

Trademark Law Alert—Non-Syndicated Newspaper Column Titles Are Now Registrable

05.31.2023 By [William M. Borchard](#) and [Theodora M. Fleurant](#)



To be registrable as a trademark on the U.S. Principal Register, the trademark must relate to “goods in trade” sold or transported in commerce for use by others as distinguished from being merely ancillary or incidental to the applicant’s own goods or services.

Historically, non-syndicated print newspaper columns have not been considered goods in trade separate from the newspapers in which they appeared, so their titles have not been eligible for a trademark registration.

A precedential decision of the Trademark Trial and Appeal Board (TTAB) has held otherwise in view of changes in the way newspaper columns are nowadays being distributed and read.

Background

The New York Times (the “Times”) filed six use-based applications to federally register the following marks on the Principal Register for printed “columns” on various subjects: THE NEW OLD AGE, A GOOD APPETITE, HUNGRY CITY, WORK FRIEND, OFF THE SHELF, and LIKE A BOSS (the “Times Marks”).

The Examining Attorney refused registration on the ground that the Times’ specimens showed that the Times Marks “identif[ied] only individual portions of [the Times’] publication” and were not used on separate goods in trade. In contrast, companion applications to register these terms

as service marks for “providing on-line publications” were granted registration because services are not subject to a goods in trade refusal.

Past Practice

The U.S. Patent and Trademark Office (USPTO) has historically treated print newspaper columns as ineligible to meet the requirements of goods in trade unless sold, syndicated, or offered for publication or broadcast by multiple parties. There were two exceptions: (1) demonstrating acquired distinctiveness of the column title; or (2) registering the trademark on the Supplemental Register (which is for terms capable of becoming a trademark if they acquire distinctiveness). Incidental items such as letterheads, invoices, and reports also were not considered goods in trade.

Arguments

The Examining Attorney argued that the goods in question were newspapers, not sections of newspapers, and that when someone buys a newspaper, they receive all the columns in the paper. The Examining Attorney was skeptical about whether buyers purchase a newspaper only for a specific section. The Examining Attorney also noted that the Times described the specimen in each application as a column printout, and argued that the Times Marks were not used to distinguish these columns from columns in third-party publications but rather, were used to distinguish these columns from other columns in the Times’ newspaper itself.

The Times argued that the printed newspaper columns were accessible independently. The newspaper submitted over three million Google search results showing that consumers could independently access the newspaper columns either through internet searches by the column’s name or at separate pages within the Times’ website.

Changes in the Marketplace

The practice of refusing marks identifying non-syndicated columns in print format was based on decisions issued in 1956 and 1962, a time when news or opinion columns were only available to consumers as part of the overall purchase of a particular newspaper, magazine, or other print publication. This was before the advent of the internet, its search engines, and the availability of columns online.

New Standard

In recognition of these changes in the marketplace, the TTAB concluded that the correct legal standard for determining whether a non-syndicated column is a good in trade should no longer depend on the format in which it is offered.

The TTAB adopted the Federal Circuit’s three-part goods in trade test in *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 Fed.3d 1376 (Fed. Cir. 2012) to evaluate whether the goods are:

- 1) simply the conduit or necessary helpful tool useful only in connection with the applicant’s primary goods or services;

- 2) so inextricably tied to and associated with the direct goods or services as to have no viable existence apart from them; and
- 3) neither sold separately nor of any independent value apart from the primary goods or services.

The TTAB clarified that acquired distinctiveness and seeking registration on the Supplemental Register are no longer necessary exceptions to the goods in trade bar for marks that identify non-syndicated columns or sections of printed newspapers because the *Lens.com* test incorporates these alternatives.

Analysis in this Case

The TTAB applied the *Lens.com* factors to the facts in this case as follows:

First factor. The Times' columns in-print format were neither simply a conduit nor necessary tool useful only to obtain the print edition of the newspaper.

Second factor. The Times' columns were not so inextricably tied to and associated with the printed newspaper as to have no viable existence apart from it. There was substantial evidence that the Times Marks were recognized as separate goods because they were searchable by name and retrieved multiple results. The evidence revealed that consumers were likely to perceive the name of each print column as a designation for the specific content found in that column as distinguished from the print newspaper as a whole.

Third factor. Although there was no evidence that the print columns were "separately sold" or syndicated, the search engine results showed that the utility of the column was more than just a section within the print edition.

Conclusion

The TTAB reversed the refusals to register the Times Marks for the non-syndicated columns in printed publications, holding that the Times' columns were separate goods in trade.

Notwithstanding its acceptance of the search engine evidence in this case, the TTAB clarified that its rationale was not based on the print content also being available online. It also warned that it was not creating a rule that all non-syndicated newspaper columns existing in print format are goods in trade. The TTAB stated that consumer perception and interaction with the product was critical. In a footnote, the TTAB listed non-exhaustive examples of other evidence that might show public perception: consumer surveys, consumer affidavits, unsolicited media attention and social media posts directed to an applicant's columns that identify applicant as their source.

Takeaway

This is a precedential change in practice for the newspaper industry. Now, the titles of non-syndicated print columns may be registered as trademarks.

If you seek to register such a print newspaper column title as a trademark, you should be prepared to submit specimens showing that the column has an independent life apart from the newspaper as a whole. This may consist of on-line title searches for the content of a column,

separately viewable portions of the publication on a website, or other evidence demonstrating the separate or independent status of the column.

[***In re The New York Times Company, Serial Nos. 90106071, 90112154, 90112577, 90115155, 90115491, 90115337 \(Consolidated\) \(T.T.A.B. March 30, 2023\).***](#)

For further information, contact [William M. Borchard](#), [Theodora M. Fleurant](#), or your CLL Attorney.

[**William M. Borchard**](#)



Counsel

[Email](#) | 212.790.9290

Bill advises on domestic and international trademark matters at the highest level. His practice consists of counseling clients and handling domestic and international trademark and copyright matters including clearance, registration, proper use, licensing, contested administrative proceedings and infringement claims.

[**Theodora M. Fleurant**](#)



Staff Attorney

[Email](#) | 212.790.9208

Theodora focuses on trademark and copyright clearance, prosecution, enforcement, litigation, and transactions. She is especially interested in assisting under-resourced businesses and communities to develop and protect their intellectual property, often a missing component of community economic development services. She has a particular interest in helping future fashion designers to achieve their goals.