

Daily Journal

www.dailyjournal.com

MONDAY, JUNE 10, 2013

Oprah's trademark woes provide cautionary tale

By Richard Kirkpatrick and
Laura Gustafson

A trademark “trap for the unwary” is spotlighted by a May 31 opinion by the 2nd U.S. Circuit Court of Appeals. *Kelly-Brown v Oprah Winfrey*, 2013 WL 2360999 (2d Cir 2013).

The practical problem illustrated by the case is the very common use in advertising of short phrases in connection with primary or secondary brands. Such “catch phrases” are often intended not to function as permanent brands or slogans — such as “Just Do it” or “You’re in Good Hands” — but merely to catch and engage the attention of potential customers in individual ads. Being tertiary and often descriptive in nature, these phrases may not be searched and cleared in the usual trademark approval process of many companies. Sometimes, however, catchy phrases catch-on; they resonate; they take on a life of their own, coming to serve as brands without ever having been intended as such, and never cleared as trademarks. Catch phrases are sometimes called “violators,” “secondary headings,” “taglines,” “endlines,” “straplines,” or “throwaways.” “Throwaway” may be particularly apt if use of the phrase results in trademark infringement litigation, and the defendant wishes it had thrown away the phrase rather than use it.

The plaintiff suing Oprah Winfrey previously registered the phrase “Own Your Power” as a service mark for motivational workshops and seminars (Reg. No. 3434419). The mark appears on the business’ homepage banner with a prominent display of “Own Your Power Communications” followed by the phrases “Personal and Business Development Coaching” and “Anything you want is attainable.” In this display, the service mark is “Own Your Power.” “Communications” is merely descriptive or a generic term, as is “Personal and Business Development Coaching.” “Anything you want is attainable” is not federally registered, and may itself be considered an innocent catch phrase or tagline.

Oprah and the other defendants published an issue of her magazine, “O”,

with the title “Own Your Power!” appearing prominently on the cover. The cover featured the trademark “O” and “The Oprah Magazine,” as well as a cover photo of Oprah Winfrey with the phrase “Own Your Power!” superimposed over it along with several article teasers, such as “Unlock Your Inner Superstar” and “The 2010 O Power List.” The phrase “Own Your Power” sounds like what one would

Being tertiary and often
descriptive in nature, these
phrases may not be searched
and cleared in the usual trade-
mark approval process of many
companies.

expect to see on the cover of most any issue of “O” magazine or a dozen others like it racked at the checkout counter of grocery stores. Variations of the phrase appear beneath it on the cover, including: “How to Tap into Your Strength,” “Focus Your Energy,” and “Let Yourself Shine.” None of those phrases, however, provoked a lawsuit. Publication of the issue was accompanied by an event featuring celebrities posing in front of an “Own Your Power” backdrop also displaying various third-party logos. Part of the event was an “Own Your Power” seminar and workshop offering motivational advice.

The plaintiff, owner of the Own Your Power motivational business, sued Oprah for trademark infringement and other species of unfair competition. The defendants moved to dismiss for failure to state a claim. Such motions are decided on the face of the pleadings, without reference to facts outside the four corners of the complaint. In trademark cases, such motions are rarely granted since the average plaintiff usually manages to give notice of a plausible claim. In this case, however, the district court judge looked at the magazine cover and concluded that the case was plain enough on its face, and not meritorious. No one, he reasoned, would think that the magazine or event was created by plaintiff; no one would think “Own Your Power” was a trade-

mark when it was plainly a mere headline describing the contents of the magazine. The case was dismissed. 2012 WL 701262 (S.D.N.Y. 2012).

The appellate court reversed. It enumerated in detail Oprah’s “wide ranging and varied” usage of what seems to have started as a mere title or catch phrase: “(1) the October Issue of the Magazine, featuring the phrase in the center of the Issue’s cover; (2) the Own Your Power Event, billed as the ‘first ever,’ that featured motivational content; (3) promotion of the Event through social media; and (4) the online video from the Event and other motivational articles provided on an ‘Own Your Power’ section of Oprah’s website.”

Sometimes ... they take on a life
of their own, coming to serve
as brands without ever having
been intended as such, and
never cleared as trademarks.

The court proceeded to define the difference between a catch phrase and a mark or brand, concluding that multiple uses may “collectively constitute use as a mark”:

“Courts are more likely to treat recurring themes or devices as entitled to protection as a mark, even where a single iteration might not enjoy such protection.

“Repetition is important because it forges an association in the minds of consumers between a marketing device and a product. When consumers hear a successful slogan, for example, they immediately think of a particular product without even being prompted by the product’s actual name ... The slogan or title becomes a symbolic identifier of a product or product line through repetition.

“The defendants began to create the association between that phrase and Oprah with the cover of the October Issue of the Magazine, and continued to encourage it through both the Event and the Website ... ‘Own Your Power,’ through these interrelated uses, would thus become symbolic shorthand for the products and message as a whole, meant to remind consumers

of a particular kind of Oprah-related content.” (Emphasis added.)

The court concluded:

“At this stage in the litigation, this array of uses is sufficient for us to infer a pattern of use. We thus conclude that [the plaintiff] has plausibly alleged that Oprah was attempting to build a new segment of her media empire around the theme or catchphrase “Own Your Power,” beginning with the October Issue and expanding outward from there.”

As a notable aside, the court further concluded that [the plaintiff] had alleged sufficient facts to “plausibly suggest that the defendants had knowledge of [the plaintiff’s] mark, liked it, and decided to use it as their own,” based solely on the fact that Oprah had previously purchased the acronym “OWN” from a third party, which the court found “plausibly suggests that the defendants conducted a trademark registration search for the word OWN, and that such a search would have turned up [the plaintiff’s] then-pending service mark” for “Own Your Power.” The court’s remarks add another level of caution for clearance.

Thus the case returns to the district court for further proceedings. Discovery may show if “own your power” was an occasional catch phrase that took on a life of its own, or was intended to serve as a brand, and was searched and cleared as a brand. Users of catch phrases beware.

Richard Kirkpatrick is a partner at Pillsbury Winthrop Shaw Pittman LLP. He can be reached at richard.kirkpatrick@pillsburylaw.com.

Laura Gustafson is counsel at Pillsbury Winthrop Shaw Pittman LLP. She can be reached at laura.gustafson@pillsburylaw.com.



RICHARD KIRKPATRICK
Pillsbury Winthrop
Shaw Pittman LLP



LAURA GUSTAFSON
Pillsbury Winthrop
Shaw Pittman LLP