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Blue Ivy — From The Cradle To The USPTO

Law360, New York (February 08, 2012, 12:49 PM ET) -- On Jan. 7, 2012, superstars Beyonce Knowles and Jay-Z (a.k.a Sean Carter) became the proud parents of their first daughter, Blue Ivy Carter. Just days later, on Jan. 11, 2012, a use-based trademark application was filed with the United States Patent and Trademark Office seeking registration of the mark "Blue Ivy Carter NYC"[1] in connection with children's apparel in International Class 25.

In the application, the applicant claims the mark was first used at least as early as Jan. 9, 2012 — a date that is coincidentally two days following the much-publicized birth of Blue Ivy Carter. As word of the application spread, the blogosphere buzzed as the fashion industry struggled to comprehend how someone could capitalize on the fame and renown of the child of these illustrious celebrities. Most of the reporting echoed the similar sentiment that there seems to be something inherently wrong with a person appropriating a famous name for their own personal profit and that the applicant would likely be hearing from Jay-Z and Beyonce's legal team.

However, in a surprising show of bureaucratic speed, within a mere 16 days from the filing of the application, the USPTO may have vitiated the need for Blue Ivy's parents to take legal action, as the USPTO, acting with extreme and unusual alacrity, issued an office action denying the application.

To provide some context to the incredible fast track the USPTO has channeled the application, any application submitted for approval to the USPTO must go through a multileveled process before any approval is issued by the USPTO. First, the proposed mark is reviewed by a trademark examining attorney. There are a host of different legal criteria that any proposed mark must meet in order to qualify for federal trademark protection, and it is the examiner's job to conduct searches and legal analysis to see if such proposed mark qualifies.

If the application is approved by the examiner, it is then published in the USPTO's Official Gazette for Trademarks for a period of 30 days, putting the public on notice that the applicant intends to have such mark certified as a federally registered trademark. During this 30-day period, other trademark owners are given the opportunity to contest the approval of such mark. However, in the case of the application, it does not appear that Jay-Z or Beyonce will be required to protect their daughter's intellectual property. The examiner has apparently struck the first blow in defense of the newborn's name.

While the office action cites several different basis for rejecting the application, of primary interest to this article is the office action's refusals based on Section 2(a) and (c) of the Trademark Act.[2] Section 2(a) bars the registration of a mark where (1) the mark is the same as, or a close approximation of, the name or identity previously used by another person or institution; (2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution; (3) the person or institution named by the mark is not connected with the activities performed by the applicant under the mark; and (4) the fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed.

Here, the office action states that "the mark consists of or includes matter which may falsely suggest a connection with BLUE IVY CARTER ... [who] is so famous that consumers would

presume a connection." Presumably, this is precisely what the applicant was hoping for. Section 2(c) bars the registration of a mark which consists of or comprises a name, portrait or signature identifying a particular living individual except by his/her written consent. In the case of the application, it is unlikely that an affidavit signed by Carter, or her parents as guardians, consenting to the registration of the mark is likely to be obtained.

It seems that the application is either a naked attempt at launching the applicant's clothing line by piggybacking on Blue Ivy's fame or is a more unscrupulous attempt to "trademark squat" on the right to use the "Blue Ivy" name on apparel, in the hopes of assigning or selling the application to either Beyonce or Jay-Z. This may explain why the application was submitted as a "use-based" application, with a questionable specimen, as opposed to an "intent-to-use" application which would provide more time to develop and use the mark but would be more difficult to assign.

There have been numerous instances, factually similar to the instant situation where it seems that someone was seeking to profit from the fame and renown of another person's name, and where the USPTO has rejected those applications based on Section 2(a) and (c) (e.g., rejection of "Little Tiger"[3] for children's golf equipment as a false suggestion of a connection with Tiger Woods; rejection of "Obama Bahama Pajamas," "Obama Pajama" and "Barack's Jocks Dress To The Left" for failure to include written consent of Barack Obama in each instance; and rejection of "Bo Ball" for false suggestion of a connection with Bo Jackson.).

Sections 2(a) and (c) are the Trademark Act's answer to the blogosphere's visceral and negative response to the application. According to Sections 1203.03(e) and 1206 of the Trademark Manual of Examining Procedure, the intention is to prevent consumers from purchasing goods under a false impression that they are somehow connected to another famous institution, as well as "to protect rights of privacy and publicity that living persons have in the designations that identify them" (citing to *In re Hoefflin*, 97 USPQ2d 1174, 1176 (TTAB 2010); see also *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1376 n.8, 217 USPQ 505, 509 n.8 (Fed. Cir. 1983); *Canovas v. Venezia 80 S.R.L.*, 220 USPQ 660, 661 (TTAB 1983)).

In today's fame-obsessed society, it appears that intellectual property infringement and counterfeiting will expand beyond luxury brands and enter into the realm of celebrity names, personas and likenesses. While Sections 2(a) and (c) of the Trademark Act will provide the legal framework to prevent "piggybacking" on the fame of others, it will be interesting to see how the matter is settled in the court of public opinion.

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[1] U.S. Serial No. 85513502

[2] 15 U.S.C. §1052(a) and (c)

[3] U.S. Serial No. 75169949

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