Fish Are Friends, Not Food. What About Sharks? Can They Be A Trademark?

While Katy Perry's ongoing attempt to conquer and rule all things "shark" has run into a couple of snafus the last couple of weeks, one thing is for certain: This battle is not the Waterloo being heralded by many Internet commandos.

The Internet's angst has arisen by Ms. Perry's attempts to obtain trademark protection covering the antics of one of her backup dancers during the 2015 Super Bowl halftime show who appeared a bit out of step with the famous singer.

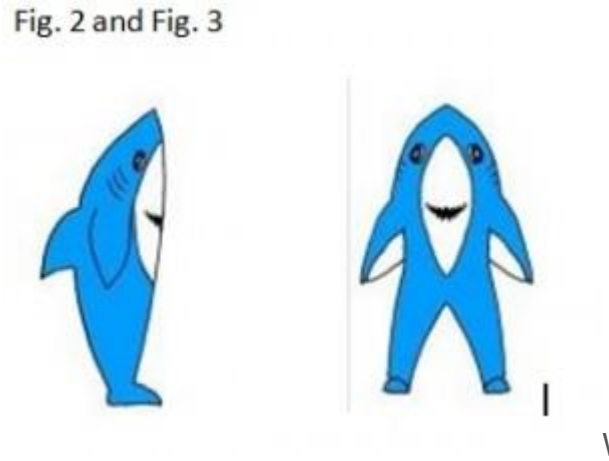
Shortly after the "dance heard round the world" became a viral Internet meme, Katy Perry's lawyers jumped into the trademark waters by filing federal intent-to-use trademark registrations on the phrases "Left Shark," "Right Shark," "Basking Shark," and "Drunk Shark" for use with cell phone covers, stickers, mugs, t-shirts, sweatshirts, hats, costumes, plush toys, action figures, figurines and live musical and dance performances. While these applications were recently rejected by a trademark examiner at the U.S. Patent and Trademark Office, the grounds for doing so were relatively minor and Ms. Perry's lawyers should not have much difficulty in getting over the rejections.

A bit more problematic for Ms. Perry is the application that was filed on a 3D shark figurine (Fig. 1), and two applications for character drawings of what appears to be the artwork used to design the shark costumes used during the performance.

Fig. 1

The 3D shark figurine was filed on February 6, 2015, a mere five days after Ms. Perry's performance at the Super Bowl–which is a good indicator of how fast the Internet meme went viral. Interestingly, the 3D shark figurine application was expressly abandoned on February 10, 2015. It can be assumed that Ms. Perry's lawyers abandoned the application once they realized that the image of the shark shown in Fig. 1 was actually a photograph of a 3D model made by well-known artist Fernando Sosa who produces 3D printed figurines of politicians and world leaders. Considering that Ms. Perry's lawyers had sent a copyright cease & desist letter on February 3 to the 3D printing service Shapeways that was making and selling Mr. Sosa's design, the use of a picture of Mr.

Sosa's shark figurine by Ms. Perry's lawyers in a trademark application was not useful to her domination of all things drunken shark.



While Ms. Perry's lawyers smartly abandoned their trademark application on the 3D shark figurine, they also filed two trademark applications covering shark drawings seen from the front and the side (Figs. 2 and 3). Coincidentally, these applications were filed on February 9 – the day before the 3D shark figurine application was abandoned. It is likely that these drawings were made as part of the process of designing the shark costumes. The shark drawing applications claimed Ms. Perry's intent-to-use the mark on cell phone covers, stickers and all the same goods as the "Left Shark" word mark trademark application. The application also made a claim *for actual use in commerce* for the services of "live musical and dance performances" with a date of first use in commerce of February 1, 2015–the date of Ms. Perry's Superbowl performance.

As Left Shark has become a viral Internet meme, the keyboard commandos across the world were outraged by Ms. Perry's original attempt to obtain trademark rights to Left Shark and its likeness–it is the Internet who made Left Shark a star and the Internet demanded to own him, they claimed. The commandos were elated on April 15 when the trademark examiner rejected the trademark applications on the shark drawings. The rejections once again contained the minor formalities rejection that the phrase "Left Shark" had received. Since Ms. Perry had claimed actual use of the shark drawings for the services of "live musical and dance performances," however, the trademark examiner also rejected the marks arguing that they presumably do not function as a service mark and merely identify the design of a character. According to the examiner:

Registration is refused because the applied-for mark, *as used on the specimen of record*, identifies only a particular character; it does not function as a service mark to identify and distinguish applicant's services from those of others and to indicate the source of applicant's services. …A design of a character is registerable as a service

mark only where the record shows that it is used in a manner that would be perceived by consumers as identifying and distinguishing the services in addition to identifying the character. …In this case, *the specimen shows* the applied-for mark used only to identify a character and not as a service mark for applicant's services because the shark does not identify and distinguish applicant's musical and dance performances. (legal citations removed and emphasis added)

The commandos had won! Left Shark would forever be owned and nurtured by those that had created it–the Internet.

As with most things in the world of sharks, what appears above the water is unlikely to be the whole story. The rejection, while sounding quite resounding, is actually somewhat easy to be overcome. The main issue is that the application in its attempt to register the drawings for the particular services of "live musical and dance performances" included a specimen showing an alleged actual use of the mark in commerce–a photograph from the Super Bowl halftime show. (Fig. 4).

Fig. 4

The problem with *this particular specimen* showing an alleged use is that it does not show the use of the actual mark for which trademark protection is being sought–a drawing of a shark from either a front perspective or side perspective–on the "live musical and dance performances" services being claimed.

The Examiner is not saying that the shark drawings cannot ever be registered as trademarks for live music and dance performances, they are merely saying that the photograph submitted by Ms. Perry's lawyers does not show the claimed trademark being used in commerce. Although, Ms. Perry's lawyers could submit a replacement specimen showing the use of the drawings in conjunction with a live music and dance performance, it is just as likely that they could claim that the mark is intended-for-use and amend the application to indicate as such. Alternatively, the portion of the trademark application relating to actual use of the shark drawings in conjunction with the live music and dance performances could be stricken and the rest of the application covering cell phone covers, stickers, and the like can move forward.

Doug Sorocco

In the end, the Internet has not yet won against the prowess of Ms. Perry's lawyers in obtaining trademark protection for Left Shark–they've only won the first skirmish on a relatively minor point that can be corrected.

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