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Tread warily with trademarks

When a Nevada corporation tried to register the trademark “Lady Gaga” for use in connection with cosmetics, perfumes and jewelry, Stefani Germanotta, better known by her stage name Lady Gaga, made the courthouse her next stop on tour.

Lady Gaga’s complaint is probably well-founded. It is likely a court will find that her “Lady Gaga” trademark has achieved sufficient “fame” to be entitled to the extra protection provided by trademark law.

That extra protection will likely bar the Nevada corporation from using the name Lady Gaga, even for products Germanotta does not offer.

Coca-Cola, McDonald’s and the Beatles are other examples of “famous marks.” Although those have been famous for considerably longer than the Lady Gaga trademark, length of time in use is only one factor in determining if a mark has become famous. Whether a trademark has become famous is also determined by its distinctiveness and its level of recognition and renown among the public. Secondary factors in the analysis include the volume of sales for products sold or services provided under the mark as well as total advertising expenditures used to promote the mark.

Trademark lawyers refer to the extra layer of protection afforded famous marks as “anti-dilution.”

Indeed, famous trademarks can be both infringed and diluted, whereas a non-famous mark can only be infringed. Dilution of a famous trademark used in connection with, for example, hair care products can occur if a mark similar to that famous one is used in connection with breakfast cereals or spark plugs.

So, one can be violating a famous trademark even if the goods or services being offered are totally unrelated to those being offered under the famous trademark.

This is the key point with respect to famous marks.

Again, under trademark law, a famous mark is so well-known among the public that people will assume affiliation with the owner of that mark even if your goods or services are totally unrelated to the goods or services offered under the famous mark.

Since famous marks are capable of being diluted, in addition to being infringed, business owners choosing a name should understand this concept of trademark dilution. A mark that lessens the uniqueness of a famous mark will likely be struck down under trademark's anti-dilution laws.

When you are in the process of choosing a new name for your business, services or products, it is suggested that you not just consult with an attorney, but with an experienced trademark attorney.

If you decide to choose a new trademark without consulting with an attorney, you should do an extensive search on your own. Searching the Trademark Office's database at www.uspto.gov is the best place to start. After that, you can use major search engines, such as Bing and Google. There are also third-party vendors that will conduct a search for you, for a fee. They will not, however, render a legal opinion about whether you should use a particular mark in light of that search.

Certainly be very mindful of famous trademarks – they are especially tricky. When a company wanted to use “Lexxus” for personal care products, it suffered an adverse ruling in litigation against Lexus, the auto manufacturer. And it was found that “Evisa” for multilingual educational services diluted the famous Visa mark. Of course, some businesses have been successful in defeating dilution claims. For example, it was found that “Bagzilla,” a website selling handbags, did not dilute Godzilla and a “Chewy Vuiton” pet toy defeated a dilution claim from the owner of the famous Louis Vuitton trademark.

Whether you like her music or not, Lady Gaga and other owners of famous marks wield a mighty stick when it comes to their marks.