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ALL I WANT FOR CHRISTMAS IS A TRADEMARK

SIMRAN THAKUR*

I. INTRODUCTION

If you use social media, this might sound familiar: You scroll through your Instagram page, "liking" a photo of your favorite author, commenting, "That looks so fun!" on a picture of your best friend's vacation trip, and "hearting" a video reel of your old school's newest incoming class. You continually come across posts from pages you "follow." Once every few posts, you encounter advertisements from pages you do not follow, like promotional material for celebrity singer/songwriter Taylor Swift's latest album.[1] Whether the advertisement is for a new album, concert, event, or just general promotional material, all followers of the account will see it.[2] If followers engage with the promotional material (comments on it, likes it, etc.), that engagement induces a ripple effect that causes the advertisement to also appear on their

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1. Gabriella Fernandez, Rebecca Jennings, & Shira Tarlo, *Every Song on Taylor Swift's Midnights, Explained*, VOX (Oct. 21, 2022), www.vox.com/culture/2022/10/21/23416464/taylor-swift-midnights-lyrics-explained-anti-hero-video [perma.cc/YR5Y-XYL9].

2. *The Effectiveness of Social Media Advertising in 2023*, SOCIALLYBUZZ, www.sociallybuzz.com/the-effectiveness-of-social-media-advertising/ [perma.cc/TG43-TPF7] (last visited Sept. 28, 2023).

"friends'" social media feeds. This exposes a potentially new audience to that content.[3] The Internet has revamped trademark law like nothing else.

Trademark law is a branch of intellectual property law that protects goods and service providers by furnishing a framework that facilitates consumers' ability to identify the source of the goods and services they purchase.[4] Trademarks are the marks or designations used as a source identifier by the producer of a good or service, for the benefit of those consumers.[5]

Although trademark law has evolved over the years, nothing has transformed the legal landscape quite like the invention and widespread use of the Internet.[6] From the early 2000's LOLcats[7] to 2023 Grimace Shakes,[8] today's vast and pervasive social media demonstrates that the Internet provides a universal platform upon which trademarks are far more easily identifiable.

The digital age influences trademark acceptances and rejections in a complex manner.[9] This comment explores how the Internet and social media have transformed the way the consuming public can be exposed to a trademark and proposes a way for trademark law to catch up with the Digital Age. Section II explores the concept of trademarks, defines what a trademark is, and describes the process of applying for a trademark and the rights associated with registration. Section III discusses past celebrity and public figure trademark cases, highlighting the dichotomy between acceptance and rejection of those trademarks and the inconsistencies in how those decisions were made. Section IV asserts that there should be an addition to 37 C.F.R. §2.41 (a)(3)[10]

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3. Andrew Roach, *Instagram Engagement: What It Is and How to Improve It*, OBERLO (Apr. 9, 2022), www.oberlo.com/blog/instagram-engagement-improve [perma.cc/SH9V-GU8S].

4. *See* 15 U.S.C. § 1127 (2006) (defining the term "trademark"); Holographic Design Systems, Inc. v. Holographic Design, Inc., 1987 U.S. Dist. LEXIS 11404 (N.D. Ill. 1987).

5. Lisowski v. Henry Thayer Co., Inc., 501 F. Supp. 3d 316, 334 n.5 (W.D. Pa. 2020) (defining a trademark as "an affirmation of authenticity, not an affirmation what the product contains or how it will perform").

6. PAMELA SAMUELSON, INTELLECTUAL PROPERTY MEETS THE INTERNET 845-71 (Normal Page., Oxford Acad. 2017).

7. Jamie Dubs, *LOLcats,* KNOW YOUR MEME, www.knowyourmeme.com/memes/lolcats [perma.cc/P8NV-CZUD] (last visited Oct. 7, 2022) (depicting pictures of cats with misspelled words overlaid, such as "I haz cheeseburger?").

8. *Grimace Shake Trend*, KNOW YOUR MEME, www.knowyourmeme.com/memes/grimace-shake-trend (last visited Dec. 19, 2023) (depicting parody videos of people drinking the McDonalds Grimace Milkshake, which are depicted to cause insanity or death.)

9. *See* discussion *infra* Part III.

10. 37 C.F.R. § 2.41(a)(3) (regulating trademark law under Section 2(f) by providing proof of distinctiveness for descriptive terms, specifically "other evidence" aside from five years substantially exclusive and continuous use in commerce.)

that would create a higher level of consistency in the decision-making process that underlies the grant of trademark rights via acquired distinctiveness/secondary meaning, in light of the Digital Age.

II. BACKGROUND

The Background section of this comment provides a more in-depth look into trademark law and related jurisprudence. Part A explores the concept of a trademark. Part B defines intellectual property, trademarks, and the statutes underlying U.S. trademark law. Part C reviews how a trademark is registered with the United States Patent and Trademark Office ("USPTO")[11] and the associated rights. Part D discusses common reasons for trademark rejection relevant to this comment. Part E highlights ambiguities in U.S. trademark law that stem from the case-by-case basis upon which celebrity and public figure trademark applications are decided. The TTAB[12] explicitly states that decisions they make in these kinds of cases hold no precedential value, which has propagated confusion concerning what constitutes a trademark.

A. Trademarks: A Concept

The age of trademarks has reigned supreme since the days of Ancient Greece, Ancient Rome, and Ancient Egypt.[13] In contemporary terms, a trademark is defined as a "word, phrase, or symbol" that is used to identify the source of a good or service and distinguish it from other sources.[14] But, before there was even a word for it, people were "trademarking" their creations.[15] In the prehistoric days, this looked like ceramics with a symbol etched on

11. *About Us*, USPTO, www.uspto.gov/about-us [perma.cc/PWV4-TEVC] (defining the United States Patent and Trademark Office, which accepts or rejects trademark applications under the Lanham Act and common law protections) (last visited Sept. 28, 2023).

12. *Trademark Trial and Appeal Board*, USPTO, www.uspto.gov/trademarks/ttab (last visited Dec. 19, 2023) ("The Trademark Trial and Appeal Board (TTAB) handles appeals involving applications to register marks, appeals from expungement or reexamination proceedings involving registrations, and trial cases of various types involving applications or registrations.")

13. Dennemeyer, *The Evolution of Trademarks – From Ancient Egypt to Modern Times*, MONDAQ (Dec. 10, 2019) www.mondaq.com/trademark/873224/the-evolution-of-trademarks--from-ancient-egypt-to-modern-times [perma.cc/A7CH-LYTF].

14. Laura Hennigan, Jane Haskins, & Rob Watts, *What Is A Trademark? Everything You Need to Know*, FORBES (Mar. 26, 2022, 12:55 PM) www.forbes.com/advisor/business/what-is-a-trademark/ [perma.cc/NH9A-7MU2].

15. Dennemeyer, *supra* note 13.

it that identified the specific producer.[16] In the Middle Ages, craft guilds would put their design on their swords, axes, and battle-ready weapons.[17]

One of the first and oldest registered trademarks in the world is a Czech beer trademark from Czechia, PILSNER, which was registered in 1859.[18] After the Trademark Registration Act passed in the United Kingdom in 1875, a flurry of businesses rushed to trademark their designs.[19] Nearly 150 years later, trademarks are still going strong, and in the U.S. they are controlled by the USPTO,[20] which was established by Congress in 1975.[21] In the United States, patents and trademarks are issued by the millions.[22]

Looking to present day, the Internet has overhauled many aspects of life, including "how the web changed fame."[23] Previously, fame was highly coveted and only bestowed to those lucky few to catch the eye of the mass media.[24] Today, almost anyone can crack the code of viral videos on social media and enjoy their "15 minutes of fame."[25]

While in 1875, trademark applications were mostly filed by

16. Mikolaj Lech, *The Oldest Registered Trademarks in the World*, LECH www.znakitowarowe-blog.pl/the-oldest-registered-trademarks-in-the-world/ [perma.cc/L22Z-9PD4] (last visited Oct. 7, 2022).

17. Lech, *supra* note 16; *see generally* Mark Cartwright, Medieval Guilds, World History Encyclopedia (Nov. 14, 2018) www.worldhistory.org/Medieval_Guilds/ [perma.cc/CSJ4-Q9Y9] (providing insight into the purpose and structure of medieval guilds).

18. Lech, *supra* note 16.

19. EDWARD MORTON DANIEL, THE TRADE MARKS REGISTRATION ACT, 1875, AND THE RULES THEREUNDER, WITH INTRODUCTION, NOTES, AND PRACTICAL DIRECTIONS AS TO REGISTERING TRADEMARKS TOGETHER WITH THE MERCHANDISE MARKS ACT, 1862, WITH NOTES, AND A COPIOUS INDEX TO THE WHOLE 73 (1876).

20. Lech, *supra* note 16; *see also* Thomas C. Frohlich & Alexander Kent, *The 10 Oldest Company Logos in the World*, USA TODAY (June 21, 2014), www.usatoday.com/story/money/business/2014/06/21/oldest-company-logos/11052039/ [perma.cc/Q85U-YL25] (illustrating the various trademarks throughout time).

21. *What is a Trademark?*, USPTO, www.uspto.gov/trademarks/basics/what-trademark [perma.cc/P62B-5XCM] (last visited Sept. 14, 2022).

22. *Milestones in U.S. Patenting*, USPTO, www.uspto.gov/patents/milestones [perma.cc/8VLQ-K9HL] (last visited Oct. 4, 2022).

23. David Weinberger, *How the Web Changed Fame*, CNN (Feb. 17, 2012), www.cnn.com/2012/02/17/opinion/weinberger-famous-web [perma.cc/M6ML-5RY4] (emphasizing that access to the Internet now provides users a pathway to ascend to fame. Previously they would have needed "a truckload of luck," and relying only on the media to decide whether to broadcast their brand or look publicly). *Id*. *See* Chris Hayes, *On the Internet, We're Always Famous*, THE NEW YORKER (Sept. 24, 2021), www.newyorker.com/news/essay/on-the-internet-were-always-famous (demonstrating public knowledge and discussion regarding the Internet and fame.)

24. Weinberger, *supra* note 23.

25. *Id*.

businesses to build brand recognition,[26] several modern trademark applications are filed by celebrities and public figures.[27] Celebrities and public figures, alongside regular people, have had many successes in trademarking names, famous phrases, and even pictures and silhouettes; still, they too face challenges concerning what constitutes a valid trademark.[28]

B. What is a Trademark?

Intellectual property is an intangible conception formed by the mind, used in commerce.[29] Intellectual property includes patents, copyrights, industrial designs, geographical indications, trade secrets, and trademarks.[30]

Generally, a trademark can be "any word, phrase, symbol, design, or combination of these things" that function to identify and distinguish a good or service.[31] While the term "trademark" is frequently used for both goods and services, a "service mark" is the proper technical term for a source-identifier used for services.[32] This comment uses the term "trademark" in a way that both describes a source-identifier for goods and services, but the analysis is nearly identical for trademarks and service marks alike.[33]

The Lanham Act of 1946 governs trademarks.[34] For a word, symbol, phrase, or design to qualify as a trademark, it must satisfy three basic requirements: (1) the trademark must be "distinctive" of the source of the goods or services to which it is affixed, (2) the

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26. Lech, *supra* note 16.

27. Gerben Trademark Library, *Celebrities*, GERBEN IP www.gerbenlaw.com/trademarks/celebrities/ [perma.cc/2GYN-F9VT] (last visited Sept. 9, 2023).

28. Hannah Roberts, *11 of the Most Unusual Company and Celebrity Trademark Applications and Disputes*, BUS. INSIDER (Dec. 31, 2016), www.businessinsider.com/unusual-celebrity-company-trademark-applications-disputes-2016-12#chanels-creative-director-karl-lagerfeld-trademarked-his-own-silhouette-featuring-his-ponytail-and-highly-noticeable-glasses-2 [perma.cc/ADV6-TY28].

29. *What is Intellectual Property?*, WORLD INTELLECTUAL PROPERTY ORGANIZATION, www.wipo.int/about-ip/en/ [perma.cc/H84X-DP89] (last visited Sept. 9, 2023).

30. *What is Intellectual Property?*, *supra* note 29.

31. *What is a Trademark?*, *supra* note 21; *see also What is a Trademark?*, WORLD INTELLECTUAL PROPERTY ORGANIZATION, www.wipo.int/trademarks/en/ [perma.cc/Z75L-ZCUA] (last visited Sept. 15, 2023).

32. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 3.01-3.02 (5th ed. 2022).

33. MCCARTHY, *supra* note 32.

34. 15 U.S.C. §1127 (1946) (defining and constructing the words for the law of trademarks, such as "commerce," "person," "trademark," etc.); *see also Lanham Act*, CORNELL L. SCH.: LEGAL INFO. INST., www.law.cornell.edu/wex/lanham_act [perma.cc/8PQG-ANAD] (last visited Oct. 7, 2022).

trademark must not be disqualified from protection by various statutory bars to protection, the most significant of which is that the trademark not be "functional," and (3) the trademark must be used in commerce.[35] Essentially, the mark must be a tangible symbol, in actual use in trade as a mark by a seller of goods that serves to identify and distinguish the seller's goods from goods made or sold by others.[36]

If a designation performs its role of identifying and distinguishing a seller's goods from others, the law deems it to be "distinctive" and legally protectable.[37] The U.S. Supreme Court has explained that a trademark "help[s] consumers identify goods and services that they wish to purchase, as well as those they want to avoid."[38] Courts rank distinctiveness on the Abercrombie Classification, a spectrum that ranges from: (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary or fanciful.[39]

Generic. Generic names are words that refer to a class of objects.[40] Examples include the word pink for the color or apple for the fruit.[41] Generic terms are not eligible for trademark protection, as everyone may use them to refer to the goods they designate.[42] Terms can be generic in two ways: (1) an invented term becomes generic through common usage over time, or (2) a term is generic *ab initio*, meaning it was commonly used before it became associated with a specific good or service.[43] A generic mark is unredeemable and there is generally no circumstance in which it will qualify for protection.[44]

There is a three-step test to determine whether a term is generic:

> (1) Identify the class of product/service to which the use of the mark is relevant; (2) Identify the relevant consuming public; and (3) Determine whether the primary significance of the mark to the relevant public is an indication of the product or services to which the

35. BARTON BEEBE, TRADEMARK LAW: AN OPEN-SOURCE CASEBOOK 21 (10th ed. 2023).

36. MCCARTHY, *supra* note 32.

37. *Id*.

38. Matal v. Tam, 582 U.S. 218, 224 (2017).

39. Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4 (2d Cir. 1976); JEROME GILSON, GILSON ON TRADEMARKS, § 2.01 (2022); *see also* Zatarain's Inc., v. Oak Grove Smoke House, Inc., 698 F.2d 786, 790 (5th Cir. 1983) (holding that trademarks are traditionally divided into four categories of distinctiveness: arbitrary or fanciful, suggestive, descriptive, and generic).

40. Otokoyama Co. v. Wine of Japan Import, Inc., 175 F.3d 266, 270 (2d Cir. 1999) ("It is a bedrock principle of the trademark law that no trader may acquire the exclusive right to the use of a term by which the covered goods or services are designated in the language. Such a term is 'generic.'") [hereinafter *Wine of Japan*].

41. *See* Zatarain's Inc., 698 F.2d 786, 790 (5th Cir. 1983).

42. *Wine of Japan*, 175 F.3d at 270.

43. Shire City Herbals, Inc. v. Blue, 410 F.Supp.3d 270, 274 (2019).

44. BEEBE, *supra* note 35, at 50.

mark relates, which suggests that it is generic, or an indication of the source or brand, which suggests that it is not generic.[45]

Descriptive. Words are in the "descriptive" category when they directly describe the nature or quality of a product, label its geographical source, or label the name of the person that makes or sells the goods.[46] Examples include the word creamy for yogurt or apple for an orchard.[47] Courts look to four factors to determine whether a term is descriptive: (1) the dictionary definition, (2) the imagination test, (3) the need to describe test, and (4) its use in the marketing of third parties.[48]

The first factor, the dictionary definition, is straightforward in its application, as it is an "appropriate and relevant indication" of the meaning of the word.[49] The second factor, the imagination test, seeks to determine the relationship between the actual words of the mark and the product to which they are applied.[50] If a term "requires imagination, thought, and perception to reach a conclusion as to the nature of the goods," it is more than descriptive.[51] The third factor, the need to describe test, concerns whether competitors marketing similar goods would need to use the word to describe their products or services – if yes, the word is likely descriptive.[52] Finally, the fourth factor, use in the marketing of third parties, asks whether competitors actually have used the term when marketing similar goods or services.[53]

Suggestive. Terms are suggestive if they require imagination, thought, and perception to reach a conclusion as to the nature of the goods.[54] An example is the words "Cocoa Puffs" for the chocolate cereal.[55] Courts emphasize the degree of "imagination" that a

45. Glover v. Ampak, Inc., 74 F.3d 57, 59 (4th Cir. 1996); *Genericness Archives*, IRWIN IP, www.irwinip.com/tag/genericness/ [perma.cc/HXE7-3LKJ] (last visited September 9, 2023) (discussing the Fourth Circuit's test to determine whether a term is generic).

46. MCCARTHY, *supra* note 32.

47. *Strong trademarks*, USPTO, www.uspto.gov/trademarks/basics/strong-trademarks#:~:text=They%27re%20only%20registrable%20in,"Apple%20pie"%20for%20potpourri [perma.cc/38GE-W6UW] (last visited Sept. 10, 2023); *see also Examples of Descriptive Trademarks*, REVISION LEGAL, www.revisionlegal.com/trademark/examples-of-descriptive-trademarks/ [perma.cc/82CT-PL3R] (last visited Sept. 10, 2023) (illustrating further examples of descriptive trademarks.).

48. *Zatarain's Inc.*, 698 F.2d at 790.

49. *Id.* at 792 (quoting Am. Heritage Life Ins. Co. v. Heritage Life Ins. Co., 494 F.2d 3, 11 (5th Cir. 1974)).

50. BEEBE, *supra* note 35.

51. *Zatarain's Inc.*, 698 F.2d at 792.

52. BEEBE, *supra* note 35.

53. *Id*.

54. Alfwear, Inc. v. Mast-Jaegermeister US, Inc., 2023 U.S. App. LEXIS 23736, 35 (10th Cir. 2023), *see also Zatarain's Inc.*, 698 F.2d at 791.

55. *Cocoa Puffs*, GENERAL MILLS www.cereals.generalmills.com/products/cocoa-puffs/ [perma.cc/YFQ8-Y7SX] (last visited Sept. 9, 2023).

consumer must use to connect the meaning of the mark to the goods.[56] Suggestive terms do not need to show secondary meaning because they are inherently distinctive, and receive recognition from the public as functioning to identify the source of the product.[57]

Arbitrary or Fanciful. Arbitrary or fanciful marks are words, symbols, or designs that use common words in unexpected ways.[58] Examples include the word Apple for the tech company or Pink for the clothing line.[59] The strongest types of marks are arbitrary or fanciful marks, which are "invented, coined, meaningless designations that appear in no dictionaries and that convey no information about the product or their uses."[60]

A trademark applicant must carefully consider where on the spectrum their proposed mark falls.[61] Generic marks cannot be trademarked, while arbitrary or fanciful marks stand a much better chance.[62] To register a trademark with the USPTO, an applicant needs to consider many factors.[63]

§ 2(f) of the Lanham Act. Registration for a mark may fail based upon certain criteria, such as a word that is deemed "descriptive."[64] However, there is a chance for redemption for these otherwise failed marks under § 2(f) of the Lanham Act.[65] Under § 2(f), trademarks can take on a secondary meaning (ownership acquired by bringing on distinctiveness), which is an acknowledgment that the word has become inherently recognizable, and thus can serve as a source-identifier of the good or service.[66] A trademark can acquire distinctiveness/secondary meaning in many ways, such as through its commercial use, social media, or online popularity.[67] Once a trademark acquires secondary meaning, the

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56. BEEBE, *supra* note 35.

57. *Id*.

58. MCCARTHY, *supra* note 32.

59. APPLE, www.apple.com [perma.cc/QU9E-7WVB] (last visited Sept. 10, 2023).

60. JEROME GILSON, GILSON ON TRADEMARKS, § 2.01 (2022).

61. *Get Ready to Apply*, USPTO, www.uspto.gov/trademarks/basics/trademark-process [perma.cc/T2UL-BD24] (last visited Oct. 8, 2022).

62. *Wine of Japan*, 175 F.3d at 270.

63. *Get Ready to Apply*, *supra* note 61.

64. 15 U.S.C. § 1052(e).

65. 15 U.S.C. § 1052(f).

66. MCCARTHY, *supra* note 32; *see 37 CFR §2.41 – Proof of Distinctiveness Under Section 2(f)*, CORNELL L. SCH.: LEGAL INFO. INST., www.law.cornell.edu/cfr/text/37/2.41 [perma.cc/5ZV5-UVUV] (last visited Sept. 10, 2023) (providing statutory support for distinctiveness through secondary meaning in descriptive marks).

67. *Secondary Meaning*, CORNELL L. SCH.: LEGAL INFO INST., www.law.cornell.edu/wex/secondary_meaning [perma.cc/5NCL-9ZW3] (last visited Oct. 26, 2022); *see* Lovely Skin, Inc. v. Ishtar Skin Care Prods., LLC, 745 F.3d 877, 882 (8th Cir. 2014) (determining that "whether a mark has acquired distinctiveness" or "secondary meaning" depends on whether in the "consumer's mind the mark has become associated with a particular source").

USPTO may permit its registration.[68] An applicant must provide evidence that a mark has acquired distinctiveness under § 2(f).[69] 37 C.F.R § 2.41 provides deeper insight into the evidentiary burden that an applicant bears to claim acquired distinctiveness for their mark under § 2(f).[70] Registering a trademark requires the applicant to consider many factors.[71]

C. Trademark Rights and Registration

Rights in trademark exist in two forms: unregistered common law rights and registered national rights.[72] One can establish common law rights to a trademark by using that trademark in commerce.[73] The owner of the trademark must make public use of that mark, so that customers "associate it with a single source" – the primary purpose of a trademark.[74] Alternatively, one may obtain national rights to a trademark by registration through the USPTO.[75]

Trademark registration with the USPTO is a rather involved process. First, the applicant must ensure that a trademark is needed.[76] Because trademarks, copyrights, patents, and domain names serve to protect intellectual property in a similar manner, an applicant might be unsure what form of protection is required and may need to register for something other than a trademark.[77] After the applicant determines that trademark protection is required, they must choose their trademark.[78] The trademark must be a word, phrase, design, symbol, or combination thereof that is distinctive and identifies their product or service.[79] The applicant should

68. MCCARTHY, *supra* note 32.

69. 15 U.SC. § 1052 relates to the registration of trademarks. Whereas, Section 2(f) refers to the distinctiveness of trademarks. *How to Claim Acquired Distinctiveness Under Section 2(f)*, USPTO www.uspto.gov/trademarks/laws/how-claim-acquired-distinctiveness-under-section-2f-0 [perma.cc/FUT4-SL42] (last visited Sept. 30, 2023).

70. *Id*.

71. *Get Ready to Apply*, *supra* note 61.

72. 15 U.S.C. §§ 1051 *et seq.*; *see* 15 U.S.C. § 1125 (outlining the protections for unregistered marks as prevention of consumer confusion concerning the source, sponsorship or affiliation of a good or service).

73. GILSON, *supra* note 60; *see also* Hana Financial, Inc. v. Hana Bank, 574 U.S. 418 (2015) (establishing the rule that one can establish common law rights to a trademark if using that trademark publicly in commerce).

74. The Lanham Act, 15 U.S.C. §1051 (1946) (providing that "the owner of a trademark used in commerce may request registration of its trademark"); *see* Construction and Definitions; Intent of Chapter, 15 U.S.C. §1127 (1946) ("[T]he term '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.").

75. *Get Ready to Apply*, *supra* note 61.

76. *Id.*

77. *Id.*

78. *Id.*

79. *Id.*

search the USPTO database for similar marks, to avoid filing a trademark that has already been claimed by someone else.[80] Finally, the applicant creates an account on the USPTO website, submits the application, and pays a filing fee.[81] The application is forwarded to an examining attorney who examines the legal basis for the filing.[82] This can take a while, ranging between twelve and eighteen months, during which time the applicant can monitor the application status.[83]

If approved, the trademark will enter the "publication period" where the USPTO will publish the trademark in its official online publication for thirty days.[84] During this period, any party may oppose the registration.[85] If a party opposes the applicant's trademark registration, there is a court process to resolve the dispute, known as an opposition proceeding.[86] If no one opposes the registration, the trademark is registered on the USPTO's Principal Register[87] and officially belongs to the applicant.[88]

D. Reasons for Trademark Rejection

There are a few reasons why a trademark application may be rejected based upon the meaning of the mark itself.[89] These reasons include but are not limited to: (1) deceptive, false suggestion of connection; (2) descriptive or misdescriptive; (3) geographical; (4)

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80. *Id.*

81. *USPTO Fee Schedule*, USPTO, www.uspto.gov/sites/default/files/documents/USPTO%20fee%20schedule_current.pdf [perma.cc/2VVY-LL23] (last visited Mar. 5, 2023).

82. Mark Tyson, *How to Register a Trademark [Step-by-Step]*, TKN TYSON (Nov. 19, 2018), www.marktysonlaw.com/blog/how-to-register-trademark [perma.cc/M525-D4MS].

83. *How Long Does It Take to Register*, USPTO www.uspto.gov/trademarks/basics/how-long-does-it-take-register [perma.cc/KEE8-JBF7] (last visited Nov. 14, 2022).

84. *Section 1(a) Timeline*, USPTO www.uspto.gov/trademarks/trademark-timelines/section-1a-timeline-application-based-use-commerce [perma.cc/9RSH-KKQK] (last visited Sept. 10, 2023); *see* Eric Perrott, *My Trademark Application was "Approved for Publication" – What's Next?*, GERBEN IP (last visited Oct. 1, 2023) www.gerbenlaw.com/blog/my-application-was-approved-for-publication-whats-next/#:~:text=Once%20the%20government%20attorney%20approves,of%20every%20trademark%20application%20process [perma.cc/6U5Z-RRD3].

85. Vic Lin, *How to Oppose a Trademark Application*, PATENT TRADEMARK BLOG, www.patenttrademarkblog.com/how-to-oppose-trademark-application/ [perma.cc/BG9Y-XAF2] (last visited Sept. 10, 2023).

86. *Id.*

87. This comment acknowledges the existence of the USPTO's Supplemental Register, but performs no analysis pertaining to registration of marks other than on the USPTO's Principal Register. *See* 15 U.S.C. § 1091 *et seq.* (outlining the process of registration to the Supplemental Register).

88. *Get Ready to Apply*, supra note 61.

89. *See also* The Lanham Act, 15 U.S.C. §2(a)-(e) (1946) (stating multiple reasons for which a mark can be refused registration).

geographically deceptively misdescriptive; (5) surnames; (6) likelihood of confusion; and (7) failure to function.[90]

Deceptive, False Suggestion of Connection. The USPTO will refuse registration, under § 2(a) of the Lanham Act, for trademarks that are deceptive or that "falsely suggest a connection."[91] The USPTO will refuse registration of any trademark that suggests to consumers that the products are attributed to a different source than they actually are.[92]

A deceptive mark, is one that will mislead or deceive consumers about the nature, quality, or origin of the goods or services being offered.[93] The test used to determine whether a trademark consists of or comprises deceptive matter is: (1) Does the trademark misdescribe something about the product/service? (2) If so, is a purchaser likely to believe that the misdescription actually describes the product/service? (3) If so, is the misdescription likely to affect a purchaser's decision to buy the product/service?[94] A deceptive trademark could look like naming a candy "Sugar-Free Yums" when the candy is, in fact, not sugar-free.[95]

A mark that suggests a false connection to a source is one that, as the name implies, suggests a false connection to a source that is not the actual source of the good or service. The test used to determine if a mark suggests a false connection to a source is to weigh the combination of the following factors: (1) a name of sufficient fame or reputation and (2) its use on or in connection with particular goods or services, that would point uniquely to a particular person or institution.[96] A mark which suggests a false connection to a source could look like naming a line of toys SEAL TEAM 6, as it may falsely suggest a connection with the elite U.S.

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90. *Id.*; *see also Possible Grounds for Refusal of a Mark*, USPTO www.uspto.gov/trademarks/additional-guidance-and-resources/possible-grounds-refusal-mark [perma.cc/3Z3P-GWB9] (last visited Oct. 5, 2022).

91. *15 U.S. Code §1052 – Trademarks Registrable on Principal Register; Concurrent Registration*, CORNELL L. SCH.: LEGAL INFO INST. www.law.cornell.edu/uscode/text/15/1052 [perma.cc/DA23-VQKL] (last visited Sept. 10, 2023) (providing that no trademark shall be refused on the "principal register on account of its nature unless it (a) consists of or compromises…deceptive…or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute.").

92. Morris E. Turek, *What is a Deceptive Trademark for Purposes of Trademark Registration?*, YOUR TRADEMARK ATTORNEY www.yourtrademarkattorney.com/what-is-a-deceptive-trademark/ [perma.cc/RC7Y-6539] (last visited Oct. 3, 2023) [hereinafter Turek, *Deceptive Trademark*].

93. Turek, *Deceptive Trademark*, *supra* note 92.

94. Hoover Co. v. Royal Appliance Mfg. Co., 238 F.3d 1357, 1361 (Fed. Cir. 2001).

95. *Id.*

96. *In re* Pedersen, 109 U.S.P.Q.2d 1185, 1202 (T.T.A.B. 2013).

naval special operations unit.[97]

Descriptive or (Deceptively) Misdescriptive. A descriptive mark is one that simply describes goods/services or its ingredients, function, features, or purpose.[98] Courts generally use the imagination test to determine if a mark is descriptive.[99] A descriptive mark may look like the label "Safari" for a service which allows clients to explore a forested area on a structured path with a tour guide.[100]

A misdescriptive mark is one that misdescribes or misleads the consumer about an ingredient, function, feature, or purpose of a good/service.[101] The test that courts generally use to determine if a mark is misdescriptive is: (1) is the mark misdescribing the good or service, (2) whether consumers believe the misdescription, and (3) whether the misdescription is material to consumer purchasing decisions.[102] A misdescriptive mark would look something like the brand "Apple" for computers.

A deceptively misdescriptive mark misdescribes something about the product in a way that consumers might believe actually and accurately describes the product.[103] The USPTO uses the following test to determine whether a trademark is deceptively misdescriptive: "(1) Does the trademark misdescribe something about the products or services recited in the trademark application? (2) If so, is a purchaser likely to believe that the misdescription actually describes the products or services?"[104] A deceptively misdescriptive trademark could look like a mark for "Vanilla Snow"

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97. Morris Turek, *What is a False Suggestion of a Connection Trademark Refusal?*, YOUR TRADEMARK ATTORNEY www.yourtrademarkattorney.com/false-suggestion-of-a-connection/ [perma.cc/3XFP-F38E] (last visited Oct. 12, 2023) [hereinafter Turek, *Connection Trademark Refusal*].

98. *Trademark Strength*, INTERNATIONAL TRADEMARK ASSOCIATION www.inta.org/fact-sheets/trademark-strength/ [perma.cc/2N5F-3LQ3] (last visited Sept. 10, 2023).

99. *See* discussion *infra* Section II B.

100. Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 11-12 (2d Cir. 1976).

101. Jennifer Sander, *Trademarks: Descriptiveness Objection*, SANDER LAW (Sept. 8, 2020), www.sanderlaw.ca/trademarks-descriptiveness-objection/ [perma.cc/KAT7-5NGV]; *see also Zatarain's Inc.*, 698 F.2d at 798 (setting forth the rule for descriptive denial).

102. Nathenson, *Deceptive, Misdescriptive, Etc. Marks*, PROFESSOR NATHENSEN (Sept. 12, 2022), www.nathenson.org/courses/ip/resources/deceptive-misdescriptive/ [perma.cc/TC2L-GA7Q].

103. Turek, *Deceptive Trademark*, *supra* note 92; *see* Gold Seal Co. v. Weeks, 129 F. Supp. 928, 933-34 (D.D.C. 1955) (accentuating merely descriptive and deceptively misdescriptive marks).

104. R. Neumann & Co. v. Overseas Shipments, Inc., 51 C.C.P.A. 946 (1964) (discussing deceptively misdescriptive trademarks under Section 2(e)(1) of the Trademark Act of 1946 generally).

to refer to something like hot chocolate or chocolate ice cream.[105] Importantly, the trademark must deceive consumers – "Vanilla Snow" for items like printer primer or paint would not be deceptively misdescriptive because consumers know the item will not taste like vanilla.[106]

Descriptive, misdescriptive, and deceptively misdescriptive marks are eligible for registration as a trademark only if it has acquired distinctiveness/secondary meaning under § 2(f) of the Lanham Act.[107] Applicants who strongly believes that their potential trademark is not deceptively misdescriptive may submit evidence to the contrary and appeal the decision.[108] Alternatively, if the trademark has been in substantial, continuous use for at least five years, applicants may submit an application for acquired distinctiveness under § 2(f).[109] Finally, applicants can either disclaim the portion of the trademark that is deceptively misdescriptive or amend their application entirely.[110]

Geographical or Geographically Deceptively Misdescriptive. A primarily geographical mark is one that shows that the source of the goods is the geographic region named in the mark.[111] The USPTO does not register primarily geographical trademarks unless there is a showing of proof that it has acquired distinctiveness.[112] Courts have devised a three-pronged test to determine if a particular mark falls within this framework: (1) whether the geographic place name included in the mark is well-known to the general public; (2) whether the general public would make an association between the place name and the goods themselves; and (3) whether the goods actually originate from the

105. *Deceptive Trademarks*, SMITH & HOPEN www.smithhopen.com/glossary/deceptive-trademarks/ [perma.cc/3QYQ-SGTS] (last visited Sept. 10, 2023).

106. *Id.*

107. Turek, *Deceptive Trademark*, *supra* note 92; Turek, *Connection Trademark Refusal*, *supra* note 97; *see also* R. Neumann & Co. v. Overseas Shipments, Inc., 326 F.2d 786 (C.C.P.A. 1964) (discussing deceptively misdescriptive trademarks under Section 2(e)(1) of the Trademark Act of 1946 generally).

108. Brandon Selinsky, *What You Need to Know About Deceptively Misdescriptive Trademarks*, WHITCOMB SELINSKY, PC www.whitcomblawpc.com/additional-blogs-of-interest/misdescriptive-trademarks [perma.cc/5LVA-EGKJ] (last visited Oct. 7, 2022).

109. Turek, *Deceptive Trademark*, *supra* note 92; Turek, *Connection Trademark Refusal*, *supra* note 97.

110. *Id.*

111. Lin, *supra* note 85.

112. The Lanham Act, 15 U.S.C. §1052(e) (1946) (providing that if a Trademark Examiner establishes a prima facie case that a trademark is primarily geographically descriptive, an applicant may rebut that showing with evidence that the public would not actually believe the goods derive from the geographic location identified by the mark).

named geographic region.[113] An example of a primarily geographical mark would be "Wisconsin hats" for a hat company based in Wisconsin.[114] This mark is primarily geographic because consumers cannot differentiate this hat company from any other hat company based out of Wisconsin.[115]

A geographically deceptively misdescriptive mark indicates that the product does not actually originate from the geographic location that it implies from the name.[116] Courts generally use the following test to determine that a mark is primarily geographically deceptively misdescriptive if: (1) the primary significance of the mark is a generally known geographic location, (2) the consuming public is likely to believe the place identified by the mark indicates the origin of the goods [or services] bearing the mark, when in fact the goods [or services] do not come from that place, and (3) the misrepresentation was a material factor in the consumer's decision.[117] An example of a geographically deceptively misdescriptive mark would be something like "ICELANDIC ICE" for an ice maker, where the ice maker is made in Detroit, Michigan, not Iceland.[118]

An applicant who believes that their potential trademark is not geographically misdescriptive may appeal the decision, following the same processes as appealing a decision for a trademark that is deceptively misdescriptive.[119]

Surnames. Surnames are marks that are also a last name.[120] Surnames, upon a showing of acquired distinctiveness, may be registered under the Lanham Act.[121] Courts consider five factors in determining whether a relevant purchasing public perceives a surname to be primarily significant term that refers to the source of a producer: (1) whether the surname is rare; (2) whether the term

113. *In re*: The Newbridge Cutlery Co., 776 F.3d 854, 860 (Fed. Cir. 2015) (describing elements used to determine whether a mark is primarily geographically descriptive or primarily geographically deceptively misdescriptive.)

114. *Examination Guide 2-14 – Geographic Certification Marks*, USPTO www.uspto.gov/sites/default/files/trademarks/resources/Exam_Guide_2-14_GeoCert.doc [perma.cc/CWM9-YLYM] (last visited Oct. 2, 2023).

115. Richard Stim, *Using Geographic Terms as Trademarks*, NOLO, www.nolo.com/legal-encyclopedia/using-geographic-terms-trademarks.html [perma.cc/AQH5-QDK2] (last visited Oct. 9, 2022).

116. Lin, *supra* note 85; *see also* Stim, *supra* note 115.

117. In Re: Les Halles de Paris J.V., 334 F.3d 1371, 1373 (Fed. Cir. 2003).

118. *See* Morris Turek, *What is a Geographically Deceptively Misdescriptive Trademark?*, YOUR TRADEMARK ATTORNEY www.yourtrademarkattorney.com/geographically-deceptively-misdescriptive-trademark/ [perma.cc/J7U3-Y3HC] (last visited Oct. 15 2023).

119. Turek, *Deceptive Trademark*, *supra* note 92; Turek, *Connection Trademark Refusal*, *supra* note 97.

120. *Surname*, MERRIAM-WEBSTER, www.merriam-webster.com/dictionary/surname [perma.cc/WF6-DT9F] (last visited Oct. 3, 2023).

121. 15 U.S.C. § 1052(f).

is the surname of anyone connected with the application; (3) whether the term has any recognized meaning other than a surname; (4) whether it has the "look and feel" of a surname; (5) in cases of stylized rather than standard character marks, whether the stylization of lettering is distinctive enough to create a separate commercial impression.[122]

The USPTO allows registration for full names without any showing that the name carries secondary meaning, provided that the applicant can show that the name is being used as an indication of commercial origin rather than as simply the applicant's own name.[123]

Likelihood of Confusion. A likelihood of confusion between two marks occurs when two marks conflict.[124] The federal test for the scope of rights in a trademark determines if the mark is "likely to cause confusion, or to cause mistake, or to deceive."[125] Likelihood of confusion is met "if the marks are similar and the goods and or services [are] related such that consumers would mistakenly believe they come from the same source."[126]

The Federal Circuit, TTAB, and USPTO use the thirteen *DuPont* factors to determine whether two marks have a likelihood of confusion.[127] Each other Circuit uses their own set of factors

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122. In re Benthin Mgmt. GmbH, 37 U.S.P.Q.2d 1332, 1333-34 (T.T.A.B. 1995).

123. BEEBE, *supra* note 35.

124. 15 U.S.C. § 2(d); *see also Likelihood of Confusion: Everything You Need to Know*, UPCOUNSEL www.upcounsel.com/likelihood-of-confusion [perma.cc/F9ZH-BXX5] (last visited Oct. 7, 2022).

125. The Lanham Act § 32(1), 15 U.S.C. §1114(1) (1976).

126. *Possible Grounds for Refusal of a Mark*, *supra* note 90.

127. Application of E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1361, (C.C.P.A. 1973) (identifying the factors as (1) the similarity or dissimilarity of the marks in their entities as to appearance, sound, connotation, and commercial impression; (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made (*i.e.,* "impulse" vs. careful, sophisticated purchasing); (5) the fame of the prior mark (*i.e.,* sales, advertising, length of use); (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used (*i.e.,* house mark, "family" mark, product mark); (10) the market interface between applicant and the owner of a prior mark: (a) a mere "consent" to register or use, (b) agreement provisions designed to preclude confusion (*i.e.,* limitations on continued use of the marks by each party), (c) assignment of mark, application, registration and good will of the related business, (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion; (11) the extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion, i.e., whether *de minimis* or substantial; (13) any other established fact probative of the effect of use).

derived from the *DuPont* factors.[128]

One example of a mark that could be rejected for likelihood of confusion involved cleaning products: Mr. Clean vs. Mr. Rust vs. Mr. Stain.[129] Since trademarks primarily operate to identify businesses/producers from their goods, three marks with the same or similar name/designation would render all of their trademarks useless.[130] In order to prevent a trademark rejection from likelihood of confusion, applicants should make a good-faith effort to check the USPTO's database of registered marks and ensure distinctiveness.[131]

Failure to Function. When a mark fails to function, it cannot

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128. *See, e.g.*, Borinquen Biscuit Corp. v. M.V. Trading Corp., 443 F.3d 112 (1st Cir. 2006) (enumerating the eight factors used to determine likelihood of confusion in the First Circuit); Fed. Express v. Fed. Espresso, 201 F.3d 168 (2d Cir. 1999) (enumerating the eight factors used to determine likelihood of confusion in the Second Circuit); Interpace Corp. v. Lapp, Inc., 721 F.2d 460, 463 (3d Cir. 1983) (enumerating the ten factors used to determine likelihood of confusion in the Third Circuit); George & Co. LLC v. Imagination Entm't Ltd., 575 F.3d 383, 393 (4th Cir. 2009) (enumerating the nine factors used to determine likelihood of confusion in the Fourth Circuit); Am. Rice Inc. v. Producers Rice Mill, Inc., 518 F.3d 321, 329 (5th Cir. 2008) (enumerating the eight factors used to determine likelihood of confusion in the Fifth Circuit); Frisch's Rest., Inc. v. Shoney's Inc., 759 F.2d 1261, 1264 (6th Cir. 1985) (enumerating the eight factors used to determine likelihood of confusion in the Sixth Circuit); Sorensen v. WD-40 Co., 792 F.3d 712, 726 (7th Cir. 2015) (enumerating the seven factors used to determine likelihood of confusion in the Seventh Circuit); Lovely Skin, Inc. v. Ishtar Skin Care Products, LLC, 745 F.3d 877, 887-89 (8th Cir. 2014) (enumerating the six factors used to determine likelihood of confusion in the Eighth Circuit); AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348-49 (9th Cir. 1979) (enumerating the eight factors used to determine likelihood of confusion in the Ninth Circuit); King of the Mountain Sports Inc., v. Chrysler Corp., 185 F.3d 1084, 1089-90 (10th Cir. 1999) (enumerating the six factors used to determine likelihood of confusion in the Tenth Circuit); Alliance Metals, Inc. of Atlanta v. Hinely Indus., Inc., 222 F.3d 895, 907 (11th Cir. 2000) (enumerating the seven factors used to determine likelihood of confusion in the Eleventh Circuit); Globalaw Ltd. v. Carmon & Carmon L. Off., 452 F. Supp. 2d 1, 48 (D.D.C. 2006) (enumerating the unofficial seven factors used to determine likelihood of confusion in the D.C. Circuit).

129. Kritika Rai, *Likelihood of Confusion in Trademark Applications: Things You Must Know*, SAGACIOUS IP, www.sagaciousresearch.com/blog/likelihood-of-confusion-in-trademark-applications/ [perma.cc/Q6NW-D5G6] (last visited Oct. 8, 2022); *see also* Multi Time Mach., Inc. v. Amazon.com, Inc., 804 F.3d 930, 932 (9th Cir. 2015) (holding that it does not constitute likelihood of confusion when a customer searches Amazon for a wristwatch brand that Amazon does not carry and is taken to brands of wristwatches that Amazon does carry. The court found that reasonable online consumers that had any experience with online shopping would not be confused. *Id.*).

130. GILSON, *supra* note 60, at § 2.02.

131. *New Trademark Search System: Beta Release*, USPTO, www.uspto.gov/trademarks/search [perma.cc/73P4-9222] (last visited Oct. 3, 2023).

be used as a source identifier in the public's mind.[132] Refusal of a trademark on failure to function grounds are "due to its inherent nature or the manner in which it is used."[133] Failure to function occurs when a trademark does not actually indicate its source or distinguish the goods because of the way it is used.[134] For example, potential trademarks that list words or names that merely convey information do not function as trademarks because it makes it "difficult for the public to perceive" the marks as proper trademarks.[135] An example of a marks that have been rejected on failure to function grounds would be a religious slogan ("Team Jesus") or political phrase, ("God Bless the U.S.A.").[136]

A specific way in which a mark may fail to function is if it is merely ornamental.[137] Ornamentality is when the mark does not serve as an identification of the product or service, but rather "merely as an ornamental or decorative feature on the goods."[138] If consumers perceive the mark to be merely a decorative feature of the goods, and not an "indication of the source of the goods," then the goods do not identify the producer or distinguish the product from any other, thus failing as a trademark.[139] The USPTO noted the factors used to determine whether a mark acts properly to identify the source of the goods or is merely ornamental include: (1) size, (2) location, (3) dominance, and (4) significance of the mark.[140] Words can be both ornamental and a trademark in some cases, but the designation can never be a trademark if it is solely ornamental.[141]

An example of a merely ornamental trademark may be a slogan prominently displayed on the front of a T-shirt that says, "I'm with

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132. *What Does a Failure to Function Mean in Trademark Law?*, MCLOUGHLIN, O'HARA, WAGNER & KENDALL L.L.P. (Nov. 12, 2021) www.mowklaw.com/2021/11/12/what-does-a-failure-to-function-mean-in-trademark-law/ [perma.cc/JSL8-2WEL].

133. *Grounds for Refusal of Trademark Registration*, WORLD INTELLECTUAL PROPERTY ORG. www.wipo.int/export/sites/www/sct/en/comments/pdf/sct21/ref_us.pdf (last visited Dec. 19, 2023).

134. Alexandra J. Roberts, *Trademark Failure to Function*, 104 IOWA L. REV. 1977 (2019) (discussing the trademark law of the doctrine of failure to function).

135. *In re* Light, 662 Fed. Appx. 929, 930 (Fed. Cir. 2016).

136. Lin, *supra* note 85.

137. *"Ornamental" Refusal and How to Overcome This Refusal*, USPTO, www.uspto.gov/trademarks/laws/ornamental-refusal-and-how-overcome-refusal-0 [perma.cc/N4VD-EUEF] (last visited Oct. 6, 2022) [hereinafter *Ornamental*].

138. *Ornamental*, *supra* note 137.

139. Pa. State Univ. v. Vintage Brand, LLC, No. 21-CV-01091, 2022 U.S. Dist. LEXIS 125170, at *3 (M.D. Pa. July 14, 2022).

140. Adidas Am., Inc. v. Calmese, No. CV-08-91-ST, 2009 U.S. Dist. LEXIS 94763, at *5 (D. Or. July 2, 2009).

141. Bobosky v. Adidas AG, 843 F. Supp. 2d 1134, 1142 (D. Or. 2011); *see also* Ithaca Indus., Inc. v. Essence Commc'ns, Inc., 706 F. Supp. 1995, 1206-07 (W.D.N.C. 1986) (providing rule that a designation can never be a trademark if it is solely ornamental).

Her" or "Sorry I'm late. I didn't want to come."[142] If it is determined that the relevant consuming public would not automatically think these slogans identified the source of the t-shirts they would be considered merely ornamental.[143]

When a trademark application is filed, other parties of interest will be provided a window of opportunity to file an opposition to block the application.[144] The basis for filing these oppositions often rely on failure to function, alleging that the proposed mark does not properly function and thus, cannot be approved as a registered trademark.[145] In response to an opposition, the applicant may produce evidence that the trademark functions properly as intended, and court proceedings commence to resolve the dispute.[146]

E. Ambiguities in Trademark Law from Celebrity and Public Figure Filings

Over the years, celebrities and public figures have used the trademark registration process to use, monetize, and protect words, phrases, and other designations that the public associates with them.[147] Due to social media, the Internet, and television, celebrities are constantly broadcasted to a following of thousands, if not millions, of fans.[148] Two notable and significant celebrity trademarks include: (1) Olympian Sprinter Usain Bolt, who registered his signature lightning bolt celebration pose, and (2) author of *Tarzan of the Apes* Edgar Rice, who registered a

142. *I'm With Him, I'm With Her, Mr. and Mrs. Shirt, Matching Couples Shirts, Couples Matching Shirts, Couple Travel Shirts, Power Couple Tees*, ETSY, www.etsy.com/listing/925429972/im-with-him-im-with-her-mr-and-mrs-shirt? [perma.cc/8ZJ8-Z2MX] (last visited Oct. 28, 2022). *See I'm Sorry I'm Late I Didn't Want to Come T-Shirt,* AMAZON, www.amazon.com/Im-Sorry-Late-Didnt-T-Shirt/dp/B07KWR5N99 (last visited Mar. 4, 2023).

143. *Ornamental*, *supra* note 137; *see also 4 Ways to Overcome a Likelihood of Confusion Refusal*, LEHRMAN BEVERAGE LAW, bevlaw.com/trademark-overcome-likelihood-confusion-refusal/ [perma.cc/3EPH-3JUN] (last visited Mar. 3, 2023) (including: (1) "argue that the marks are different," (2) sign consent agreements which "agree to coexist with a prior registrant/applicant," (3) "argue the prior registration/application is weak," (4) cancel the prior registration by issuing a "collateral attack").

144. *Get Ready to Apply*, *supra* note 61.

145. *Id; see also* Marisa Sanfilippo, *How to Register and Trademark a Brand Name*, BUS. NEWS DAILY (Feb. 21, 2023), www.businessnewsdaily.com/15762-how-to-register-trademark-brand-name.html [perma.cc/Z7KU-8TC5].

146. Tyson, *supra* note 82.

147. Danielle Gittleman, *9 Insane Things Celebrities Have Trademarked*, THETHINGS (Dec. 26, 2020), www.thethings.com/things-celebrities-have-trademarked/.

148. Kristin Wright, *Social Media and Celebrities: The Benefits of a Social Media Presence*, CAL POLY www.digitalcommons.calpoly.edu/cgi/viewcontent.cgi?article=1093&context=journsp (last visited Dec. 19, 2022).

trademark for the Tarzan yell.[149]

Celebrities have also made many attempts to trademark words and phrases that failed as marks and were ultimately rejected by the USPTO, including a vegetable pun: LETTUCE TURNIP THE BEET.[150] In Section III, this comment explores certain celebrity and public figure trademark filings—in particular trademarks filed by: Donald Trump, Jay-Z and Beyoncé, Taylor Swift, Lizzo, Cardi-B, and Mariah Carey.

These celebrities and public figures have millions of followers across their social media platforms.[151] However, the outcome of the majority of these trademark decisions were determined on a case-by-case basis without prior decisions having any precedential value, even though they shared many similarities.[152] Some received trademarks right away, others were forced to file appeals with the TTAB, and some were rejected outright.[153] There are many issues caused by this approach due to the inconsistent application of trademark principles between the various cases.[154] In the wake of the Digital Age and the advent of the Internet/social media, these trademark decisions are more than celebrity drama; they play across a stage the whole world can see, and in turn, globally influence future applicants' decisions to seek trademarks.[155]

III. ANALYSIS

This section examines a diverse set of notable trademark applications submitted by Donald Trump (as a politician and earlier as a TV reality star), rapper Jay-Z and singer Beyoncé, singer/songwriter Taylor Swift, rapper/singer Lizzo, rapper/singer

149. Roberts, *supra* note 28.

150. LTTB LLC v. Redbubble, Inc., 385 F. Supp. 3d 916 (N.D. Cal. 2019).

151. *See, e.g.*, Mariah Carey (@mariahcarey), INSTAGRAM, www.instagram.com/mariahcarey/?hl=en [perma.cc/5MHS-XMVM] (last visited Oct. 9, 2022); Kylie Jenner (@kyliejenner), INSTAGRAM, www.instagram.com/kyliejenner/ [perma.cc/9ZXC-SAHE] (last visited Oct. 9, 2022); Jay-Z (@jayzz_official), INSTAGRAM, www.instagram.com/jayzz_official/ [perma.cc/K84T-BBP5] (last visited Oct. 9, 2022); Katy Perry (@katyperry), INSTAGRAM, www.instagram.com/katyperry/ [perma.cc/E2M3-BZXM] (last visited Oct. 9, 2022); Harry Styles (@harrystyles), INSTAGRAM, www.instagram.com/harrystyles/ [perma.cc/EY7Y-J7EN] (last visited Oct. 9, 2022).

152. In re Lizzo LLC (T.T.A.B., Serial Nos. 88466264 and 88466281, Feb 2. 2023) (quoting Curtice-Burns, Inc. v. Nw. Sanitation Prods., Inc., 530 F.2d 1396, 189 U.S.P.Q. 138, 141 (C.C.P.A. 1976)).

153. Tessa Wong, Kevin Ponniah, Jay Savage, *The Kylie Minogue vs. Kylie Jenner trademark battle*, BBC NEWS (Feb. 7, 2017) www.bbc.com/news/world-australia-38877658.

154. Stacey Dogan, *What the Right of Publicity Can Learn from Trademark Law*, 58 STANFORD L. REV. 1161 (2006).

155. *Social media Stars*, THE FAMOUS PEOPLE, www.thefamouspeople.com/list-of-social-media-stars.php [perma.cc/P5FK-X7PJ] (last visited Oct. 9, 2022).

Cardi-B, and singer Mariah Carey, along with subsequent decisions. These cases highlight (1) the inconsistency of the decision-making process for trademarks, (2) the idea that popularity and fame through social media already influence the trademark process, and (3) the need for standards that govern how trademark law approaches acquiring distinctiveness in the context of the Internet/social media.[156]

Former President Donald Trump. Former President Donald Trump applied for a trademark of the slogan made famous by his political campaign, "Make America Great Again."[157] This slogan originated from Ronald Reagan during the 1980 presidential race, but Donald Trump was the first Republican party member to claim commercial rights over it.[158] Trump filed the trademark application in 2012 as a trademark for political action committee services and fundraising.[159]

Since then, Donald Trump applied to register the "Make America Great Again" mark in two separate applications for different goods, such as clothing, hats, and buttons, sports bags, backpacks, pet wear, and pants.[160] The clothing, hats, and buttons trademark was accepted, but the trademark for the sports bags, backpacks, and pet wear was refused as ornamental.[161] The USPTO found that the trademark was merely ornamental because consumers would not easily associate it with Donald Trump or his presidency when used on items such as pet wear or athletic backpacks.[162] The USPTO reasoned the association was tenuous because pet wear and athletic backpacks generally have nothing to do with politics or the presidency of the United States.[163]

Donald Trump's trademark of the political slogan sparked controversy because of significant issues surrounding political slogan trademarks.[164] A common issue that political slogans suffer from is that they are generally assumed to be "descriptive."[165] The thought is that the more common a phrase, the less likely the public will view it as a source identifier for a specific seller, and "the less

156. Dogan, *supra* note 154.

157. Danny Paez, *Celebrity Trademarks: From Donald Trump to Jay-Z*, CNBC (Oct. 29, 2015), www.cnbc.com/2015/10/29/celebrity-trademarks-from-donald-trump-to-jay-z.html [perma.cc/F4ZJ-FR3X].

158. Paez, *supra* note 157.

159. MAKE AMERICA GREAT AGAIN, Registration No. 4,773,272.

160. MAKE AMERICA GREAT AGAIN, Registration No. 5,020,556.

161. *Id*; MAKE AMERICA GREAT AGAIN, Serial No. 8,671,074.

162. MAKE AMERICA GREAT AGAIN, Serial No. 8,671,074 (reasoning that people generally do not connect athletic backpacks or pet wear with politics, as opposed to T-shirts, baseball caps, or bumper stickers, that people oftentimes wear or display precisely to indicate their preference in politics).

163. *Id*.

164. Katherine Kerrick, *(Trade)mark America Great Again: Should Political Slogans Be Able to Receive Trademark Protection?*, 18 U.N.H. L. REV. 309 (2020).

165. *Id* at 315.

likely that it can achieve trademark status."[166]

Consequently, the USPTO's approval of the trademark was surprising given Donald Trump's slogan originated from Ronald Reagan and was a part of the Republican mantra for decades before Donald Trump entered the political field..[167] First, some argued that given the words did not originate from Donald Trump, consumers would not know to associate him with the slogan.[168] After all, any politician running for office would want to "make America great again," so the slogan's connection to goods or services as a mark is not arbitrary, fanciful, or suggestive.[169] This would lead to the belief that "Make America Great Again" is merely descriptive of what Donald Trump was trying to achieve in office.[170]

A secondary argument is that Donald Trump's use of the slogan is more ornamental than it is a trademark use.[171] The use of the mark on social media as a Twitter cover photo, a domain page background, and on the front of a hat are "not trademark uses but are ornamental uses."[172] Similar to a design of a flower on the front of a shirt, or a camouflage pattern on a baseball cap, the slogan of "Make America Great Again" operates only to decorate the item, and not to call attention to its producer.[173]

The main issue of Donald Trump's political slogan trademark is why the USPTO approved the application despite the trademark's failings as merely ornamental and merely descriptive.[174] The USPTO examined the slogan, finding that it reasonably functioned as a trademark, and the logical conclusion that can be inferred is that it made that finding and granted trademark rights because of Donald Trump's significant time in the spotlight.[175] Despite filing for the trademark in 2012, by the time it was approved in 2015 Donald Trump was in the public eye and clearly using the slogan as

166. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 7.22 (5th ed. 2022) (citing *In re* Superba Cravats, Inc., 149 U.S.P.Q. 852 (T.T.A.B. 1966)). For example, using the phrase "hot as hell" would be hard for someone to trademark because generally people think of it as a descriptive phrase that lots of people use, not something that could be specifically attributed to a seller. It's not impossible for it to acquire distinctiveness, but it is unlikely and difficult.

167. Kerrick, *supra* note 164.

168. Alexandra J. Roberts, *Trademark Failure to Function*, 104 IOWA L. REV. 1977, 319 (2019) (discussing the trademark law of the doctrine of failure to function).

169. Kerrick, *supra* note 164.

170. *Id* at 319.

171. *Id* at 318.

172. *Id*.

173. *Ornamental*, *supra* note 137.

174. Kerrick, *supra* note 164.

175. *See also* Jacqueline D. Lipton, *Who Owns "Hillary.com"? Political Speech and the First Amendment in Cyberspace*, 49 B.C. L. REV. 55 (2008) (discussing the online presence of candidates in upcoming elections, and competition between politicians' names and competing trademark interests).

part of his political campaign.[176] The slogan was unconventional as a trademark, and likely would not have been granted, but for Donald Trump's online/social media presence and airtime on news networks.[177] By 2016, "Make America Great Again" was a cornerstone of Trump's campaign, and the popularity of the phrase led to the recognizability of an essentially descriptive slogan that all politicians could tout as the goal behind their platform.[178] Yet, this trademark appeared to be inconsistent with the objectives of trademark law.

Jay-Z and Beyoncé. Donald Trump's political slogan is not the only instance of the USPTO approving a trademark that should likely have been rejected, further demonstrating the inconsistencies behind trademark law.[179] In 2012, famous singer Beyoncé and her husband, rapper Jay-Z, applied for a trademark for their first daughter's name, Blue Ivy Carter, through the company BGK Trademark Holdings.[180] Veronica Morales, owner of an events planning firm named Blue Ivy Company formed in 2009, filed an opposition challenging the trademark application.[181] Morales contested the claim as a "likelihood of confusion" argument because it would be too similar to her own company and create a "risk of confusion between the two."[182] Morales' company was using its name in commerce for four years before the birth of Blue Ivy Carter and had a registration for the name BLUE IVY.[183]

The USPTO determined that there was no evidence to suggest that members of the public would confuse the two brands of "BLUE IVY" and "Blue Ivy Carter."[184] It found that Morales' attempted block of the trademark was "unnecessary and a waste of time" because there was no evidence "suggesting that they are related in a manner that would give rise to the mistaken belief that they

176. Kerrick, *supra* note 164.

177. *Id*.

178. Lipton, *supra* note 175.

179. Kerrick, *supra* note 164.

180. Nick Reilly, *Beyoncé Wins Legal Battle to Trademark Blue Ivy's Name*, NME (July 16, 2020), www.nme.com/news/music/beyonce-wins-legal-battle-to-trademark-blue-ivys-name-2708946/ [perma.cc/N8V3-NZQR].

181. *Id*.

182. Alex Montrose, *Beyoncé Secures Trademarks for Blue Ivy's Name After Legal Battle*, COMPLEX (Jul. 14, 2020), www.complex.com/music/2020/07/beyonce-secures-trademarks-for-blue-ivy [perma.cc/V5KA-5WVC].

183. Dan Hyman, *Jay-Z and Beyonce Lose Bid to Trademark 'Blue Ivy'*, CNN ENTERTAINMENT (Oct. 22, 2012), www.cnn.com/2012/10/22/showbiz/celebrity-news-gossip/jay-z-beyonce-trademark-rs [perma.cc/2TVC-EVED]. *See also Beyoncé Receives Big Win in "BLUE IVY CARTER" Trademark Opposition*, JDSUPRA (Aug. 12, 2020), www.jdsupra.com/legalnews/beyonce-receives-big-win-in-blue-ivy-34047/ [perma.cc/CTF3-AXC6] [hereinafter *Beyoncé Receives Big W*in].

184. Reilly, *supra* note 180.

emanate from the same source."[185]

Morales also claimed that Beyoncé and Jay-Z did not actually intend to use the name "Blue Ivy Carter" in commerce, but fraudulently filed for trademark protection to prevent others from using the name.[186] Trademark law generally outlaws registration that lacks actual intent to use or actual use, and considers use like Morales alleged as a fraudulent abuse of the trademark registration laws.[187] To reinforce this claim, Morales pointed to Jay-Z's interview with *Vanity Fair* where he discussed the reasons for trademarking his daughter's name stating, "it wasn't for us to do anything; as you see, we haven't done anything…you don't want anybody trying to benefit off your baby's name."[188] Because Jay-Z was not a party to the lawsuit, his interview was considered inadmissible hearsay and Morales' claim of fraud also failed.[189]

Beyoncé and Jay-Z were able to successfully pass the opposition period and trademarked "Blue Ivy Carter," the name of their first daughter.[190] Although the grant of rights to the trademark were conditioned on its use in commerce, the celebrities received the trademark despite not actually using the mark in U.S. commerce.[191] Considering the manifest weight of the evidence against the grant of trademark rights, this decision seems arbitrary and serves to muddy the waters concerning trademark law as a whole.

Taylor Swift. Successful songwriter, singer, and storyteller Taylor Swift is no stranger to trademarks.[192] Taylor Swift's first trademark registrations were filed in 2008, to protect her name in association with her musical recordings, live performances, and clothing.[193] Since 2008, Taylor Swift has filed over 350 trademarks for album names, lyrics, perfumes, her fan base, and more.[194]

When Taylor Swift filed several applications for her popular song lyrics, such as "Nice to meet you. Where you been," "could show you incredible things," "cause we never go out of style," and "party like it's 1989," she became one of the first musicians to trademark lyrics.[195] The majority of her song lyrics are registered under her

185. Montrose, *supra* note 182.
186. *Beyoncé Receives Big Win*, *supra* note 183.
187. *Id.*
188. *Id.*
189. Montrose, *supra* note 182.
190. *Id.*
191. Blue Ivy v. BGK Trademark Holdings, LLC (TTAB Jun. 30, 2020).
192. Paez, *supra* note 157.
193. Gerben Trademark Library, *Taylor Swift Trademarks*, GERBEN IP, www.gerbenlaw.com/trademarks/musicians/taylor-swift/ [perma.cc/L39J-Y399] (last visited Oct. 28, 2022).
194. *Id.*
195. April Xiaoyi Xu, A*pplying Trademark Law and Textual Analysis to the Branding of Love Song Lyrics*, U. ILL. L. REV. ONLINE 139 (2020).

name now.[196]

Taylor Swift's success is the biggest factor in her ability to trademark her lyrics.[197] Her "1989" album sold almost 25 million copies, her "Fearless" album sold around 20 million copies, and her "Red" album sold about 28 million copies.[198] At the age of thirty-four, she is one of the most successful female artists, very active in the public eye, and present on online platforms, including social media, media interviews, and fan-based meetings.[199]

The argument against granting these trademarks is that Taylor Swift's song lyrics would not function properly as a trademark.[200] Because her lyrics are often common words, such as "players gonna play," "1989," or "could show you incredible things," the average consumer may not associate that mark with the source, Taylor Swift.[201]

The USPTO, however, found that Taylor Swift's active online presence and extraordinarily strong fan base ensured that her trademarks would be recognizable as hers.[202] The trademarks ensure that Taylor Swift has the rights to her lyrics and can enforce those rights against copyright infringement claims.[203]

Taylor Swift's trademarks are particularly important given her circumstances that occurred in mid-2019.[204] At age fifteen, Taylor Swift signed with Big Machine Label Group, which owned her albums.[205] In 2019, Scooter Braun's Ithaca Holdings acquired Big Machine Label Group, a merger which Taylor Swift allegedly had

196. *Id.*

197. Marian Salzman, *Taylor Swift Fills a Blank Space in Branding With Trademarked Lyrics*, FORBES (Mar. 3, 2015), www.forbes.com/sites/mariansalzman/2015/03/03/taylor-swift-fills-a-blank-space-in-branding-with-trademarked-lyrics/?sh=7d5fc6cc41e2 [perma.cc/ZT47-XLCA].

198. *Id.*

199. *Taylor Swift albums and songs sales,* CHARTMASTERS (Jul. 11, 2023) www.chartmasters.org/taylor-swift-albums-and-songs-sales/.

200. Salzman, *supra* note 197.

201. *Possible Grounds for Refusal of a Mark*, *supra* note 90. *See* Alexandra Gibbs, *Taylor Swift just ensured she'll 'never go out of style'*, CNBC (Jan. 29, 2015), www.cnbc.com/2015/01/29/taylor-swift-just-trademarked-her-favorite-1989-lyrics-so-shell-never-go-out-of-style.html [perma.cc/5DX5-Q39R].

202. Xu, *supra* note 195.

203. Xavier Morales, *Taylor Swift Trademarks*, SECUREYOURTRADEMARKS, (Jan. 2, 2022), www.secureyourtrademark.com/blog/taylor-swift/ [perma.cc/32EX-SSG8].

204. Brittany Spanos, *Taylor Swift vs. Scooter Braun and Scott Borchetta: What the Hell Happened?*, ROLLING STONE (July 1, 2019), www.rollingstone.com/music/music-news/taylor-swift-scooter-braun-scott-borchetta-explainer-853424/ [perma.cc/FW4Z-77GD]; *see* Alexandra Del Rosario, *Scooter Braun has regrets: He sees his feud with Taylor Swift as a 'learning lesson',* L.A. TIMES (Sept. 30, 2022), www.latimes.com/entertainment-arts/music/story/2022-09-30/scooter-braun-regret-taylor-swift-feud [perma.cc/U6Z4-MXUS].

205. Spanos, *supra* note 204.

no idea about until it was publicly announced.[206] The merger resulted in Taylor Swift's loss of her six earliest albums because the record company legally owned those albums.[207]

To combat this situation, Taylor Swift chose to re-record her earlier songs, which allows her to own her "masters" (the songs' original recordings).[208] Through this ownership, Taylor Swift can control the way those particular versions of her songs are used, such as granting permission for the music to appear in advertising, movies, or other media.[209] Following these circumstances, Taylor Swift trademarked her lyrics, which then allowed her to maintain control over how her music and other creations are used.[210]

Taylor Swift's battle with Scooter Braun for ownership of her own music was highly publicized and discussed throughout various platforms, such as social media, news outlets, and even by other celebrities over their platforms.[211] Due to this widespread public arena, Taylor Swift's trademark applications for her lyrics are far more likely to be recognized by consumers as produced by her, which is the most important function of a trademark in the first place.[212] Taylor Swift's circumstances are why it is crucial to implement a consistent and uniform standard that takes into account multiple factors when accepting or rejecting a trademark application.[213]

Lizzo. Rapper and singer Lizzo is relatively new to the music industry, making her debut in 2013.[214] Lizzo had some experience with the trademark process, when she trademarked phrases such as "Hard Launch" "Twerk Out" and "Big Grrrl Twerk Out."[215]

Most recently, Lizzo applied for a clothing trademark of the phrase "100% That Bitch".[216] Lizzo was not the original creator of

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206. *Id*.

207. *Id*; *see also* Amelia Beamer, *Look What You Made Her Do: Scooter Braun and Taylor Swift Beef Explained*, THE SUN (Dec. 8, 2022), www.the-sun.com/entertainment/6875079/scooter-braun-taylor-swift-beef/ [perma.cc/36YW-T28W].

208. Brendan Morrow, *Why Taylor Swift Keeps Releasing All Those Re-Recorded Albums*, THE WEEK (May 14, 2022), www.theweek.com/briefing/1013413/why-taylor-swift-keeps-releasing-all-those-re-recorded-albums [perma.cc/VZ3J-7F6A].

209. *Id.*

210. *Id.*

211. Spanos, *supra* note 204.

212. *What is a Trademark?*, *supra* note 21.

213. Dogan, *supra* note 154.

214. *Lizzo*, VOGUE, www.thevogue.com/artists/lizzo/ [perma.cc/LUD5-93RZ] (last visited Sept. 11, 2023).

215. Gerben Trademark Library, *Lizzo Trademarks*, GERBEN IP www.gerbenlaw.com/trademarks/musicians/lizzo/ [perma.cc/RA5K-VTYG] (last visited Sept. 11, 2023).

216. *In re* Lizzo LLC (T.T.A.B., Serial Nos. 88466264 and 88466281, Feb 2. 2023).

this phrase; in fact, she encountered it on a Twitter post.[217] Initially, her application was denied because the phrase was held as a "common expression," that would fail to function as a trademark.[218] However, on appeal, the TTAB found evidence of widespread association with Lizzo and her music.[219] Despite clear evidence that Lizzo was not the source of the phrase, her popularity and the effect of her fame impacted the decision.[220] Similar to Donald Trump's "Make America Great Again" political slogan, Lizzo provided evidence that commenters on the Internet associated Lizzo with this phrase.[221]

The TTAB's decision explained that "prior decisions on other marks for other goods are of very little help one way or the other in cases of this type. Each case must be decided on its own facts and the differences are often subtle ones."[222] This absolute refusal to follow, or even develop, precedent underlies inconsistency and confusion concerning the application of trademark law in these types of decisions. While the cases discussed thus far demonstrate trademarks that were granted despite the existence of substantial reasons to reject them, next, the discussion shifts to examples of the inverse—trademark applications that were rejected despite what seemed like substantial reasoning, or even precedent from previously granted trademarks, to grant them.

Cardi-B. Rapper, singer, and musician Cardi-B attempted to trademark her signature phrase, "Okurr."[223] Since her first video in 2011, Cardi-B has been known to say the phrase "Okurr" as a

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217. Larisha Paul, *From Tweet to Trademark: Lizzo Secures Rights to '100% That Bitch' Phrase*, ROLLING STONE (Feb. 2, 2023), www.rollingstone.com/music/music-news/lizzo-100-percent-that-bitch-trademark-branding-win-1234672717/#:~:text=In%20its%20ruling%2C%20the%20appeal,%2C%20rather%20than%20the%20songwriters [perma.cc/7LHP-ESWR].

218. Kyle Jahner, *Lizzo Can Register '100% That Bitch' Trademark for Clothing Line*, BLOOMBERGLAW (Feb. 2, 2023), www.news.bloomberglaw.com/ip-law/lizzo-can-register-100-that-bitch-trademark-for-clothing-line [perma.cc/B9BQ-M3W3].

219. *Id.*

220. James Greig, *Lizzo Has Given a Songwriter Credit to the Person Behind the "100% that bitch" Tweet*, I-D MAGAZINE (Oct. 24, 2019), www.i-d.vice.com/en/article/j5ynd3/lizzo-songwriter-credit-meme-tweet-truth-hurts (noting a deciding factor in the T.T.A.B. decision for Lizzo's "100% That Bitch" trademark was that Lizzo did in fact credit the author who founded that phrase via Twitter, giving a songwriter credit); *see generally* Rebecca Zilberman, "*That's Hot!" Celebrities Use Trademarks to Add to Their Wealth, but Is It Excessive?*, 42 LOY. L.A. L. REV. 273 (2022).

221. *In re* Lizzo LLC (T.T.A.B., Serial Nos. 88466264 and 88466281, Feb 2. 2023).

222. *Id.* (quoting Curtice-Burns, Inc. v. Nw. Sanitation Prods., Inc., 530 F.2d 1396, 189 U.S.P.Q. 138, 141 (C.C.P.A. 1976)).

223. *Cardi B Can't Trademark 'Okurrr',* NPR (July 6, 2019), www.npr.org/2019/07/06/739154474/cardi-b-cant-trademark-okurrr [perma.cc/6RJR-AJ89].

replacement for the word "okay."[224].

In its rejecting decision, the TTAB found that the phrase "Okurrr" was not initially created by the rapper.[225] First, other celebrities had been known to use the phrase or variations of the phrase on their own merchandise, particularly Khloé Kardashian.[226] Most important to the TTAB decision, the phrase likely originated in the drag queen community.[227]

However, Cardi-B appears to have brought the phrase to peak popularity.[228] In her trademark application, Cardi-B provided 134 attachments of evidence that she was publicly well-associated with the phrase "Okurr."[229] Laganja Estranja, one of the original sources of the phrase "Okurrr," tweeted that Cardi-B "didn't steal anything" and "was smart enough to capitalize on it. Props to you, mama."[230]

When comparing Cardi B's situation to that of Lizzo's success in trademarking the phrase "100% That Bitch," which also originated from a distinct source, an applicant could easily presume that Cardi-B should have been granted this trademark. The lack of standardization concerning how these trademarking decisions are made produces vast confusion and disrupts the general understanding of trademark law as a whole.

Mariah Carey. Famous singer, songwriter, and actress Mariah Carey filed a trademark application for the phrases "The Queen of Christmas," "QOC," "Princess of Christmas," and "Christmas Princess."[231] In 1994, Mariah Carey released "All I Want for Christmas is You," one of the most popular Christmas and holiday songs of all time.[232] The song was, and continues to be, a hit

224. Arianna Davis, *Who Actually Came Up With "Okurr," Cardi B Or Khloé Kardashian?*, REFINERY29 (Apr. 10, 2018), www.refinery29.com/en-us/2018/04/196048/cardi-b-khloe-kardashian-okurr-origin [perma.cc/RKZ2-RLGC]; *Cardi B Explains Her Famous Catchphrases*, YOUTUBE (Apr. 10, 2018), www.youtube.com/watch?v=YplKPH_qcRw [perma.cc/KM28-LSJ8].

225. Ben Beaumont-Thomas, *Cardi B Denied Trademark for 'okurrr' Catchphrase*, THE GUARDIAN (July 2, 2019) www.theguardian.com/music/2019/jul/02/cardi-b-denied-trademark-for-okurrr-catchphrase-commonplace [perma.cc/Z3DB-S98N].

226. Davis, *supra* note 224.

227. *Cardi B Can't Trademark 'Okurrr', supra* note 223.

228. Davis, *supra* note 224.

229. U.S. Trademark Application Serial No. 88333999.

230. *Cardi B Can't Trademark 'Okurrr'*, *supra* note 223 (quoting a Twitter post from one of the original sources of the phrase, "Okurrr," giving props to Cardi-B for attempting to trademark the phrase.).

231. Jonathan Edwards, *Singers Fight Mariah Carey's Bid to Trademark 'Queen of Christmas'*, WASH. POST (Aug. 17, 2022), www.washingtonpost.com/nation/2022/08/17/mariah-carey-queen-christmas-trademark/ [perma.cc/XXT3-2KNN].

232. Jem Aswad, *Mariah Carey's 'All I Want For Christmas is You' Makes Billboard Hot 100 History*, (Dec. 21, 2021), www.variety.com/2021/music/news/mariah-carey-all-i-want-for-christmas-is-you-billboard-hot-100-history-1235141498/.

and is played on the radio every holiday season.[233] As of 2023, "All I Want for Christmas Is You" made No. 1 and spent twelve weeks atop the "Billboard Hot 100."[234] As of 2021, her Christmas song made No. 1 on the Billboard Hot 100.[235] The song made the top 10 in 2017, No. 1. in December of 2019 (for three weeks), December 2020 (for two weeks), and December 2021 (for six weeks).[236]

Mariah Carey's application was challenged by Elizabeth Chan, who filed a declaration of opposition to Mariah Carey's trademark bid.[237] Elizabeth Chan's argument for the opposition was that "Christmas has come way before any of us on earth, and hopefully will be around after any of us on earth. I feel strongly that no one person should hold onto anything around Christmas or monopolize it in the way that Mariah seeks to in perpetuity…Christmas is for everyone."[238] The press began to call Elizabeth Chan the "Queen of Christmas" in 2014, and she used the phrase as an album title in 2021.[239] Elizabeth Chan also opposed Mariah Carey's "Princess of Christmas" trademark on the basis that she refers to her daughter as the Princess of Christmas.[240]

Mariah Carey's trademark application was rejected because she never filed a counter to Elizabeth Chan's opposition.[241] However, under the circumstances, when looking at instances like Jay-Z and Beyoncé, it seems that their trademark application should have never made it that far. Despite the marks using the same name, the USPTO found that Jay-Z and Beyoncé mark –

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233. *Id.*

234. Gary Trust, *Mariah Carey's 'All I Want for Christmas Is You' Adds 12th Week Atop Hot 100, Nat King Cole Hits Top 10*, BILLBOARD (Jan. 1, 2023), www.billboard.com/music/chart-beat/mariah-carey-all-i-want-for-christmas-is-you-12-weeks-number-one-nat-king-cole-top-10-1235192947/ [perma.cc/6T6N-X9N6].

235. Aswad, *supra* note 232.

236. *Id.*

237. Chris Willman, *Mariah Carey's Move to Trademark 'Queen of Christmas' Angers Fellow Holiday Music Singers Darlene Love and Elizabeth Chan*, (Aug. 15, 2022), www.variety.com/2022/music/news/mariah-carey-trademark-queen-christmas-darlene-love-elizabeth-chan-1235341993/.

238. *Id.*

239. *Id.*

240. *Id.* Mariah Carey's trademark application was rejected because she never filed a counter to Elizabeth Chan's opposition. María Luisa Paúl, *Who's the Queen of Christmas? Not Mariah Carey, Trademark Agency Rules*, WASH. POST (Nov. 16, 2022), www.washingtonpost.com/nation/2022/11/16/mariah-carey-queen-christmas-denied/ [perma.cc/324B-DLS3].

241. Paúl, *supra* note 240.

242. *See* Mariah Carey (@mariahcarey), INSTAGRAM, www.instagram.com/mariahcarey/ [perma.cc/P5FD-TNN3] (last visited Oct. 6, 2023); *see also* Elizbeth Chan (@lizchanmusic), INSTAGRAM, www.instagram.com/lizchanmusic/ perma.cc/9TKL-6NKT] (last visited Oct. 6, 2023).

243. Martin Wolk, '*You're fired!' Could Become Trump Trademark*, NBC NEWS (Mar. 18, 2004), www.nbcnews.com/id/wbna4557459 [perma.cc/M3X9-EKF4].

which at the time, was not used in commerce, was acceptable. Seemingly, one would presume that the USPTO would find Mariah Carey able to overcome the opposition.

The USPTO has accounted for fame and popularity, explicitly and implicitly, in its decisions to grant trademark rights, as evidenced in cases like Taylor Swift and Jay-Z/Beyoncé. Considering Mariah Carey's prevalence on social media (over 12.2 million Instagram followers), and the pervasiveness of "All I want for Christmas is You" during the holiday season, the relevant consuming public would likely associate those Christmas trademarks with Mariah Carey over Elizabeth Chan, who has approximately 5,250 Instagram followers and not one Christmas song that has experienced that level of commercial success.[242] The differences in the application of trademark law—namely Lanham Act § 2(f)—is confusing and potentially harmful to trademark applicants.

Reality TV Host Donald Trump. Before embarking into politics, reality TV host Donald Trump attempted to trademark his signature phrase, "You're Fired", from *The Apprentice* for clothing, games, and casino services.[243] In the early 2000s, Donald Trump was a staple of reality TV, and gained notoriety for hosting *The Apprentice*, a reality TV show where sixteen candidates would compete to complete difficult tasks, and at the end of each episode, one candidate would be sent home.[244] Donald Trump famously uttered, "You're Fired" when sending home the loser of the episode, and it spread like wildfire.[245]

Donald Trump attempted to trademark this phrase, but was rejected under the likelihood of confusion, with the concern that the words could be mistaken for the already trademarked Franklin Learning's children's educational board game "You're Hired."[246] Donald Trump also faced an opposition from Susan Brenner, the owner of a pottery shop named *You're Fired*.[247]

Once again, when looking at the trademark granted to Jay-Z and Beyoncé, the decision to deny Donald Trump this trademark seems arbitrary. One could hardly see the connection or the likelihood of confusion between an educational game, a pottery studio, and a reality TV star's signature phrase. Given that after this application, Donald Trump received a trademark for a political slogan, the basis that the USPTO used to reject trademarking this

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244. *Id.*

245. *Id.*

246. Eric Dash, *'Fired' Topped by 'Hired' At the Trademark Office*, N.Y. TIMES, (Aug. 30, 2004), www.nytimes.com/2004/08/30/business/fired-topped-by-hired-at-the-trademark-office.htm [perma.cc/Y228-9MTE].

247. Daily Dish, *Trump's "You're Fired" patent rejected*, SFGATE (Sept. 1, 2004), www.sfgate.com/news/article/Trump-s-You-re-Fired-patent-rejected-J-Lo-2697282.php [perma.cc/RP3P-TV6N].

signature phrase becomes even less clear.[248]

What is clear, is that these trademark decisions lack uniformity, making them appear arbitrary and confusing.[249] For famous figures and celebrities like Donald Trump, Taylor Swift, and Mariah Carey, while the Internet did not spring them into the spotlight, it certainly increased their ability to connect with a much wider audience.[250] Each celebrity faced a different battle throughout their trademark applications, and the USPTO and TTAB should take into account the social media and online presence of an applicant when deciding if their marks will function as a trademark.[251] Otherwise, these decisions promote ambiguity and arbitrariness at best, granting some trademark applications, rejecting others, and providing inconsistent reasoning behind the decisions.[252]

IV. PROPOSAL

Trademarks are intended to identify and differentiate goods and services from one producer to another.[253] If consumers can identify producers who have manufactured the corresponding

248. *See also* Christian G. Stahl, *Trademark: "I Love You. You're Fired!"* 4 CHI.-KENT J. INTELL. PROP. 147 (2004) (discussing the litigation that might have occurred between Donald Trump and Ms. Susan Brenner).

249. Aaron Hall, *Trademark Infringement in the Age of the Internet*, HALL PC, www.aaronhall.com/trademark-infringement-in-the-age-of-the-internet/ [perma.cc/2299-5D49] (last visited Nov. 16. 2022).

250. Kaitlyn Tiffany, *The Internet Won't Be the Same After Trump*, THE ATLANTIC (Oct. 30, 2020), www.theatlantic.com/technology/archive/2020/10/trump-internet-memes-section-230-disinformation-reddit/616890/ [perma.cc/7YEQ-2FE7].

251. Dreu Dixson, *Celebmarks: The Battle of Trademarks Between Celebrities and Small Business Owner and How We Protect the Little Guys*, 45 T. MARSHALL L. REV. 21 (2020); see Maria Crimi Speth, *Celebrity Brands: The Line Between Fair Use and Infringement*, JABURG WILK L. FIRM, www.jaburgwilk.com/news-publications/celebrity-brands-the-line-between-fair-use-and-infringement [perma.cc/5FD6-RRH3] (last visited Mar. 1, 2023) (discussing the value of trademarks for celebrities, along with the concept that the more famous a trademark is, the more likely others may use it). Fair use refers to the legal permission to use "another's trademark to refer to the trademark owner's actual good and services." *Id*. This often occurs in fan pages, clothing that feature the celebrity's name or image, and social media platforms. *Id*.

252. Curtice-Burns, Inc. v. Nw. Sanitation Prods., Inc., 189 U.S.P.Q. 138, 141 (C.C.P.A. 1976).

253. *Lanham Act*, CORNELL L. SCH.: LEGAL INFO. INST., www.law.cornell.edu/wex/lanham_act [perma.cc/AE96-ZUEW] (last visited Oct. 7, 2022). *See also Trademarks, Trademark Protection, and Trademark Infringement*, INTERNICOLA L. FIRM, www.franchiselawsolutions.com/learn/franchise-your-business/what-is-the-lanham-act [perma.cc/8D9X-D3CZ] (last visited Mar. 3, 2023) (including examples of violations of the Lanham Act).

goods, then the mark has performed its primary function.[254] Section IV of this comment asserts that there should be an addition made to 37 C.F.R. § 2.41(a)(3), which provides the rules of practice for what "Other Evidence" should be considered under Lanham Act § 2(f) when making determinations of whether a proposed mark has acquired distinctiveness.[255]

Trademarks revolve entirely around a finding of distinctiveness.[256] Under the current statute, trademark registrations are granted for marks that perform their proper function of source identification and distinguishment.[257]

The Internet continues to facilitate an age of expansion and globalization that further invents new ways to extend a person's reach and influence.[258] Once, a trademark would have taken years to become known by only a few hundred people.[259] Now, that same trademark can become recognizable, worldwide, overnight. Trademark law and, consequently, the USPTO and TTAB have been unwilling—or unable—to consistently take this into account when issuing new decisions, resulting in confusion, ambiguity, and a complete lack of clarity regarding trademark rights.

To bridge the gap between the inconsistent recognition of trademarks and what should constitute a properly functioning trademark in the Digital Age requires the Rules of Practice for the Lanham Act to be amended to include a new benchmark within § (a)(3). This benchmark should read as follows: In appropriate cases regarding content creation or social media, the applicant can submit proof of engagement, providing evidence of recognition of a mark,

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254. *What is a trademark?, supra* note 21.

255. *37 CFR § 2.41 – Proof of Distinctiveness Under Section 2(f)*, *supra* note 66 ("In appropriate cases, where the applicant claims that a mark has become distinctive in commerce of the applicant's goods or services, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.").

256. R. Neumann & Co. v. Overseas Shipments, Inc., 326 F.2d 799(C.C.P.A. 1964).

257. Morales, *supra* note 203; *s.ee also In re* JS ADL, LLC, 777 F. App'x. 991, 993 (Fed. Cir. 2019) (holding that under the Lanham Act, a trademark applicant is entitled to registration of a proposed mark subject to several restrictions. One restriction is that the proposed mark may not resemble a mark already registered in the Patent and Trademark Office, or a mark that was previously used in the United States 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.")

258. *The Impact of the Internet on Globalization*, WESTFORD UNIV. COLLEGE, www.mywestford.com/blog/the-impact-of-the-internet-on-globalization/ [perma.cc/BMA4-54JP] (last visited Nov. 17, 2022).

259. Dennemeyer, *supra* note 13.

which shall be weighed under the totality of the circumstances using the following factors: (1) the level of engagement the applicant receives on social media platforms, (2) the level of engagement an applicant receives on events outside of social media, and (3) related evidence to demonstrate the likelihood of recognition that a creator's mark will receive online.

A. Factor One: The Level of Engagement the Applicant Receives on Social Media Platforms

For the implementation of the first factor, the USPTO and TTAB should take into account that an average consumer would most likely recognize a mark based on their general knowledge of popular Internet/social media accounts.[260] For example, Taylor Swift's YouTube account, where she regularly posts new music and videos, has nearly 60 million subscribers, and her videos get over two million views.[261] Furthermore, Taylor Swift has over 274 million followers on Instagram.[262] In the United States, the population is approximately 335 million people.[263] Thus, while Taylor Swift's Instagram is available to follow worldwide, the number of her followers is equivalent to nearly 82% of the United States' population.[264] Taylor Swift, across her social medias, could post that her new catchphrase is "purple bears" and 274 million people would receive the notification – and that is not even considering the collateral exposure incurred by followers that interact with that post, which could be millions more.

Upon further reflection on Taylor Swift's case, she successfully trademarked her song lyrics, her name, her fan base, and her new recordings of her older songs.[265] Some of Taylor Swift's song lyrics would likely be considered as merely ornamental if any other

260. Matt Whibley, *Celebrity and Trademarks: Why Courts Should Recognize a Celebrity-Likeness-Mark*, 43 SW. L. REV. 121, 125 (2013) (advocating for courts to recognize celebrity-likeness when deciding to accept or reject trademark applications submitted by celebrities).

261. *Taylor Swift Channel*, YOUTUBE, www.youtube.com/channel/UCqECaJ8Gagnn7YCbPEzWH6g [perma.cc/Q8Y5-VYW6] (last visited Nov. 17, 2022).

262. *See, e.g.*, Taylor Swift (@taylorswift), INSTAGRAM, www.instagram.com/taylorswift/ [perma.cc/M5RJ-3CRE] (last visited Nov. 17, 2022).

263. *U.S. and World Population Clock*, U.S. CENSUS, www.census.gov/popclock/ [perma.cc/NF32-YQNW] (last visited Nov. 18, 2022); *see also* Daniel Victor, *World Population Reaches 8 Billion*, *U.N. Says*, N.Y. TIMES (Nov. 15, 2022), www.nytimes.com/2022/11/15/world/world-population-8-billion.html [perma.cc/US3R-MA4G].

264. Taylor Swift Instagram Page: 232 Million; United States Population: 333 Million; 232 ÷ 333 = 0.696 = 0.70 (rounded up) * 100 = 70%.

265. Gerben Trademark Library, *Taylor Swift Trademarks*, GERBEN IP, www.gerbenlaw.com/trademarks/musicians/taylor-swift/ [perma.cc/3XH5-WE2D] (last visited Oct. 28, 2022).

applicant attempted to trademark them.[266] Due to her fame, her social media followers, and the reach of her music, Taylor Swift's song lyrics are easily identifiable by the relevant consumer base and function to distinguish her products from others. The only logical presumption is that the USPTO considered these factors when issuing those trademarks, because any other applicant trademarking phrases such as "Nice to meet you. Where you been," and "cause we never go out of style," would have been unequivocally roadblocked by the merely ornamental concern.[267] Yet, the USPTO has not made these factors an official consideration, nor has it addressed concerns regarding trademarking these common words that happened to become song lyrics.

The level of engagement an applicant receives across social media platforms should be codified as a consideration when evaluating a trademark application.[268] The USPTO should consider criteria like the percentage of social media followers an applicant has, as well as the population of the country in which they are applying for a trademark and further clarify how it weighs these quantifications. It should also consider how many times the applicant has been featured in news, media, and articles, and the reach of those news articles and media outlets. Codification will provide more consistent trademark decisions and help to protect non-celebrities, particularly content creators, seeking trademarks.

B. Factor Two: The Level of Engagement an Applicant Receives on Events Outside of Social Media

Popularity and news media has already been partially noted in the cases that have come before the TTAB, like Jay-Z/Beyoncé.[269] The two celebrities applied to trademark their daughter's name, Blue Ivy Carter.[270] The USPTO ultimately granted the trademark, despite a current registration by an event planning business named BLUE IVY and there being no use or intent to use the Blue Ivy Carter mark in commerce.[271] Beyoncé is a highly famous singer and songwriter, and her husband Jay-Z is equally as famous as a rapper and musician.[272] Beyoncé is easily recognizable outside of her social media presence as well. She has won 28 Grammy awards, sold tens

266. Salzman, *supra* note 197.

267. *Can I Trademark a Common Word?*, PATTERSON THUENTE IP, www.ptslaw.com/trademark/can-i-trademark-a-common-word-2/ [perma.cc/A3HV-G2Y6] (last visited Sept. 12, 2023).

268. *Get Ready to Apply*, supra note 61.

269. Veronica Morales d/b/a Blue Ivy v. BGK Trademark Holdings, LLC, Opposition No. 91234467 (T.T.A.B. June 30, 2020).

270. Reilly, *supra* note 180.

271. *Beyoncé Receives Big Win*, *supra* note 183.

272. *See*, *e.g.*, Beyoncé (@beyonce) INSTAGRAM, www.instagram.com/beyonce/ [perma.cc/XZ9H-2EUL] (last visited Nov. 18, 2022) (showing Beyoncé's 282M followers on Instagram alone).

of millions of albums, performed at the 2013 Superbowl, and filled stadiums on tour, becoming known as "one of the most influential American artists" of this age.[273] Her husband, Jay-Z, won 21 Grammy awards, had fourteen albums debut at Number One, and he was toasted by President Barack Obama as the first rapper in the Songwriters Hall of Fame.[274] It is only logical to presume that the USPTO and TTAB take into account this fame when making decisions, but they should codify it as a decision-making tool and provide a method of quantification to provide clarity and conformity.

This is further demonstrated by the TTAB granting Lizzo the trademark, "100% That Bitch," considering that Lizzo was not the original source of the words that she looked to obtain rights in.[275] Lizzo performs concerts, meet-and-greets, and tours outside of recording music, with her third tour in 2022 earning $10.8 million that year.[276] The more well-recognized, popular, and famous a figure is, the more likely they will receive a higher level of engagement with events outside of social media. Thus, the more publicity a celebrity or public figure has, the more likely that a merely descriptive mark will acquire distinctiveness and take on a secondary meaning.

The idea that publicity lends itself to secondary meaning is also shown through the Donald Trump case, where he was able to successfully trademark the political slogan, "Make America Great Again". Despite the slogan originating from Ronald Reagan, and merely describing how any presidential candidate would want to improve America, the USPTO granted the trademark to Donald Trump.[277] At the time, Donald Trump was a well-known TV personality, and by the time the application was accepted, he was in the public spotlight as a presidential candidate. He was famous for the airtime he received on news outlets such as Fox News, as well as the number of public appearances he made before officially beginning his campaign.

By including this factor within the Rules of Practice for the Lanham Act, the USPTO and TTAB will gain greater consistency in

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273. Anna Nicolaou, *Is Beyoncé Still a Pop Star?*, FINANCIAL TIMES, www.ft.com/content/bcafee2d-684e-4839-87e8-7fa8029de29f [perma.cc/AW3K-V3R8] (last visited Oct. 18, 2023).

274. Christopher R. Weingarten et al., *Jay-Z: 50 Greatest Songs*, ROLLING STONE (Dec. 4, 2019), www.rollingstone.com/music/music-lists/jay-z-50-greatest-songs-123196/roc-boys-and-the-winner-is-2007-196665/ [perma.cc/4DVG-WPC2].

275. Greig, *supra* note 220.

276. Jason Guerrasio, *How Lizzo Makes and Spends Her Millions – from Launching Yitty to Buying a Home Previously Owned by Harry Styles*, BUS. INSIDER (Aug. 2, 2023), www.insider.com/lizzo-worth-how-she-makes-spends-money-millions [perma.cc/F7UT-HCXT]; *see generally Lizzo*, SONGKICK www.songkick.com/artists/5031783-lizzo [perma.cc/DJ68-CH62] (last visited Sept. 13, 2023).

277. Kerrick, *supra* note 164.

trademark application decisions. This will ultimately provide better clarity of our trademark laws for all trademark applicants.

C. Factor III: Related Evidence to Demonstrate the Likelihood of Recognition that a Creator's Mark Will Receive Online.

Although a celebrity or public figure may acquire distinctiveness for their trademark by providing evidence of their social media and public reach, the mark may still appear to fall short of trademark requirements.[278] Adding a third factor that serves as a "catchall" provides an opening for future applicants to provide evidence not currently contemplated, or that—as fast a technology develops—does not currently exist. This factor will help to ensure that trademark law adapts to the breakneck pace of technological developments and the resulting novel methods of outreach.

While a catchall provision may be interpreted as potentially detracting from the clarity that this amendment looks to bring to a finding of acquired distinctiveness under § 2(f) of the Lanham Act, it will provide greater accessibility to the law and, ultimately, trademark protection for applicants. It is better to standardize trademark law and allow for exceptions than it is to begin with the stance that it should be decided on a case-by-case basis. Deciding trademark applications on a case-by-case basis opens the doors for arbitrary decisions and concerns of bias, confusion, and intimidation for new applicants. It is only natural that this inconsistency results in those applicants becoming dissuaded by the very process that is supposed to vest them with rights and provide them with protection for their intellectual property.[279]

V. CONCLUSION

If we return to our Instagram feed, you might see another advertisement for Taylor Swift's newest album. Curious, you click on it, and it takes you to her Instagram page. To your utter amazement, you see that Taylor Swift currently has 274 million followers on her Instagram page (whether you make that 274 million and one is up to you).[280] For perspective, the current

278. The Lanham Act, 15 U.S.C. § 1052.

279. *Trademarks – Are They Really Worth It?*, LAWBITE (Jul. 31, 2018), www.lawbite.co.uk/resources/blog/trademarks-are-they-really-worth-it [perma.cc/LW4H-JBWQ]; *see, e.g.*, Paul R. Tremblay, *Transactional Legal Services, Triage, and Access to Justice*, 48 WASH. U. J. L. & POL'Y 011 (2015) (discussing the access to justice issue that pervades our legal system and its application in the trademark law arena).

280. *Taylor Swift Channel*, *supra* note 261.

population of France is approximately 67 million people,[281] which equates to roughly 25% of Taylor Swift's fanbase, and the current population of Norway is approximately five million people,[282] which is about 2% of her fanbase. Fifty years ago, it would have been easy to miss big news about any celebrity or public figure. Now, thanks to the Internet, you have access to more details about Taylor Swift – or any public figure – than you could have ever imagined.

As ancient as the concept of a trademark is, trademark law is still developing. Social media platforms, news outlets, and the Internet have all added new twists to the world of trademarks. One more twist that ought to be added to the law should be an addition to 37 C.F.R § (a)(3) regarding acquiring distinctiveness via publicity status.

The Internet provides people across the globe with a glimpse into the smallest details of a social media star's life. Fans in India are aware of song lyrics written and sung by an American singer.[283] People across America are aware of political slogans and identify their candidates depending on the ones they use.[284] Celebrities and influencers now have such a wide reach, having access to nearly all corners of the world.

These public figures already use their social media platforms to their advantage when designing or submitting applications for trademarks, and trademark law should officially reflect this new change that the Internet and the Digital Age has brought on.

281. *Population, Total – France*, THE WORLD BANK, www.data.worldbank.org/indicator/SP.POP.TOTL?locations=FR [perma.cc/BR7S-PXAV] (last visited Feb. 26, 2023).

282. *Population, Total – France*, *Norway*, THE WORLD BANK, www.data.worldbank.org/indicator/SP.POP.TOTL?locations=FR-NO [perma.cc/5VLH-V8J4] (last visited Feb. 26, 2023).

283. *See, e.g.*, Indianswiftie (@indianswiftie) INSTAGRAM, www.instagram.com/indianswiftie/?hl=en [perma.cc/7UYY-6D7T] (last visited Mar. 5, 2023) (showing Indianswiftie has approximately 4,960 followers on Instagram).

284. Cail Newsome, *The Use of Slogans in Political Rhetoric*, 4 THE CORINTHIAN 3, 21 (2002).