

Brandmarking

THOUGHTS ON THE CREATION,
PROTECTION, AND ENFORCEMENT OF
BRAND IDENTITY

TAYLOR SWIFT'S EXCELLENT BRANDMARKING ADVENTURE

Making a splash is more or less what pop stars and other celebrities do for a living. But not many of them do it by applying for federal trademark registrations.

Taylor Swift is an exception.

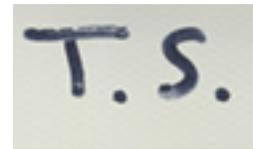
Shortly before the release of her latest album, "1989," Ms. Swift attracted attention by **filing no fewer than 58 applications in the Trademark Office** to register various lyrics from the album as trademarks:

- Nice to Meet You, Where You Been?
- This Sick Beat
- Could Show You Incredible Things
- Cause We Never Go Out of Style
- Party Like It's 1989

While she was at it, Ms. Swift also updated her old "TS" logo (on the left) with a newer model:



2010



2014

Most recording artists register at least their names, and usually their logos, as trademarks not only for their music and videos, but also for concert swag like caps and t-shirts. **And it's not unheard of for big stars to register their signature song titles as trademarks for licensing ventures.** Jimmy Buffet has registered "Margaritaville" as a trademark for everything from restaurants to computer games – even a casino on the Vegas Strip.

But usually it's only *after* a song has gone super-platinum that it dawns on someone that the title might be exploitable for other types of products. What's striking about Ms. Swift's activity isn't just the number of applications or the expansive range of goods and services covered by them, but the fact that she applied to register **phrases that hadn't even had the opportunity to become well known yet**, given that the album on which they are used hadn't yet been released.

Perhaps this is the future of brandmarking in a viral society. Thanks to the internet and social media, cultural memes emerge so quickly that their originators are often behind the curve in protecting or exploiting them. Not the aptly-named Ms. Swift, who is, in effect,



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THIS MONTH:

Taylor Swift

"Trademark" Is Not a Verb

Redskins Appeal

ABOUT "BRANDMARKING"

The word is a combination of "branding" and "trademark." It reflects a conviction that marketing and legal professionals share a common goal, and that they need to learn to speak each other's language in order to reach it. That goal is simple: to develop powerful, durable brand identities and capture them in names, slogans, and designs that customers will associate with their products -- and with no one else's.

If you like what you find here, feel free to pass it along to others.



ABOUT THE AUTHOR

Attorney John Blattner helps businesses develop and protect brand identities. He does trademark counseling, clearance, prosecution, enforcement, and litigation, in the fashion, entertainment, financial services, technology, retailing, media, automotive, sporting goods, restaurant, and other industries. John also teaches Trademarks and Unfair Competition at Michigan State University College of Law.

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betting that at least some of her lyrics will *become* well known, and will make effective trademarks for at least some types of products.

She did this by taking advantage of a provision of the Trademark Act that permits you to apply to register trademarks you haven't used yet but that you have a "bona fide intent" to use in the (relatively) near future. **In effect, you can reserve rights in a trademark for up to three years while you decide what you really want to do with it.** In the meantime, the rest of the world is on notice of your claim of rights, and needs to think twice before using your mark on its own products. It's a strategy that any business should consider for goods and services that are still on the drawing board.

"TRADEMARK" IS NOT A VERB

Almost every article I've read about Taylor Swift's brandmarking campaign has committed **the cardinal sin of using the word "trademark" as a verb.** For example:

- "Taylor Swift Trademarks 'Party Like It's 1989'"
- "Can Taylor Swift Really Trademark 'This Sick Beat'?"
- "Taylor Swift Just Trademarked Her Favorite '1989' Lyrics"

And so on. This isn't just the pet peeve of an inveterate grammar geek. It embodies the common misconception that trademark rights are something that only the federal government can give – and thus something that the government can take away. As regular *Brandmarking* readers know, trademark rights arise from actual use of the mark in commerce. **As I tell my law students, it's the Forrest Gump principle: "Trademark Is as Trademark Does."**

When you adopt a name, or a slogan, or a logo, and use it to identify your goods and services in the marketplace, it becomes your trademark and you automatically gain common law trademark rights. Registration enhances and perfects those rights. But as we learned from the Washington Redskins case, the fact that the government takes away your *registration* doesn't mean you can no longer use your *trademark*.

So, just to set the record straight: Taylor Swift did *not* "trademark" her song lyrics. She *applied to register* her song lyrics as trademarks.

SPEAKING OF THE REDSKINS...

It's been almost a year since the Trademark Trial and Appeal Board ordered the cancellation of six registrations owned by the professional football team that include the word REDSKINS. As expected, Pro-Football appealed, in the form of a lawsuit filed in U.S. District Court for the Eastern District of Virginia. In addition to simply arguing that the TTAB arrived at the wrong decision, Pro-Football also argues that **the statute on which the challenge was based – Section 2(a) of the Lanham Act, which permits cancellation on grounds that a trademark "may be...disparaging," – is unconstitutional:**

- Noting that trademarks are "commercial speech" protected by the First Amendment, Pro-Football argues that Section 2(a) impermissibly penalizes it for taking the position, in public discourse, that using REDSKINS as a team name is not disparaging but a sign of respect.
- Pro-Football also argues that the statute is unduly vague, noting that the term "disparaging" has a variety of dictionary definitions, none of which is formally specified by the statute, and that **no one can reasonably anticipate whether the Trademark Office, or a court, would find that any particular term "may be" disparaging.**
- Pro-Football also argues that the statute unfairly allows the TTAB to cancel its registrations now, devaluing an asset that Pro-Football spent millions of dollars developing, even though the first of the registrations issued almost 50 years ago, and the Trademark Office has renewed all of the registrations several times over the years. **Perhaps inevitably, one observer has written that Pro-Football is calling the Trademark Office an "Indian giver."**

These arguments were part of a motion for summary judgment filed by Pro-Football in the lawsuit last week. The motion, in effect, asks the question that I have posed here before: **Why on earth do we ask trademark attorneys to pass judgment on what is "immoral" or what "may be" disparaging?**

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