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"That's Hot!" Celebrities Use Trademarks to Add to Their Wealth, But Is It Excessive?

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“THAT’S HOT!” CELEBRITIES USE TRADEMARKS TO ADD TO THEIR WEALTH, BUT IS IT EXCESSIVE?

*Rebecca Zilberman**

Celebrities are constantly registering for trademarks to protect and monetize off their brand, but they take advantage of trademark laws. Although certain trademark registrations are justified and necessary for brand protection, others are not. Furthermore, allowing celebrities to have hundreds of registered trademarks does nothing to achieve the purpose of trademark law.

This Note is about how celebrities excessively register trademarks for their names and catchphrases. First, this Note discusses the background of trademark law, including the difference between ® and TM. In addition, this Note explains the ways in which celebrities can sue under the Lanham Act – Federal Trademark Infringement, Federal Unfair Competition, and/or Federal Trademark Dilution. The criteria that must be met in order to register a trademark is also discussed. Next, this Note examines how some trademarks are allowed to be registered while others are not. Lastly, this Note contends that there is over-protection of celebrities and trademark law can be too generous at times, which disadvantages non-celebrities and small businesses. This note suggests that celebrities should not be allowed to have trademark protection for a name or phrase if they are not already producing, selling, or distributing products with the mark. In addition, celebrities should not be allowed to register just their first name and should not be allowed to register catchphrases that are common strings of words. With these proposed solutions, the current law would have to change in order for the U.S. Patent and Trademark Office to be stricter when deciding which marks should be registered.

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I. INTRODUCTION

"Rise and Shine." To some, this is an everyday phrase, but to Kylie Jenner, this is the subject of one of her recent trademark applications.¹ This simple phrase has been a lucrative way for Kylie to monetize off of her likeness.² "In the age of personal brands and influencers, . . . more and more famous people" register trademarks for their names and catchphrases.³ Celebrities have realized they can amass more wealth "without explicitly selling a traditional product, and trademark registrations give [celebrities] the power to do so without [concern of others] taking advantage of the opportunity."⁴

The Kardashians/Jenners, Beyoncé, Rihanna, and Justin Bieber are all well-known examples of celebrities who have registered for trademarks for their names.⁵ Some celebrities have even registered or attempted to register their slogans, such as Paris Hilton and Donald Trump.⁶ "One of the first pop stars to protect her name and likeness was Madonna in the 1980s, and one of the most influential trademark cases involving a celebrity name was the 1998 battle between Elvis Presley's estate and a dive bar in Houston[, which was] called The Velvet Elvis [at the time]."⁷

1. Shannon Barbour, *Twitter Is So Annoyed that Kylie Jenner Filed to Trademark "Rise and Shine"*, COSMOPOLITAN (Oct. 22, 2019), <https://www.cosmopolitan.com/entertainment/celebs/a29549935/kylie-jenner-trademark-rise-and-shine-twitter-reactions/> [https://perma.cc/GPW6-QU6L].

2. *Id.*

3. Kaitlyn Tiffany, *Why Celebrities Try to Trademark Their Catchphrases and Baby Names*, VOX (Apr. 19, 2019, 2:40 PM), <https://www.vox.com/the-goods/2019/4/19/18507920/celebrity-trademark-history-baby-names-taylor-swift> [https://archive.is/wy9aP].

4. *Id.*

5. *Celebrities, Sports Stars, and Trademarking Names*, CORSEARCH (Apr. 18, 2019), <https://corsearch.com/knowledge-base/article/celebrities-sports-stars-and-trademarking-names/> [https://perma.cc/KM3P-BK84].

6. Danny Paez, *Celebrity Trademarks: From Donald Trump to Jay-Z*, CNBC (Oct. 29, 2015, 3:36 PM), <https://www.cnn.com/2015/10/29/celebrity-trademarks-from-donald-trump-to-jay-z.html> [https://perma.cc/E57W-E56H].

7. Tiffany, *supra* note 3; *Elvis Presley Enters. v. Capece*, 141 F.3d 188, 191 (5th Cir. 1998); see discussion *infra*, Section IV.B.

Celebrities also try to register their children's names for two reasons: (1) "they are using the names on products and services," or (2) the famous parents have a "desire to ensure third parties do not attempt to register" their children's names and "commercialize them for their own benefit without authorization."⁸ However, the second circumstance potentially leads to a failed registration because the U.S. Patent and Trademark Office ("USPTO") usually has a "use" requirement.⁹ Nevertheless, celebrities can sometimes circumvent this requirement if they show an "intention to use."¹⁰

Both celebrity names and phrases are classified as "descriptive" marks.¹¹ "Descriptive marks are those trademarks or service marks that only describe the products or services to which they are applied."¹² Unless they achieve a secondary meaning, "[m]arks that are merely descriptive are not protected or accorded trademark rights."¹³ Secondary meaning can be achieved when "consumers recognize the mark as a designation of a particular source."¹⁴ Thus, a celebrity can only register the name or phrase if it has a secondary meaning, such that the name or phrase is synonymous in the public mind with the service provided by the plaintiff (such as Kylie Jenner's "Rise and Shine").¹⁵ However, because famous trademarks are more likely to be associated and remembered in the public's mind, they enjoy a broad scope of legal protection.¹⁶ Although trademark law forbids hoarding trademarks and creating a stash of the words in the English language that someone might use someday, celebrities have found loopholes in the rules, enabling

8. *Why Are Celebrities Seeking (and Often Failing) to Register Their Children's Names?*, FASHION LAW (Feb. 18, 2019), <https://www.thefashionlaw.com/why-are-celebrities-rushing-to-trademark-their-childrens-names/> [<https://perma.cc/W88W-8RMG>].

9. *Id.*

10. 15 U.S.C. § 1051(b)(1).

11. *Cairns v. Franklin Mint Co.*, 24 F. Supp. 2d 1013, 1034–35 (C.D. Cal. 1998); *see also Descriptive Trademarks and Service Marks*, JUSTIA, <https://www.justia.com/intellectual-property/trademarks/strength-of-marks/descriptive-marks/> [<https://perma.cc/PG24-XEKS>].

12. *Descriptive Trademarks and Service Marks*, *supra* note 11.

13. *Id.*

14. *Id.*

15. *Cairns*, 24 F. Supp. 2d at 1034; *Barbour*, *supra* note 1.

16. *Tiffany*, *supra* note 3.

them to excessively register names and catchphrases.¹⁷ Consequently, there is too much protection for celebrities and the system is overcrowded with registered trademarks.¹⁸

Since 1985, 6.7 million trademark applications have been filed with the U.S. Patent and Trademark Office.¹⁹ The Kardashian/Jenner family cumulatively holds hundreds of registered trademarks.²⁰ This includes names and phrases, many of which are obscure and not used in commerce.²¹

In May 2019, Kim Kardashian filed a trademark for her son's name, Psalm West, when he was only 14 days old.²² Kim also filed documents to trademark the names of her other kids—Saint, North, and Chicago West.²³ Likewise, her sister, Khloe Kardashian, filed trademarks for her daughter, True Thompson.²⁴ The trademarks were for the use of the name on a number of products, "including a clothing line, toys and skin care products."²⁵ More recently, in September 2020, Kim filed a trademark "for KKW Home, which includes a laundry list of household items set to be sold in various retail stores."²⁶

17. *Id.*

18. *Id.*

19. *Id.*

20. Lisette Voytko, *Kardashian Clan's 716 Trademarks: How Kim, Kanye, Kylie, and Kendall Protect Their Brands*, FORBES (July 5, 2019, 5:43 AM), <https://www.forbes.com/sites/lisettevoytko/2019/07/05/kardashian-clans-716-trademarks-how-kim-kanye-kylie-and-kendall-protect-their-brands/?sh=4ab818d24e67> [<https://archive.is/BR6Rq>].

21. See *id.*

22. *Psalm West I'm Joining the Kardashian Empire . . . Starting My Own Business*, TMZ (May 23, 2019, 7:37 AM), <https://www.tnz.com/2019/05/23/psalm-west-trademark-kim-kardashian-kanye/> [<https://archive.ph/a2Wx2>].

23. *Kim, Khloe & Kylie Putting Our Kids' Names to Work*, TMZ (Feb. 18, 2019, 6:52 AM), <https://www.tnz.com/2019/02/18/kim-khloe-kylie-kardashian-trademark-true-stormi-north-chicago-saint/> [<https://archive.ph/CgRaB>].

24. *Id.*

25. *Id.*

26. Georgia Slater, *Kim Kardashian Trademarks KKW Home as She Looks to Expand Her Empire with Line of Home Goods*, PEOPLE (Sept. 5, 2020, 7:00 PM), <https://people.com/home/kim-kardashian-trademarks-kkw-home/> [<https://perma.cc/DA3Y-9F7J>].

In February 2019, Kylie Jenner successfully registered a trademark for her daughter, Stormi Webster, and in March 2019, she attempted to sue “a company called Business Moves Consulting for trying to trademark ‘Stormi Couture,’ [which was] just a month after she gave birth.”²⁷ Kylie “believe[d] the company was trying to make money off her daughter’s name and that they filed the trademark ‘in bad faith.’”²⁸ In October 2019, Kylie Jenner registered for the trademark of “Rise and Shine” after she went viral in a video where she sang those words to her daughter, Stormi.²⁹ People on Twitter were unhappy that she was able to register a trademark for such a common phrase.³⁰ One person wrote that it was like registering “happy birthday.”³¹

In August 2020, Kris Jenner filed trademark documents for her iconic phrase, “You’re doing amazing sweetie.”³² Kris’s trademark will apply to using the phrase on items such as coats, dresses, footwear, headwear, jackets, jumpers, loungewear, rompers, scarves, baby onesies, hairbrushes, home decor, baby carriers, journals, calendars, greeting cards, accessories and cosmetics.³³ In addition, Kris filed documents in May 2015 to trademark “Momager.”³⁴ Subsequently, “[a] [two]-year battle ensued after the trademark office blocked her[,] . . . concluding the name was too similar to an existing trademark someone had for ‘momanger.’”³⁵ The parties “settled the

27. Mehera Bonner, *Kylie Jenner Is Suing a Company for Trying to Trademark “Stormi Couture,”* COSMOPOLITAN (Apr. 29, 2020), <https://www.cosmopolitan.com/entertainment/celebs/a32317759/kylie-jenner-suing-stormi-couture/> [<https://perma.cc/XZL8-PND5>].

28. *Id.*

29. Barbour, *supra* note 1.

30. *Id.*

31. *Id.*

32. Chelsea Hirsch, *Kris Jenner Files Trademark for ‘You’re Doing Amazing Sweetie’ Catchphrase,* PAGE SIX (Aug. 27, 2020, 11:17 AM), <https://pagesix.com/2020/08/27/kris-jenner-files-trademark-for-youre-doing-amazing-sweetie-catchphrase/> [<https://perma.cc/9P2Z-RDMC>].

33. *Id.*

34. *Kris Jenner Lemme Try This Again . . . ‘Momager’ is Ready for Business!!!*, TMZ (May 14, 2018, 7:18 AM), <https://www.tz.com/2018/05/14/kris-jenner-files-trademark-momager-kylie-jenner/> [<https://archive.ph/NoIQF>].

35. *Id.*

dispute in November 2017 under one condition—Kris [cannot] use the name for any reality [television] or web programming.”³⁶

It is evident from the above examples that celebrities have often filed for a variety of trademarks, but at what point are these registrations excessive? This Note argues that celebrities should not be allowed to have trademark protection for a name in which they are not already producing, selling, or distributing products with the mark. It is clear that celebrities abuse trademark law. Allowing the Kardashians to have hundreds of registered trademarks does nothing to achieve the purpose of trademark law in the celebrity context, which is to protect a celebrity’s brand.³⁷ Part II of this Note discusses the background of trademark law, including the difference between the symbols Registered® and Trademark™ (most celebrity trademark litigation only involves registered ® marks) as well as the trademark statutory law and case law which allows celebrities to sue under the Lanham Act. Part III discusses how some trademarks are allowed to be registered while others are not. Part IV argues that celebrities should not be allowed to hold innumerable trademarks. Lastly, Part V proposes a solution for how the U.S. Patent and Trademark Office (“USPTO”) should handle celebrities excessively registering trademarks: not allow celebrities to reserve rights in a trademark just because they have an “intent to use” the trademark in commerce; not allow celebrities to register only their first name; not allow celebrities to register a trademark for a common phrase; and provide an adequate remedy to non-celebrities being sued by celebrities.

II. BACKGROUND

The background of trademark law and an explanation of its provisions is important to understand how celebrities are able to excessively register trademarks. First, it is essential to differentiate “TM” and “®” because only celebrity marks which include “®” are officially registered with the U.S. Patent and Trademark Office.³⁸ For a mark to be eligible for trademark protection, a celebrity must use the mark in commerce and the mark must have

36. *Id.*

37. This purpose of trademark law is true in the celebrity context but not as a general principle.

38. *The Difference Between Trademark & Registered in Brands*, CHRON. (Sept. 8, 2021), <https://smallbusiness.chron.com/difference-between-trademark-registered-brands-26370.html> [<https://perma.cc/R6H6-WQQQ>].

acquired secondary meaning.³⁹ If the two requirements for trademark protection are established, a celebrity can sue for Federal Trademark Infringement, Federal Unfair Competition, and/or Federal Trademark Dilution.⁴⁰

A. Difference Between Registered® and Trademark™

“In the United States, parties are not required to register their marks to obtain protectable rights.”⁴¹ Celebrities “can establish ‘common law’ rights in a mark based solely on use of the mark in commerce, without a registration.”⁴² When celebrities file applications for different trademarks, they seek to gain the right to use the ® symbol. The context of this Note focuses on when a celebrity successfully registers a trademark with the USPTO, and thus would gain the right to use the ® symbol, rather than when a celebrity merely puts a “TM” after their name or a phrase.

If a mark is registered with the USPTO, there should be an ® symbol after the mark.⁴³ A mark that is not yet registered may use TM for goods or SM for services to indicate that the mark has been adopted as a “common law” trademark or service mark.⁴⁴

Although TM stands for trademark under the common law, “its use does not mean the associated mark holds legal protection. Anyone can use the TM on a symbol, phrase, word, or design.”⁴⁵ A company may use “TM” to show competitors that they claim a trademark on a particular symbol, phrase, word, or design.⁴⁶ Additionally, “[m]any companies also use [TM] on their marks when the trademark application is in process with the USPTO.

39. *Lanham Act*, LEGAL INFO. INST., https://www.law.cornell.edu/wex/lanham_act [<https://perma.cc/G2TK-8LSN>].

40. *See generally id.*

41. U.S. Pat. & Trademark Off., *Protecting Your Trademark* 13 (2020).

42. *Id.*

43. *Trademark vs. Registered: Everything You Need to Know*, UPCOUNSEL, (July 21, 2020), <https://www.upcounsel.com/trademark-vs-registered> [<https://perma.cc/B6QG-M89K>].

44. U.S. Pat. & Trademark Off., *supra* note 41, at 13.

45. *Trademark vs. Registered: Everything You Need to Know*, *supra* note 43.

46. *Id.*

In this case, it means that the trademark is pending."⁴⁷ By contrast, "[w]hen a mark includes the ® symbol, this means that it has an approved trademark through the USPTO."⁴⁸ A person "cannot legally use the registered symbol until" their trademark registration application is approved.⁴⁹

"Trademark registration includes public notice of the owner's claim to the mark, a legal presumption that the party that registered the mark owns it and has the exclusive right to use the mark in the [United States] and [gives the registered owner] the ability to bring an action concerning the mark in federal court."⁵⁰ Consequently, "a company that registers its trademarks may have an easier time defending its trademarks against anyone who tries to use them without permission."⁵¹

B. Requirements for Trademark Protection

1. Trademark Generally

A trademark is statutorily defined as a word, phrase or symbol used to identify a manufacturer or sponsor of a good or the provider of a service.⁵² It is "the owner's way of preventing others from duping consumers into buying a product they mistakenly believe is sponsored by the trademark owner."⁵³ Trademarks "inform[] people that trademarked products come from the same source."⁵⁴

The Lanham Act (also known as the Trademark Act) is the federal statute, enacted by Congress in 1946, that governs trademarks, service marks, and unfair competition.⁵⁵ The Lanham Act sets out procedures for federally

47. *Id.*

48. *Id.*

49. *Id.*

50. *The Difference Between Trademark & Registered in Brands*, *supra* note 38.

51. *Id.*

52. 15 U.S.C. § 1127.

53. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002).

54. *Id.*

55. *See Lanham Act*, *supra* note 39.

registering trademarks, details when owners of trademarks may be entitled to federal judicial protection against infringement, and establishes other guidelines and remedies for trademark owners.⁵⁶ The Act “protects the owner of a federally registered mark against the use of similar marks if such use is likely to result in consumer confusion, or if the dilution of a famous mark is likely to occur.”⁵⁷

The Act prohibits a number of activities, including trademark infringement, unfair competition, and trademark dilution.⁵⁸ A plaintiff can sue for Federal Trademark Infringement, in violation of 15 U.S.C. Section 1114; Federal Unfair Competition, in violation of 15 U.S.C. Section 1125(a); and/or Federal Trademark Dilution, in violation of 15 U.S.C. Section 1125(c).⁵⁹

“Two basic requirements must be met for a mark to be eligible for trademark protection [under the Lanham Act]: it must be in use[d] in commerce and it must be distinctive.”⁶⁰ This means that a plaintiff will be unable to sue for trademark infringement, unfair competition, and/or trademark dilution unless the mark is both used in commerce and distinctive.

2. Use in Commerce

The Lanham Act defines a trademark as a mark used in commerce or registered with a bona fide intent to use it in commerce.⁶¹ “Commerce” is defined as “all commerce which may lawfully be regulated by Congress.”⁶² The statute then provides that “‘use in commerce’ means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.”⁶³ “Examples of insufficient usage would include

56. *See generally id.*

57. *Id.*

58. Explained further in the following subsections.

59. *Lanham Act*, *supra* note 39; *see also* 15 U.S.C. § 1125.

60. *Lanham Act*, *supra* note 39.

61. 15 U.S.C. § 1127.

62. *Id.*

63. *Id.*

token use or minimal use for the sole purpose of supporting a trademark application."⁶⁴

The starting point of whether a mark is used in commerce is the identification of goods and services recited in the trademark application.⁶⁵ First, "[f]or goods, use in commerce refers to the product being sold and transported within the United States in the ordinary course of trade with the mark preferably displayed on the product itself or on external materials such packaging, tags and labels."⁶⁶ Regarding "services, use in commerce refers to the services being rendered within the United States in connection with the mark. Acceptable specimens of use for service marks may include advertising and marketing materials displaying the mark and referencing the services identified in the application."⁶⁷

Alternatively, if a mark is not used in commerce at the time the application for registration is filed, registration may still be permitted if the applicant establishes, in writing, a good faith intent to use the mark in commerce at a future date.⁶⁸ This is called an intent-to-use trademark application (ITU application).⁶⁹ A person who has not yet made use of a trademark may file an application for registration of the mark if such person "has a bona fide intention, under circumstances showing the good faith of such person, to use [the] trademark in commerce."⁷⁰ This "bona fide intention must be 'firm' and 'must reflect an intention to use the mark . . . in the ordinary course of trade, and not made merely to reserve a right in a mark.'"⁷¹ However, filing

64. Vic Lin, *What Is Trademark Use in Commerce?*, PAT. TRADEMARK BLOG: IP Q&A, <http://www.patenttrademarkblog.com/trademark-use-in-commerce/> [https://perma.cc/B67G-25RL].

65. *Id.*

66. *Id.*

67. *Id.*

68. 15 U.S.C. § 1051(b); see, e.g., *Psalm West I'm Joining the Kardashian Empire . . . Starting My Own Business*, *supra* note 22.

69. *Trademark Applications – Intent-to-Use (ITU) Basis*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks-application-process/filing-online/intent-use-itu-applications> [https://perma.cc/R7KH-WJ9N].

70. 15 U.S.C. § 1051(b)(1).

71. *Veronica Morales d/b/a Blue Ivy v. BGK Trademark Holdings, LLC*, No. 91234467 at 31 (T.T.A.B. 2020), <https://ttabvue.uspto.gov/ttabvue/ttabvue-91234467-OPP-55.pdf>.

a trademark application merely so no one else can use it is not enough to successfully register a mark because there has to be future intent to use the mark in commerce.⁷² The registrant must show that they have “taken business steps to use the mark, such as establishing a business plan [or] reaching out to manufacturers.”⁷³ Once the trademark application is approved by the USPTO, the celebrity registering the mark “will have up to three years to provide ‘proof of use.’”⁷⁴ However, the registrant will have to pay a fee every six months “to extend the life of the application.”⁷⁵

It is very common for a celebrity to submit an intent-to-use application rather than an actual use-in-commerce application.⁷⁶ Many celebrities may be tempted to register for a mark just to prevent others from doing so, even if at the time they do not have an intent to use the mark. On the other hand, a lack of proof of actual use in commerce can open the door to trademark litigation if there is a lack of the intent to use as well. The opposer of a trademark “may establish prima facie evidence of a lack of a bona fide intent[] to use a mark” in commerce by showing that the applicant does not have evidence of its “alleged intent to use” the mark on the identified goods and/or services “as of the filing date of a trademark application.”⁷⁷

Nevertheless, trademark rights in a personal name or catchphrase are not automatic just because the mark is used in commerce. Obtaining a trademark registration with the USPTO in a personal name or catchphrase

72. *Id.*

73. Josh Gerben, *Celebrities File Trademarks to Protect Their Children’s Names - Should You?*, GERBEN LAW, <https://www.gerbenlaw.com/blog/celebrities-attempt-to-protect-their-childrens-names-under-trademark-law/> [<https://perma.cc/Q6A3-3WNU>].

74. *Id.*

75. *Id.*

76. *See, e.g.*, Dina Leytes & Christine E. Weller, *Would Kylie by Any Other Name Still Make Millions?*, ABA (2016), https://www.americanbar.org/groups/intellectual_property_law/publications/landslide/2016-17/november-december/would-kylie-any-other-name-still-make-millions-rise-trademark-disputes-over-celebrity-branding/ [<https://perma.cc/ZDY7-RHJX>].

77. Cathy Dahl, *Beyoncé Trademark Case Provides Evidentiary Lessons Before the TTAB*, JDSUPRA (Aug. 11, 2020), <https://www.jdsupra.com/legalnews/beyonce-trademark-case-provides-68539/> [<https://perma.cc/6YMV-JH9G>].

requires a solid argument that the name has secondary meaning when used in commerce.⁷⁸

3. Distinctive Requirement: Secondary Meaning

“The second requirement, that a mark be distinctive, addresses a trademark’s capacity for identifying and distinguishing particular goods as [originating] from one producer or source and not another.”⁷⁹ In order “to qualify for a trademark registration a mark must be either: (i) inherently distinctive, or (ii) distinctive by virtue of having acquired a secondary meaning.”⁸⁰ “Marks are generally classified in one of five categories of distinctiveness: (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.”⁸¹ “Suggestive, arbitrary, and fanciful marks are considered ‘inherently distinctive’ and are automatically entitled to federal trademark protection because ‘their intrinsic nature serves to identify a particular source of a product.’”⁸² “Generic marks are never entitled to trademark protection and descriptive marks may become protected if they have acquired ‘secondary meaning,’ that is, ‘acquired distinctiveness as used on or in connection with the [trademark owner’s] goods in commerce.’”⁸³ “Secondary meaning is the consuming public’s understanding that the mark, when used in context, refers, not to what the descriptive word ordinarily describes, but to the particular business that the mark is meant to identify.”⁸⁴

Personal names—both surnames and first names—are regarded as descriptive terms; they “are not inherently distinctive marks and can be protected as trade or service marks only where they have acquired secondary

78. *Boldface Licensing + Branding v. By Lee Tillett, Inc.*, 940 F. Supp. 2d 1178, 1186 (C.D. Cal. 2013).

79. *Trademark*, LEGAL INFO. INST., <https://www.law.cornell.edu/wex/trademark> [<https://perma.cc/W95V-D5UT>].

80. *A.V.E.L.A., Inc. v. Est. of Marilyn Monroe, LLC*, 131 F. Supp. 3d 196, 213–14 (S.D.N.Y. 2015).

81. *Boldface Licensing + Branding*, 940 F. Supp. 2d at 1186.

82. *Id.*

83. *Id.*

84. *Perini Corp. v. Perini Constr., Inc.*, 915 F.2d 121, 125 (4th Cir. 1990).

meaning.”⁸⁵ “A person asserting trademark infringement against another must prove as a factual matter that they had established secondary meaning in the mark (1) as to the particular line of goods in question (2) prior to the date that the alleged infringer began using the mark.”⁸⁶ For example, “a plaintiff must allege that the personal name asserted as a mark has acquired secondary meaning such that the name is synonymous in the public mind with the service provided by the plaintiff.”⁸⁷ “Implicit in the concept of a trademark ‘is a requirement that there be direct association between the mark . . . and the services specified in the application, i.e., that it be used in such a manner that it would be readily perceived as identifying such services.’”⁸⁸

Under this analysis, “[m]ere ‘association’ is not sufficient to establish secondary meaning.”⁸⁹ Rather, “a specific type of association must be proven.”⁹⁰ This specific “kind of association is demonstrated where individuals viewing the design over which trademark rights are asserted associate that design *with a single source*, whether or not they can name that source.”⁹¹

Different circuit courts have different case law factors for analyzing secondary meaning. The Eleventh Circuit has considered “four factors in assessing secondary meaning: (1) ‘the length and nature of the name’s use,’ (2) ‘the nature and extent of advertising and promotion of the name,’ (3) ‘the efforts of the proprietor to promote a conscious connection between the name and the business,’ and (4) ‘the degree of actual recognition by the public that the name designates the proprietor’s product or service.’”⁹² “The Second Circuit has offered the following factors as relevant to, though not dispositive of, the ‘secondary meaning’ inquiry: (1) advertising

85. Cairns v. Franklin Mint Co., 24 F. Supp. 2d 1013, 1034 (C.D. Cal. 1998).

86. Chrysler Corp. v. Vanzant, 44 F. Supp. 2d 1062, 1074 (C.D. Cal. 1999).

87. *Cairns*, 24 F. Supp. 2d at 1034.

88. *Id.*

89. *Chrysler Corp.*, 44 F. Supp. 2d at 1073.

90. *Id.*

91. *Id.*; see, e.g., Caroline Donnelly, 7 *Famous Phrases Famous People Own*, MENTAL FLOSS (Jan. 23, 2008), <https://www.mentalfloss.com/article/17881/7-famous-phrases-famous-people-own> [<https://perma.cc/2TXF-C2WA>] (a person viewing a product with “That’s Hot” would know the product was associated with Paris Hilton).

92. *Tana v. Dantanna’s*, 611 F.3d 767, 776 (11th Cir. 2010).

expenditures; (2) consumer studies linking the mark to a source; (3) sales success; (4) unsolicited media coverage of the product; (5) attempts to plagiarize the mark; and (6) the length and exclusivity of the mark's use."⁹³ There is no prevailing standard, and the inquiry is fact-specific that differs for each jurisdiction.⁹⁴

For example, Kylie Jenner successfully registered trademarks for words involving her makeup and skincare lines because the words acquired a secondary meaning.⁹⁵ Products such as her "lip kits" can be directly associated in the mind of the public with Kylie Jenner.⁹⁶ Her "kyliner," "kyshadow," and "kybrow" can all be associated with Kylie Jenner.⁹⁷ Thus, due to her status as a beauty mogul, Kylie Jenner was able to acquire many trademarks that have to do with her makeup and skincare businesses.⁹⁸

In contrast, "Cardi B's application to trademark her signature phrase 'okurrr' was refused by the [USPTO]."⁹⁹ The USPTO refused to register the trademark "because it is a 'commonplace term, message, or expression widely used by a variety of sources that merely conveys an ordinary, familiar, well-recognized concept or sentiment.'"¹⁰⁰ The phrase "is 'commonly used in the drag community and by celebrities as an alternate way of saying 'OK' or 'something that is said to affirm when someone is being put in their

93. *Perini Corp. v. Perini Constr., Inc.*, 915 F.2d 121, 125 (4th Cir. 1990).

94. Jonathan Schmig, *The Fact-Specific Mess of Secondary Meaning in Trademark Law*, LAWINC (May 11, 2015), <https://www.lawinc.com/secondary-meaning-trademark> [https://perma.cc/MJ23-8STS].

95. See Kelsey Stiegman, *Kylie Jenner Reportedly Working on Kyshadow, Kyliner and Kybrow Kits*, SEVENTEEN (Apr. 12, 2016), <https://www.seventeen.com/beauty/celeb-beauty/news/a39648/kylie-jenner-reportedly-working-on-eyeshadow-eyeliner-and-eyebrow-kits/> [https://perma.cc/GJ23-7SYZ].

96. See Kayleen Schaefer, *Kylie Jenner Built a Business Empire Out of Lip Kits and Fan Worship*, VANITY FAIR (Oct. 21, 2016), <https://www.vanityfair.com/style/2016/10/kylie-jenner-lip-kits-seed-beauty-colourpop> [https://perma.cc/92LW-MYB9].

97. Stiegman, *supra* note 95.

98. See Schaefer, *supra* note 96.

99. Carma Hassan, *Cardi B Wanted to Trademark 'Okurrr.' The Patent Office Said 'uh uh'*, CNN (July 1, 2019, 2:42 PM), <https://www.cnn.com/2019/07/01/entertainment/cardi-b-okurrr-trademark-trnd/index.html> [https://perma.cc/LV7A-NSPZ].

100. *Id.*

place.”¹⁰¹ Consequently, individuals viewing the design over which trademark rights were asserted would not have associated that design with *only* Cardi B.¹⁰² Thus, although “okurrr” is commonly associated with Cardi B, that mere “association” was not sufficient to establish secondary meaning.

C. What Provisions Allow a Celebrity to Sue for Trademark Infringement?

1. Trademark Infringement in Violation of 15 U.S.C. Section 1114

To prevail on a Lanham Act trademark claim for a registered mark, a plaintiff must prove: (1) the plaintiff has a valid and legally protectable mark; (2) the plaintiff owns the mark; and (3) the defendant’s use of the mark to identify goods or services causes a likelihood of confusion.¹⁰³ The statute provides that:

Any person who shall, without the consent of the registrant . . . use . . . any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services . . . which . . . is likely to cause confusion, or to cause mistake, or to deceive . . . shall be liable in a civil action by the registrant.¹⁰⁴

To show consumer confusion, the plaintiff must show more than a possibility of confusion, although actual confusion is not necessary.¹⁰⁵ Nevertheless, “actual confusion among significant numbers of consumers provides strong support for the likelihood of confusion.”¹⁰⁶

Likelihood of confusion turns on whether a “reasonably prudent consumer in the marketplace is likely to be confused as to the origin of the good

101. *Id.*

102. See *id.*

103. *A&H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 210 (3rd Cir. 2000).

104. 15 U.S.C. § 1114(1)(a).

105. *Rearden LLC v. Rearden Com., Inc.*, 683 F.3d 1190, 1209 (9th Cir. 2012).

106. *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1151 (9th Cir. 2011).

or service bearing one of the marks."¹⁰⁷ To prevail, "the plaintiff must demonstrate that the defendant is 'using a mark confusingly similar to a valid, protectable trademark' owned by the plaintiff."¹⁰⁸

When determining the likelihood of confusion in a celebrity case, the Ninth Circuit generally considers the following eight factors:

(1) [t]he level of recognition that the [celebrity] has among the segment of the society for whom the defendant's product is intended; (2) [t]he relatedness of the fame or success of the [celebrity] to the defendant's product; (3) [t]he similarity of the likeness used by the defendant to the actual [celebrity]; (4) [e]vidence of actual confusion; (5) [m]arketing channels used; (6) [l]ikely degree of purchaser care; (7) [d]efendant's intent on selecting the [celebrity]; and (8) [l]ikelihood of expansion of the product lines.¹⁰⁹

Notably, however, "[t]hese factors 'are not necessarily of equal importance, nor do they necessarily apply to every case.'"¹¹⁰ Moreover, "whether a party [hits] a majority of the factors is not the point."¹¹¹ The factors should not "be rigidly weighed."¹¹²

The Ninth Circuit used the likelihood of confusion factors in a dispute between Boldface and Tillett. "Tillett is a Florida-based company that sells beauty services and all-natural cosmetics under the trademark KROMA in the United States and the United Kingdom."¹¹³ On November 12, 2010, "Tillett filed a federal trademark application for the KROMA mark on

107. Boldface Licensing + Branding v. By Lee Tillett, Inc., 940 F. Supp. 2d 1178, 1186 (C.D. Cal. 2013).

108. *Id.*

109. Fifty-Six Hope Rd. Music, Ltd. v. A.V.E.L.A., Inc., 778 F.3d 1059, 1069 (9th Cir. 2015).

110. *Id.*

111. *Id.*

112. *Id.*

113. Boldface Licensing + Branding v. By Lee Tillett, Inc., 940 F. Supp. 2d 1178, 1182 (C.D. Cal. 2013).

cosmetics.”¹¹⁴ Boldface has “a cosmetics line under the mark KHROMA BEAUTY BY KOURTNEY, KIM AND KHLOE, which is affiliated with the celebrity Kardashian sisters—Kourtney, Kim, and Khloe.”¹¹⁵ Boldface filed applications with USPTO for the following two marks in June 2012: “KHROMA BEAUTY BY KOURTNEY, KIM AND KHLOE” and “KARDASHIAN KHROMA.”¹¹⁶ Tillett sought “to enjoin Boldface’s use of the mark on its cosmetics throughout the United States, believing that the product launch has caused and will cause substantial consumer confusion with its federally registered KROMA mark for cosmetics.”¹¹⁷ Boldface sued “to obtain a declaration that the KHROMA BEAUTY products do not infringe Tillett’s mark, and Tillett counterclaimed for trademark infringement and false designation of origin under the Lanham Act, 15 U.S.C. [Sections] 1114(1)(a) and 1125(a).”¹¹⁸

As to the similarity of the marks, “Tillett claims without dispute that [“kroma” and “khroma”] are both derived from the word ‘chroma,’ which is the Greek word for ‘color.’”¹¹⁹ Furthermore, “the words ‘kroma’ and ‘khroma’ sound identical, despite the different spelling.”¹²⁰ In addition, “[t]he heart of both parties’ marks are . . . the words KHROMA and KROMA, which appear prominently on the parties’ products in all capital letters in a similar font.”¹²¹ As to relatedness of the goods, both parties “sell cosmetics, and in fact, some of their products are identical, such as blush, compacts, gloss, lip kits, foundation, eye shadow, and bronzer.”¹²² The court then noted that “[a]s to the parties’ comparative commercial strength [of their marks], Tillett’s KROMA mark has some commercial strength, but Boldface’s marks are far stronger and could easily overwhelm Tillett’s efforts”

114. *Id.*

115. *Id.* at 1181.

116. *Id.* at 1183.

117. *Id.* at 1181.

118. *Id.* at 1185.

119. *Id.* at 1187.

120. *Id.*

121. *Id.*

122. *Id.* at 1188.

because "Boldface's marks are backed by the Kardashian's nationwide fame."¹²³ As to actual confusion, "Tillett claims that commenters on social media and news sites regularly confuse the parties' marks."¹²⁴

The court also found "some overlap between the parties' marketing channels, which weighs in favor of a likelihood of confusion."¹²⁵ Moreover, "given the similarity of the parties' marks and relatedness of the goods on which those marks appear . . . even the high degree of care exercised by purchasers does not dispel the likely confusion created by Boldface's KHROMA BEAUTY mark."¹²⁶ As to intent, "Boldface was unquestionably aware of Tillett's rights and still proceeded with the multi-million-dollar rollout of the KHROMA BEAUTY product line."¹²⁷ Lastly, "[t]he expansion of product lines factor does not carry much weight here because the parties already directly compete with overlapping products."¹²⁸ The court concluded that "[a]n overall evaluation of the . . . factors demonstrates that a factfinder would likely find a likelihood of confusion here."¹²⁹ Accordingly, Tillett "demonstrated likely success on the merits of its infringement claims."¹³⁰

2. Federal Unfair Competition in Violation of 15 U.S.C. Section 1125(a)

Alternatively, a mark owner can choose to sue for federal unfair competition (false advertisement) under Section 1125(a) of the Lanham Act.¹³¹ The test is the same as for a trademark claim for a registered mark under 15 U.S.C. Section 1114: to establish trademark infringement under 15 U.S.C.

123. *Id.* at 1189–90.

124. *Id.* at 1192.

125. *Id.* at 1194.

126. *Id.* at 1194–95.

127. *Id.* at 1195.

128. *Id.* at 1195–96.

129. *Id.* at 1196.

130. *Id.*

131. 15 U.S.C. § 1125(a).

Section 1125(a), the "plaintiff must demonstrate that (1) it has a valid and legally protectable mark; (2) it owns the mark; and (3) the defendant's use of the mark to identify goods or services causes a likelihood of confusion."¹³² It is up to the plaintiff to choose which section of the Lanham Act he or she wants to bring suit under.

Title 15 U.S.C. Section 1125(a) creates a federal cause of action for unfair competition by prohibiting the use in interstate commerce of any "word, term, name, symbol or device . . . or any false designation of origin . . . which . . . is likely to cause confusion . . . as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person."¹³³ In this context, "[c]onsumer confusion occurs when consumers believe that the products or services offered by the parties are affiliated in some way, or when consumers make an incorrect mental association between the involved commercial products or their producers."¹³⁴ Additionally, "[a] 'likelihood' means a 'probability' rather than a 'possibility' of confusion."¹³⁵

Courts have found that "[i]n cases involving confusion over endorsement by a celebrity plaintiff, 'mark' means the celebrity's persona."¹³⁶ In such cases, "[t]he 'strength' of the mark refers to the level of recognition the celebrity enjoys among members of society."¹³⁷ Celebrities are entitled to sue under Section 1125(a) "because they possess an economic interest in their identities akin to that of a traditional trademark holder."¹³⁸ Thus, "[a] celebrity whose endorsement of a product is implied through the imitation of a distinctive attribute of the celebrity's identity has standing to sue for false

132. *A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 210 (3d Cir. 2000).

133. 15 U.S.C. § 1125(a).

134. *Parks v. LaFace Records*, 329 F.3d 437, 446 (6th Cir. 2003) (internal citations omitted).

135. *Id.*

136. *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992).

137. *Id.*; *see also Acad. of Motion Picture Arts & Scis. v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1455 (9th Cir. 1991).

138. *Parks*, 329 F.3d at 445.

endorsement under [Section 1125(a)] of the Lanham Act."¹³⁹ This means celebrities can sue if someone uses their likeness/name to sell products, even if they do not have a registered trademark.¹⁴⁰

Celebrities are constantly involved in lawsuits claiming false advertisement.¹⁴¹ For example, in July 2019, in a default judgment, Kim Kardashian won almost \$2.8 million in a false advertisement lawsuit against the clothing brand Missguided.¹⁴² The lawsuit stated that "Missguided's use of [Kim Kardashian's] marks [wa]s likely to cause consumers to mistakenly believe that [Kim Kardashian was] associated with Missguided, or that [she] sponsor[ed] or endorse[d] Missguided and its websites."¹⁴³ Indeed, consumers "already expressed such confusion, suggesting in social media posts and online articles that [Kardashian] must be in a 'collaboration' with Missguided."¹⁴⁴ There was consumer confusion because Missguided's website and Instagram had images of Kardashian West and her outfits, in which "customers could click on photos of her and be taken to a Missguided page selling a similar look."¹⁴⁵ Thus, "the company used her 'persona and trademarks' to sell replicas of her outfits, in part by continually tagging her on Instagram."¹⁴⁶ Missguided is not allowed to "use any of Kardashian West's trademarks 'in connection with the sale, marketing, or distribution of its products.'"¹⁴⁷ Thus, Missguided's use of "the names and images of

139. *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992).

140. *Parks*, 329 F.3d at 445.

141. See, e.g., Ashley Carman, *Kim Kardashian West Wins \$2.8 Million from Company that Kept Tagging Her in Instagram Posts*, VERGE (July 3, 2019, 3:19 PM), <https://www.theverge.com/2019/7/3/20681128/missguided-kim-kardashian-west-lawsuit-instagram-tag-fashion> [<https://perma.cc/9E4E-SUYG>].

142. *Id.*

143. *Id.*

144. *Id.*

145. *Id.*

146. *Id.*

147. Will Martin, *Kim Kardashian Won \$2.7 Million in a Lawsuit Accusing Fast-Fashion Brand Missguided of 'Knocking Off' Her Clothes*, BUS. INSIDER (July 4, 2019), <https://www.businessinsider.com/kim-kardashian-missguided-lawsuit-awarded-damages-california-judge-2019-7> [<https://perma.cc/Y94G-6MCP>].

Kardashian and other celebrities to advertise and spark interest in its website and clothing,” almost certainly violated the Lanham Act.¹⁴⁸

3. Federal Trademark Dilution in Violation of 15 U.S.C. Section 1125(c)

A famous mark enjoys broader protection than a mark that is not famous. The owner of a famous mark can also sue under 15 U.S.C. Section 1125(c) for trademark dilution.¹⁴⁹ To obtain injunctive relief for trademark dilution, plaintiffs must establish at least a fair chance of success on the merits of their claim by establishing that (1) the mark is famous; (2) defendants are using the mark commercially; (3) defendants’ use began after the mark became famous; and (4) defendants’ use dilutes the quality of the mark by diminishing the capacity of the mark to identify and distinguish goods and services.¹⁵⁰ The use must harm the reputation of the mark.¹⁵¹

Trademark “[d]ilution is defined as ‘the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of (1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake or deception.’”¹⁵² The statute provides that “a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.”¹⁵³

Dilution can either be by blurring or by tarnishment.¹⁵⁴ The Lanham Act defines “dilution by blurring” as the “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.”¹⁵⁵ It defines “dilution by tarnishment” as

148. *Id.*

149. 15 U.S.C. § 1125(c)(1).

150. *Cairns v. Franklin Mint Co.*, 24 F. Supp. 2d 1013, 1033–34 (C.D. Cal. 1998).

151. 15 U.S.C. § 1125(c)(2).

152. *Cairns*, 24 F. Supp. 2d at 1033.

153. 15 U.S.C. § 1125(c)(2)(A).

154. *Id.* § 1125(c).

155. *Id.* § 1125(c)(2)(B).

the "association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark."¹⁵⁶

An example of a lawsuit involving Federal Trademark Dilution was when Australian singer, Kylie Minogue, filed a notice of opposition to Kylie Jenner registering a trademark for "Kylie." Here, Minogue claimed Jenner's trademark was likely to cause confusion and it was likely to tarnish Minogue's reputation and branding.¹⁵⁷ Kylie Jenner applied for the trademark "Kylie" in 2015.¹⁵⁸ However, Minogue owns the website www.kylie.com, and has been performing as "Kylie" since before Jenner was born.¹⁵⁹ Minogue alleged that her marks were distinctive and famous, and therefore subject to the protections and remedies of 15 U.S.C. Section 1125(c).¹⁶⁰ Minogue further argued that registration of Jenner's mark would injure her "by causing a likelihood of dilution, through blurring and tarnishment, of the distinctive quality of [Minogue's] marks."¹⁶¹ Thus, Minogue sought to deny Jenner from registering the mark "Kylie."¹⁶² The parties settled out of court, and Minogue still owns www.kylie.com.¹⁶³

In 2018, Beyoncé sued Andre Maurice and Leana Lopez for operating a business that sells clothing and apparel with the mark FEYONCÉ and certain phrases from Beyoncé's well known songs.¹⁶⁴ Beyoncé "filed a

156. *Id.* § 1125(c)(2)(C).

157. USPTO, *Notice of Opposition* (2016), <https://ttabvue.uspto.gov/ttabvue/v?pno=91226456&pty=OPP&eno=1>, at 6–9.

158. *Id.* at 1, 5.

159. *Id.* at 2. (noting that Minogue registered www.kylie.com in 1996 and has been performing as "Kylie" since 1988); *Kylie Jenner Biography*, BIOGRAPHY (Nov. 19, 2019), <https://www.biography.com/personality/kylie-jenner> [<https://perma.cc/6BCQ-K8C4>](noting that Kylie Jenner was born August 10, 1997).

160. USPTO, *supra* note 157, at 9.

161. *Id.*

162. *See generally* USPTO, *supra* note 157.

163. *See* TFL, *On the Heels of the Kylie v. Kylie Trademark Battle, Kylie Minogue Launches Cosmetics*, THE FASHION LAW (Jun. 26, 2019), <https://www.thefashionlaw.com/on-the-heels-of-the-kylie-v-kylie-trademark-battle-kylie-minogue-launches-cosmetics/> [<https://perma.cc/7X9F-9M3Z>]; *see also* KYLIE, <https://www.kylie.com/> [<https://perma.cc/7LJG-ZPEC>].

164. *Knowles-Carter v. Maurice*, No. 1:2016CV02532 (S.D.N.Y. 2018) at 1.

complaint against Defendants Maurice and Lopez, in addition to Lee Lee and Feyonce, Inc., asserting causes of action for Federal Trademark Infringement, in violation of 15 U.S.C. [Section] 1114; Federal Unfair Competition, in violation of 15 U.S.C. [Section] 1125(a); [and] Federal Trademark Dilution, in violation of 15 U.S.C. [Section] 1125(c).¹⁶⁵ Often, a plaintiff will sue under all three causes of action.¹⁶⁶

In this case, the marks were “extremely similar in text, font, and pronunciation.”¹⁶⁷ However, “the core of the inquiry is whether ordinary purchasers would have difficulty distinguishing the products or ascertaining whether the [non-celebrity] product [was] affiliated with or sponsored by the [celebrity product].”¹⁶⁸ The Court could not conclude as a matter of law that confusion was likely.¹⁶⁹ Thus, Beyoncé’s motion for summary judgment on her unfair competition claims and federal trademark dilution claims were denied.¹⁷⁰

To conclude, if a plaintiff has a valid registered trademark, they are eligible to sue for Federal Trademark Infringement, in violation of 15 U.S.C. Section 1114; Federal Unfair Competition, in violation of 15 U.S.C. Section 1125(a); and/or Federal Trademark Dilution, in violation of 15 U.S.C. Section 1125(c).¹⁷¹ Celebrities often sue under all three statutes to cover all their bases.¹⁷² However, before a plaintiff can sue, they need to have a valid registered mark. The two basic requirements that need to be met for a mark to be eligible for trademark protection under the Lanham Act are that it is used

165. *Id.* at 4

166. *See, e.g., id.*

167. *Id.* at 8.

168. *Id.* at 12.

169. *Id.* at 11.

170. *Id.* at 16.

171. To bring an action for trademark violation, a celebrity will likely first list 15 U.S.C. Section 1114 on their complaint because it is the overall statute for trademark infringement. A celebrity would not likely sue under only 15 U.S.C. Section 1125(c) because the celebrity must first establish that they own a valid trademark recognizable under the U.S. Trademark Law or state law.

172. *See, e.g., Knowles-Carter v. Maurice*, No. 1:2016cv02532 (Plaintiffs filed a complaint against Defendants, asserting causes of action for Federal Trademark Infringement, in violation of 15 U.S.C. Section 1114; Federal Unfair Competition, in violation of 15 U.S.C. Section 1125(a); and Federal Trademark Dilution, in violation of 15 U.S.C. Section 1125(c)).

in commerce and it is distinctive. The next section analyzes why some trademarks are accepted while others are rejected.

III. CRITERIA FOR ACCEPTED TRADEMARKS

A mark must be used in commerce or there must be an intent to use, and the mark must be inherently distinctive, or distinctive by virtue of having acquired a secondary meaning.¹⁷³ However, although celebrities have fairly easy access to obtaining and protecting their trademarks, there are times when the USPTO will reject a trademark registration.¹⁷⁴ One of the most common instances is if the mark is identical or confusingly similar to an existing trademark.¹⁷⁵ "Similarity in sound, appearance, or meaning may be sufficient to support a finding of likelihood of confusion."¹⁷⁶ To avoid this problem, when celebrities "seek to create new trademarks to distinguish their brands, they may search the [online] database [of registered trademarks] to avoid creating and using marks that are [confusingly] similar to registered marks."¹⁷⁷

"The principal factors considered in reaching [a decision that the mark is identical or confusingly similar to an existing trademark] are the similarity of the marks and the commercial relationship between the goods and services identified by the marks."¹⁷⁸ In order "[t]o find a conflict, it is not required that the marks and the goods/services be exactly the same; instead, it is sufficient if the marks are similar and the goods and or services are related such

173. See 15 U.S.C. § 1127; see also *A.V.E.L.A., Inc. v. Est. of Marilyn Monroe, LLC*, 131 F. Supp. 3d 196, 213–14 (S.D.N.Y. 2015).

174. See generally *Possible Ground for Refusal of a Mark*, USPTO (July 11, 2016, 6:07 PM), <https://www.uspto.gov/trademark/additional-guidance-and-resources/possible-grounds-refusal-mark> [<https://perma.cc/S9JY-276X>].

175. *Id.* Registration of a mark is prohibited if it "[c]onsists of or comprises a mark which so resembles a mark registered in the [USPTO], or a mark or trade name previously used in the [U.S.] by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d).

176. *Possible Ground for Refusal of a Mark*, *supra* note 174.

177. *The Difference Between Trademark & Registered in Brands*, CHRON., <https://small-business.chron.com/difference-between-trademark-registered-brands-26370.html> [<https://perma.cc/R6H6-WQQQ>].

178. *Possible Ground for Refusal of a Mark*, *supra* note 174.

that consumers would mistakenly believe they come from the same source.”¹⁷⁹

For example, Paris Hilton was able to register “That’s Hot” but Donald Trump was unable to register “You’re fired!”¹⁸⁰ The decision about whether a phrase is registered hinges on whether or not the mark is identical or confusingly similar to an existing mark.¹⁸¹ The USPTO decided that “You’re Fired!” was too close to an existing trademark for an educational game for middle-school students called “You’re Hired!”¹⁸² Thus, the USPTO turned down Donald Trump’s attempt to trademark “You’re Fired!”¹⁸³ Paris Hilton was granted three trademarks for “That’s Hot” in 2007: “one for use in men and women’s clothing, another for electronic devices, and a third for alcoholic beverages.”¹⁸⁴ Presumably, Paris was able to register “That’s Hot” because it was not similar to an existing mark, the mark had acquired secondary meaning, and she was using it in commerce.¹⁸⁵ Thus, there was a clear difference between Paris Hilton’s trademark registration and Donald Trump’s attempt at a registration.

Another example is when Beyoncé and Jay-Z originally tried and failed to register their daughter’s name, Blue Ivy Carter, as a trademark in 2012.¹⁸⁶ Veronica Morales, a wedding planner, started her company Blue Ivy in 2009, and claimed first use of the BLUE IVY mark in commerce in October 2009.¹⁸⁷ Morales filed a trademark application “for the mark BLUE IVY in

179. *Id.*

180. Andrew LaSane, *From Cat Names to Fruit, Here Are 11 Bizarre Things Celebrities Have Tried to Trademark*, INSIDER (Oct. 22, 2019, 11:21 AM), <https://www.insider.com/bizarre-things-famous-people-have-tried-to-trademark-2019-6#donald-trump-tried-and-failed-to-trademark-his-reality-tv-phrase-youre-fired-8> [<https://perma.cc/B8FM-HKQ6>].

181. *Possible Ground for Refusal of a Mark*, *supra* note 174.

182. Eric Dash, *‘Fired’ Topped by ‘Hired’ at the Trademark Office*, N.Y. TIMES (Aug. 30, 2004), <https://www.nytimes.com/2004/08/30/business/fired-topped-by-hired-at-the-trademark-office.html> [<https://perma.cc/VQ3Y-M34D>].

183. *Id.*

184. Donnelly, *supra* note 91.

185. *See id.*

186. Dahl, *supra* note 77.

187. *Id.*

February 2012 for her event planning services, which registered in October 2012.”¹⁸⁸ BGK Trademark Holdings, LLC (Beyoncé Giselle Knowles-Carter) “filed an application for the mark BLUE IVY CARTER on January 26, 2012, on an intent-to-use basis, for a variety of consumer goods and services.”¹⁸⁹ This “application subsequently abandoned in February 2016 because no evidence of use was filed within the deadline.”¹⁹⁰ In January 2016, “BGK filed an identical replacement intent-to-use application for the BLUE IVY CARTER mark . . . which was approved and published for opposition in January 2017.”¹⁹¹

Morales opposed the registration of the BLUE IVY CARTER mark claiming: (1) a likelihood of confusion with her own BLUE IVY mark for wedding/event planning services; (2) no bona fide intent on the part of BGK to make use of the BLUE IVY CARTER mark for the goods/services in the application; and (3) fraud on the PTO.¹⁹² The Trademark Trial and Appeal Board ultimately dismissed all three of Morales’ claims in the Opposition in favor of BGK.¹⁹³ The court found that the goods and services are not identical, and there is no evidence suggesting they are related in a manner that would give rise to the mistaken belief that they emanate from the same source.¹⁹⁴ In addition, Morales “failed to demonstrate that the parties’ respective goods and services are related in any manner, or that they travel within the same trade channels to the same class of purchasers.”¹⁹⁵ Furthermore, “a mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark,” and although the Board lacked sufficient information to analyze relative commercial strength, Morales’ mark was most likely commercially weak compared to

188. *Id.*

189. *Id.*

190. *Id.*

191. *Id.*

192. Veronica Morales d/b/a Blue Ivy v. BGK Trademark Holdings, LLC, Opposition No. 91234467 (TTAB 2020), <https://ttabvue.uspto.gov/ttabvue/ttabvue-91234467-OPP-55.pdf>.

193. *Id.* at 43.

194. *Id.* at 24–25.

195. *Id.* at 27.

Beyoncé's mark.¹⁹⁶ Lastly, the trial record lacked evidence that could persuade the court that Beyoncé "possessed no evidentiary means to demonstrate its bona fide intention to use its proposed mark at the time it filed its application."¹⁹⁷

Even though BGK objected to all of Morales' interrogatories and requests for production, the Board still found none of the evidence or arguments compelling.¹⁹⁸ Beyoncé was not very cooperative and yet the court allowed her to also trademark BLUE IVY CARTER, despite Morales' opposition.¹⁹⁹ Typically, this would be a case of a trademark registration rejection, but due to Beyoncé's celebrity status, she was allowed to register a trademark that was the same as an existing trademark.

Therefore, to successfully register a trademark, there needs to be no likelihood of confusion with another mark, the mark must have a secondary meaning, and the registration cannot be in bad faith.²⁰⁰ Even with these hurdles, celebrities are constantly able to successfully register trademarks.²⁰¹

IV. SHOULD CELEBRITIES BE ALLOWED TO HOLD SO MANY TRADEMARKS?

Celebrities are clearly treated differently and receive more legal protection simply because their marks have extensive public recognition.²⁰² This disparity in treatment does not further the purpose of trademark law.

196. *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353 (Fed. Cir. 1992); *Veronica Morales d/b/a Blue Ivy*, No. 91234467, at 30.

197. *Veronica Morales d/b/a Blue Ivy*, No. 91234467, at 41.

198. *Id.* at 32.

199. *See generally id.*

200. A mark can be rejected by the Trademark Trial and Appeal Board if the application is a bad faith registration. Bad faith conduct can be found "where multiple applications have been filed for the identical mark." However, "one new trademark application for the identical mark will not . . . establish a pattern of bad faith conduct." Dahl, *supra* note 77. "[T]he existence of only one abandoned application to register [a] mark for the same goods does not by itself support a finding that [a]pplicant has engaged in a pattern of bad faith conduct. Indeed, an applicant can file more than one intent-to-use application covering the same goods or services and still have the requisite bona fide intention to use each mark." *Veronica Morales d/b/a Blue Ivy*, No. 91234467, at 36–37.

201. *See, e.g.,* Voytko, *supra* note 19 (the Kardashians have hundreds of registered trademarks).

202. Normally a mark can be rejected if it is "primarily merely a surname," absent a showing of acquired distinctiveness or a secondary meaning. *See* 15 U.S.C. § 1052(e), (f). Thus, a non-

One purpose of trademark law is to “make it easier for consumers to quickly identify the source of a given good” or service.²⁰³ Celebrities do not want consumers to falsely believe that certain goods or services come from them when they in fact come from someone else.²⁰⁴ However, allowing a registration for “intent to use” can lead to excessive registrations when there is not a third party falsely identifying a good or service as belonging to a celebrity. If the mark is not already being used in commerce, then allowing the registration does not make it easier for consumers to quickly identify the source of a given good or service. A celebrity should only register a trademark they are currently using in commerce if there is already a third-party’s goods or services falsely connected to a celebrity.

Another purpose of trademark law is to protect the owner’s investment and reputation.²⁰⁵ If a celebrity does not have an actual product being used in commerce, then there is no unfair competition because there is no product to compete with. Registering a trademark allows celebrities to prevent others from using their name for dishonest commercial purposes. It is true that if a celebrity cannot register a certain mark then a third-party has the potential to register a mark that could harm a celebrity’s reputation. However, 15 U.S.C. Section 1052(a) of the Trademark Act “bars the federal registration of . . . a mark that consists of or comprises matter which falsely suggests a connection with a famous person.”²⁰⁶ Since there is already protection from 15 U.S.C. Section 1052(a), celebrities should not be allowed to hold so many trademarks.

celebrity would not be allowed to register his or her name. However, since the mark a celebrity seeks to register has acquired secondary meaning due to the fame of the celebrity, celebrities are not subject to this type of trademark registration rejection. *See Possible Ground for Refusal of a Mark, supra* note 175.

203. *Trademark Law*, FASHION LAW, <https://www.thefashionlaw.com/resource-center/trademark-law/> [<https://perma.cc/K5Y2-HBFR>].

204. *See id.*

205. *See id.*

206. Ron Abrams, *Those Seeking to Pounce on Tiger King Popularity Likely to Get Mauled By the Trademark Act*, FORBES (Apr. 14, 2020, 2:44 PM), <https://www.forbes.com/sites/legalentertainment/2020/04/14/those-seeking-to-pounce-on-tiger-king-popularity-likely-to-get-mauled-by-the-trademark-act/?sh=2efa3aa43be2> [<https://perma.cc/5639-BJKU>].

A. 15 U.S.C. Section 1052(a) Provides Protection for Celebrities Without the Need for a Registered Trademark

Title 15 U.S.C. Section 1052(a) is similar to 15 U.S.C. Section 1125 (false advertising), and both can serve as the statutory basis for a trademark infringement claim.²⁰⁷ The main difference is that 15 U.S.C. Section 1052(a) may only be invoked for registered marks whereas 15 U.S.C. Section 1125 may be invoked for any marks.²⁰⁸

Title 15 U.S.C. Section 1052(a) “protects a well-known party’s control over the use of its identity or ‘persona’” by preventing the unauthorized use of the persona of a person or institution.²⁰⁹ A “name” is protected “even when the mark consists of less than the individual’s full legal name, and [protection] applies to first names, surnames, shortened names, pseudonyms, stage names, titles and nicknames.”²¹⁰ Thus, a third-party would be unable to beat a celebrity to register a trademark for their name.²¹¹ Consequently, a celebrity should not be allowed to register a mark if they are not yet using the mark in commerce because they do not face the potential problems a non-celebrity would face due to the 15 U.S.C. Section 1052(a) protection.

Since celebrities already have protections over their identity or persona, they do not need to register everything and anything they say or name. For example, multiple people registered trademarks for Tiger King and Joe Exotic, none of which were registered by Joe Exotic himself.²¹² They were registered by people probably thinking they beat Joe to the punch “on cashing in on [the] ‘Tiger King’ popularity.”²¹³ However, “their chances of securing registrations [are] slim . . . unless an applicant can get Joe Exotic

207. See 15 U.S.C. § 1052; see 15 U.S.C. § 1125.

208. See 15 U.S.C. § 1052; see 15 U.S.C. § 1125.

209. “A party acquires a protectable interest in a name or equivalent designation under §2(a) where the name or designation is unmistakably associated with, and points uniquely to, that party’s personality or ‘persona.’” Abrams, *supra* note 206.

210. *Id.*

211. *See id.*

212. *Id.*

213. *Id.*

himself to consent to registration."²¹⁴ Celebrities thus have protection from someone monetizing off their name or harming their reputation by using their name. Therefore, it is unnecessary to allow celebrities to try to register a trademark just to prevent third parties from registering those marks.

Celebrities may claim they have an intent to use the mark, when in reality they just do not want third parties to use the mark. Celebrities do not want to wait until they actually put the mark in use to file a standard trademark application because they do not want someone else to monetize off their brand or image. Thus, the intent-to-use allowance is overbroad and allows celebrities to attain far too many unnecessary trademark registrations. Consequently, if celebrities were not allowed to trademark their names, third parties would mostly not be able to use celebrity names in order to trick consumers into thinking the product or service came from the celebrity or was endorsed by that celebrity.

B. When Registering a Trademark Is Necessary

It should be acknowledged that in some circumstances it is necessary for celebrities to register certain names and phrases. An example of this is The Velvet Elvis nightclub in Texas, which opened in 1991.²¹⁵ The menu, décor, advertisements and the name of the nightclub all had references to Elvis Presley.²¹⁶ The owner of the nightclub, Barry Capece, "filed a federal service mark application for 'The Velvet Elvis' for restaurant and tavern services with the [USPTO]."²¹⁷ However, "[p]laintiff-appellant Elvis Presley Enterprises, Inc. ('EPE') is the assignee and registrant of all trademarks, copyrights, and publicity rights belonging to the Elvis Presley estate."²¹⁸ The court noted that "EPE has at least seventeen federal trademark registrations, as well as common-law trademarks, for 'Elvis Presley' or 'Elvis' and

214. *Id.*

215. *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 191 (5th Cir. 1998).

216. *Id.* at 192.

217. *Id.* at 191.

218. *Id.*

other registrations for his likeness.”²¹⁹ On appeal, the court ruled that The Velvet Elvis mark infringed plaintiff’s marks.²²⁰

Absent trademark protection, The Velvet Elvis would have been able to use the Elvis name, misleading consumers to believe it was affiliated with or endorsed by Elvis Presley Enterprises. In these circumstances, if compliance with trademark laws is not established, celebrities would have trouble achieving success with selling their “brand”—something that uniquely identifies their products or services. Therefore, in such a case, it makes sense for celebrities to register trademarks for their name and then sue for trademark infringement.

However, there are inconsistent results because sometimes it is necessary for a celebrity to receive trademark protection, while other times it is excessive. The circumstances where celebrities monopolize words and phrases must be differentiated from legitimate registrations. Additionally, when a non-celebrity uses a mark in commerce that was first registered to a celebrity, that would typically constitute trademark infringement. However, that scenario must be distinguished from when a non-celebrity uses a mark in commerce *before* a celebrity, and then the celebrity wishes to register that mark and thereafter sue the non-celebrity.

C. Celebrities Monopolize Words and Phrases

Although sometimes it is necessary for a celebrity to register a trademark in order to protect their brand, often a celebrity will register for a trademark with no good faith intention of solely protecting their brand.²²¹ Rather, the celebrity wants to use their power in the marketplace to disadvantage small businesses.²²² A celebrity can register a word or phrase and then prevent a non-celebrity from using the same mark, even if the non-celebrity may have already been using the mark for years.²²³ Small businesses are subject

219. *Id.*

220. *Id.* at 206–07.

221. See generally *Veronica Morales d/b/a Blue Ivy*, No. 91234467; see generally USPTO, *supra* note 158.

222. See, e.g. *Veronica Morales d/b/a Blue Ivy*, No. 91234467, at 37–38. (opposer argued that Beyoncé simply wanted to abuse the trademark process and lacked a bona fide intent to use the mark).

223. See generally *id.*

to litigation if their goods or services even resemble an aspect of a celebrity's brand.²²⁴ This can be problematic because it allows celebrities to have a monopoly over certain products and services. If from the facts it is clear the small business is not trying to deceive consumers into thinking their product or service came from the celebrity, then they are acting in good faith.²²⁵ Regardless, they can be forced to pay millions of dollars, or change the name of their goods, or cease operations of their services.

For example, in *Veronica Morales d/b/a Blue Ivy v. BGK Trademark Holdings, LLC*, the court denied Morales' claim preventing Beyoncé from registering BLUE IVY CARTER.²²⁶ Although the court's conclusion was based on a finding that there was no likelihood of confusion, it seems unfair for Beyoncé to be allowed to register a mark that already existed. Morales responded to the star's claim, citing that Beyoncé and Jay-Z had no actual intention of using "Blue Ivy Carter" in commerce, but rather, filed for trademark protection simply to stop other people from using the name.²²⁷ Beyoncé's argument was that a boutique wedding event planning business and Blue Ivy Carter, the daughter of two of the most famous performers in the world, would not be confused.²²⁸ Such a decision could potentially have an effect on Morales' business.

Another example occurred in mid-June 2020 when members of the country music trio, formerly known as Lady Antebellum, announced they were going to change their name to Lady A.²²⁹ Just "[t]wo weeks after George Floyd's death . . . sparked a national [outcry] over racial injustice," the trio "were 'regretful and embarrassed' . . . that they did [not] previously take into account the Antebellum South's associations with the pre-

224. *See generally id.*

225. "If the defendant used the mark in order to describe the underlying services or products, it is likely the defendant will be found to have had good faith when using the mark." *See What Is a Good Faith Defense?*, UP COUNSEL, <https://www.upcounsel.com/good-faith-defense> [<https://perma.cc/766D-SL5F>].

226. *Veronica Morales d/b/a Blue Ivy*, No. 91234467, at 45.

227. *Id.* at 37.

228. *Id.* at 18.

229. Emily Yahr, *One Name, Two Musical Acts and a Story of Privilege: How the Lady A Controversy Captured the State of the Music Industry in 2020*, WASH. POST, (Nov. 11, 2020), <https://www.washingtonpost.com/arts-entertainment/2020/11/11/lady-a-lady-antebellum-name-change-controversy/> [<https://perma.cc/P2CR-CXNK>].

Civil War slavery era.”²³⁰ However, Lady A was already the name of a 62-year-old black singer in Seattle, Anita White, who had recorded and performed music with the name for decades.²³¹ In July 2020, “the band filed a declaratory judgment lawsuit against the singer in the U.S. District Court for the Middle District of Tennessee, asking a court to affirm its right to use the name Lady A.”²³² In September 2020, “Lady A the singer countersued for trademark-infringement, seeking damages and use of the name; the suit says she has ‘accrued common law rights in the Lady A trademark’ by using it since the early 1990s.”²³³ “In its complaint, the band says it holds federal trademarks while the singer does not.”²³⁴ However, White “started using the name in her music career 20 years ago, while the band officially adopted it in 2020.”²³⁵ White will have to prove that she did not just call herself Lady A 20 years ago, but used the name in billboards, ticket sales, and advertising in order to win the lawsuit.²³⁶

Although the matter is still pending, based on other celebrity trademark cases, it is possible that Anita White will lose her ability to use the name Lady A, due to the trio’s celebrity status compared to hers. This example demonstrates how celebrities monopolize names. A non-celebrity may have already been using a mark for years but is subject to litigation because her name is the same as a celebrity’s. This type of scenario is unfair to the non-celebrity, especially in this situation, since the famous trio changed their name to Lady A and did not go by that name originally. In a case such as this one, the court should allow the person who first registered the trademark and subsequently used the mark in commerce to prevail. The court should not allow the celebrity to prevail when a non-celebrity has been using a mark in commerce before the celebrity sought to register the mark. The court should consider how long the mark has been registered to the non-celebrity,

230. *Id.*

231. *Id.*

232. Amy X. Wang, *What Is Lady A’s Case Against the Other Lady A?*, ROLLING STONE (July 13, 2020), <https://www.rollingstone.com/pro/news/lady-a-lady-antebellum-lawsuit-case-1026653/> [<https://perma.cc/Q99T-ZKEU>]

233. Yahr, *supra* note 229.

234. Wang, *supra* note 232.

235. *Id.*

236. *Id.*

how long it has been used in commerce, and if it is currently being used in commerce at the time of litigation.

A different problem arises when the celebrity is not already using the mark but is able to monopolize the mark. An example is when trademark law allowed Kim Kardashian to register a trademark for Psalm because she had an intent to use the mark, even though she had not yet used the mark.²³⁷ It is likely that Kim registered Psalm just so that a third party would be unable to use that name in commerce. It seems unethical to allow a celebrity to trademark a child's name to try to monetize from the name of that child when the child is only 14 days old.

A celebrity's claim would have merit once the celebrity started making products with the desired trademark. For example, if Kim Kardashian had already been using the mark in commerce when she registered Psalm, it would be more ethical to issue the trademark. If Kim Kardashian sold baby blankets on her website, and she wished to print a logo that said, "Psalm West," the registration would be ethical. Alternatively, if Psalm was even more than a year old, had her own modeling deal, and Kim Kardashian wished to trademark Psalm's name, the registration would be ethical. In those circumstances, the trademark registration's purpose would be to protect Psalm's brand since there would be a desire to use the name in commerce. The key to the inquiry is whether the mark is being used in commerce and if the purpose of the registration is to protect the celebrity's brand.

Allowing excessive registrations, when a mark is not being used in commerce, and when the purpose of the registration is not to protect the celebrity's brand, does nothing to further the purpose of trademark law. There is no need to prevent unfair competition when there are no third parties trying to monetize off a mark.²³⁸ Kim did not spend any time or money in presenting a service or product to the consumer using her child's name at the time of her registration. She had no investment to protect, so it is hard to understand why the USPTO allowed her to register "Psalm."

Even though trademark law can protect a celebrity's brand, there are clearly times when a celebrity takes advantage of the current trademark law by registering a mark that is already in use by a non-celebrity or registers a mark that they are not using. There are also circumstances where a celebrity is allowed to register a mark for a phrase that does not seem to be

237. See *Psalm West I'm Joining the Kardashian Empire . . . Starting My Own Business*, *supra* note 22.

238. See *Purpose of Trademark: Everything You Need to Know*, UP-COUNSEL, <https://www.upcounsel.com/purpose-of-trademark> [<https://perma.cc/3WRF-XBE2>].

distinctive.²³⁹ However, due to a celebrity having so much fame, if they utter some basic words, suddenly the words become distinctive.²⁴⁰ A non-celebrity would not receive this kind of protection and would not be able to use trademark law in their favor in the same way.

A celebrity like Kylie Jenner was allowed to register the common phrase “Rise and Shine” simply because she went viral on social media for saying it.²⁴¹ Her application for the trademark was approved because she used the phrase in commerce and it was distinctive.²⁴² Within days of her video saying “Rise and Shine” went viral, she “launched two ‘Rise and Shine’ hoodies on her personal shop for \$65, both of which sold out almost immediately.”²⁴³ This constituted using the phrase in commerce.²⁴⁴ The phrase is distinctive because it acquired a secondary meaning—the phrase became synonymous in the public mind with Kylie Jenner, even though she did not come up with the phrase herself.²⁴⁵ Although the mark meets the requirements for a validly registered trademark, the laws are too lenient toward celebrities. It is likely that someone who was not famous and owned a small business would not have been allowed to register a trademark for the same thing because a non-celebrity would not be able to acquire secondary meaning for such a common phrase.²⁴⁶ For example, “good morning,” is a common phrase that is not distinctive on its own.²⁴⁷ But when a celebrity with such a high level of fame and social media following utters words that are commonplace, suddenly he or she can get the rights to a trademark and

239. See generally Julia Alexander, *Kylie Jenner’s Viral ‘Rise and Shine’ TikTok Meme Led to Merchandise and a Trademark Application*, VERGE (Oct. 22, 2019, 4:19 PM), <https://www.theverge.com/tldr/2019/10/22/20927323/kylie-jenner-rise-and-shine-tiktok-youtube-merchandise-trademark-application> [<https://perma.cc/2ZGC-DYDC>].

240. See generally *id.*

241. *Id.*

242. *Id.*

243. *Id.*

244. See *id.*

245. *Id.*

246. See *Perini Corp. v. Perini Constr., Inc.*, 915 F.2d 121, 125 (4th Cir. 1990).

247. *Id.*

monetize off products with the phrase.²⁴⁸ Therefore, celebrities should not be allowed to register such common phrases.²⁴⁹

Celebrities are thus at an advantage compared to small businesses to have exclusive rights to a word or phrase.²⁵⁰ They are allowed to continue to add to their wealth, while small businesses might be overshadowed. Allowing Kylie to register her phrase does not make it easier for consumers to quickly identify the source of a given good or service nor does it protect the owner's investment or reputation. Kylie could have made her products without registering the phrase, but she strategically did so to prevent third parties from monetizing off the phrase. Thus, although small businesses could have made products with the phrase, now they are unable to, or they will be subject to litigation. Evidently, celebrities are taking advantage of the current trademark laws, and the only way for that to change is if the USPTO changes current trademark registration laws.

V. HOW SHOULD THE USPTO HANDLE CELEBRITIES EXCESSIVELY REGISTERING TRADEMARKS?

There are several different ways the USPTO can try to prevent celebrities from excessively registering trademarks. This section discusses changes the USPTO can implement in order to curb excessive registrations. First, the USPTO should not allow celebrities to reserve rights in a trademark just because they have an "intent to use" the trademark in commerce. Second, the USPTO should not allow celebrities to register only their first name. Third, the USPTO should not allow celebrities to register a trademark for a common phrase. Lastly, courts should provide an adequate remedy to non-celebrities and small businesses when a celebrity uses a mark that is already registered to a non-celebrity or small business.

One of the problems with current trademark law arises when a celebrity has not used a name or phrase in commerce and is allowed to register the trademark because they have a good faith "intent to use" the trademark in commerce.²⁵¹ This allows a celebrity like Kim Kardashian to file an

248. See Alexander, *supra* note 239.

249. See *infra* Section V.

250. See, e.g., Veronica Morales d/b/a Blue Ivy v. BGK Trademark Holdings, LLC, No. 91234467 (T.T.A.B. 2020), <https://ttabvue.uspto.gov/ttabvue/ttabvue-91234467-OPP-55.pdf>.

251. Gerben, *supra* note 73.

application for her newborn child before she has sold any product or service in connection with her child's name.²⁵² Although there are limitations set in place for trademark registration, celebrities are not necessarily subjected to those limitations because they can easily prove secondary meaning with names or phrases associated with their persona, and therefore file an intent to use registration.²⁵³ Therefore, one solution for celebrities excessively registering trademarks would be for the USPTO to not allow celebrities to reserve rights in a trademark just because they have an "intent to use" the trademark in commerce.

Eliminating the "intent to use" exception would prevent some of the excessive registrations. If a celebrity were only allowed to register a trademark if it was used in commerce, then there would be an actual reason for the registration—to protect the celebrity's brand. Requiring actual use would make it harder for a celebrity to register a trademark because the celebrity would need to have a product, with the desired trademark, in the marketplace.

Another problem arises with the secondary meaning requirement. Celebrities are able to acquire secondary meaning for just about anything since their name or phrases they say immediately gain public recognition.²⁵⁴ A celebrity name or phrase becomes associated in the minds of consumers with that celebrity.²⁵⁵ There is a level of unfairness though, since a non-celebrity is not allowed to register their name and would not be allowed to register any simple phrase they say.²⁵⁶ Thus, it is inevitable for celebrities to be afforded greater protection. The only solution would be to not allow celebrities to register only their first name, since a first name is not ordinarily distinctive on its own.²⁵⁷ However, it is reasonable to allow a celebrity to trademark

252. *See id.*

253. For example, famous trademarks are more likely to be associated and remembered in the public's mind, and thus have a secondary meaning, so they enjoy a broader scope of legal protection. *See generally* Tiffany, *supra* note 2. A non-celebrity most likely cannot register a trademark for his or her name because it is unlikely to have a secondary meaning. *Cairns v. Franklin Mint Co.*, 24 F. Supp. 2d 1013, 1034 (C.D. Cal. 1998).

254. *Cairns*, 24 F. Supp. 2d at 1034.

255. *Id.*

256. *Id.*

257. *See id.*

their first and last name together since that would achieve the purpose of trademark law in the celebrity context, to protect a celebrity's brand.

Unlike the previous suggestion, this suggestion would not make it harder for a celebrity to register a trademark. However, there would be less registrations because many celebrities currently try to register both their first name and their first and last name together.²⁵⁸

Additionally, there would be less litigation if only first and last names together could be registered. A celebrity could only sue a non-celebrity for trademark infringement if the non-celebrity held a registration for the exact full name as the celebrity, which is not as common as having a registration for just a first name. If a non-celebrity named their business "Kim Kardashian," it would likely constitute an actual infringement, and thus litigation would be justified. In contrast, if a non-celebrity named their business "Kim," because it was the non-celebrity's first name, it would be unjust for Kim Kardashian to be able to sue the non-celebrity. However, under current trademark law, if Kim Kardashian held a registration for just her first name, she would be able to sue in this hypothetical and would likely prevail.

Another suggestion to curb excessive registrations is to prohibit celebrities from registering a trademark for a phrase if that specific string of words is commonly used, such as "good morning." It seems unfair to allow a celebrity to register a trademark for a common phrase just because he or she spoke it a certain way in a song or viral video. Although the common phrases allowed to be registered have acquired secondary meaning, it is likely a third-party would accidentally use the phrase on products and then be subject to litigation. Furthermore, there are many small businesses that could be at a disadvantage if they were unable to make and sell merchandise with a common phrase on it, just because that phrase happened to be a registered celebrity trademark.

This suggestion would greatly limit the number of trademarks that a celebrity could register. Celebrities would fight back if the USPTO enacted this new restriction, because the celebrities would argue that a common phrase had secondary meaning. However, the USPTO should consider how much secondary meaning the common phrase has acquired—has the phrase been used over and over, or was it just used once in a viral video? There may be a grey area in deciding which phrases should be allowed, because the USPTO would need to determine the level of secondary meaning acquired and determine the level of commonality of the phrase. For example,

258. See *Kylie Jenner, Inc. Trademarks*, JUSTIA, <https://trademarks.justia.com/owners/kylie-jenner-inc-2296420/index.html> [<https://perma.cc/NF93-MG53>].

registering a common string of words put together in a unique way might not be excessive, whereas registering a strictly common phrase would be excessive. Therefore, the USPTO would have to decide where to draw the line. Lastly, incorporating this Note's first suggestion for the USPTO, if the celebrity uttered a common phrase but is not currently using the phrase in commerce, the celebrity should not be allowed to register the mark.

Finally, courts should provide an adequate remedy to non-celebrities and small businesses when a celebrity uses a mark that is already registered to a non-celebrity or small business, even if the court finds that there is no likelihood of confusion. If a small business or non-celebrity has a registered trademark they are using in commerce, and then a celebrity starts using the mark in commerce, the celebrity should have to pay money damages. For example, in cases such as *Veronica Morales d/b/a Blue Ivy v. BGK Trademark Holdings, LLC*, the court will dismiss the claims on the grounds that there is no likelihood of confusion.²⁵⁹ In such a circumstance, the celebrity does not have any repercussions for infringing on a non-celebrity's trademark. The third party or small business may have been disadvantaged and financially harmed by the celebrity using the mark, but nevertheless receives no award of damages. Even when there is no likelihood of confusion, the owner of a registered mark can be harmed when a powerful and wealthy celebrity uses the mark. Celebrities should still be allowed to register marks that are used in commerce, but it is important to hold celebrities responsible for harming those that have less power and wealth.

The recommendation above, to provide an adequate remedy to a non-celebrity or small business, could be implemented in two undecided lawsuits: the Lady A lawsuit²⁶⁰ and the Taylor Swift lawsuit with the Evermore Amusement Park.²⁶¹ In February 2021, Utah's Evermore Park "filed a federal lawsuit against Taylor Swift claiming the title of her latest album[,] ['Evermore,'] infringes on the theme park's trademarks."²⁶² According to court documents filed in the U.S. District Court of Utah, the "park is seeking

259. *Veronica Morales d/b/a Blue Ivy v. BGK Trademark Holdings, LLC*, No. 91234467, 30, 43 (T.T.A.B. 2020), <https://ttabvue.uspto.gov/ttabvue/ttabvue-91234467-OPP-55.pdf>.

260. *See discussion supra* p. 39.

261. David Williams, *A Utah Theme Park Is Suing Taylor Swift Over 'Evermore' Album Title*, CNN (Feb. 4, 2021, 7:31 PM), <https://www.cnn.com/2021/02/04/us/taylor-swift-theme-park-lawsuit-trnd/index.html> [<https://perma.cc/KDN5-U4CK>].

262. *Id.*

millions of dollars in damages.”²⁶³ The lawsuit states that Swift’s album “drove Evermore Park off the first page of Google search results.”²⁶⁴ The suit argues “that the park and CEO Ken Bretschneider have invested approximately \$37,000,000 in the creation and promotion of Evermore Park and the Evermore trademark.”²⁶⁵ The park further alleges that it has had trademarks for the Evermore name since 2015 which apply to entertainment services, theme parks, and clothing.²⁶⁶ The park claims “that some of the merchandise sold on Swift’s website infringes on those trademarks and it is seeking \$2 million for each of the types of goods and services Swift sold and other damages.”²⁶⁷ Considering Taylor Swift is a major celebrity, with great fame and success, the amusement park will likely lose the lawsuit.²⁶⁸ Similar to the case *Veronica Morales d/b/a Blue Ivy v. BGK Trademark Holdings, LLC*, “a mark with extensive public recognition . . . receives more legal protection than an obscure or weak mark.”²⁶⁹ Thus, even though Swift is infringing on the park’s trademarks, she will likely not have to pay the millions of dollars in damages the park seeks because of the argument that there is no likelihood of confusion.²⁷⁰ Although unfair to the amusement park, current trademark law favors protection of celebrities.²⁷¹ Swift will argue that she is largely recognized, famous, and successful compared to the Utah amusement park, there is no overlap in the marketing channels, and there is no actual confusion. While there is probably no likelihood of confusion, the park alleges that its reputation and business have been harmed by Swift’s use of the mark.²⁷² Therefore, if Swift was not a celebrity, she would likely have to

263. *Id.*

264. *Id.*

265. *Id.*

266. *Id.*

267. *Id.*

268. *See id.*

269. *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353 (Fed. Cir. 1992).

270. *See Williams, supra* note 261.

271. *See id.*

272. *Id.*

pay the Amusement Park for damages. However, because she is famous, she likely will escape liability.

Since the Swift case has not yet been decided, the court should follow this Note's suggestion to provide an adequate remedy to non-celebrities and small businesses when a celebrity uses a mark that is already registered to a non-celebrity or small business, even if the court finds that there is no likelihood of confusion. The court should rule in favor of the amusement park. Although Swift is a celebrity, she should not be able to escape liability for using the amusement park's mark. This Note's other suggestions for the USPTO would not apply here because Taylor Swift was not registering a trademark with only an intent to use, nor was she registering just her first name, nor was she registering a common phrase.

To implement these proposed solutions, current trademark law would have to change in order for the USPTO to be stricter when deciding which marks should be registered. This would require Congress to pass stricter trademark laws. The above suggestions go against the current state of the law considering Beyoncé was allowed to register a trademark for a name already registered.²⁷³ This could create a problem for already decided cases, because individuals or small businesses who had disputes with celebrities would want their case overturned. Nevertheless, it would be a step in the right direction for the USPTO to rethink the "intent to use" requirement as well as address the unfairness in the ease for celebrities' marks to acquire secondary meaning.

Overall, a change in the law would have a positive impact on non-celebrities and small businesses. This Note's proposed suggestion would protect small businesses and non-celebrities from facing legal repercussions for using their own first names and certain common phrases on products. However, the suggestions may make it harder for celebrities to register trademarks. It would only make it more difficult for a celebrity to register a trademark that was just their first name, a common phrase, or a mark they were not actually using in commerce. For the most part, the suggestions would not affect a celebrity who was using a mark and making money off the mark. Thus, if the law changed, it would not negatively affect the market for celebrity products and would not make a significant difference on a celebrity's financial gain. Celebrities would still be able to monetize their brand and have sufficient protection. Celebrities would not be losing money from the proposed suggestions because the suggestions would mostly affect those

273. Veronica Morales d/b/a Blue Ivy v. BGK Trademark Holdings, LLC, No. 91234467, 43 (T.T.A.B. 2020), <https://ttabvue.uspto.gov/ttabvue/ttabvue-91234467-OPP-55.pdf>.

celebrities who register a mark with the intent to use. Those celebrities are not monetizing off the mark yet. Therefore, only the marks not already in use and not producing financial returns for the celebrity would be affected.²⁷⁴ Consequently, a change in the law would allow non-celebrities, who would actually use a mark in commerce, to register and make money from the mark.

Finally, a wealthy celebrity is in a better place, financially, to litigate trademark infringement, false advertising, and dilution claims than a small business or non-celebrity. From a policy standpoint, non-celebrities need to have adequate protection. Thus, it is necessary to change the law in order to disallow celebrities from financially destroying a small business or non-celebrity with preventable litigation.

VI. CONCLUSION

The Kardashians are just one example of celebrities who are notorious for trademarking hundreds of names and slogans associated with their many business ventures. However, many other celebrities have been in the media for litigation involving trademarks of their name, children's names, or their slogans and catchphrases. Celebrities are constantly registering for trademarks to protect and monetize their brand. Although certain trademark registrations are justified and necessary for brand protection, others are not. Celebrities are over-protected by trademark law. Excessive protection by trademark law occurs when celebrities are allowed to register hundreds of marks they have not yet used. The USPTO should ensure that celebrities are already using the mark in commerce before allowing the mark to be registered. Additionally, USPTO should be stricter with the secondary meaning requirement. By doing so, the USPTO would prevent hundreds of nonsense or commonly used words from being registered, which would ensure that the trademarks registered furthered the purpose of trademark laws without disadvantaging non-celebrities and small businesses.

274. The financial returns would be those profits from the sales of products using the trademark.