Cause [Trademarks] Never Go Out of Style

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In this age of digital downloads and streaming music we often hear musicians lament that they simply are not making enough money. Gone are the days of traditional record deals including substantial advances, cushy tour budgets, label-sponsored merchandising deals, and, if all goes right, fans lining up at brick and mortar stores to buy music on the release date. Times have changed; there is no doubt. Recording artists, now tasked with the revenue generating activities formerly handled by the record labels, are pursuing all available means to secure and control revenue streams and capitalize on their music, including through merchandising.

Artist Taylor Swift has been making headlines due to her attempt to obtain trademark registrations for some of her song lyrics and titles. While Ms. Swift seems to be doing just fine financially, and, unlike many musicians is likely not awaiting her next royalty check to pay rent, her efforts to control the revenue streams available to recording and touring musicians are instructive. Ms. Swift has filed dozens of trademark applications with the United States Patent and Trademark Office for marks such as THIS SICK BEAT, CAUSE WE NEVER GO OUT OF STYLE, NICE TO MEET YOU. WHERE YOU BEEN?, and PARTY LIKE IT'S 1989 for goods and services like: home décor; umbrellas; writing instruments; art supplies; musical instruments; Christmas tree decorations; wigs; shoe laces; knitting implements; clothing and footwear; kitchen and bath linens; canvas bags; beverageware and dinnerware; cookware; jewelry; computer software; keychains; toiletries; tanning products; hair color; potpourri; non-downloadable games; contests and sweepstakes; and retail services, among others.

Certainly, this is not an altogether new phenomenon. Margaritaville Enterprises, LLC, Jimmy Buffet's entity, has more than 700 pending trademark applications and registrations for marks such as IT'S FIVE O'CLOCK SOMEWHERE, PARROTHEAD, TOES IN SAND - FORK IN HAND, LICENSE TO CHILL, and MARGARITAVILLE for a variety of goods and services. Michael Jackson's estate, through the entity Triumph International, Inc., has over 300 pending and registered trademarks for marks like BILLIE JEAN, NEVERLAND RANCH, KING OF POP, THIS IS IT, BAD, and THRILLER, also for a myriad goods and services. Elvis Presley, Steve Miller and many other artists have applied for, and in some instances have successfully obtained, trademark protection for their lyrics or song titles.

But, is this proper trademark use? Or, is it simply an effort to deter third parties from making use of these artists' song lyrics, titles, or catch phrases on merchandise? More likely than not, it is the latter.

In simple terms, the essential functions of a trademark are to indicate a single source of origin of goods and/or services, and to prevent consumer confusion in the marketplace. For example, when a consumer walks into a store and sees a handbag bearing the mark LOUIS VUITTON®, that consumer knows where that product came from, and can rely on the mark holder's reputation regarding the quality of the goods. A trademark owner can prevent competitors from using the owner's mark, or a similar mark, to deceive consumers and pass their own, usually inferior, goods or services off as the genuine goods or services. In other words, U.S. trademark

law is designed to protect consumers – not trademark holders. Trademark rights are also limited to the goods and services listed in the registration. Thus, if Louis Vuitton owns its mark for "handbags," for instance, it only has the right to use the mark on similar or related goods. In the strictest interpretation of trademark law, an unrelated party could begin selling Louis Vuitton semiconductors and would not be infringing.

Artists like Taylor Swift, however, are attempting to create monopolies over certain words and phrases in an attempt to "own" those words or phrases in connection with all goods and services to the exclusion of others. Taylor Swift's trademark applications are not likely an effort to protect her fans from buying an inferior THIS SICK BEAT wig or CAUSE WE NEVER GO OUT OF STYLE t-shirt. Rather, Ms. Swift has likely broadly filed for phrases such as THIS SICK BEAT and CAUSE WE NEVER GO OUT OF STYLE in order to prevent third parties from using that phrase to make money – money that Ms. Swift believes she herself should be making, should she choose to do so. Artists fear that their catch phrases and lyrics will become so popular that third parties will begin plastering them on any and all kinds of goods in order to capitalize on the artists' fame and goodwill. This is a valid fear. Unfortunately for the artists, though, U.S. trademark protection will only help them to a point.

Using phrases as song lyrics or titles does not establish any trademark rights. In the U.S., one cannot obtain trademark protection or registration without use of the mark in commerce on or in connection with all of the goods or services in the application. This means that in order for Taylor Swift to ultimately achieve registration of her marks, she'll have to use phrases like THIS SICK BEAT on wigs, tanning products, and temporary tattoos, for example. Undoubtedly, Ms. Swift plans to engage in a major merchandising push in connection with her tour. Thus, perhaps it is cynical to presume that Ms. Swift's trademark filings are not the signal of an ambitious licensing program, rather than merely protection against potential third-party exploitation of her song lyrics and titles. But, the likelihood of her using her marks on all of the goods and services in her applications seems slim.

Nevertheless, under U.S. trademark registration procedures, assuming a trademark applicant complies with all necessary maintenance filings, an applicant may have up to three and a half years before the applicant has to prove use of the mark. During that entire time period, the mark application blocks others from obtaining registration for the same or similar mark for identical or related goods or services. Additionally, while the application is pending, and even before proof of use of the mark is required, an applicant can use its application defensively to stop others in the marketplace from using the mark in commerce on the goods or services covered by the applications. Accordingly, an applicant can file an application and, for approximately three years, know that they have a defensive tool against copycats in the marketplace. For artists like Taylor Swift, in all likelihood in three years she will have a new album, with new popular song lyrics and titles, and the song titles and lyrics from her current album will be out of the zeitgeist and have little further value as trademarks to be applied to merchandise. Thus, even if Ms. Swift never proves use of her marks on all of the goods and services in her applications, the pending applications are a valuable asset that can be used to assert control over the potential revenue stream stemming from the popularity of her music.

In short, artists like Taylor Swift are attempting to capitalize on their fame and the popularity of their music, and there is nothing wrong with that. The problem arises when these artists attempt to monopolize certain words and phrases under the guise of preventing third-party exploitation. Whether these artists will actually use their marks, or whether the multiple application filings fail due to lack of use in the marketplace is yet to be seen. In the interim, third parties are put on notice of the artists' supposed bona fide intent to use the marks in commerce in connection with all of the goods or services listed in the applications. The deterring effect will likely be successful, at least to some extent, in preserving these artists' right to capitalize on their lyrics and titles themselves. Thus, even if Ms. Swift's and other artists' trademark filings do not fall squarely within the parameters of the policy behind U.S. trademark law, these filings provide the artists with some level of control over the revenue streams from their music and popularity.

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