record show use of THE MAGIC SCHOOL BUS in a trademark manner and, significantly, the record also includes evidence of the public's recognition of THE MAGIC SCHOOL BUS as a trademark. We believe that this case is the type of case the Board had in mind by indicating that a portion of titles in a series of books could function as a trademark if the matter were used in a trademark fashion. The designation THE MAGIC SCHOOL BUS appears in each title and serves to identify and distinguish applicant's series of books from those of others. Thus, to the extent that *National Council Books* and *Scholastic* would suggest a different result in the instant case, the holdings of those cases are confined to the particular facts therein. One must look to the specimens of record and evidence in each case to ascertain the manner in which the designation is used and the commercial impact created to determine what function the designation performs under particular circumstances. The evidence in this case convinces us that the commercial impression of THE MAGIC SCHOOL BUS made on the public, as shown by applicant's book covers, is that of a trademark. The designation THE MAGIC SCHOOL BUS is more than just a portion of the title of each book in the series--it functions as a trademark for the series itself.⁴

Decision: The refusal to register is reversed.

E.J. Seeherman

T.J. Quinn

Members, Trademark Trial and Appeal Board

CONCURRING OPINION

*7 L.E. Rooney

Member

The evidence submitted in this case by applicant convinces me that the phrase, THE MAGIC SCHOOL BUS, is registrable as a trademark for a series of books. The prominent and entirely separate display of those words on the goods apart from the books' subtitles has apparently allowed them to acquire their own commercial impression apart from the complete title of each book. It has also been shown that applicant has advertised and promoted THE MAGIC SCHOOL BUS series of books in a manner to cause that expression to be recognized as a trademark for the series by the

relevant purchasing public. The fact that no MAGIC SCHOOL BUS, per se, appears in the text of the books is another factor supporting the conclusion of trademark use. While one of these factors alone might not be enough to prove that THE MAGIC SCHOOL BUS functions as a trademark, certainly the cumulative effect is sufficient to accomplish that purpose.

Accordingly, I would reverse the refusal to register in this case.

Footnotes

- 1 Application Serial No. 73/794,140, filed April 18, 1989, alleging first use in October 1986.
- 2 We note that applicant has relied upon a third-party registration, namely Registration No. 1,370,096 for the mark A DAY IN THE LIFE OF for a series of photographic books of different geographic areas. Applicant submitted copies of the covers of books titled A DAY IN THE LIFE OF AMERICA and A DAY IN THE LIFE OF HAWAII. Neither a copy of the registration nor the file history thereof has been submitted. In any event, we agree with the Examining Attorney that the existence of this registration is of little probative value in determining the registrability of applicant's mark. See: [In re The Signal Companies, Inc.](#), 228 USPQ 956, 959 (TTAB 1986).
- 3 The Examining Attorney points to other series of books emanating from applicant which books allegedly show trademark use. For example, applicant publishes a series of children's books with such titles as CLIFFORD AT THE CIRCUS and CLIFFORD TAKES A TRIP. In addition to appearing in the title of each book, the name CLIFFORD appears in the upper right hand corner of each cover. Likewise, in another of applicant's series of books, the mark THE BABY-SITTERS CLUB, which serves as a trademark for the series, appears separate and apart from the specific book's title (e.g., KRISTY'S GREAT IDEA and BABY-SITTERS' ISLAND ADVENTURE). While applicant uses THE MAGIC SCHOOL BUS in a manner admittedly different from that shown in the CLIFFORD and THE BABY-SITTERS CLUB examples, we nonetheless believe that the public perception of THE MAGIC SCHOOL BUS would be the same, that is, as a source identifier of a series of children's books.
- 4 In the Cooper case, as noted above, the court distinguished the registrability of the title of a single book from the title of a series of books, stating that the name of the series is not descriptive of any one book and each book has its individual name or title. The Examining Attorney has confined the refusal to register to applicant's alleged failure, as shown by the specimens of record, to use the mark in a technical trademark manner. Although the Examining Attorney referred to the bus as a "central element of each story plot" (brief, p. 10), there was no refusal on the ground that THE MAGIC SCHOOL BUS is descriptive as applied to applicant's books. Thus, the issue of whether or not acquired distinctiveness must be established is not before us. See: [Trademarks and Unfair Competition, supra at 10:3.B](#). We would add that, in any event, the evidence of record, as discussed above, proves that THE MAGIC SCHOOL BUS is a distinctive mark for a series of books.

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